

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

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JAMES S. HERMAN, JR.

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Appeal No. 1998-1803  
Application 08/409,188

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ON BRIEF

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Before JERRY SMITH, LALL, 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 1-21, which constitute all the claims in the application.

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The disclosed invention pertains to the projection of identifying images onto cut parts of a sheet material to enable the parts to be sequentially removed for subsequent processing.

Representative claim 1 is reproduced as follows:

1. A part identification system for temporarily identifying parts cut from a sheet material, comprising:

(a) a visual signal generator for projecting a subset identifying image onto a portion of the sheet material;

(b) a label for each part cut from the sheet material, the label including an association of the cut part with a given subset of parts; and

(c) a labeling program for accessing the labels, grouping members of the given subset and directing the subset identifying image to identify members of the given subset in the cut sheet material.

The examiner relies on the following references:

Gerber et al. (Gerber)	4,583,181	Apr. 15, 1986
Campbell, Jr. et al. (Campbell)	5,172,326	Dec. 15, 1992

Claims 1-21 stand rejected under 35 U.S.C. § 103. As evidence of obviousness the examiner offers Campbell in view of Gerber.

Rather than repeat the arguments of appellant or the examiner, we make reference to the briefs and the answer for

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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 appellant's arguments set forth in the briefs 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 not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 1-21. Accordingly, we reverse.

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,

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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,

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

The examiner observes that Campbell discloses a web cutting system wherein templates are manipulated on a computer screen to control where the cuts will be made on the sheet material. With respect to each of the independent claims on appeal, the examiner asserts that Campbell differs from the claimed invention only in the claimed projection of an identifying image onto the sheet material. Gerber teaches

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that a desired pattern to be cut from sheet material which is shown on a display can also be projected directly onto the fabric. It is the examiner's position that it would have been obvious to the artisan to replace the template display of Campbell with the projection system of Gerber [answer, pages 3-4].

With respect to the independent claims, appellant makes several arguments of which the following are considered to be most pertinent. First, appellant argues that there is no basis for modifying the teachings of Campbell with the teachings of Gerber, and such modification does not result in the claimed invention anyway [brief, pages 7-11]. Second, appellant argues that Campbell and Gerber are each directed to a technique for determining where to cut a piece of sheet material whereas the claimed invention is directed to a method and apparatus for handling material pieces which have already been cut from the sheet material [id., pages 11-22]. We agree with each of these arguments.

We will not explain our position in detail in this decision because we essentially agree with appellant's

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position which is explained in detail in the brief. The examiner has not responded to any of appellant's pertinent arguments in the brief, but instead, the examiner has simply repeated erroneous positions held from the start of prosecution in this application. The claims relate to a method and apparatus for projecting an identifying image onto previously cut material pieces to enable identification and sorting for subsequent processing. Neither Campbell nor Gerber relates to the identification of previously cut pieces. Appellant is also correct that there is nothing to be gained by projecting the templates of Campbell onto the material itself. The templates would still be used only to determine where to cut the sheet material and would not satisfy the claim recitations of projecting identifying information onto material parts previously cut from sheet material.

Since each of the independent claims recites limitations which are not taught or suggested by the applied prior art, we do not sustain the examiner's rejection of any of claims 1-21 based on the prior art applied by the examiner. Therefore,

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the decision of the examiner rejecting claims 1-21 is  
reversed.

REVERSED

JERRY SMITH	)	
Administrative Patent Judge	)	
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	)	
	)	BOARD OF PATENT
PARSHOTAM S. LALL	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
	)	
LANCE LEONARD BARRY	)	
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