

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOSEPH ANTHONY HO-LUNG, JAMES GORDON MCCLEAN
and TIN-LUP WONG

Appeal No. 2003-0429
Application 09/282,862

ON BRIEF

Before THOMAS, JERRY SMITH 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 1-11, which constitute all the claims in the application.

The disclosed invention pertains to a method and apparatus for sensing biometric parameters of an individual to control access to a personal computer using a biometric sensor.

Representative claim 1 is reproduced as follows:

1. A personal computer comprising:

a memory;

an input device;

a processor connected to the memory and the input device for receiving inputs from the input device;

a biometric sensing system for controlling access to the personal computer processor and memory, said biometric sensing system including a first biometric sensor for receiving a personal input and identifying the individual, at least one additional sensor adjacent to the biometric sensor for determining whether the personal input is for a living person and a cover for protecting the biometric sensor and the at least one additional sensor from environmental forces when the sensor is not in use.

The examiner relies on the following references:

Lapsley et al. (Lapsley)	5,737,439	Apr. 07, 1998
Bolle et al. (Bolle)	6,064,753	May 16, 2000 (filed June 10, 1997)
Rambaldi et al. (Rambaldi)	6,292,173	Sep. 18, 2001 (filed Sep. 11, 1998)

Claims 1-11 stand rejected under 35 U.S.C. § 103(a). As evidence of obviousness the examiner offers Bolle in view of Rambaldi with respect to claims 1-4, 6 and 8-11, and the examiner adds Lapsley to this combination with respect to claims 5 and 7.

Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs 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 appellants' arguments set forth in the briefs 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 1-4, 6, 8 and 10. We reach the opposite conclusion with respect to claims 5, 7, 9 and 11. Accordingly, we affirm-in-part.

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

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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 appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered and are deemed to be waived [see 37 CFR § 1.192(a)].

We consider first the rejection of claims 1-4, 6 and 8-11 based on the teachings of Bolle and Rambaldi. With respect to independent claims 1, 6 and 8, the examiner finds that Bolle teaches the claimed invention except that Bolle does not teach a cover for protecting the sensor from environmental forces when the sensor is not in use. The examiner cites Rambaldi as teaching such a sensor. The examiner finds that it would have been obvious to the artisan to combine the teachings of Bolle and Rambaldi [answer, pages 5-6].

With respect to claim 1, appellants argue that there is no motivation to combine Bolle with Rambaldi. Specifically, appellants argue that the examiner has not shown why Bolle should be modified based on either the nature of the problem to be solved, the teachings of the prior art, or the knowledge of persons of ordinary skill in the art. Appellants insist that there is no suggestion within the applied prior art to make the combination proposed by the examiner. Appellants note that the sensors of Bolle, as applied by the examiner, do not meet the

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limitations of claim 1. Appellants also dispute that Rambaldi teaches a protective cover for a biometric sensor as claimed [brief, pages 5-10].

The examiner responds that appellants have failed to argue what the references would have suggested to one having ordinary skill in the art. The examiner repeats his position that the motivation to combine the references is found in common knowledge and common sense. With respect to the location of the two sensors of claim 1, the examiner observes that they are adjacent or closely positioned since they are part of the same system [answer, pages 9-14].

Appellants respond that the examiner is not entitled to rely on common knowledge and common sense of the artisan to support the combination of references. Appellants argue that the examiner must submit objective evidence in support of modifying or combining Bolle and Rambaldi [reply brief, pages 2-5].

We will sustain the examiner's rejection of claim 1. At the outset, we agree with the examiner that Bolle teaches the invention of claim 1 except for the claimed cover. Appellants appear to argue that Bolle does not teach the first biometric sensor and the one additional sensor of claim 1 simply because the examiner clearly reversed the reading of the claimed sensors

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on the sensors of Bolle. In other words, it is apparent to us that equipment 660 in Bolle captures images of fingerprints and is, therefore, a biometric sensor. It is also clear to us that force sensor 665 in Bolle is used to detect force variations [column 8] and is, therefore, a sensor for determining if the personal input is from a living person. The fact that the examiner reversed the reading of the Bolle sensors does not negate what the reference actually teaches to the skilled artisan. The two sensors are clearly adjacent to each other because the additional sensor of Bolle measures temporal changes of the fingertip at the fingerprint sensor.

Claim 1 simply recites that the computer has a cover for protecting the sensors from environmental forces when the sensors are not in use. Although Rambaldi may not be the best reference for teaching a cover as recited in claim 1, Rambaldi does teach providing a protective coating or cover for sensors. As noted by appellants, the examiner cannot simply rely on common sense and common knowledge as a substitute for evidence lacking in the record. This particular record, however, does support the rejection as formulated by the examiner. Although there must be prior art which teaches or suggests the broad concept of a cover for a biometric sensor, the knowledge of the artisan cannot

simply be ignored. The artisan would have found it obvious to broadly protect a sensor by providing a cover when the sensor is not in use. Rambaldi teaches a coating or cover for protecting the sensors from abrasion, contamination and electrostatic discharge. The artisan would have appreciated that the sensors of Bolle should be covered when not in use so the fingerprint sensor does not become dirty. Such contamination would severely hamper the accuracy of a fingerprint detector.

With respect to dependent claim 2, appellants argue that Rambaldi does not inherently teach a cover that includes a discharge path as claimed [brief, pages 10-11]. The examiner responds that Rambaldi teaches a cover for protecting a sensor against electrostatic discharge.

We will sustain the examiner's rejection of claim 2. The collective teachings of the applied prior art and the knowledge of the skilled artisan would have suggested the cover as discussed above with respect to claim 1. Since Rambaldi teaches that an electrostatic discharge path is desirable, we find that the discharge path recitation of claim 2 would have been obvious to the artisan.

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With respect to dependent claim 3, appellants simply broadly contest the examiner's finding that Rambaldi teaches the additional limitation of claim 3, but appellants offer no substantive analysis to support this position [brief, pages 11-12].

We will sustain the examiner's rejection of claim 3. The artisan would have found it obvious to effect the electrostatic discharge taught by Rambaldi by providing a conductive path between the cover and ground. Providing a grounding path to prevent electrostatic discharge is a conventional procedure well known to artisans in this area.

With respect to dependent claim 4, appellants argue that the examiner has improperly relied on inherency in making the rejection of claim 4 [brief, pages 12-13].

We will sustain the examiner's rejection of claim 4. Bolle teaches the additional limitations of claim 4 because the additional sensor of Bolle measures temporal variations of the fingerprint signals. Therefore, the additional sensor of Bolle must be located at the point where the fingerprint signals are detected, that is, at the same location.

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With respect to independent claim 6, appellants argue that the examiner has not provided any objective evidence to support the proposed modification [brief, page 13].

We will sustain the examiner's rejection of claim 6. Claim 6 is similar to claim 1 except that it recites that the biometric sensor is provided within a housing of a personal computer. The biometric sensor disclosed by Bolle has to be placed somewhere. The artisan would have expected that the sensor could be placed at any accessible location with respect to the processing device including within the housing. Therefore, we find that it would have been obvious to the artisan to broadly locate the sensor within the housing of a personal computer.

With respect to independent claim 8, appellants dispute the examiner's position that movable covers were well known in the art and that the applied prior art teaches providing an electrostatic discharge path when the cover is opened [brief, pages 14-16].

We will sustain the examiner's rejection of claim 8. As noted above, we have found that the applied prior art and the skill of the artisan teaches a cover for a sensor and Rambaldi teaches protecting the sensor against electrostatic discharge. We are not persuaded by appellants' argument that movable covers

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were not well known. Everyday experience for most people is sufficient to demonstrate that covers are typically movable so to protect something when closed and to provide access to something when open. The artisan would have understood that the cover as taught by Rambaldi must provide the electrostatic discharge path when the sensor is in use, that is, when a movable cover is open.

With respect to dependent claim 9, appellants broadly contest the examiner's finding that the applied prior art teaches the additional limitation of claim 9 and argue that the examiner has provided no objective evidence in support of the rejection [brief, pages 17].

We will not sustain the examiner's rejection of claim 9. We have carefully reviewed the record in this case, and it appears to us that the examiner has never addressed the specific limitation of claim 9. In making the rejection, the examiner lumped claims 6 and 8-11 together and asserted that these claims were rejected for the same reasons as claims 1-4. The specific recitation of claim 9, however, does not appear in claims 1-4. Therefore, the examiner has never addressed the limitation of claim 9 on this record. The examiner, therefore, has failed to establish a prima facie case of the obviousness of claim 9.

With respect to dependent claim 10, appellants argued this claim together with claim 4. Therefore, for reasons discussed above with respect to claim 4, we will sustain the examiner's rejection of claim 10. With respect to dependent claim 11, we have carefully reviewed the record in this case, and it appears to us that the examiner has never addressed the specific limitation of claim 11. As noted above, in making the rejection, the examiner lumped claims 6 and 8-11 together and asserted that these claims were rejected for the same reasons as claims 1-4. The specific recitation of claim 11, however, does not appear in claims 1-4. Therefore, the examiner has never addressed the limitation of claim 11 on this record. The examiner, therefore, has failed to establish a prima facie case of the obviousness of claim 11. Thus, we will not sustain the examiner's rejection of claim 11.

We now consider the rejection of claim 5 and 7 based on the teachings of Bolle, Rambaldi and Lapsley. The examiner asserts that although Lapsley only teaches a blood flow sensor, it would have been obvious to the artisan to incorporate an oxygen sensor as well [answer, pages 7-8]. Appellants argue that there is no motivation to combine the references in the manner proposed by the examiner. Appellants also challenge the

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examiner's finding that it would have been obvious to modify the blood flow sensor of Lapsley to include an oxygen sensor as claimed [brief, pages 17-21]. The examiner responds that oxygen detectors were well known in the art and that Lapsley inherently teaches detecting oxygen in the blood flow [answer, pages 19-20]. Appellants respond that the examiner has provided no objective evidence to support the addition of a pulse oximeter to the applied prior art [reply brief].

We will not sustain the examiner's rejection of claims 5 and 7. The examiner has provided no evidence to support the proposed modification of the applied prior art to include an oxygen sensing mechanism. The fact that oxygen sensing mechanisms were known is irrelevant. There is no evidence on this record that an oxygen sensing mechanism can detect whether an input is from a living person. The examiner's position that Lapsley inherently detects oxygen is without merit. The record in this case totally fails to support the examiner's findings with respect to claims 5 and 7.

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In summary, we have sustained the examiner's rejection of claims 1-4, 6, 8 and 10, but we have not sustained the examiner's rejection of claims 5, 7, 9 and 11. Therefore, the decision of the examiner rejecting claims 1-11 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

JAMES D. THOMAS)	
Administrative Patent Judge)	
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JERRY SMITH)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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