

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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 JEREMY RUSSEL LEACH and BRYAN JAMES CHRISTOPHERSEN

Appeal No. 2006-0549
Application No. 10/181,184

HEARD March 7, 2006

Before JERRY SMITH, BARRY, and MACDONALD, 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 4 and 7-10. Pending claims 1-3, 5 and 6 have been indicated by the examiner to contain allowable subject matter.

The disclosed invention pertains to a method and apparatus for authenticating documents of value. The invention uses a light emitting diode (LED) which emits ultra-violet (UV) radiation in a wavelength range at which non-genuine documents have a different reflectivity than genuine documents.

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Representative claim 4 is reproduced as follows:

4. An authenticating apparatus for documents of value comprising a LED which emits UV radiation in a wavelength range at which non-genuine documents have a different reflectivity than genuine documents; a transport system for transporting documents past the LED so that they are irradiated with UV radiation; a detector for detecting the reflected UV; and a processor for comparing the intensity of the reflected UV radiation with a threshold to determine the authenticity of the documents.

The examiner relies on the following references:

Lebens et al. (Lebens)	6,305,818	Oct. 23, 2001
Jones et al. (Jones)	6,363,164	Mar. 26, 2002

Claims 4 and 7-10 stand rejected under 35 U.S.C. § 103(a). As evidence of obviousness the examiner offers Jones in view of Lebens.

Rather than repeat the arguments of appellants or the examiner, we make reference to the brief and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the brief along with the examiner's rationale in support of the rejection 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 the claims on appeal. Accordingly, we affirm.

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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 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

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the brief have not been considered and are deemed to be waived [see 37 CFR § 41.37(c)(1)(vii)(2004)].

The examiner's rejection is based on the examiner's findings that Jones teaches the claimed invention except for the use of an LED as the UV light source. The examiner finds that the artisan would have been motivated to use a UV LED as disclosed by Lebens since Jones does not limit the type of UV light source and since UV LEDs have known advantages [answer, pages 4-6].

Appellants argue that Lebens is not analogous prior art with respect to their invention because it is not in the field of appellants' endeavor and is not reasonably pertinent to the problem solved by appellants. They also argue that there is no teaching, suggestion or motivation to combine Lebens with Jones from within the prior art references, the knowledge of the artisan or from the nature of the problem to be solved [brief, pages 11-15].

The examiner responds that Lebens is analogous prior art because the artisan would have looked to UV LEDs to solve the known problems of regular UV lamps as described in appellants' specification. The examiner also responds that the motivation to combine comes from Lebens' teaching that UV LEDs have considerable advantages for many different applications and the knowledge generally available to the skilled artisan. The examiner also notes that Lebens teaches that such LEDs are readily used to view fluorescing materials such as taggants, stamps, security codes and security seals [answer, pages 6-8].

We will sustain the examiner's rejection of the claims on appeal. We do not agree with appellants' argument that Lebens is non-analogous art. The Lebens invention

relates to the field of illumination using an LED as the light source. Although Lebens teaches that such LEDs can be used in a portable flashlight, the teachings are much more general than that. Lebens discloses that his invention also relates to the art of providing high intensity LEDs in the visible spectrum, infrared or ultraviolet [column 5, lines 42-50]. Lebens also teaches that the described LEDs have application in the art of viewing fluorescing materials [column 6, lines 39-42]. Thus, we find that Lebens is analogous prior art because it relates generally to the field of illuminating objects.

We also do not agree with appellants' argument that there is no motivation to combine the teachings of Lebens with the teachings of Jones. The portion of Jones relied on relates to the illumination of objects which either reflect ultraviolet light or fluoresce in response to such illumination in order to determine the authenticity of the object. Jones does not suggest that there is any special light source required other than it provide illumination in the ultraviolet range. Thus, the artisan would have been motivated to select an appropriate UV light source to illuminate such objects. As noted above, Lebens teaches that a UV LED provides an advantageous light source for illumination of documents which fluoresce. Therefore, we agree with the examiner that the artisan would have been motivated to use UV LEDS as the light source in Jones because these UV LEDs have advantages over conventional light sources as taught by Lebens and it was known to use UV illumination to illuminate documents as required in Jones.

In summary, we have sustained the examiner's rejection of the claims on appeal. Therefore, the decision of the examiner rejecting claims 4 and 7-10 is affirmed.

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

AFFIRMED

JERRY SMITH)
Administrative Patent Judge)
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) BOARD OF PATENT
LANCE LEONARD BARRY) APPEALS AND
Administrative Patent Judge) INTERFERENCES
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