

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(2) is not binding precedent of the Board.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

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MASARU KITO

Appeal No. 1998-0995
Application 08/387,298

HEARD: October 11, 2000

Before JERRY SMITH, FLEMING and BLANKENSHIP, **Administrative Patent Judges.**

FLEMING, **Administrative Patent Judge.**

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 6, 10, 15 through 17, 20 and 21, all the claims pending in the present application. Claims 1 through 5, 7 through 9, 11 through 14, 18 and 19 have been canceled.

The invention relates to a bar code reader which is capable of scanning and reading a bar code by employing, for example, a hand held laser scanner or the like and to method of reading a bar code.

Independent claim 6 is reproduced as follows:

6. A bar code reader comprising:

a transmitter including a light source,

a vibrating mirror which scans bar codes using a light beam from said transmitter and collects light reflected by the bar codes,

a receiver made up of a light sensor which converts the reflected light that is collected into electrical signals,

a decoder which converts the electrical signals from said receiver into data characters,

determining means for determining a time period in which there is no change in the amount of the reflected light, and

a vibration angle adjuster means for scanning the bar codes while changing the angle of vibration of said vibrating mirror, wherein said vibration angle adjuster means stepwisely decreases the angle of vibration of the vibrating mirror in order to stepwisely decrease the scanning region for the bar codes when said determining means determines said time period to be longer than a first predetermined value.

The Examiner relies on the following references:

Bianco et al. (Bianco) 5,115,121 May 19, 1992

Roger C. Palmer, The Bar Code Book, pgs. 28-35 and 69-75 (2nd ed. 1991) (Palmer)

Claims 6 and 10 stand rejected under 35 U.S.C. § 103 as being unpatentable over Bianco.

Claims 15 through 17, 20 and 21 stand rejected under 35 U.S.C. § 103 as being unpatentable over Bianco in view of Palmer.

Rather than reiterate the arguments of Appellant and the Examiner, reference is made to the briefs¹ and answer for the respective details thereof.

OPINION

We will not sustain the rejection of claims 6, 10, 15 through 17, 20 and 21 under 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'

¹ The Appellant filed an appeal brief on May 23, 1997, and filed a reply brief on October 29, 1997. The Examiner mailed an Office communication on February 2, 1998 stating that the reply brief had been received and entered into the file.

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of the invention.” ***Para-Ordnance Mfg. v. SGS Importers Int'l, Inc.***, 73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995), ***cert. denied***, 519 U.S. 822 (1996) ***citing W.L. Gore & Assoc., 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 and pages 3 through 7 of the reply brief, Appellant argues that the prior art fails to teach or suggest a time period in which there is no change in the amount of reflected light from the bar codes nor changing a mirror vibration angle by stepwisely decreasing the scanning region in response to such a determination. Appellant points out that Appellant's claim 6 recites

determining means for determining a time period in which there is no change in the amount of the reflected light, and . . . vibration angle adjuster means [which] stepwisely decreases the angle of vibration of the vibrating mirror in order to stepwisely decrease the scanning region for the bar codes when said determining means determines said time period to be longer than a first predetermined value.

Appellant further points out that claim 10, the other independent claim, recites

detecting a time period in which there is no change in the amount of the reflected light when the scanning beam is scanning the bar codes wherein when said time period is longer than a first predetermined value.

Appellant further points out that claim 10 recites an additional step which includes

decreasing the angle of vibration of the vibrating mirror so as to stepwisely decrease the scanning region for the bar codes.

Upon our careful review of Bianco we fail to find that Bianco teaches a determining

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means for determining a time period in which there is no change in the amount of reflected light and a vibration angle adjuster means for scanning the bar

codes while changing the angle of vibration of the vibrating mirror, wherein said vibrating angle adjuster means stepwisely decreases the angle of vibration of the vibrating mirror in order to stepwisely decrease the scanning region for the bar codes when said determining means determines said time period to be longer than a predetermined value.

Furthermore, we fail to find that Bianco suggests such a modification.

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 reviewing court states in *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984) the following:

The Supreme Court in *Graham v. John Deere Co.*, 383 U.S. 1 (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 102 and 103". *Citing In re Warner*, 379 F.2d

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1011, 1016, 154 USPQ 173, 177 (CCPA 1967).

In regards to the rejection of claims 15 through 17, 20 and 21 under 35 U.S.C. § 103 as being unpatentable over Bianco in view of Palmer, we fail to find that Bianco or Palmer suggest the above discussed Examiner's modification. Therefore, we will not sustain this rejection for the same reasons as above.

In view of the foregoing, we have not sustained the rejection of claims 6, 10, 15 through 17, 20 and 21 under 35 U.S.C. § 103. Accordingly, the Examiner's decision is reversed.

REVERSED

JERRY SMITH)	
Administrative Patent Judge)	
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MICHAEL R. FLEMING)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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HOWARD B. BLANKENSHIP)
Administrative Patent Judge)

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