

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD W. HARRISON
and JOHN F. SCARZELLO

Appeal No. 95-4662
Application 08/048,101¹

ON BRIEF

Before THOMAS, FLEMING and CARMICHAEL, Administrative Patent Judges.

CARMICHAEL, Administrative Patent Judge.

ON REQUEST FOR REHEARING

This is a decision on a request for rehearing filed July 23, 1998 (Paper No. 26), of our Decision dated July 14, 1998 (Paper No. 25). Appellants argue that: (1) our decision is confusingly characterized as an amplification of the examiner's reasons whereas in fact the opinion is inconsistent with the examiner's reasoning and presents

¹ Application for patent filed April 16, 1993.

a new ground of rejection; and (2) claim 10 requires that transmitted signals be limited to radiation emitted within and propagated through the water.

(1) Consistency with the examiner's reasoning

Our decision began by saying “[w]e affirm for the reasons given by the examiner, amplified as follows.” Decision at 2. By the phrase “[w]e affirm for the reasons given by the examiner” we meant that we agree with the examiner’s rationale as stated in the examiner’s Answer. We adhere to that view. That is, we still agree that the combination of teachings from multiple references as explained by the examiner would have rendered the claimed subject matter obvious to one of ordinary skill in the art.

By the phrase “amplified as follows” we meant that affirmance of the examiner’s rejection was further supported as set forth in the Decision. In particular, we found that “the subject matter of claim 10 would have been obvious from Kirkland, with or without the additional references cited.” Decision at 4. This is consistent with the examiner’s rationale which states:

Appellants argue that the prior art differs from the present invention in that the prior art transmits electromagnetic energy through air as well as through a body of electrically conductive liquid, e.g. sea water. Namely it is argued that the primary references to Kirkland (‘822) and to Shostak (‘520) show transmission of electromagnetic energy through air and sea water. Examiner is in agreement with this point but fails to see how the present claim language precludes the prior art rendering it obvious. The references do show transmission of electromagnetic energy into sea water for the purpose of detecting a submerged object. This is the teaching relied upon.

Examiner's Answer at 4, lines 2-12. We are in harmony with the examiner's position that although Kirkland shows some transmission through air and some through water, the present claim language does not preclude obviousness since Kirkland shows transmission via sea water as claimed.

Relying on Kirkland alone does not constitute a new ground of rejection. In affirming a multiple reference rejection under 35 U.S.C. § 103, the Board may rely on one of the one references alone in an obviousness rationale without designating it as a new ground of rejection. *In re Bush*, 296 F.2d 491, 496, 131 USPQ 263, 266-67 (CCPA 1961); *In re Boyer*, 363 F.2d 455, 458 n.2, 150 USPQ 441, 444 n.2 (CCPA 1966). Thus, our decision did not include a new ground of rejection.

(2) Scope of Claim 10

Appellants argue in their Request that claim 10 requires that transmitted signals be limited to radiation emitted within and propagated through the water. We disagree.

Claims undergoing examination are given their broadest reasonable interpretation consistent with the specification. *In re Donaldson*, 16 F.3d 1189, 1194, 29 USPQ2d 1845, 1850 (Fed. Cir. 1994) (in banc).

In the present case, Claim 10 recites processing means “for comparing differences in analyses of the transmitted signals.” Appellant’s argument proceeds as if the recited function were comparing differences in only the water-transmitted signals. Request at 2. However, Claim 10 is not limited to using only the water-transmitted signals. Claim 10 broadly refers to differences in “analyses” of the water-transmitted signals. The “analyses” are not necessarily informed only by the water-transmitted signals.

Kirkland discloses the same means as Appellants for performing the recited function of “comparing differences in analyses of the transmitted signals.” Kirkland’s processing means compares differences in analyses of signals transmitted from transmitter T through water W to receiver R at different times. Column 4, lines 29-40. Kirkland’s analyses of the water-transmitted signals involve the phase relationship between the water-transmitted signals and the air-transmitted signals, but such analysis is not precluded by the claims on appeal.

CONCLUSION

We have thoroughly reconsidered the appeal in light of the entire record including the present Request. The modification sought by Appellants is denied.

Appeal No. 95-4662
Application 08/048,101

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

DENIED

JAMES D. THOMAS)
Administrative Patent Judge)
)
)
) BOARD OF PATENT
MICHAEL R. FLEMING)
Administrative Patent Judge) APPEALS AND
)
) INTERFERENCES
)
JAMES T. CARMICHAEL)
Administrative Patent Judge)

Appeal No. 95-4662
Application 08/048,101

OFFICE OF COUNSEL, CODE 004
NAVAL SURFACE WARFARE CENTER
CARDEROCK DIVISION
9500 MACARTHUR BOULEVARD
BETHESDA, MD 20817-5700