

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TSUYOSHI FUKUDA,
TATSUO KONNO, and TOSHIO MATSUMOTO

Appeal No. 1994-4024
Application No. 07/759,865

ON REQUEST FOR REHEARING

Before STONER, Chief Administrative Patent Judge, and CALVERT
and TORCZON, Administrative Patent Judges.

TORCZON, Administrative Patent Judge.

DECISION ON REHEARING UNDER 35 U.S.C. § 6(b)

The examiner has requested reconsideration (Paper No. 29) of the Board's decision on appeal (Paper No. 27) in which the rejection was reversed. Upon consideration of the request, the Appellant's response (Paper No. 30), and the administrative record of the application, rehearing is granted and the rejection of claims 1-18 is affirmed.

BACKGROUND

The appeal relates to a mount for attaching apparatus to a camera. In the examiner's answer, the examiner found that the sole difference between the admitted prior art lens mounts and the claimed subject matter was the limitation requiring

the lens mounts to be made of plastic (Paper No. 23 at 4).

The examiner relied on Doi, U.S. Patent No. 4,239,364 at 8-10 and 40-46 (16 Dec. 1980) for the suggestion to mold mounts from plastic to reduce the weight of the camera (Paper No. 23 at 4).

In the appeal, the claims stood or fell together, so the Board selected as the representative claim Appellant's claim 7:

A mount for an apparatus adapted to be attached to and detached from a mount of another apparatus, said mount for the apparatus being molded of plastic material, wherein:

a circumferential groove or projection is provided by molding on an abutment surface of said mount for the apparatus which comes into contact with said mount of said other apparatus.

(Paper 7 (Supp. Amdt.) at 2-3.) While Appellant's specification discloses a plastic camera mount with a circumferential groove to reduce defacement of the mount (Paper No. 1 at 7:6-23), the claim is directed to "A mount for an apparatus" and "a mount for another apparatus" without explicitly stating what each respective apparatus was. The examiner's answer offered no construction for claim 7 or any other claim.

In the decision, the Board concluded that the broadest reasonable interpretation in light of the specification was

that the first apparatus was a camera mount, while the second apparatus corresponded to the lens mount (Paper No. 27 at 4-5). The decision cautioned, however, that if claim 7 covered a plastic lens mount having a circumferential groove, then "the admitted prior art provides the teaching for a lens mount with such a groove" (Paper No. 27 at 5 n.3). The decision listed two reasons why the first apparatus had to be the camera:

(1) the mount for the first apparatus had to be made of plastic and only the camera mount was disclosed as being made of plastic; and

(2) the concave portion **3c** on the lens mount was not a circumferential groove.

On rehearing, the examiner offers a claim construction for the first time, including a basis in the specification for reading claim 7 more broadly (Paper No. 29 at 1):

Specifically, it is apparent that the Board overlooked the disclosure of a plastic lens mount at page 9, lines 7-10, of the specification.

The portion of the specification cited states (Paper No. 1 at 9:5-11):

It should be noted that though in the above described embodiments, the plastic mount has been used for the mount for [the] camera, the mounts of the photographic lens, [the] intermediate tube,

[the] extender, etc.[,] may be made to be plastic mounts according to the present invention. Even in these cases, there are similar advantages.

Appellant's response relies on the earlier finding that there is no circumferential groove on the claimed lens mount as sufficient to maintain the Board's construction (Paper No. 30 at 2-3). Appellant further argues that placing the groove on the lens mount would be a less practical solution to the problem the inventors faced.

DISCUSSION

The cited portion of Appellant's specification requires a broader claim construction. Not only does the passage disclose that the lens mount may be plastic, but it also provides that it be made "according to the present invention" such that "there are similar advantages" (Paper No. 1 at 9:9-11). Generally, the claims of a patent are not limited to the preferred embodiment, unless by their own language. Karlin Tech., Inc. v. Surgical Dynamics, Inc., 177 F.3d 968, 973, 50 USPQ2d 1465, 1469 (Fed. Cir. 1999). Thus, while a plastic camera mount with a circumferential groove is plainly the preferred embodiment, a plastic lens mount with the same groove is also disclosed. Nothing in the language of the claim excludes a plastic lens mount made according to the

Appellant's invention from being the first apparatus of the claim.

Under this broader construction, claim 7 reads on a camera using the admitted prior art lens mount with the concave portion **3c** (when the mount is made of plastic as Doi suggests) such that the claimed circumferential groove corresponds to the lens mount abutment surface **3b**.

Effect of new decision

Since this decision is, in effect, a new decision within the meaning of 37 CFR § 1.197(b), Appellant may file a request for rehearing under that same rule. Appellant should note that any request for an extension of time would be subject to the provisions of 37 CFR § 1.136(b).

DECISION

The rejection holding the subject matter of claims 1-18
to have been obvious in view of the admitted prior art and the
Doi patent is

AFFIRMED

BRUCE H. STONER, JR., Chief
Administrative Patent Judge

IAN A. CALVERT
Administrative Patent Judge

RICHARD TORCZON
Administrative Patent Judge

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