

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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 SHERMAN M. CHOW,
NUR M. SERINKEN, and SEYMOUR SHLIEN

Appeal No. 1998-3332
Application No. 08/643,961

ON BRIEF

Before FLEMING, HECKER, and BARRY, Administrative Patent Judges.
BARRY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the rejection of claims 3, 11-16, 31, and 32. We reverse.

BACKGROUND

The invention at issue in this appeal relates to identification (ID) instruments. ID instruments, e.g., passports, credit cards, driver's licences, and building passes, are ubiquitous. Unfortunately, such instruments often

are illegally fabricated or stolen and altered for fraudulent use.

The appellants' invention creates and authenticates an ID instrument that resists falsification. Such an instrument carries a legitimate holder's photograph or signature, his personal data, and an encrypted machine readable security code. The code comprises a combination of digitized forms of the photograph or signature and biographical data.

Claim 11, which is representative for our purposes, follows:

11. A method of creating a personal identification instrument on which personal data and at least one of a picture and signature of a legitimate holder are retained, comprising the steps of:

(a) acquiring a first digital representation of at least one of a picture and signature of said legitimate holder of said instrument,

(b) extracting first feature data from said digital representation,

(c) combining said feature data with said personal data into a single data sequence,

(d) generating a security code by encrypting said single data sequence using a private secret key of a kind for which decrypting using a public key would allow authentication of the instrument, and

(e) affixing the personal data, and said at least one of a picture and a signature of a legitimate holder and said encrypted security code to the instrument to provide a substantially forgery-proof instrument.

Besides the appellants' admitted prior art (AAPA), the prior art of record relied on in rejecting the claims follows:

Bonicalzi et al. (Bonicalzi)	4,179,686	Dec. 18, 1979
Lee	4,180,207	Dec. 25, 1979
Silverman et al. (Silverman)	4,213,038	July 15, 1980
Nathans	4,972,476	Nov. 20, 1990
Petajan	4,975,960	Dec. 4, 1990.

Claims 11, 12, 16, 31, and 32 stand rejected under 35 U.S.C. § 103 as being obvious over Nathans, AAPA, and either Lee or Silverman. Claims 3 and 13-15 stand rejected under § 103 as being obvious over Nathans, Bonicalzi, AAPA, Petajan, and

either Lee or Silverman. Rather than reiterate the arguments of the appellants or examiner in toto, we refer the reader to the briefs and answer for the respective details thereof.

OPINION

In deciding this appeal, we considered the subject matter on appeal and the rejection advanced by the examiner. Furthermore, we duly considered the arguments and evidence of the appellants and examiner. After considering the record, we are persuaded that the examiner erred in rejecting claims 3, 11-16, 31 and 32. Accordingly, we reverse.

We begin by noting the following principles from In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993).

In rejecting claims under 35 U.S.C. Section 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).... "A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." In re Bell, 991 F.2d 781, 782, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) (quoting In re Rinehart,

531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976)).

With these principles in mind, we consider the examiner's rejection and the appellants' arguments.

The examiner alleges, "[c]ol. 7 of Nathans describes the embodiment where the PIN is stored as a control code which is combined with the scrambled code to form a data sequence." (Examiner's Answer at 7.) He further alleges, "it would have been obvious ... to have utilized the well known private/public encryption technique in the above system in order to improve security of the data stored." (Id.) The appellants argue, "none of th[e] teaching of Nathans is the equivalent of 'acquiring a first digital representation of at least one of a picture and signature of said legitimate holder, and extracting first feature data from said digital representation, combining the feature data with personal data into a single data sequence, and then encrypting the combined single data sequence'. The combination of the admitted prior art and either Lee or Silverman does not overcome the deficiencies of Nathans." (Reply Br. at 5.) They also argue,

"there is no suggestion in the references as to the desirability [sic] and thus the obviousness of making this combination of references." (Appeal Br. at 15.)

"`[T]he main purpose of the examination, to which every application is subjected, is to try to make sure that what each claim defines is patentable. [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)(quoting Giles S. Rich, The Extent of the Protection and Interpretation of Claims--American Perspectives, 21 Int'l Rev. Indus. Prop. & Copyright L. 497, 499, 501 (1990)). Here, claims 3, 11-15, and 32 specify in pertinent part the following limitations: "(a) acquiring a first digital representation of at least one of a picture and signature of said legitimate holder of said instrument, (b) extracting first feature data from said digital representation, (c) combining said feature data with said personal data into a single data sequence, (d) generating a security code by encrypting said single data sequence" Similarly, claims 16 and 31 specify in pertinent part the following limitations: "a private secret key encrypted machine

readable security code . . . , said code being comprised of a combination of a digitized form of said personal information and a digitized descriptor of a first feature of said photograph" Accordingly, claims 3, 11-16, 31, and 32 require combining a legitimate holder's feature data and his personal data and then encrypting the combination to form a code.

The examiner fails to show a teaching or suggestion of the limitations in the prior art. "Obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor." 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, 1551, 1553, 220 USPQ 303, 311, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984)). "It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992) (citing In re Gorman, 933 F.2d 982, 987, 18 USPQ2d

1885, 1888 (Fed. Cir. 1991)). "[T]o establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000) (citing In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998) and In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984)).

Here, although Nathans teaches a legitimate holder's feature data as a "scrambled stripe[,]" col. 4, l. 44, and his personal data as a "descramble command code[,]" col. 7, ll. 15-16, both of which are recorded on an ID card (24), the scrambled stripe and descramble code are not combined. To the contrary, the code is recorded on the card separate from the stripe. Specifically, "the descramble command code could be recorded upon the magnetic stripe **31** shown in FIG. 2 during issuance of card **24**." Col. 7, ll. 15-18. Figure 2 shows that

the magnetic stripe, which stores the code, is separate from the stripe (13).

Furthermore, the examiner fails to identify a sufficient suggestion to combine the AAPA with Nathans. As aforementioned, Nathans' stripe is already scrambled, which makes it secure. It is unclear that the scrambled stripe would benefit from subsequent encryption. In addition, Nathans explains that its descramble code need not be encrypted. Specifically, "recording the descramble code upon the card, even without encrypting it, does not substantially compromise [sic] security" Col. 3, ll. 12-14. Relying on Lee and Silverman merely to "show the storage of personal information which is readable by a person in addition to being stored in a machine readable form[,]" (Examiner's Answer at 5), and on Bonicalzi and Petajan merely to show the use of grey scale, (id.), the examiner fails to allege, let alone show, that the addition of the reference cures the deficiency of Nathans and AAPA.

Because Nathans records its descramble code separate from its scrambled stripe, and there is no evidence that the AAPA's encryption would have been desirable for Nathans code and stripe, we are not persuaded that teachings from the prior art would have suggested the combination of AAPA nor the claimed limitations of "(a) acquiring a first digital representation of at least one of a picture and signature of said legitimate holder of said instrument, (b) extracting first feature data from said digital representation, (c) combining said feature data with said personal data into a single data sequence, (d) generating a security code by encrypting said single data sequence" or "a private secret key encrypted machine readable security code ..., said code being comprised of a combination of a digitized form of said personal information and a digitized descriptor of a first feature data of said photograph" Therefore, we reverse the rejection of claims 11, 12, 16, 31, and 32 as being obvious over Nathans, AAPA, and either Lee or Silverman and the rejection of claims 3 and 13-15 as being obvious over Nathans, Bonicalzi, AAPA, Petajan, and either Lee or Silverman.

CONCLUSION

In summary, the rejection of claims 3, 11-16, 31, and 32 under 35 U.S.C. § 103 is reversed.

No time for taking any subsequent action concerning this appeal may be extended under 37 C.F.R. § 1.136(a).

REVERSED

MICHAEL R. FLEMING)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
STUART N. HECKER)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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LANCE LEONARD BARRY)	
Administrative Patent Judge)	

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