

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 23

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

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Ex parte ERIC C. NEIDERMAN and JAMES L. FOBES

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Appeal No. 2002-1064  
Application No. 09/126,385

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ON BRIEF

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Before McQUADE, NASE, and BAHR, Administrative Patent Judges.  
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 8 and 10 to 25. Claims 9 and 26, the only other claims pending in this application, have been objected to as depending from a non-allowed claim.

We AFFIRM.

### BACKGROUND

The appellants' invention relates to a computer-implemented means for projecting the simulated image of contraband or other images on a baggage screening monitor (specification, p. 2). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

Claim 10 stands rejected under 35 U.S.C. § 112, first paragraph.

Claims 1 to 8 and 10 to 25 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,243,693 to Maron.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (Paper No. 22, mailed November 6, 2001) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 17, filed February 5, 2001) and supplemental brief (Paper No. 21, filed July 19, 2001) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art reference to Maron, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

**The rejection under 35 U.S.C. § 112**

We will not sustain the rejection of claim 10 under 35 U.S.C. § 112, first paragraph.

Claim 10 reads as follows:

In a baggage screening system including a monitor the improvement which comprises means for intentionally causing said monitor to show images of simulated items in selected items of baggage being screened.

The examiner states (answer, p. ) that claim 10 is rejected

because the specification, while being enabling for a baggage screening monitor which shows images of simulated items, does not reasonably provide enablement for "means for intentionally causing" said monitor to show said images. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims [sic, this claim].

The single means claim which covers every conceivable means for achieving the stated purpose of intentionally causing said monitor to show images of simulated items is held non-enabling for the scope of the claim

because the specification disclosed at most only those means known to the inventor. *In re Hyatt*, 708 F.2d 712, 714-715, 218 USPQ 195, 197 (Fed. Cir. 1983).

We agree with the appellants' argument (supplemental brief, p. 1) that the reasoning for an enablement rejection set forth in Hyatt is not applicable to claim 10 since claim 10 is not a single means claim. Claim 10 is a combination claim; the combination being "a baggage screening system including a monitor" and "means for intentionally causing said monitor to show images of simulated items in selected items of baggage being screened."

Furthermore, we note that the examiner's position (answer, pp. 6-7) that the above-noted means-plus-function clause "covers any conceivable means for achieving the stated purpose" is legally incorrect. As stated in 35 U.S.C. § 112, paragraph 6, and explained in In re Donaldson, 16 F.3d 1189, 1193, 29 USPQ2d 1845, 1848-49 (Fed. Cir. 1994), an element of a claim expressed in means-plus-function format is construed to cover only the corresponding structure, material, or acts described in the specification and equivalents thereof.

For the reasons set forth above, claim 10 is not a single means claim nor is it tantamount to a single means claim. In our view, claim 10 complies with the enablement requirement of 35 U.S.C. § 112, first paragraph.<sup>1</sup> Accordingly, the decision of the examiner to reject claim 10 under 35 U.S.C. § 112, first paragraph, is reversed.

### **The anticipation rejection**

We sustain the rejection of claims 1 to 8 and 10 to 25 under 35 U.S.C. § 102(b).

In the Grouping of claims section of the brief (p. 2), the appellants stated that "[t]he claims are in three groups: group 1, means claims 1-8 and 10-18; group 2, method claims 19-25; and group 3, claims 9 and 26. Groups 1 and 2 stand or fall together." We have selected claim 19 as the representative claim from the appellants' grouping of groups 1 and 2 together (i.e., claims 1 to 8 and 10 to 25) to decide the appeal on the rejection under 35 U.S.C. § 102(b).<sup>2</sup> Accordingly, claims 1 to 8, 10 to 18 and 20 to 25 will stand or fall with claim 19.

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<sup>1</sup> The test for enablement is whether one skilled in the art could make and use the claimed invention from the disclosure coupled with information known in the art without undue experimentation. See United States v. Telectronics, Inc., 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988), cert. denied, 109 S.Ct. 1954 (1989); In re Stephens, 529 F.2d 1343, 1345, 188 USPQ 659, 661 (CCPA 1976).

<sup>2</sup> See In re Young, 927 F.2d 588, 590, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991); In re Wood, 582 F.2d 638, 642, 199 USPQ 137, 140 (CCPA 1978); and 37 CFR § 1.192(c)(7) and (8)(iv).

Claim 19 reads as follows:

The method of training baggage screening system operators which comprises providing a baggage screening system including a monitor and further providing means for projecting simulated images of contraband onto said monitor.

Maron discloses a system for simulating X-ray scanners. Maron's system includes a first memory for storing a database of component X-ray images, a second memory for storing an instruction set and respective relative opacities of the stored component images, and a computer coupled to the first and second memories and responsive to the stored instruction set for creating composite X-ray images from the stored component images. A display is coupled to the computer for displaying at least one of the composite X-ray images as a displayed image. A data entry keyboard is coupled to the computer to permit data to be entered thereto in accordance with the stored instruction set. A selection device is coupled to the computer for comparing the selected component image with a subset of the stored component images representing hazardous objects so as to determine whether the selected component image matches one of the component images in the subset. The system further includes a reporting device coupled to the computer for reporting whether a match occurred.

Maron teaches (column 2, line 56, to column 3, line 29) that

when used for airport security systems, a system according to the invention includes a computer containing a database of component images corresponding, generally, to non-hazardous "background" images and hazardous "foreground" images. In one mode, the computer may be programmed to combine various of the background and foreground images so as to produce a prearranged lesson in which the hiding of dangerous firearms and the like in a passenger's luggage may be simulated. The simulated image is then presented on a suitable display terminal and a student employs the selection means in order to identify a component image which he believes to represent a hazardous item.

Preferably, standard X-ray scanner functions are provided such as, for example, displaying many images on the display terminal simultaneously, stopping and re-starting a conveyer belt on which passenger luggage is conveyed so as to permit close scrutiny of a particular piece of luggage, and so on.

Preferably, the computer may also identify a hazardous piece of luggage so that novice students may learn to identify their contour when concealed amongst other luggage. Furthermore, a printer connected to the computer facilitates the preparation of printed reports which summarize a student's performance during the simulation.

The method for simulating the moving image is particularly adapted for use with the simulated X-ray scanner according to the invention which simulates the movement of passenger luggage along a conveyer belt. The method requires that only a single frame of image data be stored derived from a still X-ray photograph of the piece of luggage which is to be displayed. The single frame of image data is segmented so as to provide a plurality of consecutive image segments which are then shifted along corresponding segments of a display terminal at a sufficiently high rate to produce the impression of continuous, flicker-free movement. Such a method requires the provision of relatively little computer memory for storing each image and avoids the need for time-consuming image digitization which is required in prior art animation techniques.

Maron further provides (column 8, lines 10-15) that "the system is intended for coupling to actual X-ray scanners in order to enhance the effectiveness of such scanners during their normal operation. Such coupling is achieved by connecting the video output of the X-ray scanner to the video input of the simulator."

In our view, claim 19 is anticipated<sup>3</sup> by Maron when Maron's system for simulating X-ray scanners is coupled to an actual X-ray scanner as taught by Maron in order to enhance the effectiveness of such actual X-ray scanners during their normal operation. Claim 19 is readable on<sup>4</sup> Maron as follows: The method of training baggage screening system operators (Maron's system for simulating X-ray scanners is used as a teaching aid for baggage screening systems at airports) which comprises providing a baggage screening system (Maron's actual X-ray scanner) including a monitor (the graphics terminal/display monitor of Maron's system for simulating X-ray scanners) and further providing means for projecting simulated images of contraband onto said monitor (Maron's computer displays hazardous simulated images of firearms and the like).

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<sup>3</sup> To support a rejection of a claim under 35 U.S.C. § 102(b), it must be shown that each element of the claim is found, either expressly described or under principles of inherency, in a single prior art reference. See Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

<sup>4</sup> The inquiry as to whether a reference anticipates a claim must focus on what subject matter is encompassed by the claim and what subject matter is described by the reference. As set forth by the court in Kalman v. Kimberly-Clark Corp., supra, it is only necessary for the claims to "'read on' something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or 'fully met' by it."

The argument presented by the appellants (brief, pp. 2-4) does not convince us that the subject matter of claim 19 is novel. In that regard, while the appellants disclosed threat image projection system may be more sophisticated than the system of Maron, the difference(s) has not been set forth in claim 19. The appellants argue that their system tests to see if the stored contraband image that has been selected can be integrated to fit into the image of a piece of baggage being inspected by a baggage screening system and that Maron does not. However, claim 19 is not commensurate in scope with this argument since claim 19 does not recite this feature/function.

For the reasons set forth above, the decision of the examiner to reject claim 19 under 35 U.S.C. § 102(b) is affirmed. As set forth above, claims 1 to 8, 10 to 18 and 20 to 25 stand or fall with claim 19. Thereby, claims 1 to 8, 10 to 18 and 20 to 25 fall with claim 19. Thus, it follows that the decision of the examiner to reject claims 1 to 8, 10 to 18 and 20 to 25 under 35 U.S.C. § 102(b) is also affirmed.

#### CONCLUSION

To summarize, the decision of the examiner to reject claim 10 under 35 U.S.C. § 112, first paragraph, is reversed and the decision of the examiner to reject claims 1 to 8 and 10 to 25 under 35 U.S.C. § 102(b) is affirmed.

Since at least one rejection of each of the appealed claims has been affirmed,  
the decision of the examiner is affirmed.

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

AFFIRMED

JOHN P. McQUADE  
Administrative Patent Judge

JEFFREY V. NASE  
Administrative Patent Judge

JENNIFER D. BAHR  
Administrative Patent Judge

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