

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEPHEN NEUSHUL

Appeal No. 1997-2293
Application No. 08/089,311

ON BRIEF

Before KRASS, RUGGIERO and GROSS, Administrative Patent
Judges.

RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the final rejection
of claims 5 and 8 to 23. Claims 1 to 4, 6 and 7 have been
canceled. The claimed invention relates to a light box
scanner in which a scanner is coupled to the light box and

disposed within the light box housing to form a single integral unit. A transport mechanism moves a media image underneath a vertically mounted light source during scanning and returns the media image to a position where it can be viewed on the light box. Appellant asserts at page 1 of the specification that the vertical mounting of the light box scanner provides for viewing and scanning in the vertical plane providing only minimal contact between the media image and the light box scanner unit.

Claim 5 is illustrative of the invention and reads as follows:

5. A light box scanner to scan a media image stored on a media and to allow viewing the media image, said light box scanner comprising:

a scanner to scan the media image; and

an x-ray viewing light box coupled to the scanner, and arranged so that said scanner is disposed within a housing of said light box, said light box and said scanner forming a single, integral unit which allows viewing of the media image without touching or removing the media.

The Examiner relies on the following prior art references:

| | | |
|----------------------------|-----------|----------|
| Koshiyouji | 4,879,604 | Nov. 07, |
| 1989 | | |
| Johnston et al. (Johnston) | 5,241,406 | Aug. 31, |
| 1993 | | |

Appeal No. 1997-2293
Application No. 08/089,311

(Filed Jan. 18, 1990)

Appeal No. 1997-2293
Application No. 08/089,311

Claims 5 and 8 to 23 stand rejected under 35 U.S.C. § 103 as being unpatentable over either one of Johnston or Koshiyouji in view of the asserted well known prior art.¹

Rather than reiterate the arguments of the Appellant and the Examiner, reference is made to the Briefs² and Answers for the respective details.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the Examiner and the evidence of obviousness relied upon by the Examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellant's arguments set forth in the Briefs along with the Examiner's rationale in support of the rejection and arguments in rebuttal set forth

¹ This is a new ground of rejection set forth in the Examiner's Answer. In addition, in response to the Appellant's arguments in the Reply Brief, the Examiner withdrew a 35 U.S.C. § 112, first paragraph, rejection of the appealed claims.

² The original Appeal Brief was filed May 21, 1996. In response to the Examiner's Answer dated August 13, 1996 a Reply Brief was filed October 21, 1996 to which the Examiner responded with a Supplemental Examiner's Answer dated January 23, 1997.

Appeal No. 1997-2293
Application No. 08/089,311

in the Examiner's Answers.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 5 and 8 to 23. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole

Appeal No. 1997-2293
Application No. 08/089,311

or knowledge generally available to one having ordinary skill
in
the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044,
1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S.
825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories,
Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985),
cert.
denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v.
Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed.
Cir. 1984). These showings by the Examiner are an essential
part

Appeal No. 1997-2293
Application No. 08/089,311

of complying with the burden of presenting a prima facie case
of

obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24
USPQ2d

1443, 1444 (Fed. Cir. 1992).

Appellant's primary argument in the Briefs centers on the contention that neither of the Johnston and Koshiyouji references discloses a light box structure, let alone any teaching or suggestion of the formation of a light box and scanner into a single integral unit as claimed. After careful review of the applied prior art in light of the arguments of record, we are in agreement with Appellant's position as stated in the Briefs. We note that the relevant portion of each of the independent appealed claims 5, 13, and 18 recites:

an x-ray viewing light box coupled to the scanner, and arranged so that said scanner is disposed within a housing of said light box, said light box and said scanner forming a single, integral unit . . .

Our interpretation of the disclosures of Johnston and Koshiyouji coincides with that of the Appellant, i.e. these references, at most, suggest only a scanner light source and scanner mechanism mounted inside a housing. We are at a loss

Appeal No. 1997-2293
Application No. 08/089,311

as to what structure of Johnston or Koshiyouji could be construed to correspond to the claimed light box structure and we find no enlightenment on this issue from the Examiner's reasoning in the Answers.

Further, it is our view that, notwithstanding the merits of the Examiner's generalized assertion (Answer, page 5) that vertically mounted light boxes for viewing x-rays are well known in the art, such assertion does not address the issue of obviousness with respect to the specific limitations of the appealed claims. As discussed supra, we find no disclosure of any light box structure in Johnston or Koshiyouji. The Examiner has provided no indication as to how and where the skilled artisan might have found it obvious to modify either of Johnston or Koshiyouji to arrive at the particular light box and scanner arrangement of the claimed invention. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992). Since all of the claim limitations are not taught or suggested by the applied

Appeal No. 1997-2293
Application No. 08/089,311

prior art, it is our opinion that the Examiner has not established a prima facie case of obviousness with respect to the claims on appeal. Accordingly, we do not sustain the Examiner's 35 U.S.C. § 103 rejection of independent claims 5, 13, and 18, nor of claims 8 to 12, 14 to 17, and 19 to

Appeal No. 1997-2293
Application No. 08/089,311

23 dependent thereon. Therefore, the Examiner's decision
rejecting claims 5 and 8 to 23 is reversed.

REVERSED

| | | |
|-----------------------------|---|-----------------|
| |) | |
| ERROL A. KRASS |) |) |
| Administrative Patent Judge |) | |
| |) | |
| |) | |
| |) | BOARD OF PATENT |
| JOSEPH F. RUGGIERO |) | |
| Administrative Patent Judge |) | APPEALS AND |
| |) | |
| |) | INTERFERENCES |
| |) | |
| ANITA PELLMAN GROSS |) |) |
| Administrative Patent Judge |) | |

JFR:hh

Appeal No. 1997-2293
Application No. 08/089,311

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN
12400 Wilshire Boulevard, Seventh Floor
Los Angeles, CA 90025-1026