

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today  
(1) was not written for publication in a law journal and  
(2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte WILLIAM BERSON,  
MICHAEL D. O'HARE  
and KENNETH C. ZEMLOK

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Appeal No. 96-2278  
Application 08/175,001<sup>1</sup>

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ON BRIEF

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Before THOMAS, JERRY SMITH and HECKER, Administrative Patent  
Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134

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<sup>1</sup> Application for patent filed December 29, 1993.

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from the examiner's rejection of claims 1-3, 5-8 and 10-15. Claims 4, 9 and 16 have been indicated by the examiner as containing allowable subject matter. An amendment after final rejection was filed on June 23, 1995 and was entered by the examiner.

The disclosed invention pertains to a method and apparatus for verifying an identification card. The identification card contains both an image of an object to be identified as well as a coded representation of the image. The card is placed in a card holding station where the image of the object is visible. The coded representation is decoded into the image which is displayed on a display. The visible image of the card in the card holder and the display are situated such that the two images can be easily compared by an operator.

Representative claim 1 is reproduced as follows:

1. An apparatus for verifying an identification card, said card including an image of an object to be identified on a first portion and a coded representation of an encrypted signal comprising a representation of said image on a second portion, said apparatus comprising:

a) a card holding station for receiving said card so that said image is visible to an operator of said apparatus;

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b) control means for controlling the operation of said apparatus[;]

c) means for reading said coded representation of said signal from said card; when said card is received in said station[;]

d) decoding means, responsive to said reading means for decoding said representation of said signal to provide a decoded signal;

e) decrypting means for decrypting said decoded signal to provide a decrypted signal[;]

f) display means responsive to said decrypting means for displaying said representation of said image, said display means being positioned adjacent to said image, whereby comparison of said representation of said image and said image is facilitated.

The examiner relies on the following references:

Piosenka et al. (Piosenka)	4,993,068	Feb. 12, 1991
Senanayake	5,053,608	Oct. 01, 1991
Axelrod et al. (Axelrod)	5,337,358	Aug. 09, 1994

(filed Nov. 20,  
1992)

Claims 1-3, 5-8 and 10-15 stand rejected under 35 U.S.C. § 102(e) as being anticipated by the disclosure of Axelrod. Claims 1-3, 5-8 and 10-15 also stand rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of Senanayake in view of Piosenka.

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Rather than repeat the arguments of appellants or the examiner, we make reference to the brief<sup>2</sup> 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 anticipation and 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 brief 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 disclosure of Axelrod does not fully meet the invention as recited in claims 1-3, 5-8 and 10-15. We are also of the view that the teachings of Senanayake and Piosenka

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<sup>2</sup> The reply brief filed February 7, 1996 was denied entry by the examiner [Paper No. 15]. Accordingly, we have not considered the reply brief in the formulation of this decision.

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and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 1-3, 5-8 and 10-15. Accordingly, we reverse.

We consider first the rejection of claims 1-3, 5-8 and 10-15 under 35 U.S.C. § 102(e) as being anticipated by the disclosure of Axelrod. Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.); cert. dismissed, 468 U.S. 1228 (1984); W.L. Gore & Assocs. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

The examiner asserts that Axelrod's Figure 1 illustrates all the components of the apparatus recited in claims 1-12 as well as the method recited in claims 13-16 [final rejection, page 2]. With respect to independent claims 1 and 13, appellants argue that in Axelrod "there is nothing

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which teaches or suggests a card holding station where the image on the card is visible to an operator after the card is received, or that the apparatus should be configured so that the image and the displayed representation of that image are adjacent" [brief, page 4]. The examiner responds that Figure 1 of Axelrod discloses these features [answer, page 3].

We agree with appellants that the invention of claims 1 and 13 is not fully met by the disclosure of Axelrod. There is clearly no card holding station disclosed in Axelrod so that there is no disclosure of the image on the card being visible when the card is received in the card holding station. Axelrod discloses a bar code scanner for reading the card, but there is no disclosure of how this card is received in a card holding station. Although Axelrod teaches that the image on the card C and the image on display 36 are compared by an operator, and although Axelrod shows the card C and the display 36 in close proximity in Figure 1, there is no disclosure that the comparison should take place while the card is in the card holding station. Axelrod could just as easily suggest that the comparison take place after a card is removed from whatever mechanism is used to hold and decode the

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data on the card.

Thus, the examiner's anticipation rejection of claims 1 and 13 is based on pure speculation as to how one might implement the comparison suggested by Axelrod. A rejection cannot be made under 35 U.S.C. § 102 based upon speculation with respect to the teachings of a reference or based on assumptions of what an artisan might decide to do given the disclosure of a reference. These considerations would be more relevant to a rejection under 35 U.S.C. § 103, however, we do not have a rejection on that ground before us using Axelrod.

Although Axelrod is the most pertinent reference on this record, it does not anticipate the invention of independent claims 1 and 13 for reasons discussed above, and the obviousness issue has not been properly raised by the examiner. We would have no difficulty agreeing with the examiner that it would have been obvious to the artisan that the image on card C in Axelrod and the image on display 32 should be placed adjacent to each other to facilitate Axelrod's disclosure that a human must compare these two images. Humans are well aware that when comparing two images to each other, they should be simultaneously viewable and

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relatively close to each other. This is a matter of simple common sense. There is no evidence on this record, however, regarding the obviousness of the card holding station of claims 1 and 13 in which the image of the object is visible when the card is received. As we noted above, such a condition is not necessary to the operation of Axelrod, and the examiner has not addressed the obviousness of this limitation.

Independent claims 7 and 12 also contain the recitation of "a card holding station for receiving said card so that said image is visible to an operator of said apparatus." For reasons we have already discussed at length, Axelrod does not disclose any card holding mechanism so that Axelrod does not anticipate these claims within the meaning of 35 U.S.C. § 102. Therefore, we do not sustain the examiner's rejection under 35 U.S.C. § 102 of any of the appealed claims based on Axelrod.

We now consider the rejection of claims 1-3, 5-8 and 10-15 under 35 U.S.C. § 103 as being unpatentable over the teachings of Senanayake and Piosenka. In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to

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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

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USPQ2d 1443, 1444 (Fed. Cir. 1992).

The examiner cites Senanayake as teaching everything recited in the claims except for the public key encryption techniques. The examiner cites Piosenka as teaching an identification card having encrypted versions of physical identification information stored on the card. The examiner asserts that it would have been obvious to the artisan to substitute Piosenka's encrypted facial information for Senanayake's fingerprint image [final rejection, pages 2-3]. Appellants argue that with respect to the teachings of Senanayake and Piosenka, "provision of a holding station where the card remains visible after insertion, and positioning of a display adjacent to such a holding station would be meaningless in the context of these references, and their combination cannot be considered to make the claimed invention, which includes these limitations, obvious" [brief, page 5]. We agree with appellants.

Senanayake is designed to compare an actual image on a card with a coded image on the card automatically by computer. Since the comparison is made by computer, there is no motivation to make the card in Senanayake visible when it is

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inserted in a card holder because no one is expected to be looking at the card. Piosenka is also intended to primarily operate to automatically compare an actual image with a coded image on a card by computer. Once again, since the comparison is made by computer, there is no incentive to have the data on the card be visible when it is received in a card holder.

Piosenka does describe a situation, however, where the comparison is made by a human operator [column 9, lines 5-21]. In this situation, however, two images on a card are not compared, but rather, a decoded displayed image is compared to the actual facial feature biometric of the person seeking validation. There is again no reason for the information on the card to be visible to the human operator when it is received in a card holding mechanism.

Thus, the examiner has failed to explain why it would have been obvious to the artisan to have a card holding station for receiving an identification card so that an image on the card is visible to an operator as recited in each of the independent claims. This recited limitation is clearly not suggested by either Senanayake or Piosenka. Therefore, the examiner has failed to establish a prima facie case for

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the obviousness of the claimed invention. Accordingly, we do not sustain the examiner's rejection of the claims under 35 U.S.C. § 103 based on the teachings of Senanayake and Piosenka.

The decision of the examiner rejecting claims 1-3, 5-8 and 10-15 is reversed.

REVERSED

	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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