The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID NOWAK

Appeal No. 2001-1795
Application 08/825,196

ON BRIEF

Before JERRY SMITH, RUGGIERO and BARRY, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-19, which constitute all the claims in the application.

The disclosed invention pertains to an ocular mounting assembly for adjustably mounting a pair of ocular devices such as telemicroscopic loupes to an eyeglass frame or headband with linear and rotational adjustments. A particular feature of the

invention is that the convergence angle of the ocular devices is fixed as a function of working distance which provides a highly stable configuration, resistant to vibration or impact and misadjustment during use.

Representative claim 1 is reproduced as follows:

1. An ocular mounting assembly, comprising:

an ocular support assembly providing interpupillary distance adjustment for a pair of ocular devices attached to the support assembly, each ocular device being initially rotatable with respect to the support assembly at respective regions of rotation, the relative rotation between the pair of oculars establishing a convergence angle;

means for independently and permanently preventing the rotation of each ocular with respect to the support assembly at respective regions of rotation once a desired convergence angle has been achieved; and

an adjustable clamp assembly rotatably attached to the ocular support assembly providing height and view angle adjustment of the ocular devices and allowing the ocular devices to be flipped up out of the way when not needed.

The examiner relies on the following references:

Frantz et al. (Frantz)	3,597,041	Aug. 03, 1971
Burbo et al. (Burbo)	4,449,787	May 22, 1984
Moore	4,818,086	Apr. 04, 1989
Vansaghi	4,834,525	May 30, 1989
Funathu	5,062,698	Nov. 05, 1991
Thomanek	5,179,735	Jan. 19, 1993
Buechler	5,372,504	Dec. 13, 1994

The admitted prior art described in appellant’s specification.

The following rejections are on appeal before us:

1. Claims 1, 15, 18 and 19 stand rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of Burbo in view of Vansaghi and Funathu.

2. Claims 2 and 4 stand rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of Burbo in view of Vansaghi and Funathu, and further in view of the admitted prior art.

3. Claims 3, 16 and 17 stand rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of Burbo in view of Vansaghi and Funathu, and further in view of the admitted prior art and Frantz.

4. Claim 5 stands rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of Burbo in view of Vansaghi and Funathu, and further in view of Moore.

5. Claim 10 stands rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of Burbo in view of the admitted prior art, Vansaghi and Frantz.

6. Claim 11 stands rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of Burbo in view of the admitted prior art, Vansaghi and Frantz, and further in view of Moore.

7. Claims 12-14 stand rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of Burbo in view of the admitted prior art, Vansaghi and Frantz, and further in view of Thomanek and Buechler.

The rejections of the claims under the first paragraph of 35 U.S.C. § 112 and on double patenting have been withdrawn by the examiner [answer, page 3].

Rather than repeat the arguments of appellant or the examiner, we make reference to the brief and the answer for the respective details thereof.

OPINION

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, the appellant's arguments set forth in the brief 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 evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in

the art the obviousness of the invention as set forth in claims 10-14. We reach the opposite conclusion with respect to claims 1-9 and 15-19. Accordingly, we affirm-in-part.

Even though the examiner has applied seven different groupings of references to reject all the claims on appeal, appellant has, nevertheless, indicated that the claims should stand or fall together in only three groups. Specifically, appellant has indicated that claims 1-9 stand or fall together as a first group, claims 10-14 stand or fall together as a second group, and claims 15-19 stand or fall together as a third group [brief, page 4]. Since appellant has not argued each of the rejections independently, we will consider the rejections against claims 1, 10 and 15 as representative of all the claims on appeal. Note In re King, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986); In re Sernaker, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983).

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 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. 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). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d

1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered and are deemed to be waived by appellant [see 37 CFR § 1.192(a)].

With respect to representative, independent claim 1, the examiner indicates how he finds the invention of claim 1 to be obvious [answer, pages 4-6]. Specifically, the examiner finds that Burbo teaches the claimed invention except for the means for independently and permanently preventing the rotation of each ocular with respect to the support assembly at respective regions of rotation once a desired convergence angle has been achieved. The examiner notes that the intermediate stage of the apparatus as claimed such as each ocular device being initially rotatable with respect to the support assembly is not given any patentable weight. The examiner cites Funathu as teaching a means for independently and permanently preventing the rotation of each ocular. The examiner cites Vansaghi as teaching that it was well known to establish a convergence angle to provide a desired working distance for the binocular. The examiner finds that it would have been obvious to the artisan to provide these features of Funathu and Vansaghi to the ocular support assembly of Burbo.

Appellant argues that claim 1 recites a "means for independently and permanently preventing the rotation of each ocular with respect to the support assembly at respective regions of rotation once a desired convergence angle has been achieved" which is written in means-plus-function form. Appellant argues that the examiner has failed to consider appellant's specification to determine what corresponds to the claimed means. Appellant argues that neither Burbo nor Funathu discloses the feature of fixing a convergence angle as a function of working distance. Appellant also argues that there is no motivation for combining the teachings of Burbo and Funathu. Finally, appellant argues that Vansaghi does not teach an apparatus which begins with a variable convergence angle which is then fixed into place through a permanent means.

The examiner responds by essentially repeating the rejection of claim 1 [answer, pages 14-16].

We will not sustain the examiner's rejection of claim 1 because the rejection fails to establish a prima facie case of obviousness. The rejection states that the limitation that "each ocular device being initially rotatable with respect to the support assembly at respective regions of rotation, the relative rotation between the pair of oculars establishing a convergence

angle" was given no patentable weight. It was error for the examiner to fail to consider this limitation of the claimed invention. All limitations of a claimed invention must be considered when making prior art rejections. Not only does the rejection fail to consider the claimed invention as a whole, but the rejection also fails to evaluate the claimed means as required by the sixth paragraph of 35 U.S.C. § 112. The examiner has not identified the disclosed structure which corresponds to the claimed means nor explained how or why this structure would have been obvious over the teachings of the applied prior art. We agree with appellant that there has been no showing that the applied prior art teaches a pair of oculars which are initially adjustable but are then permanently fixed in place as a function of a desired working distance and convergence angle. With respect to dependent claims 2-9, we note that the additionally applied references do not overcome the deficiencies discussed above. Therefore, we do not sustain the rejection of claims 1-9.

With respect to representative, independent claim 10, the examiner's rejection is set forth on pages 9-11 of the answer. Appellant argues that the claimed limitation of ocular support arms and other structural elements defining a preset convergence angle as a function of working distance does not appear in any of

the cited references and that appellant can see no justification for the examiner's proposed combination. Appellant asserts that the examiner is simply picking and choosing different structural elements from unrelated prior art references [brief, pages 8-9]. The examiner responds that Vansaghi clearly teaches the feature of a preset convergence angle as a function of working distance [answer, page 16].

We will sustain the rejection of claims 10-14. We agree with the examiner that Vansaghi teaches that the relationship between convergence angles and working distances was well known to the artisan. Thus, we find that it would have been obvious to the artisan to have ocular support arms which define preset convergence angles as a function of working distance as claimed. Appellant's argument that he finds no justification for the examiner's proposed combination of references is not persuasive of error in the rejection. Appellant has offered no analysis of why the proposed combination is not justified other than a bare assertion. The examiner's rejection explains why the references have been combined in a sufficient manner to establish a prima facie case of obviousness. Appellant's arguments fail to rebut this rejection with any persuasive arguments.

With respect to representative, independent claim 15, the examiner included this claim with the rejection of claim 1. Appellant argues that neither Burbo, Vansaghi nor Funathu teaches the step of determining a preferred convergence angle as a function of working distance, and permanently fixing the ocular devices to the preferred convergence angle as claimed [brief, pages 9-10]. The examiner responds that the claimed method limitations are essentially inherent functional teachings of the applied prior art. The examiner also finds that Vansaghi teaches the argued limitations of claim 15 [answer, pages 16-17].

We will not sustain the rejection of claims 15-19. Although Vansaghi does teach the relationship between a preferred convergence angle and a working distance, the applied prior art does not teach the step of permanently fixing the ocular devices to the preferred convergence angle after the preferred convergence angle has been determined through adjustment. The applied prior art appears to leave the convergence angle always adjustable so that the working distance can be modified for other uses.

In summary, we have sustained the examiner's rejection with respect to claims 10-14, but we have not sustained the rejection with respect to claims 1-9 and 15-19. Therefore, the decision of the examiner rejecting claims 1-19 is affirmed-in-part.

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

AFFIRMED-IN-PART

JERRY SMITH Administrative Patent Judge	)	
JOSEPH F. RUGGIERO Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
LANCE LEONARD BARRY Administrative Patent Judge	)	

JS/ki

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