

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PETER G. BORDEN and JAMES B. STOLZ

Appeal No. 96-3969
Application No. 08/271,311¹

ON BRIEF

Before MARTIN, BARRETT and RUGGIERO, Administrative Patent Judges.

RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1, 3, 4, and 6-8, which constitute all the claims in the application. Claims 2 and 5 have been canceled.

The claimed invention relates to a method and a configuration for reducing stray light errors in a particle

¹ Application for patent filed July 6, 1994.

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monitor. A laser beam is passed through a monitoring region and a lens is positioned to collect scattered light.

Appellants state at page 4 of the specification that the lens is positioned so that the lens focus is centered on the laser beam permitting light to emerge from the lens as parallel rays. A filter is positioned at a preferential angle of incidence to produce maximum transmission of a selected laser beam wavelength at the preferred angle of incidence as illustrated in Figures 2 and 3 of the drawings.

Claim 1 is illustrative of the invention and reads as follows:

1. A method for reducing errors due to stray light in a particle monitor, said particle monitor detecting light scattered from a laser beam by particles, said method comprising:

positioning a lens in said particle monitor to collect said light scattered from said laser beam, said lens positioned such that a focus of said lens lies on said laser beam, so that said light scattered from said laser beam emerges from said lens as parallel rays;

positioning a filter to filter said parallel rays, said filter having a preferential angle of incidence, wherein said filter provides maximum transmission of a selected wavelength of said laser beam at said angle of incidence; and

positioning a detector to receive said filtered parallel rays.

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The Examiner relies on the following reference:

Rabl 4,074,939

Feb. 21, 1978

Claims 1, 3, 4, and 6-8 stand rejected under 35 U.S.C. §
103 as unpatentable over Rabl.

Rather than reiterate the arguments of Appellants and the
Examiner, reference is made to the Briefs² and Answer for the
respective details thereof.

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, Appellants'
arguments set forth in the Briefs along with the Examiner's
rationale in support of the rejection and arguments in
rebuttal

² The Appeal Brief was filed April 8, 1996. In response
to the Examiner's Answer dated July 23, 1996, a Reply Brief
was filed August 12, 1996 which was acknowledged and entered
by the Examiner without further comment on August 23, 1996.

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set forth in the Examiner's Answer. It is our view, after consideration of the record before us, that the collective 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 1, 3, 4, and 6-8. 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

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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 Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part 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).

With respect to independent claims 1 and 4, as the basis for the obviousness rejection, the Examiner has proposed to modify Rabl by substituting a laser source for Rabl's light source-monochromator combination, asserting the functional

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equivalence of the two sources. As correctly pointed out by the Examiner at page 4 of the Answer, Appellants have not questioned this proposed modification of the Rabl reference. Rather, Appellants' sole point of contention with respect to independent claims 1 and 4 centers on the recited "preferential angle of incidence" characteristic of the claimed filter. The relevant portion of claim 1 reads as follows:

positioning a filter to filter said parallel rays, said filter having a preferential angle of incidence, wherein said filter provides maximum transmission of a selected wavelength of said laser beam at said angle of incidence;

The Examiner contends that the description and Figure 1 illustration in Rabl of light entering the filter F_A at an angle of 90 degrees meets the claimed limitation since, in the Examiner's view, a preferential angle of incidence can be any angle including ninety degrees (Answer, page 4). In response, Appellants argue at page 10 of the Brief that the term "preferential" in the claimed context clearly connotes that a certain angle of incidence is chosen over other angles unlike Rabl whose description is silent as to the selection of the

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illustrated 90 degree angle of incidence. After careful review of the arguments of record and of the Rabl reference, we are in agreement with Appellants. It is axiomatic that, in proceedings before the PTO, claims in an application are to be given their broadest reasonable interpretation consistent with the specification, and that claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983). In our view, there is nothing in the disclosure of Rabl to support the interpretation that the illustrated 90 degree angle of incidence is a chosen or "preferred" angle of incidence. As to the Examiner's suggestion that even a filter which filters light the same for all angles would meet the claimed "preferential" angle feature, it is our view that such interpretation is clearly unwarranted in view of the accepted meaning of the term "preferential". We agree with Appellants that such a broad interpretation essentially nullifies any meaning attached to the term "preferential" which on its face must be interpreted to mean at the very least "one or some but not others." While we agree that the term "preferential" in

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the present context does not require a "narrow band" filter as the Examiner suggests that Appellants' arguments imply, it is quite clear that the term "preferential" requires something more than the 0 to 180 degree filter suggested by the Examiner.

Further, even assuming arguendo, that the 90 degree angle of incidence in Rabl could be considered a "preferential" angle, there is no disclosure in Rabl of the maximum transmission of a selected wavelength at the preferred angle, a feature in both of independent claims 1 and 4. The Examiner has cited a passage from Rabl (column 6, lines 42-45) as support for the position that this feature is met by Rabl. However, this excerpt from Rabl is concerned merely with a description of the cut-off of excitation light and the concomitant transmission of emission light and, in our view, falls well short of describing the claimed maximum transmission of a selected wavelength at a preferred angle of incidence.

In conclusion, with respect to independent claims 1 and 4, it is our opinion that the Examiner's factual findings are not supported by the record in this case, and the Examiner's

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rejection has failed to appropriately establish a prima facie case of obviousness. Since all the limitations of independent claims 1 and 4 are not suggested by the applied prior art, we cannot sustain the Examiner's rejection of appealed claims 3 and

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6-8 which depend therefrom, under 35 U.S.C. § 103.

Accordingly, the Examiner's rejection of claims 1, 3, 4, and
6-8 is reversed.

REVERSED

JOHN C. MARTIN)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
LEE E. BARRETT)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
JOSEPH F. RUGGIERO)	
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JENINE GILLIS

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Serial No. 08/271,311

Judge Ruggiero

Judge Barrett

Judge Martin

Received: 3/30/99

Typed: 3/30/99

DECISION: REVERSED

Send Reference(s): Yes No
or Translation(s)

Panel Change: Yes No

3-Person Conf. Yes No

Remanded: Yes No

Brief or Heard

Group Art Unit: 2878

Index Sheet-2901 Rejection(s):

Acts 2: _____

Palm: _____

Mailed:

Updated Monthly Disk (FOIA): _____

Updated Monthly Report: _____