

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(2) is not binding precedent of the Board.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. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte RICHARD B. NAYLOR and DONALD J. SHARP

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Appeal No. 96-3728  
Application 08/132,078<sup>1</sup>

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ON BRIEF

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Before GARRIS, PAK, and ELLIS, Administrative Patent Judges.  
GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the refusal of the  
examiner to allow claims 2 through 6, 9 through 16, 18, 19 and  
21 through 27 as amended subsequent to the final rejection.

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<sup>1</sup> Application for patent filed October 5, 1993.

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These are all of the claims remaining in the application.

The subject matter on appeal relates to a tamper resistant magnetic stripe for encoding by magnetic particle rotation and to a method for encoding a magnetic stripe. This appealed subject matter is adequately illustrated by independent claims 2 and 22 which read as follows:<sup>2</sup>

2. A tamper resistant magnetic stripe for encoding by magnetic particle rotation comprising:

a radiation crosslinkable material which is solid at ambient temperature and which before cross-linking has a viscosity of 1,200 poise or less at 40EC; and

magnetized particles of a magnetic composition in suspended distribution throughout said crosslinkable material, said particles have a coercivity of at least 5 kOe;

said particles in selected regions of said material being substantially all similarly aligned with respect to their magnetic polarity and the material of said regions is cross-linked, and in the remaining regions of said material the particles therein being substantially all similarly aligned with respect to their magnetic polarity in a direction which is 180E opposed to said particles in said selected cross-linked regions;

wherein said selected and remaining regions alternate along said stripe to define a magnetic code.

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<sup>2</sup> We observe that claims 22 and 23 have been inaccurately reproduced in the appendix of the appellants' brief. Suffice it to say that our decision on this appeal is based upon the actual language of the appealed claims rather than the inaccurate language of the appellants' claim reproductions.



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Gutterman,<sup>3</sup> while claims 22 through 25 are rejected over this reference and further in view of Burroughs and Fayling.

We refer to the brief and to the answer for a complete exposition of the opposing viewpoints expressed by the appellants and the examiner concerning these rejections.

OPINION

Neither of the rejections before us can be sustained.

As correctly indicated by the appellants, Gutterman contains no teaching or suggestion of the coercivity feature recited in independent claim 2. For this reason alone, we can not sustain the examiner's section 103 rejection of this claim and of the claims which depend therefrom as being unpatentable over Gutterman.

As for the section 103 rejection of claims 22 through 25 as being unpatentable over Gutterman in view of Burroughs and Fayling, it is our determination that the examiner has failed

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<sup>3</sup> In his exposition of this rejection on page 4 of the answer, the examiner has referred to other references in addition to Gutterman as support for his conclusion of obviousness even though these other references are not included in the statement of the rejection. This is inappropriate as explained in the case of In re Hoch, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3. (CCPA 1970). As a consequence, we have not considered these other references in assessing the merits of the above noted rejection.

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to carry his initial burden of establishing that it would have been prima facie obvious for one with ordinary skill in the art to combine the teachings of these references in such a manner as to result in a method which corresponds to the one defined by independent claim 22. Indeed, a review of the examiner's exposition of this rejection on pages 4 and 5 of the answer reveals a failure on the examiner's part to even express a conclusion of obviousness much less the rationale therefore with respect to a combination of the applied reference teachings. Further, it is particularly unclear to us why one with ordinary skill in the art would combine the seemingly disparate methods of Gutterman and Burroughs, as the examiner seems to implicitly propose, without impermissibly using the appellants' own disclosure as a guide to thereby produce a method having the steps recited in the claim under review. It follows that we also can not sustain the examiner's section 103 rejection of claims 22 through 25 as being unpatentable over Gutterman in view of Burroughs and Fayling.

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The decision of the examiner is reversed.

REVERSED

	Bradley R. Garris	)	
	Administrative Patent Judge	)	
		)	
		)	
	Chung K. Pak	)	BOARD OF
PATENT	Administrative Patent Judge	)	APPEALS AND
		)	INTERFERENCES
		)	
	Joan Ellis	)	
	Administrative Patent Judge	)	

tdc

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