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| 15/175,028  | 06/06/2016  | Franz Fadler         | 11371-10469B        | 7493             |
| 58898   | 7590        | 07/01/2020           | EXAMINER            |                  |
| Lempia Summerfield Katz LLC<br>20 South Clark<br>Suite 600<br>CHICAGO, IL 60603 |             |                      | COOK, CHRISTOPHER L |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* FRANZ FADLER and OLIVER HORNUNG

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Appeal 2019-003632  
Application 15/175,028  
Technology Center 3700

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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,<sup>1</sup> Franz Fadler et al.,  
appeals from the Examiner’s decision to reject claims 21–36. We have  
jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

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<sup>1</sup> 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  
Healthcare GMBH. Appeal Br. 2.

### CLAIMED SUBJECT MATTER

The claims are directed “to an apparatus for medical examinations.”

Spec. ¶ 2. Claim 21, reproduced below, is illustrative of the claimed subject matter:

21. An apparatus for medical examinations, the apparatus comprising:

a first arm rotatable about an axis, a first component being disposed on an end of the first arm, the first component being one of a radiation detector and a radiation source;

a second arm rotatable about the same axis, the second arm carrying a second component on an end of the second arm, the second component being the other of the radiation source and the radiation detector,

wherein the apparatus further includes, as another end of the first arm, a rotatable solid body, or the other end of the first arm is rigidly secured to a side wall of the rotatable solid body,

wherein one end of the second arm is movably disposed on the side wall of the rotatable solid body and is positionable along an outer surface of the side wall of the rotatable solid body, such that when the second arm moves along the side wall of the rotatable solid body, the second arm rotates about the axis, relative to the rotatable solid 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,

wherein the rotatable solid body is configured to receive a component for high-voltage conversion,

wherein the rotatable solid body is configured to receive at least one component for transmitting energy, data, or energy and data between a static part of the apparatus and a rotatable part of the apparatus, for furnishing coolant, or a combination thereof, the component for transmitting energy, data, or energy and data comprising at least one slip ring.

REFERENCES

The prior art relied upon by the Examiner is:

| <b>Name</b> | <b>Reference</b> | <b>Date</b>   |
|-------------|------------------|---------------|
| 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 21–36 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Crain, Yamakawa, and Appellant’s admitted prior art. Non-Final Act. 3.

Claims 21–36 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Crain, Yamakawa, Lieutaud, and Appellant’s admitted prior art. Non-Final Act. 7.

Claims 21–36 are provisionally rejected on the ground of nonstatutory double patenting as being unpatentable over claims 1, 3–6, and 8–20 of copending Application No. 12/877,649. Non-Final Act. 11.

## OPINION

### *Obviousness*

The Examiner finds that Crain discloses a first arm 18, a second arm 20, and a base 22. Non-Final Act. 3, 4 (Examiner’s annotated Crain Fig. 4). Appellant argues, *inter alia*, that the combination of Crain and Yamakawa fails to teach “the second arm, which extends away from an outer surface of a side wall of a rotatable solid body of a first arm, being movably disposed on the outer surface of the side wall of the rotatable solid body and being positionable along the side wall, such that when the second arm moves along the side wall of the rotatable solid body, the second arm rotates about the axis, relative to the rotatable solid body, as required by independent claim 21.” Appeal Br. 4, 5. As Appellant points out, Crain’s “articulated robot arms 18 and 20, however, extend away from a face of the base 22, not, away from an outer surface of a side wall of the base 22, as required by independent claim 21” *Id.* at 6. 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 deficiency in the Examiner's proposed modification is that claim 21 requires one of the arms to be "movably disposed on the side wall of the rotatable solid body" of a first arm and "positionable along an outer surface of the side wall of the rotatable solid body." 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. Consequently, 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 might be an improvement over Appellant's claimed device to the extent the modified structure might allow for even more flexibility in positioning around the base, the proposed combination 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. 12/877,649. Non-Final Act. 9. 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).<sup>2</sup>

### DECISION

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

### DECISION SUMMARY

| <b>Claims Rejected</b> | <b>Reference(s)/Basis</b>   | <b>Affirmed</b> | <b>Reversed</b> |
|------------------------|---|-----------------|-----------------|
| 21-36                  | § 103 Crain, Yamakawa, and Appellant's admitted prior art           |                 | 21-36           |
| 21-36                  | § 103 Crain, Yamakawa, Lieutaud, and Appellant's admitted prior art |                 | 21-36           |
| 21-36                  | Provisional nonstatutory double patenting <sup>3</sup>              |                 |                 |
| <b>Overall Outcome</b> |   |                 | 21-36           |

### REVERSED

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<sup>2</sup> MPEP § 804(I)(B)(1)(b) (9th ed., January 2018 [R-08.2017]) provides guidance as to the handling of provisional nonstatutory double patenting rejections.

<sup>3</sup> As explained above, we do not reach this rejection per *Ex parte Moncla*.