

**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(2) is not binding precedent of the Board.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. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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**Ex parte** DAVID EVERETT

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Appeal No. 1998-0085  
Application 08/343,540

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HEARD: MAY 15, 2000

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Before FLEMING, GROSS and LEVY, **Administrative Patent Judges.**

FLEMING, **Administrative Patent Judge.**

**DECISION ON APPEAL**

This is a decision on appeal from the final rejection of  
claims

1 through 17, all the claims pending in the present application.

The invention relates to reading data from a smart card.

The independent claim 1 is reproduced as follows:

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1. A method of reading data from a smart card, the smart card having a microprocessor and a memory holding use-variable data, the method comprising:

coupling a reader to the card to establish a data transmission path between the reader and the card;

accessing required use-variable data in said memory; and

incorporating said accessed data as part of an answer-to-reset signal transmitted from the card to the reader.

The Examiner relies on the following reference:

Claus et al. (Claus)	5,310,999	May 10, 1994
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Claims 1 through 17 stand rejected under 35 U.S.C. § 103 as being unpatentable over appellant's disclosed prior art in view of Claus.

Rather than reiterate the arguments of the Appellant and the Examiner, reference is made to the briefs<sup>1</sup> and answer for the respective details thereof.

#### **OPINION**

We will not sustain the rejection of claims 1 through 17 under

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<sup>1</sup> Appellant filed an appeal brief on October 11, 1996. Appellant filed a reply brief on July 28, 1997. The Examiner stated in a letter dated February 24, 2000, that receipt is acknowledged of the reply brief filed. The Examiner further stated that the application is provided to the Board of Patent Appeals and Interferences for further considerations. Although it is not entirely clear that the Examiner has entered and considered the reply brief, we note that the Examiner has not made it clear that the reply brief had not been considered or entered. In view of no clear statement that the reply brief is not considered or entered, we will treat the reply brief as being entered and considered and as properly before us for our consideration.

35 U.S.C. § 103.

The Examiner has failed to set forth a **prima facie** case. It is the burden of the Examiner to establish why one having ordinary skill in the art would have been led to the claimed invention by the express teachings or suggestions found in the prior art, or by implications contained in such teachings or suggestions. **In re Sernaker**, 702 F.2d 989, 995, 217 USPQ 1, 6 (Fed. Cir. 1983).

"Additionally, when determining obviousness, the claimed invention should be considered as a whole; there is no legally recognizable 'heart' of the invention." **Para-Ordnance Mfg. v. SGS Importers Int'l.**, 73 F.3d 1085, 1087,

37 USPQ2d 1237, 1239 (Fed. Cir. 1995), **cert. denied**, 519 U.S. 822 (1996) **citing W. L. Gore & Assocs., Inc. v. Garlock, Inc.**, 721 F.2d 1540, 1548, 220 USPQ 303, 309 (Fed. Cir. 1983), **cert. denied**, 469 U.S. 851 (1984).

On pages 6 and 7 of the brief, Appellant argues that the Examiner has incorrectly read Claus. In particular, Appellant argues that Claus does not teach an ATR signal having use-variable data contained therein. To further support the Appellant's arguments, Appellant has provided a declaration of William Reding,

wherein Mr. Reding indicates that he cannot find a disclosure or suggestion in the Claus reference that a ATR signal includes variable data.

Upon our careful review of Claus, we fail to find that Claus teaches that the ATR signal includes variable data. Furthermore, we note that independent claim 1 recites "incorporating said accessed data as part of an answer to reset signal transmitted from the card to the reader." Therefore, we find that the Examiner has failed to show that the prior art teaches this limitation.

We are not inclined to dispense with proof by evidence when the proposition at issue is not supported by a teaching in a prior art reference or shown to be common knowledge of unquestionable demonstration. Our reviewing court requires this evidence in order to establish a *prima facie* case. *In re Piasecki*, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984); *In re Knapp-Monarch Co.*, 296 F.2d 230, 232, 132 USPQ 6, 8 (CCPA 1961); *In re Cofer*, 354 F.2d 664, 668, 148 USPQ 268, 271-72 (CCPA 1966). Furthermore, our

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reviewing court states in *In re Piasecki*, 745 F.2d at 1472, 223  
USPQ at 788 (Fed. Cir. 1984) the following:

The Supreme Court in *Graham v. John Deere Co.*, 383 U.S.  
1, 86 S.Ct. 684, 15 L.Ed.2d 545, 148 USPQ 459 (1966),  
focused on the procedural and evidentiary processes in  
reaching a conclusion under section 103. As adapted to  
*ex parte* procedure, *Graham* is interpreted as continuing  
to place the "burden of proof on the Patent Office which  
requires it to produce the factual basis for its  
rejection of an application under sections 103 and 103."  
*Citing In re Warner*, 379 F.2d 1011, 1016, 154 USPQ 173,  
177 (CCPA 1967).

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We have not sustained the rejection of claims 1 through 17 under 35 U.S.C. § 103. Accordingly, the Examiner's decision is reversed.

**REVERSED**

Michael R. Fleming	)	
Administrative Patent Judge	)	
	)	
	)	
Anita Pellman Gross	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
Stuart S. Levy	)	
Administrative Patent Judge	)	

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