

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHARLES B. HOPSON

Appeal No. 2005-2119
Application No. 10/103,063

ON BRIEF

Before KIMLIN, TIMM and JEFFREY T. SMITH, **Administrative Patent Judges**.
JEFFREY T. SMITH, **Administrative Patent Judge**.

DECISION ON APPEAL

Applicant appeals the decision of the Primary Examiner finally rejecting claims 1 to 6 and 14 to 23. We have jurisdiction under 35 U.S.C. §134.¹

¹ In rendering this decision, we have considered Appellant's arguments presented in the Brief, filed December 9, 2004 and the Reply Brief, filed April 20, 2005.

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CITED PRIOR ART

As evidence of unpatentability, the Examiner relies on the following references:

Falcoff et al. (Falcoff)	4,615,902	Oct. 07, 1986
Dattilo	6,296,706	Oct. 02, 2001
Corrigan et al. (Corrigan)	6,522,977	Feb. 18, 2003
Dion	2002/0,192,357	Dec. 19, 2002

The Examiner entered the following rejections:

- (I). Claims 1-4, 14-17 and 20-23 stand rejected under 35 U.S.C. §102(e) as anticipated by Corrigan. (Answer, pp. 3-5).
- (II). Claims 6 and 19 stand rejected under 35 U.S.C. §103(a) as unpatentable over Corrigan further in view of either of Dattilo or Dion. (Answer, pp. 5-6).
- (III). Claims 5 and 18 stand rejected under 35 U.S.C. §103(a) as unpatentable over Corrigan further in view of Falcoff. (Answer, pp. 6-7).

We have carefully reviewed the claims, specification and applied prior art, including all of the arguments advanced by both the Examiner

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and Appellant in support of their respective positions. This review leads us to conclude that the Examiner's § 102 rejection and the § 103 rejections are not well founded. Our reasons follow.

Rather than reiterate the conflicting viewpoints advanced by the Examiner and the Appellant concerning the above-noted rejections, we refer to the Answer and the Briefs.

OPINION

Appellant's invention generally relates to a system for matching paint colors on different vehicle body components that are individually painted at different locations prior to being assembled as part of one vehicle. (Brief, p. 2). Appellant further discloses that the invention provides an arrangement for monitoring colors and adjusting paint formulations as needed to ensure achieving a satisfactory end product. (Brief, p. 2).

Claims 1 and 14, as presented in the Brief, are reproduced below:

1. A system for painting various portions of a vehicle exterior, comprising:

a first sensor that provides an indication of a color of paint applied to a first portion of the vehicle in a first paint application station;

a controller that communicates with the first sensor and determines the color of paint applied to the first portion of the vehicle;

a second sensor that provides an indication of a color of paint being applied at a second paint application station; and

a paint color adjuster at the second paint application station, the controller communicating with the second sensor and selectively causing the paint color adjuster to adjust the color of paint at the second paint application station such that the color of a second portion of the vehicle at the second paint application station matches the color of the first portion of the vehicle.

14. A system for separately painting separate portions of a vehicle exterior before a vehicle is assembled, comprising:

a first paint application station for applying paint to a first portion of the vehicle;

a first sensor that provides an indication of a color of paint applied to the first portion of the vehicle;

a controller that communicates with the first sensor and determines the color of paint applied to the first portion of the vehicle;

a second paint application station for applying paint to a second portion of the vehicle;

a second sensor that provides an indication of the color of paint being applied at the second paint application station; and

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a paint color adjuster associated with the second paint application station, the controller communicating with the second sensor and selectively causing the paint color adjuster to adjust the color of paint applied at the second paint application station such that the color of the second portion of the vehicle matches the color of the first portion of the vehicle.

The Examiner rejected claims 1-4, 14-17 and 20-23 under 35 U.S.C. §102(e) as anticipated by Corrigan.

According to the Examiner,

Corrigan discloses a paint matching system utilizing a first sensor (handheld scanner, see for example column 6, lines 1-3 and 24-30), a controller which communicates with the sensor (remote terminal, see column 5, line 65 to column 22), and a paint color adjuster and adjusting process (column 8, line 60, to column 13, line 3, which describes the remote paint matching process).

Corrigan also discloses that the paint matching system is intended to be duplicated from one repair/painting shop to the next (see column 1, line 62). Thus, the overall system discloses first and second (and more) sensors at each remote locations, a controller (at each location and a central location), and a paint color adjuster at the second location (and in fact, at each location). Therefore, the system of Corrigan, when duplicated across repair shops as disclosed and intended, discloses each element of the claimed system. (Answer, pp. 3-4).

Appellant argues that although the system of Corrigan may have multiple sensors, these sensors do not correspond to the claimed first and

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second sensors, in part, because they do not have a functional relationship to a controller as claimed. Appellant further states:

It is no surprise that there is no correlation between the colors used at different repair shops in the Corrigan reference because an individual repairing a vehicle at one repair shop using a color sensor does not need paint color information from an individual using another sensor at a different repair shop for purposes of repairing a completely different vehicle. There is nothing in the Corrigan reference that corresponds to the claimed functional relationship between a controller and first and second sensors to ensure a color match between paints applied at different painting stations. Therefore, at least the second sensor is missing from the reference.

(Brief, pp. 6-7).

In order for a claimed invention to be anticipated under 35 U.S.C. § 102, all of the elements of the claim must be found in one reference. *Scripps Clinic & Research Found. v. Genentech Inc.*, 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991).

We agree with Appellant that Corrigan does not anticipate the claimed subject matter because it does not provide a disclosure sufficiently specific to direct one skilled in the art to the claimed invention. The system of claims 1 and 14 requires a first sensor that provides an indication of a color of paint applied to a first portion of the

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vehicle and a second sensor that provides an indication of a color of paint being applied at a second paint application station to another portion of that vehicle. The system as explained by the Examiner does not function in the same manner as the claimed invention. The system of the Corrigan reference uses the described remote terminals which include a scanning device (sensor) for identifying the coloration data from a painted surface of a vehicle and transmitting the data to the central computer. (Col. 4, ll. 48-54). The identified remote terminal may function the same as the first sensor specified by the claimed invention. The remote terminal first functions to obtain the color information which is transmitted to the central computer. The central computer utilizes the received color information to determine the appropriate color and the mix formulation for creating this color. This mix formulation is subsequently transmitted to the remote terminal where the suggested color formulation is provided for mixing the color to match the color originally identified at the remote terminal.² At this location the paint is

² Corrigan discloses that the suggested color determination may be determined at the remote terminal without communication to a central computer. (Col. 5, ll. 13-15). Thus,

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mixed and applied to the object. Subsequently, Corrigan discloses the painted object is scanned and data may be transmitted back to the central computer for comparison. (Paragraph bridging columns 11 and 12). It appears that the remote terminal of Corrigan functions the same as the first and second sensors of the present invention. As such, the Corrigan reference does not disclose the same invention as described by the present claims within the meaning of 35 U.S.C. § 102.³

Accordingly, we determine that the Examiner has not established a *prima facie* case of anticipation with respect to the subject matter of claims 1-4, 14-17 and 20-23.

The Examiner utilized additional references along with Corrigan to reject the subject matter of claims 5, 6, 18 and 19. These additional references were not applied by the Examiner to address the differences from the Corrigan invention and the claimed invention identified above. Thus, the rejections under 35 U.S.C. § 103(a) are reversed.

the remote terminal may function as the central computer.

³ While the color formulation determined by the central computer may be transmitted to a different remote terminal as suggested by the Examiner, there is no indication that this is necessarily the process disclosed by Corrigan.

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Our determination that the disclosure of Corrigan does not anticipate the subject matter of the claims does not preclude a finding that the disclosure of Corrigan would have rendered the subject matter of the claims on appeal *prima facie* obvious under 35 U.S.C. § 103 (a). See *In re Arkley*, 455 F.2d 586, 589, 172 USPQ 524, 527 (CCPA 1972). However, the Examiner has not provided a discussion as to the obviousness of the subject matter of the independent claims over the Corrigan reference. Thus, in light of our discussion above, we remand this application to the jurisdiction of the Examiner to explore or determine whether the appealed subject matter is obvious over the Corrigan reference alone or in combination with other prior art.

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CONCLUSION

The Rejections under §§ 102 and 103 are reversed. The application is remanded to the Examiner for an obviousness determination as discussed above.

This remand to the examiner pursuant to 37 CFR ' 41.50(a)(1) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)) is not made for further consideration of a rejection. Accordingly, 37 CFR ' 41.50(a)(2) does not apply.

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TIME FOR TAKING ACTION

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv) (2004).

REVERSED; REMANDED

EDWARD C. KIMLIN)
Administrative Patent Judge)
CATHERINE TIMM)
Administrative Patent Judge) BOARD OF PATENT
JEFFREY T. SMITH) APPEALS
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