

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CONRAD J. BELL

Appeal No. 97-0126
Application No. 08/314,749¹

ON BRIEF

Before BARRETT, KRASS, and RUGGIERO, Administrative Patent Judges.

RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-4, all of the claims pending in the present application. An amendment after final rejection was filed May 25, 1995 which was denied entry by the Examiner.

The claimed invention relates to a gradient index lens assembly formed of a plurality of lens arrays which are joined

¹ Application for patent filed September 29, 1994.

Appeal No. 97-0126
Application No. 08/314,749

We have carefully considered the subject matter on appeal, the rejections advanced by the Examiner and the evidence of obviousness relied upon by the Examiner as support for the rejections. 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 rejections and arguments in rebuttal 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 1-4. 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

Appeal No. 97-0126
Application No. 08/314,749

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
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.

Appeal No. 97-0126
Application No. 08/314,749

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 apparatus claims 1-3, the Examiner seeks to modify the lens arrangement of Yamanishi by suggesting the obviousness of staggering the disclosed lens array in the lengthwise direction. In the Examiner's view, it would be a matter of obvious design choice to do so since Appellant has not disclosed any purpose for such staggered configuration.

In response, Appellant (Reply Brief, page 2) challenges this basis for the Examiner's obvious design choice conclusion by referring to pages 1 and 6 of the specification which describes how the claimed staggered lens array assembly with optically stitched outputs enables the copying of extra wide documents. In addition, Appellant contends that Yamanishi discloses only a conventional single lens array arrangement with staggered rows of optical fibers and offers no

Appeal No. 97-0126
Application No. 08/314,749

suggestion to combine a plurality of lens arrays into a staggered assembly as claimed.

Upon careful review of Yamanishi, we are in agreement with both of the above arguments of Appellant. The Examiner's questioning of the purpose of Appellant's staggered lens assembly does not address the issue of obviousness. The conclusion that such arrangement is a matter of obvious design choice, as suggested by the Examiner, is not supported by any evidence of record. We further agree that the portion of the disclosure of Yamanishi relied on by the Examiner teaches only a single lens array with no suggestion that a plurality of such arrays could be coupled together, let alone in the staggered configuration as claimed. Although not mentioned by the Examiner, we do note that the embodiment illustrated in Figure 14 of Yamanishi has an assembly of two lens arrays. As evident from the Figure 14 illustration and accompanying disclosure, however, the assembled arrays are in a side-by-side configuration instead of staggered end-to-end as claimed.

With respect to method claim 4, we note that the Examiner has never addressed the limitations contained in the recited

Appeal No. 97-0126
Application No. 08/314,749

method steps. The Examiner's sole basis for the rejection of this claim appears to be a reference to a portion of Yamanishi which relates to a method of reading a document image and not to an assembling method for a lens as claimed. Since the Examiner has not addressed the particulars of this claim, we are constrained, on the record before us, to agree with Appellant's contention that none of the claimed method steps of forming a lens array assembly are taught or suggested by Yamanishi.

Since it is our opinion, for at least the reasons discussed above, that the Examiner has failed to establish a prima facie case of obviousness with respect to claims 1-4 we can not sustain the Examiner's 35 U.S.C. § 103 rejection of claims 1-4. Accordingly, the Examiner's decision rejecting claims 1-4 is reversed.

REVERSED

ERROL A. KRASS)
Administrative Patent Judge)
)
)
)
)
) BOARD OF PATENT
LEE E. BARRETT) APPEALS

Leticia

Appeal No. 97-0126
Application No. 08/314,749

APJ RUGGIERO

APJ KRASS

APJ BARRETT

DECISION: REVERSED
Send Reference(s): Yes No
or Translation (s)
Panel Change: Yes No
Index Sheet-2901 Rejection(s): _____

Prepared: February 10, 2000

Draft Final

3 MEM. CONF. Y N

OB/HD GAU

PALM / ACTS 2 / BOOK
DISK (FOIA) / REPORT