

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. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN S. RICHARDS

Appeal No. 1999-1847
Application No. 08/810,581

ON BRIEF

Before JERRY SMITH, 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 7-12,¹ which are all of the claims pending in this application.

We REVERSE.

¹ Claims 1-6 and 13-15 were canceled in an after final amendment which was entered by the examiner. In this amendment, claim 10 was also amended.

BACKGROUND

The appellant's invention relates to a remote ink fountain selection method and apparatus. An understanding of the invention can be derived from a reading of exemplary claim 7, which is reproduced below.

7. A method for aiding remote ink fountain selection comprising the steps of:
 - digitizing sample images and providing each said sample image with an identification;
 - digitizing a printed signature image from a printing press which corresponds to at least one of the sample images;
 - comparing the digitized printed signature image to the digitized sample images; and
 - outputting the identification of the digitized sample image upon a match with the digitized signature image.

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Wuhrl et al. (Wuhrl)	5,163,012	Nov. 10, 1992
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Claims 7-12 stand rejected under 35 U.S.C. § 112, first paragraph as failing to provide an enabling disclosure. Claims 7-12 stand rejected under 35 U.S.C. § 102 as being anticipated or in the alternative, under 35 U.S.C. § 103(a) as obvious over Wuhrl.

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Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 14, mailed Mar. 2, 1999) for the examiner's reasoning in support of the rejections, and to the appellant's brief (Paper No. 13, filed Jan. 26, 1999) for the appellant's arguments thereagainst.

OPINION

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

35 U.S.C. § 112, FIRST PARAGRAPH

The examiner goes on at great length that the system components (software and hardwired programming) are not sufficiently disclosed as to ascertain how each performs its disclosed function. The examiner maintains that the structural connections, circuitry and cooperation are not sufficiently disclosed. (See answer at pages 4-13.) We find that the examiner has not attempted to establish why the supporting specification in combination with the relevant prior art fails to enable the claims which is the examiner's initial burden. **In re Marzocchi**, 439 F.2d 220, 223, 169 USPQ 367, 369 (CCPA 1971). From our review of the examiner rejection, the examiner maintains that the programming and

specific interconnection of the functional units “must” be disclosed in the specification. (See answer at page 8.) We disagree with the examiner. The examiner provides no reasoned analysis of why these would be needed or required. The examiner then hedges by stating that if the interconnections are not disclosed then “it is likely that undue experimentation, or more than routine experimentation would be required.” (See answer at page 9.) This likelihood is not the test for a lack of enablement. The examiner carries the initial burden to establish a case. Here, the examiner has not met his burden, and we will not sustain the rejection of claims 7-12 under 35 U.S.C. § 112, first paragraph.

However, appellant has not argued that the examiner failed to establish a *prima facie* case, but merely that the specification is enabling to those skilled in the art. (See brief at pages 3-4.) Furthermore, appellant relies on a basic example of the operation of the invention at pages 5 and 6 of the brief. Appellant cites to only specific portions of pages 5, 6, and 7 of the specification to support the example. Appellant argues that the devices in the specification and claims are standard components which are connected by standard electrical connections and that one skilled in the art would be able to make and use the invention without undue experimentation. (See brief at page 7.) We agree with appellant. Specifically, the prior art to Wuhrl applied against the claims is indicative of the level of skill in the relevant art. Wuhrl contains a similar level of description as the instant description with respect to the interconnection of standard elements and does not provide any of the

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specifics for programming these standard functional units. Similarly, we find that from the basic functional description of these standard components, it would have been obvious to one of ordinary skill in the art at the time of the invention to program and interface these components together to make and use the system to aid in the selection of ink fountains for adjustment by an operator.

35 U.S.C. § 102

"Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention."

RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984).

It is well settled that the burden of establishing a *prima facie* case of anticipation resides with the Patent and Trademark Office (PTO). **See In re Piasecki**, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). After the PTO establishes a *prima facie* case of anticipation based on inherency, the burden shifts to the appellant to prove that the subject matter shown to be in the prior art does not possess the characteristics of the claimed invention. **See In re Thorpe**, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985); **In re King**, 801 F.2d 1324, 1327, 231 USPQ 136, 138 (Fed. Cir. 1986). Hence, appellant's burden before the PTO is to prove that the applied prior art reference does not perform the functions defined in the claims. Compare **In re Best**, 562 F.2d 1252, 1255,

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195 USPQ 430, 433-34 (CCPA 1977); **In re Ludtke**, 441 F.2d 660, 664, 169 USPQ 563, 566-67 (CCPA 1971).

In the rejection, the examiner merely bodily incorporates quotations from Wuhrl (answer at pages 14-20) and then states that appellant's remarks "have been answered by the application of the reference as noted above." (See answer at page 20.) We disagree with the examiner. The examiner acknowledges appellant's argument that Wuhrl compares a single image and not plural images and that Wuhrl does not teach the use of an image comparator for comparing the signature image to a plurality of sample images, but the examiner does not provide a response to this argument or identify a teaching in Wuhrl. (See answer at page 21.) Furthermore, the examiner's prior discussion of Wuhrl with respect to the comparing step (answer at page 19) does not address this aspect of the claimed invention. The examiner maintains that the control information for control measurement points are plural samples. (See answer at page 22.) We disagree with the examiner's creative interpretation of Wuhrl. We agree with appellant that Wuhrl is not directed to plural images as recited in claim 7.

Appellant argues that Wuhrl does not teach outputting the identification of the digitized sample image upon a match with the digitized signature image. (See brief at page 9.) We agree with appellant. The examiner maintains that Wuhrl outputs correlation information to the operator. (See answer at page 22; Wuhrl at col. 8.) We disagree with

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the examiner that the correlation information is an identification which is provided with each image as recited in the first step of claim 7. Nor do we find that the coordinate points are a stored identification which is output. Since appellant has shown that the examiner has not established a ***prima facie*** case of anticipation, we will not sustain the rejection under 35 U.S.C. § 102 of claims 7-12.

35 U.S.C. § 103

“To reject claims in an application under section 103, an examiner must show an un rebutted ***prima facie*** case of obviousness. **See In re Deuel**, 51 F.3d 1552, 1557, 34 USPQ2d 1210, 1214 (Fed. Cir. 1995). In the absence of a proper ***prima facie*** case of obviousness, an applicant who complies with the other statutory requirements is entitled to a patent. **See In re Oetiker**, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). On appeal to the Board, an applicant can overcome a rejection by showing insufficient evidence of ***prima facie*** obviousness or by rebutting the ***prima facie*** case with evidence of secondary indicia of nonobviousness.” **In re Rouffet**, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1455 (Fed. Cir. 1998). Here, we agree with appellant that the examiner has not established a ***prima facie*** case of obviousness.

The examiner maintains that the teachings of Wuhrl are an “obvious patentable equivalent” to the recited claimed subject matter. (See answer at page 23.) We disagree with the examiner. The examiner further maintains that the motivation for using any desired

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images and identification data would have flowed from the substitution of equivalent image and identification data so as to obtain the expected and desired results taught by Wuhrl. We disagree with the examiner position and find that the examiner has not established a **prima facie** case of obviousness. Since the examiner has not established a **prima facie** case of obviousness, we will not sustain the rejection under 35 U.S.C. § 103 of claims 7-12.

CONCLUSION

To summarize, the decision of the examiner to reject claims 7-12 under 35 U.S.C. § 112, first paragraph is reversed, and the decision of the examiner to reject claims 7-12 under 35 U.S.C. §§102 and 103 is reversed.

REVERSED

JERRY SMITH)	
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)	

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