The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ISAMU TOBITA

Appeal No. 2005-1384
Application 09/886,200

ON BRIEF

Before THOMAS, SAADAT, and NAPPI, Administrative Patent Judges.

THOMAS, Administrative Patent Judge.

ON REQUEST FOR REHEARING

In a paper received by facsimile communication on September 21, 2005, Appellant requests that we rehear our decision dated August 23, 2005, wherein we affirmed all rejections of the claims on appeal under 35 U.S.C. § 103.

We have carefully reviewed our original opinion in light of appellant's request, but we find no point of law or fact which we overlooked or misapprehended in arriving at our original decision. Even in light of appellant's current arguments set forth in the Request for Rehearing, we find no error in the analysis or logic set forth in our original opinion.

With respect to appellant's first position under topic A at page 2 of the request, we reemphasize again our remarks at page 5 of our original opinion which affirmed the examiner's remarks at page 11 of the answer that appellant effectively was inviting us to limit the scope of meaning of the term "character set" by essentially urging us to read disclosed limitations thereof into the claims on appeal which are not specifically claimed. Contrary to the belief apparently set forth at the bottom of page 2 of the request, we did not misunderstand the disclosed meaning of the term "character set". Nor do we deny appellant's right to be his own lexicographer. Claims are to be given their broadest reasonable interpretation during prosecution, and the scope of a claim cannot be narrowed by reading disclosed limitations into the claim. See In re Morris, 127 F.3d 1048, 1054, 44 USPQ 1023, 1027 (Fed. Cir. 1997); In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989); In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550 (CCPA 1969). "[D]uring patent prosecution

when claims can be amended, ambiguities should be recognized, scope and breadth of language explored, and clarification imposed." In re Zletz, 893 F.2d at 321, 13 USPQ2d at 1322.

Next we treat appellant's urging that Kikuchi and Kobayashi do not teach or suggest the limitations of claims 8 and 9. We treated this third stated rejection of claims 7 through 9 rejected under 35 U.S.C. § 103 over these references at pages 11 through 14 of our prior opinion. In doing so, we expanded upon the examiner's rationale of combinablitiy and, contrary to the urging at page 3 of the Request for Rehearing, we did address the mode change capability in accordance with a number of dots that are arranged across the width of the lines forming an object image. A careful reading of the paragraph bridging pages 12 and 13 of our original opinion at least emphasizes this language from the claims.

Under topic C at page 4 of the Request for Rehearing appellant urges again that the combination of Kikuchi with Ohsawa would change the principle of operation of Kikuchi. This first stated rejection is discussed in detail in our prior opinion at pages 3 through 9. We simply did not agree with appellant's initial urging in the brief as to this argument in accordance

with the discussion in the paragraph of page 7 of our prior decision. There we considered the argument misplaced to the extent that appellant urged that the combination of these two references would have changed the operation of Kikuchi such that it would be unable to form its intended purpose. We viewed appellant's argument as arguing the structural combinablitiy of the references would have lead to the inoperablity of the Kikuchi reference. We did not and continue not to agree with a basic urging in appellant's views upon the noted court case at page 4 of the Request for Rehearing that substantial reconstruction and redesign would be necessary as well as changing the basic principle of operation. We stated at the bottom of page 6 in a summary manner that "Plainly, Ohsawa adds a capability to Kikuchi's teachings that is not readily recognized within its own content." We repeatedly emphasized this in a lengthy discussion since we considered the teachings of Ohsawa to add to the teachings of Kikuchi in an advantageously enhancing manner.

The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of a primary reference. It is also not that the claimed invention must be expressly suggested in any one or all of the

references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. In re Keller, 642 F.2d 414, 425, 208 USPQ 871, 881 (CCPA 1981); In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991).

Turning to topic D at page 5 of the Request for Rehearing, the focus of the reasoning here is the examiner's alleged failure to present a reasonable expectation of success of combining Kikuchi with the IBM disclosure bulletin. This is not the rejection the examiner set forth under the second stated rejection which we discussed at pages 9 through 11 of our prior decision. We affirmed the rejection alternatively in view of Kikuchi and Ohsawa or Kikuchi in view of Ohsawa, further in view of IBM. We considered IBM to be cumulative to what was already taught in the other two references. Appellant's arguments here did not question our own analysis on Request for Rehearing but only that of the examiner. Appellant's urging at page 15 of the principal brief on appeal makes no mention of Ohsawa as a reference which is a part of the rejection. Our extensive analysis from pages 3 through 11 in our prior decision relating to the combination of Kikuchi and Ohsawa plainly sets forth a

reasonable expectation of success when combining these two references. We explained in greater detail at pages 9 through 11 of our prior decision a pertinent feature of both references to the extent that they related to the argued features of claims 12 and 13 in the second stated rejection.

Lastly, under topic E at pages 5 and 6 of the Request for Rehearing, appellant wrongly urges again that examiner has not identified any source of motivation for combining the respective references. Again, the focus of the arguments is upon the examiner's alleged deficiencies rather than any argued deficiency with respect to our reasoning set forth in our prior opinion. Moreover, when viewed from a motivational perspective, our analysis in the prior decision greatly emphasizes the combinablitiy of Kikuchi with Ohsawa and optionally with the IBM Technical Disclosure Bulletin as well as Kikuchi with Kobayashi in the respective rejections.

At this point, it also deserves mention as stated at the top of page 3 of our earlier opinion, that we sustained the three separately stated rejections of the examiner "for the reasons set forth by the examiner as embellished upon here." Contrary to the view expressed at the bottom of page 6 of the Request for

Rehearing, appellant had the opportunity in the form of filing the brief and a reply brief to respond and assess the strength of the examiner's rejections. Moreover, a Request for Rehearing permits appellant to ask for rehearing of our prior decision. The evidence of unpatentablity of appellant's claims presented on appeal is based primarily upon the applied prior art and to a much lesser extent the examiner's arguments.

In view of the forgoing, appellant's Request for Rehearing is granted the extent that we have in fact reviewed our findings but is denied as to making any change therein.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

DENIED

JAMES D. THOMAS Administrative Patent Judge	)	
MAHSHID D. SAADAT Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
ROBERT E. NAPPI Administrative Patent Judge	)	

JDT:pgc

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