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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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEROME SWARTZ, RAJ BRIDGELALL, RON GOLDMAN,
EUGENE JOSEPH and JOSEPH KATZ

Appeal No. 97-0171
Application No. 08/187,290¹

ON BRIEF

Before KRASS, FLEMING, and DIXON, **Administrative Patent Judges**.
DIXON, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the Examiner's final rejection of claims 1, 3, 8, 9, 18 and 19, which are all of the claims pending in this application.

We REVERSE.

¹ Application for patent filed January 27, 1994.

BACKGROUND

The appellants' invention relates to an apparatus for processing information contained in an original document. The document contains two separate portions. The first portion contains information and the second portion contains a graphical symbol which is data encoded to represent the information contained in the first portion of the document. The apparatus contains an editing system which allows the original decoded information to be modified and a graphical symbol representing the modified information is printed with the modified information. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. Apparatus for processing information, from an original document containing document information on a first portion of the original document and a graphic symbol on a second portion of the original document physically separated from the first document portion, the graphical symbol encoding data representing the original document information, said apparatus comprising, in combination:
 - a scanner/decoder for scanning the symbol to produce symbol data;
 - a translator for translating the symbol data to document information data;
 - means for converting the document information data into humanly intelligible information different in form from the document information;
 - an editing system connected to receive the document information data from the translator and produce edited document information data;

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an edited document information data translator for translating the edited document information data to edited symbol data; and

a printer for printing the edited document information data as edited document information on an edited document and printing the edited symbol data as an edited graphic symbol on the edited document at a single location disassociated from the edited document information printed on the edited document.

The prior art references of record relied upon by the Examiner in rejecting the appealed claims are:

Bockholt et al. (Bockholt)	4,488,679	Dec. 18, 1984
Mihm et al. (Mihm)	5,387,783	Feb. 07, 1995 (filing date Apr. 30, 1993)
Duthion (French patent)	FR 2 494 873	May 28, 1982

Claims 1, 3, 8, 9, 18 and 19 stand rejected under 35 U.S.C. § 103 as being unpatentable over Duthion in view of Bockholt and Mihm.

Rather than reiterate the conflicting viewpoints advanced by the Examiner and the appellants regarding the above-noted rejection, we make reference to the Examiner's answer (Paper No. 16, mailed August 7, 1996) for the Examiner's complete reasoning in support of the rejections, and to the appellants' brief (Paper No. 15, filed November 13, 1995) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the Examiner. As a consequence of our review, we make the determinations which follow.

Appellants argue that

[Mihm] does not disclose or suggest the editing feature in the context recited in claims 1 and 18. That is, while the electronic document in Mihm. et al. may be an edited version of an original electronic document, there is absolutely no teaching in this reference that the original electronic document was obtained from reading a coded [graphical] symbol on the original document, as recited in claims 1 and 18. Specifically, there is no mention in Mihm et al. of reading a ZIP CODE in order to edit or change the graphic data of the ZIP CODE and then print the edited graphic data as an edited ZIP CODE on a document. Consequently, there is absolutely no motivation that can be gleaned from these references for applying any of the teachings of Mihm. et al. to the combined disclosures of Duthion and Bockholt et al. (See brief at page 6.)

We agree with appellants.

As pointed out by our reviewing court, we must first determine the scope of the claim. "[T]he name of the game is the claim." **In re Hiniker Co.**, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998).

Clearly the Examiner understands the limitations set forth in claim 1 since the Examiner correctly paraphrases the invention set forth in claim 1 as "[t]he underlying

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inventiveness of the present invention is the ability of reading a printed bar code, converting the read information into audible sounds, allowing one to edit the read information and, converting the edited information into a [new] bar code.” (See answers at page 7.)

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of presenting a *prima facie* case of obviousness. **See In re Rijckaert**, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A *prima facie* case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. **See In re Lintner**, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is *prima facie* obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. **See In re Fine**, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

After a careful review of the record in this case, we are compelled to agree with appellants that the Examiner’s conclusion of obviousness is not supported by the types of

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factual findings necessary to reach this conclusion. Our reading of the Examiner's reasons for the determination of obviousness causes us to conclude that the Examiner

believes the claimed invention to be obvious merely because it seems that it would have been obvious.

We do not find any teaching by Mihm of editing the original information, but even if we were to find that Mihm does teach some sort of editing of original information, appellants argue that the Examiner used "impermissible hindsight gained from a reading of applicants' specification and claims" to combine the teachings of Duthion, Bockholt and Mihm. We agree with appellants. The Examiner has not provided any convincing line of reasoning why it would have been obvious for one of ordinary skill in the art at the time of the invention to combine the teachings of Mihm with those of Duthion and Bockholt. Mihm merely appends a postal bar code to the document and does not allow for further change to the document. Mihm does not teach an editing function nor how to edit the information in the document to generate a new document. The Examiner has not set forth a convincing line of reasoning why it would have been obvious for one of ordinary skill in the art at the time of the invention to combine a bar code printing system for faster processing of mail into a device for learning as disclosed by Duthion or to use the high density bar code as taught by Bockholt. The Examiner has not provided such a statement of motivation for the

combination in the answer or in the final rejection. The final rejection merely concludes on page 6 that the

editing would “allow[s] the operator to easily insert a line of music scores, or any other important information (such as notes, modifications, memos, etc.) into the original document.” Alternatively, Mihm does not provide motivation for this type of editing. Mihm merely teaches the skilled artisan to append a bar code to a document which did not previously contain a bar code.

The Examiner states the teachings of Mihm as follows:

Another difference is that both Duthion and Bockholt fail to disclose the claimed editing system, the edited text data translator, and the printer for printing the edited symbol data. Mihm et al., on the other hand, disclose all of the missing features. Mihm et al. disclose a method and an apparatus for inserting graphical data into a page of document and then prints the edited document. According to Mihm et al., the system generates graphical symbols from the editing text, insert these symbols into a document page, and then sends the edited document page to a printer for printing (see the abstract and any other corresponding section). This system allows a quick and a reliable method for updating and editing information. It would have been an obvious expedient for one with ordinary skill to incorporate an editing system and the associating means and functions into Duthion/Bockholt et al.'s system. The motivation is that it allows the operator to easily insert a line of music scores, or any other important information (such as notes, modifications, memo, etc.) into the original document. (Emphasis added.) (See answer at pages 5-6.)

Upon close review of the Mihm reference, we do not find that Mihm teaches the editing of the information content of the original document, as discussed above. Rather, Mihm merely discloses a system for “inserting bar code graphics information representing

a complete zip code.” (See abstract.) Mihm does not disclose that the system edits the document or changes a bar code which is already in the document.

The language of claim 1 requires that

the graphical symbol encoding data representing the original document information . . .

an editing system connected to receive the document information data from the translator and produce edited document information data;

an edited document information data translator for translating the edited document information data to edited symbol data; and

a printer for printing the edited document information data as edited document information on an edited document and printing the edited symbol data as an edited graphic symbol on the edited document at a single location disassociated from the edited document information printed on the edited document.

If the system of Mihm were to read a bar code and edit the content thereof and generate a new bar code of the changed information, this would be a teaching of editing as set forth in claim 1. We do not find such a teaching in Mihm and the Examiner has not cited to any portion of the reference beyond “(see the abstract and any other corresponding section).” (See answer at page 5.) Furthermore, Mihm retrieves the document information in electronic form which is print ready and then evaluates the document for the zip code information and appends the bar code thereto. (See Mihm at col. 20 and claim 1.) Using the Examiner’s interpretation of Mihm, the document information could only be the actual

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address or zip code and not the actual document which is encoded as a bar code.

Therefore, the text of the letter is not edited as the Examiner implies. Clearly, this is not a reasonable interpretation of the limitations as set forth in claim 1.

The Examiner responds to appellants' arguments stating that

The Zip Code information, coded or uncoded, is considered machine readable data. Since the Zip Code data is in alphanumeric forms, it is highly probable and obvious that this type of information could also be input[t]ed into a computer file or database using an optical character[s] recognition [OCR] reader. From Mihm's disclosure, it is clear that the barcoder 2 could read and interpret this data information. The only difference is that Mihm is silent about the use of an optical device for input this information in the barcoder 2.

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In this case, Duthion discloses the method of converting music information in barcode form into audible sound. Bockholt, in addition, extends Duthion's teaching to print such musical information as a code on a sheet paper along with text information. Mihm, further extends this teaching to allow one to edit such information and printed as a barcode on a sheet of paper. With the motivation provided in page 6 of the Final Office Action and the reasons stated above, the examiner firmly believes that the proposed combination has established a prima facie case of rejection. (See answer at pages 8-9.)

As stated above, we disagree with the Examiner's conclusion of obviousness and the statement of the motivation for the combination of references. Therefore, we will not sustain the rejection of claim 1. Similarly, we will not sustain the rejection of independent claim 18 for the same reasons as above. Since we will not sustain the rejection of independent claims 1 and 18, we will not sustain the rejection of dependent claims 3, 8, 9 and 19.

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CONCLUSION

To summarize, the decision of the Examiner to reject claim 1, 3, 8, 9, 18 and 19 under 35 U.S.C. § 103 is reversed.

REVERSED

ERROL A. KRASS)	
Administrative Patent Judge)	
)	
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)	BOARD OF PATENT
MICHAEL R. FLEMING)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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)	
JOSEPH L. DIXON)	
Administrative Patent Judge)	

vsh

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