

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

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SYMBOL TECHNOLOGIES, INC.

Appeal No. 2000-0610
Control No. 90/005,099

HEARD: DECEMBER 4, 2000

Before KRASS, JERRY SMITH and LALL, Administrative Patent Judges.

LALL, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the final rejection of claims of 1, 2, 6-12, 17-21, and 28, claims 3-5, 13-16, and 22-27 having been confirmed in this reexamination.

The invention relates to a system of providing a record with

Appeal No. 2000-0610
Control No. 90/005,099

Examiner. We have, likewise, reviewed Appellants' arguments against the rejections as set forth in the briefs.

It is our view, after consideration of the record before us, that the rejections under 35 U.S.C. § 102 and under 35 U.S.C. § 103 are not proper. Accordingly, we reverse.

At the outset we note that Appellants assert [brief, page 3] that claims 1, 2, 6-12, 17-21, and 28 do not stand or fall together, but instead they argue them in five different groups.

Analysis

We have reviewed the positions of the Examiner [answer, pages 4 to 12 and final rejection, pages 2 to 11] and Appellants [brief, pages 3 to 14 and reply brief, pages 1 to 6] and reach a conclusion that the Examiner is over-reaching in his effort to reject the claims on appeal. Whereas we commend the examiner in answering each and every point which Appellants raised in their briefs, we are of the view that the Examiner is stretching his reasoning to meet the claimed

Appeal No. 2000-0610
Control No. 90/005,099

limitations. We add below some elaboration and clarification for the two grounds of rejection.

Rejection under 35 U.S.C. § 102

A prior art reference anticipates the subject of a claim when the reference discloses every feature of the claimed invention, either explicitly or inherently (see Hazani v. Int'l Trade Comm'n, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed.

Cir. 1997) and RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984)).

The Examiner is using a reference from the year 1856 to anticipate claims relating to a system whose operation is carried out by a digital computer system. The age of a reference is not per se determinative of its relevancy to the claims of an invention, however, in this case, the claimed matter involves subject matter which was not even envisioned at the date of publication of the reference. The Examiner has indulged in broad general logic in a vacuum in interpreting the recited claimed defining phrases such as "codeword",

Appeal No. 2000-0610
Control No. 90/005,099

"machine-readable format" and "encoding". In doing so, the Examiner has ignored, or arbitrarily expanded beyond reasonable broad interpretation, the definitions of these terms which have been provided in the specification.

Independent claims 1, 2 and 28 each have claimed, inter alia, the phrases involving "codewords" and "machine-readable format." It can be argued, as the Examiner has, that the use of any language or any type of numerals is essentially a system of "coding" of a human thought, and any printed material can be regarded to be read by a machine using

"OCR" technology, but the Examiner is required to give a broad, yet reasonable, interpretation to the claims consistent with the specification.

This, the Examiner has ignored in this case. The remaining independent claim, 17, also includes the recitation of the phrase "encoding means" and "error correctable" format.

Again, the Examiner has over-extended the interpretation of these phrases, not consistent with the specification. The

Appeal No. 2000-0610
Control No. 90/005,099

words in the Hannay reference stand for themselves, they are not "encoded" to represent something different from their ordinary meaning, and are not "error correctable" and in a "machine-readable" format in the context of the specification. Therefore, we do not sustain the anticipation rejection of claims 1, 2, 6, 7, 11, 17, 20, 21 and 28 by Hannay.

Rejection under 35 U.S.C. § 103

As a general proposition, in an appeal involving a rejection under 35 U.S.C. § 103, an Examiner is under a burden to make out a prima facie case of obviousness. If that burden is met, the burden of going forward 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 In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); 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

Appeal No. 2000-0610
Control No. 90/005,099

1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

Here, the claims rejected under 35 U.S.C. § 103, that is, claims 8, 9, 10, 12, 18 and 19 are all dependent on the independent claims discussed above, and are rejected over the same single reference (Hannay). The line of reasoning presented by the Examiner in support of rendering obvious over Hannay the claimed subject matter of each of these claims does not overcome the deficiencies noted above. Therefore, we do not sustain the obviousness rejection of claims 8, 9, 10, 12, 18 and 19 over Hannay.

In conclusion, we reverse the Examiner's final rejection under 35 U.S.C. § 102 of claims 1, 2, 6, 7, 11, 17, 20, 21 and 28 by Hannay, and also reverse the final rejection under 35 U.S.C. § 103 of claims 8, 9, 10, 12, 18 and 19 over Hannay.

The decision of the Examiner rejecting claims 1, 2, 6-12, 17-21, and 28 is reversed.

REVERSED

Appeal No. 2000-0610
Control No. 90/005,099

ERROL A. KRASS)	
Administrative Patent Judge)	
)	
)	
)	
JERRY SMITH)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
PARSHOTAM S. LALL)	
Administrative Patent Judge)	

Appeal No. 2000-0610
Control No. 90/005,099

Finnegan, Henderson, Farabow
Garrett and Dunner
1300 I Street, NW
Washington, DC 20005-3315