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Lempia Summerfield Katz LLC 20 South Clark Suite 600 CHICAGO, IL 60603			COOK, CHRISTOPHER L	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte FRANZ FADLER and OLIVER HORNUNG

Appeal 2019-002514
Application 12/877,649
Technology Center 3700

Before EDWARD A. BROWN, BRETT C. MARTIN, and
MICHELLE R. OSINSKI, *Administrative Patent Judges*.

MARTIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant,¹ Franz Fadler et al.,
appeals from the Examiner's decision to reject claims 1, 3–6, and 8–20.
Claims 2 and 7 were cancelled during prosecution. App. Br. 12–13. We
have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

¹ We use the word “Appellant” to refer to “applicant” as defined in 37
C.F.R. § 1.42(a). Appellant identifies the real party in interest as Siemens
Aktiengesellschaft. App. Br. 2.

CLAIMED SUBJECT MATTER

The claims are directed “to an apparatus for medical examinations.”
Spec. ¶ 2. Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. An apparatus for medical examinations, the apparatus comprising:
 - a first arm rotatably attached to a stand, the first arm including a cylindrical body at a first end of the first arm, the cylindrical body having a center and a side wall, the first arm being rotatably attached to the stand so that the first arm, with the cylindrical body, is rotatable about an axis that extends through the center of the body and an area for examining a patient, such that the first arm is not rotatable relative to the body, the first arm being configured to carry one of a radiation source and a radiation detector; and
 - a second arm that is rotatable about the axis, the second arm being movably disposed on an outer surface of the side wall of the body and being translatable along the side wall, such that when the second arm translates along the side wall, the second arm rotates about the axis relative to the body, the second arm extending away from the outer surface of the side wall to an arm section configured to carry the other of the radiation source and the radiation detector, the area for examining the patient being disposed between the radiation source and the radiation detector.

REFERENCES

The prior art relied upon by the Examiner is:

Lieutaud	US 4,979,196	Dec 18, 1990
Yamakawa	US 6,373,060 B1	Apr. 16, 2002
Crain	US 6,637,936 B2	Oct. 28, 2003

REJECTIONS

Claims 1, 3–6, 10–13, and 17–20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Crain and Yamakawa. Non-Final Act. 3.

Claims 8, 9, 11, 14–16, and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Crain, Yamakawa, and Applicant’s Admission of the prior art. Non-Final Act. 7.

Claims 1, 3–6, 10–13, and 17–20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Crain, Yamakawa, and Lieutaud. Non-Final Act. 8.

Claims 8, 9, 11, 14–16, and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Crain, Yamakawa, Lieutaud, and Appellant’s Admission of the prior art. Non-Final Act. 10.

Claims 1, 3–6, and 8–20 are provisionally rejected on the ground of nonstatutory double patenting as being unpatentable over claims 21–36 of copending Application No. 15/175,028. Non-Final Act. 13.

OPINION

Obviousness

The Examiner finds that Craig discloses a first arm 18, a second arm 20, and a base 22. Non-Final Act. 3, 4 (Examiner’s annotated Craig Fig. 4). Appellant argues, *inter alia*, that the combination of Crain and Yamakawa “would not teach or disclose one of the robot arms 18, 20 being movably disposed on an outer surface of a side wall of a cylindrical body of the other of the robot arms 18, 20, as required by claim 1.” Reply Br. 4. As Appellant points out, “base 22 is not part of either of the robot arms 18, 20.” *Id.* The Examiner proposes moving arms 18, 20 from the top surface of base

22 to the perimeter, as well as changing the connection from an articulating joint as in Crain to a sliding joint as in Yamakawa. *See, e.g.*, Ans. 11. In this fashion, both arms 18, 20 would then rotate around the base, which would allow for a variety of arm configurations.

The problem with the Examiner's modification is that claim 1 requires one of the arms to be "movably disposed on an outer surface of the side wall of the body" and "translatable along the side wall" of the first arm. As shown in Appellant's drawings, cylindrical body 3 is part of, for example, first arm 1. *See* Fig. 3. This construction allows the second arm to rotate around body 3 to change its position relative to first arm 1. The Examiner's combination, however, makes both arms movable with regard to a completely separate base 22. In this manner, neither arm is part of the base and so rather than one arm moving with regard to the other arm and its affixed base, both arms may move separately relative to each other and to the base. Even if this modified structure may somehow be an improvement over Appellant's claimed device to the extent it may allow for even more flexibility in positioning around the base, it does not meet the claim language at issue. All of the obviousness rejections rely on this same error and so we do not sustain any of the four obviousness rejections for the same reason.

Double Patenting

The Examiner provisionally rejected all of the pending claims on the basis of nonstatutory double patenting in view of claims 21–36 of copending Application No. 15/175,028. Final Act. 13. Appellant does not contest this rejection. Because this rejection is provisional, we decline to reach it. We leave it to the Examiner to determine at the time when any claims of this

application are otherwise in condition for allowance whether the obviousness-type double patenting rejection remains proper. *See Ex parte Moncla*, 95 USPQ2d 1884 (BPAI 2010) (precedential). The Manual of Patent Examining Procedure (MPEP) § 804(I)(B)(1)(b) (9th ed., January 2018 [R-08.2017]) provides guidance to examiners as to the handling of provisional nonstatutory double patenting rejections.

DECISION

The Examiner's obviousness rejections are REVERSED and we do not reach the double patenting rejection.

DECISION SUMMARY

Claims Rejected	Basis	Affirmed	Reversed
1, 3-6, 10-13, 17-20	§ 103 Crain and Yamakawa		1, 3-6, 10-13, 7-20
8, 9, 11, 14-16, 20	§ 103 Crain, Yamakawa, and Applicant's Admission of the prior art		8, 9, 11, 14-16, 20
1, 3-6, 10-13, 17-20	§ 103 Crain, Yamakawa, and Liuteaud		1, 3-6, 10-13, 17-20
8, 9, 11, 14-16, 20	§ 103 Crain, Yamakawa, Lieutaud, and Applicant's Admission of the prior art		8, 9, 11, 14-16, 20
1, 3-6, 8-20	Provisional nonstatutory double patenting over Application No. 15/175,028		
Overall Outcome			1, 3-6, 8-20

REVERSED