

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte EUGENE JOSEPH

Appeal No. 97-1631
Application No. 08/245,267¹

ON BRIEF

Before JERRY SMITH, CARMICHAEL, and BARRY, Administrative Patent Judges.

BARRY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the final rejection of claims 1-4, 17, and 20. Claims 5-16, 18, 19, and 21 were allowed.

We reverse.

¹ Application for patent filed May 18, 1994.

BACKGROUND

The invention relates to electro-optical scanning. Variations in scanning speed generally need correction to ensure that indicia being scanned are read accurately. Bar codes feature embedded location, timing, or synchronization codes used for correction. Indicia such as signatures, however, lack such embedded codes. The invention interposes a mask with location, timing, or synchronization codes into a scanning beam so that the codes are read along with the indicia.

Claim 1, which is representative for our purposes, follows:

1. A scanner for reading indicia comprising:
 - (a) scanning means for scanning a light beam over a predetermined area, said area covering an indicia to be read;
 - (b) masking means positioned in the beam intermediate the scanning means and the indicia, and out of the plane of the indicia, the masking means carrying at least one coded symbol; and
 - (c) means for receiving light reflected from the indicia and for reading the indicia using information from the at least one coded symbol.

The references relied on by the patent examiner in rejecting the appealed claims follow:

Badgley et al. (Badgley)	2,580,270	Dec. 25, 1951
Guthmueller et al. (Guthmueller)	4,822,986	Apr. 18, 1989
Abe et al. (Abe)	5,028,797	Jul. 2, 1991

Claims 1-4, 17, and 20 stand rejected under 35 U.S.C. § 103 as obvious over Guthmueller, Abe, and/or Badgley. Rather than repeat the arguments of the appellant or examiner in toto, we refer to the appeal brief and the examiner's answer for the respective details thereof.

OPINION

In reaching our decision in this appeal, we have considered the subject matter on appeal, the rejection advanced by the examiner, and the evidence supporting the rejection. We have also considered the appellant's arguments along with the examiner's argument in rebuttal. After considering the record before us, it is our view that the

collective evidence relied on and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the invention of claims 1-4, 17, and 20. Accordingly, we reverse.

At the outset, we note that the examiner's answer omits the statutory basis of his rejection. All rejections in the prosecution history, however, were based on 35 U.S.C. § 103. (First Action at 2; Final Rejection at 2.) In addition, the examiner applies plural references in "the rejection," (Examiner's Answer at 1), i.e., the single rejection, in the answer. Accordingly, we interpret the rejection as under 35 U.S.C. § 103.

In rejecting claims under 35 U.S.C. § 103, the patent examiner bears the initial burden of establishing a prima facie case of obviousness. A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person having ordinary skill in the art. If the examiner fails to establish a prima facie case, an obviousness

rejection is improper and will be overturned. In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). It is against this background that we consider the examiner's rejection.

At the outset, we observe that the rejection lacks meaningful analysis. The appellant's comment about the examiner's first rejection, viz., "[t]he Examiner's rationale for the rejection is unclear," (Amendment B at 7), applies similarly to the instant rejection. The examiner fails to map the claim language to the disclosures of Guthmueller, Badgley, or Abe. He also neglects to indicate what language is missing from any of the references. In addition, the examiner omits an explanation of how he proposes to combine the references or why one of ordinary skill in the art would have been motivated to do so.

The examiner's rejection repeats the rejected claims and adds three comments. First, the examiner opines, "Guthmueller, in Fig. 1 teaches a coded mask for reading bar code indicia. Coded mask a 'symbols' [sic] are shown by

Badgley or Abe Fig. 6(A)) [sic]." (Examiner's Answer at 2.)
Second, he alleges, "[t]he Grid or 'Grating' or [sic]
Guthmueller provides synchronization information as does the
secondary art coding." (Id.) Third, the examiner states,
"[t]he 'method' of claim 1 and subject [sic] to the same
rejection." (Id. at 3.) The examiner's response to the
appellant's arguments is more laconic and less helpful than
his rejection. He remarks, "[a]ppellant's arguendo [sic] is
essentially meaningless since it either ignores or
misconstrues the teachings of the above prior art."
(Examiner's Answer at 3.)

We find that neither Guthmueller, Abe, nor Badgley, alone
or in combination, teaches or suggests the claimed invention.
We will address the failure of the references seriatim.

Regarding the Guthmueller reference, we agree with the
appellant that the reference "lacks any teaching or suggestion
of a masking means which carries a coded symbol" (Appeal
Br. at 4.) Independent claim 1 specifies inter alia "masking
means positioned in the beam intermediate the scanning means

and the indicia, and out of the plane of the indicia, the masking means carrying at least one coded symbol;"

Independent claim 20 specifies inter alia an analogous step of "positioning masking means in the beam intermediate the scanning means and the indicia, and the masking means being out of the plane of the indicia, the masking means carrying at least one coded symbol;"

Guthmueller employs a Video Processor Unit (VPU) to detect and read bar codes. An optical scanner of the VPU generates video data representing data written, printed, or coded on mail. A Video Controller processes the video data and then transmits it to a Bar Code Reader (VPUBR). The VPUBR moves a template mask, Fig. 1, over the scanned video data to find tall and short bars of the code, Col. 2, ll. 19-47, which represent binary ones and zeros, respectively. Col. 1, ll. 15-17.

Comparison of the claim's language to the reference's teachings evidences that Guthmueller fails to teach or suggest the claimed masking means or the step of positioning it. The

claimed masking means is positioned in a scanning beam between a scanning means and indicia to be scanned. The positioning is outside the plane of the indicia. In contrast, the reference's template is positioned in an array of scanned video data comprising cells of video data. Col. 4, ll. 5-12 and 27-40. The claimed masking means carries at least one coded symbol. In contrast, Guthmueller's template mask comprises video scan cells. Col. 4, ll. 27-29. Therefore, we find that Guthmueller fails to teach or suggest the masking means and step of positioning masking means as specified in claims 1 and 20, respectively.

Regarding the Abe reference, we find that the reference fails to teach or suggest the claimed masking means and step of positioning masking means. We also find that Abe neither teaches nor suggests the receiving means specified in claim 1 and the step of receiving light specified in claim 20. Independent claim 1 specifies inter alia "means for receiving light reflected from the indicia and for reading the indicia using information from the at least one coded symbol." Independent claim 20 specifies inter alia an analogous step of

"receiving light reflected from the indicia and reading the indicia using information from the at least one coded symbol."

Abe relates to semiconductor manufacturing. It facilitates the transfer of a circuit pattern formed on a mask to a semiconductor wafer. Specifically, it helps to align the mask and wafer. Col. 1, ll. 1-26. Alignment marks 507M and 509M are formed on the surface of the mask and wafer, respectively. Col. 1, ll. 58-63, Fig. 6(A). Light reflected by the alignment marks is used to detect a positional deviation between the mask and wafer. Col. 1, l. 64 - Col. 2, l. 19.

Comparison of the claim's language to the reference's teachings evidences that Abe fails to teach or suggest the claimed masking means and the step of positioning it. The claimed masking means carries at least one coded symbol. In contrast, the reference's alignment marks are lines, which are not encoded. Fig. 6(A).

Further comparison of the claim's language to the reference's teachings evidences that Abe also fails to teach or suggest the claimed receiving means and the step of receiving light. The claimed indicia are read "using information from the at least one coded symbol." In contrast, Abe uses light reflected by the alignment marks to detect a positional deviation between the mask and wafer. Therefore, we find that Abe, alone or in combination with Guthmueller, fails to teach or suggest the masking means and receiving means and the steps of positioning masking means and receiving light as specified in claims 1 and 20, respectively.

Regarding the Badgley reference, we find that the reference fails to teach or suggest the claimed receiving means and step of receiving light. Badgley relates to the selection of recorded data optically. Col. 1, ll. 1-3. It detects coincidence between apertures formed in a master record strip, which bear indicia of a characteristic sought, and those formed in a scanning strip, which bears indicia of the characteristics available. Id. at ll. 42-48. The strips are superimposed and then disposed to intercept a beam of

light trained on a photoelectric cell. Id. at 13-21. If enough apertures match, the light beam reaches a sufficient intensity to energize the cell, which in turn causes the frame containing the matching apertures to be flashed upon a screen and then recorded on photographic film for later reference. Col. 3, ll. 51-59.

Comparison of the claim's language to the reference's teachings evidences that Badgley fails to teach or suggest the claimed receiving means and the step of receiving light. The claimed indicia are read by "receiving light reflected" therefrom. In contrast, Badgley uses light passing through the apertures to detect a matching record. The record is read by projecting it on a screen. Therefore, we find that Badgley, alone or in combination with Guthmueller or Abe, fails to teach or suggest the receiving means or step of receiving light as specified in claims 1 and 20, respectively. Claims 2-4 and 17 depend from claim 1. As such, neither Guthmueller, Abe, nor Badgley, alone or in combination, teaches or suggests the invention specified in these claims.

For the foregoing reasons, we find that the statement of the examiner's rejection does not amount to a prima facie case of obviousness. Because the examiner has not established a prima facie case, the rejection of claims 1-4, 17, and 20 over Guthmuller, Abe, and/or Badgley is improper and is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-4, 17, and 20 under 35 U.S.C. § 103 is reversed.

REVERSED

JERRY SMITH)	
Administrative Patent Judge)	
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)	
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)	BOARD OF PATENT
JAMES T. CARMICHAEL)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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