THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES A. CAMPO, DONALD M. EMBREE,
DONALD I. SLOAN, ROGER H. RAMSEY,
ROBERT G. MARTINEZ, and DENNIS M. FUTO

Appeal No. 98-0588
Application 08/501,293[1]

ON BRIEF

Before: McKELVEY, Senior Administrative Patent Judge, and SCHAFER and LEE, Administrative Patent Judges.

LEE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 21-40. Claims 1-20 have been canceled. No claim has been allowed.

References relied on by the Examiner

Moellering	Patent 3,826,900	July 30, 1974

[1] Application for patent filed July 12, 1995.

Tremmel et al. (Tremmel) Patent 4,418,277 Nov. 29, 1983

Shepard et al. (Shepard) Patent 5,130,520 July 14, 1992

Tymes Patent 5,157,687 Oct. 20, 1992

Reddersen et al. (Reddersen) Patent 5,347,113 Sep. 13, 1994

The Rejections on Appeal

In the final office action, the examiner finally rejected claims 21-40 "as set forth previously" and explicitly rejected claims 21-40 as being unpatentable over Reddersen in view of Tymes, Tremmel, Moellering and Shepard. (Paper No. 12 at 2). In the previous office action, the examiner rejected claims 21, 37 and 40 under 35 U.S.C. § 102(e) as being anticipated by Reddersen, and also rejected claims 22-36, 38 and 39 under 35 U.S.C. § 103 as being unpatentable over Reddersen in view of "the prior art of record in the parent". (Paper No. 7 at 2).

We decline to speculate as to the precise ground of rejection for claims 22-36, 38 and 39. The case will be remanded to the examiner for a clearer statement of the applicable ground of rejection and the reasons therefore, after we have reviewed the other grounds of rejection on appeal.

The Invention

The invention is directed to a portable bar code scanner that decodes information contained in a control bar code that is associated with a host computer, and configures itself based on that information in order to communicate with the host computer. The independent claims 21, 37 and 40 are reproduced below:

21. Apparatus for scanning bar codes, comprising:

one or more host computers, each host computer having an associated radio receiver configured to receive data over a predetermined communication channel;

a control bar code associated with each host computer, the control bar code containing information identifying a predetermined communication channel associated with the associated host computer; and

a portable bar code scanner having a decoding device that decodes the information in a bar code and a radio transmitter configured to transmit data over a selected one of a plurality of communication channels, wherein the portable bar code scanner, upon decoding a control bar code associated with a selected host computer, configures its radio transmitter to communicate with the radio receiver associated with the selected host computer, such configuring including selecting the predetermined communication channel of that radio receiver, based on the information contained in the decoded control bar code.

37. A method for configuring a portable bar code scanner of a kind having a bar code scanning device, a bar code decoding device and a radio transmitter that transmits data over a selected one of a plurality of communication channels to communicate with a selected host computer via an associated radio receiver that receives data over a predetermined communication channel, comprising:

providing a control bar code that carries information identifying the communication channel of an associated host computer;

causing the portable bar code scanner to scan the control bar code associated with a desired host computer and to decode the information contained in the control bar code, to identify the communication channel associated with the hose (sic) computer; and

configuring the bar code scanner's radio transmitter to communicate with the selected host computer, such configuring including selecting the communication channel of the radio receiver associated with that host computer.

40. Apparatus for scanning bar codes, comprising:

one or more host computers, each host computer having an associated radio receiver configured to receive data over a communication channel;

a control bar code associated with each host computer, the control bar code containing information identifying a predetermined parameter associated with the associated host computer; and

a portable bar code scanner having a decoding device that decodes the information contained in a bar code and a radio transmitter configured to transmit data over the communication channel, wherein the portable bar code scanner, upon decoding a control bar code associated with a selected host computer, configures itself by selecting the parameter associated with that host computer, based on the information contained in the decoded control bar code.

Opinion

We reverse the rejection of claims 21, 37 and 40 under 35 U.S.C. § 102(e) as being anticipated by Reddersen. We affirm the rejection of claims 21, 24-37, 39 and 40 under 35 U.S.C. §

103 over Reddersen in view of Tymes, Tremmel, Moellering and Shepard. We reverse the rejection of claims 22, 23, and 38 under 35 U.S.C. § 103 over Reddersen in view of Tymes, Tremmel, Moellering and Shepard. Our decision sustaining the obviousness rejection of claims 21, 24-37, 39 and 40 is based only on the arguments presented by appellants in their briefs. Arguments not raised are not before us, are not at issue, and thus are not considered.

The anticipation rejection

Anticipation is established only when a single prior art reference discloses, either expressly or under the principles of inherency, each and every element of the claimed invention. In re Spada, 911 F.2d 705, 707, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990); RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed.Cir. 1984). See also In re King, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986); Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984). The prior art reference must either expressly or inherently describe each and every limitation in a claim. Verdegaal Bros. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Claims 21, 37 and 40 recite a portable bar code scanner

having a radio transmitter. We interpret the language of independent claims 21, 37 and 40 to mean that the transmitter is part of the scanner, and find that Reddersen fails to teach this configuration. Reddersen does discuss RF transmission between the scanner and the host computer, but in that context, Reddersen fails to describe that a radio transmitter is part of the scanner. What Reddersen does describe is that the center of the interconnect cable 38, which is connected to the scanner (Reddersen, Figs. 1 and 2), "may comprise any suitable transmission medium including a … radio frequency link." (Reddersen column 5, lines 35-38). However, Reddersen does not describe that the transmitter for such a link is part of the scanner. Further, Reddersen describes that the scanner may be connected by a connector cable to a given communication module, such as an RF transmitter. (Reddersen, column 6, lines 12-23). Here, Reddersen explicitly describes a transmitter separate from the scanner.

Because Reddersen does not teach a bar code scanner having a radio transmitter as recited in independent claims 21, 37 and 40, the anticipation rejection of claims 21, 37 and 40 cannot be sustained.

The obviousness rejection

Claims 21, 24-37, 39 and 40

The examiner finally rejected claims 21, 24-37, 39 and 40 as being unpatentable under 35 U.S.C. § 103 over Reddersen in view of Tymes, Shepard, Tremmel, and Moellering. In the examiner's answer, the examiner states that only Reddersen and Tymes will be discussed in order to simplify the issues. (Paper No. 21 at 2).
Therefore, our discussion is limited only to Reddersen and Tymes.

In the examiner's answer the examiner states that the claims comprehensively recite a bar code reading system as shown in Figs. 1-6 of Tymes. The examiner acknowledges that Tymes does not utilize a control bar code to configure the communication from scanner to central. However, the examiner argues that Reddersen clearly teaches this feature, in that Reddersen discloses scanning a bar code to configure a scanner's communication parameters, referring to column 8, lines 24-58 of Reddersen. The examiner concludes that it would have been obvious that Reddersen's teaching could be employed with a non-cable system such as Tymes. (Paper No. 21 at 4). We agree.

The appellants, in their brief, argue that the examiner's final rejection of the claims over Reddersen in light of

Tymes, Tremmel, Moellering and Shepard is improper, since the examiner failed to comply with 37 C.F.R. § 1.106(b), which appellants state "requires the examiner to clearly explain the pertinence of each reference." (Paper No. 17 at 6). We agree that the examiner did not make clear how the references of Tymes, Tremmel, Moellering and Shepard applied to the rejection in the final office action. However, in the examiner's answer the examiner made clear the rejection and the pertinence of Reddersen and Tymes. (Paper No. 21 at 4). Furthermore, the appellants responded to the examiner's particular comments regarding the Tymes and Reddersen references in a Reply Brief. (Paper No. 22). Therefore, the appellants' arguments in the brief that the examiner failed to comply with 37 C.F.R. § 1.106(b) are moot. Through the examiner's answer, the examiner did describe the pertinence of Reddersen and Tymes.

In the appellants' reply brief, the appellants argue that neither Reddersen nor Tymes discloses: 1) a scanner capable of selecting between a plurality of host computers, 2) incorporating radio transmitters within the scanner and within each host computer, and 3) a radio transmitter within the scanner that could be programmed to a particular one of a plurality of communication channels, which is associated with

the selected host computer. (Paper No. 22 at 3).

We will first address appellants' second argument and then address appellants' first and third arguments together. While we agree with appellants that Reddersen does not teach a scanner having a transmitter, or a host computer having a receiver, we disagree with appellants that Tymes fails to teach these features. Tymes generally teaches a data transmission system for linking a plurality of bar code readers with a host computer through intermediate computers, or intermediate base stations. The bar code readers communicate with the intermediate computers over an RF link. (Tymes at abstract). The bar code readers have a radio transceiver 44 which, depending on a switch setting, functions as both a radio receiver and radio transmitter, for receiving information from the intermediate computers and for transmitting information to the intermediate computers. (Tymes, Fig. 4, column 8, lines 41-45, Fig. 9, column 15, lines 58-60). Tymes further describes that the radio transceiver 44 and the antenna 45 are contained within the scanner housing shown in Fig. 5. (Tymes, Fig. 5, column 10, lines 45-50).

Tymes further teaches that associated with each intermediate computer is a radio transceiver 34 connected to

an antenna 35 for RF transmission to and reception from the remote units 15. (Tymes, column 6, lines 66 to column 7, line 2, Fig. 10, column 17, lines 16-21). The transceivers of the scanners and the intermediate computers are configured so that the intermediate computers and the bar code readers communicate with each other. (Tymes, column 2, lines 38-43). Tymes also describes that data is transmitted from the reader when the communication channel is free for receipt of data by the computer. (Tymes, column 5, lines 39-67). It follows that Tymes clearly describes a wireless communications system between a scanner and a computer, where the scanner has a radio transceiver and the computer has a radio transceiver which are configured to communicate with one another over a communication channel.

As to appellants' first argument, we find that Reddersen explicitly teaches a scanner capable of selecting between a plurality of host computers. Further as to appellants' final argument, we find that although neither Reddersen nor Tymes alone teach a radio transmitter within the scanner that could be programmed to a particular one of a plurality of communication channels, in combination, the references suggest appellants' claimed invention as recited in independent claims 21, 37 and 40.

Reddersen describes an interface selection and configuration system for a peripheral device, such as a bar code scanner, in which configuration for the scanner and/or the host computer may at least in part be accomplished by scanning a bar code. (Reddersen, column 2, lines 20-27). In particular, Reddersen discloses that when a user desires to select or switch to a particular host computer, the scanner may be configured for the selected computer by selecting the correct interconnect cable. (Reddersen, column 4, lines 27-35, column 5, lines 51-59). More importantly, Reddersen discloses that the scanner may additionally, or alternately be configured for the selected host computer by scanning a bar code label, which may be attached to the interconnect cable. (Reddersen, column 7, lines 55-59). Reddersen claim 13, for example, recites: "… a label with configuration data encoded thereon, the configuration data comprising information used by the handheld data reader unit to configure itself for the given host…" (Reddersen, column 12, lines 11-14). Further, Reddersen discloses that the scanner can configure its communication parameters upon scanning a bar code. (Reddersen, column 8, lines 24-43).

From the above, it is clear that Reddersen discloses a scanner capable of selecting between a plurality of host

computers. The scanner "selects" between a plurality of host computers upon scanning the bar code associated with a selected computer and configures itself in order to communicate with the selected computer. Similarly, appellants' own claims and disclosure disclose that the scanner "selects" between a plurality of host computers upon scanning the bar code associated with a selected computer and configures itself in order to communicate with the selected computer.

Lastly, we agree with the examiner that "the Reddersen system could obviously be employed with a 'non-cable' system such as Tymes." (Paper No. 21 at 4). As even suggested in Tymes, wireless scanner systems are desirable over scanner systems with cables, since a user of such a wireless scanner may be free to move about. (Tymes, column 1, lines 19-24 and column 3, lines 38-41). We further conclude that it would have been obvious to configure a wireless scanner's transmitter to a particular communication channel upon scanning a bar code to communicate with a selected host computer, since Reddersen generally teaches a scanner scanning a bar code and configuring its communication parameters based on the bar code information.

Based on the record before us, the appellants have failed

to rebut the examiner's prima facie case of obviousness. The appellants merely argue against the references individually and do not focus on the combination of the references. Appellants cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

For the foregoing reasons, the rejection of claims 21, 24-37, 39 and 40 under 35 U.S.C. 103 over Reddersen in view of Tymes, Tremmel, Moellering and Shepard is affirmed.

Claims 22, 23 and 38

The appellants separately argue the features recited in claims 22 and 38 and also separately argue the features recited in claim 23. (Paper No. 17 at 8 and 9). As to these additional limitations, the examiner has failed to make a prima facie case of obviousness. Because the examiner has failed to show how either Reddersen or Tymes meet the additional limitations of claims 22, 23, and 38, the obviousness rejection of claims 22, 23 and 38 is reversed.

Conclusion

The rejection of claims 21, 37 and 40 under 35 U.S.C. § 102(e) as being anticipated by Reddersen is reversed. The rejection of claims 21, 24-37, 39 and 40 under 35 U.S.C. § 103 over Reddersen in view of Tymes, Tremmel, Moellering and Shepard is affirmed. The rejection of claims 22, 23 and 38 under 35 U.S.C. § 103 over Reddersen in view of Tymes, Tremmel, Moellering and Shepard is reversed.

The case is remanded to the examiner for a clearer statement of the outstanding rejection of claims 22-36, 38 and 39 over Reddersen in view of "the prior art of record in the parent." The examiner should consider, in light of this opinion, whether to maintain this rejection. If, upon consideration of our opinion, the examiner decides to maintain the rejection, the examiner should make clear the ground of rejection as well as the rationale for the rejection.

AFFIRMED-IN-PART and REMANDED

FRED E. McKELVEY, Senior Administrative Patent Judge	)	
RICHARD SCHAFER Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES

)
)
)
JAMESON LEE)
Administrative Patent Judge)

SHEPPARD, MULLIN, RICHTER & HAMPTON
333 South Hope Street, 48th Floor
Los Angeles CA 90071