

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. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

**Ex parte** BURTON A. ROSENBERG

---

Appeal No. 2000-2074  
Application 09/178,070

---

ON BRIEF

---

Before FLEMING, RUGGIERO, and LALL, **Administrative Patent Judges**.  
FLEMING, **Administrative Patent Judge**.

**DECISION ON APPEAL**

This is a decision on appeal from the final rejection of claims 1-22.<sup>1</sup>

The invention relates to an identification system. The system includes counterparts; some of the counterparts (26) are attached to things (24); a counterpart (16,18), which has a known

---

<sup>1</sup> Appellant included claim 23 in the Appendix of the Reply Brief, Paper No. 25, filed November 29, 2001. Since Appellant canceled claim 23 in Paper No. 7, filed on July 15, 1999, it is not part of the appeal.

identity, is within range of electromagnetic emissions from some of the counterparts (26,20) attached to the things (24); it emits an electromagnetic code which identifies the category the counterpart belongs in; and some of the other counterparts (26,20) start to pulsate in unison because the emitted code matches their category code thereby activating their inductive pulse circuits. See Appellant's specification, page 3, lines 21-28, page 4, lines 21-23 and associated figure 1. The counterpart (16) emits a momentary irregularity in its pulsing emission; and after a varied number of pulses, the other counterparts (26,20) emit irregularities in their inductively pulsing circuits. See Appellant's specification on page 3, lines 26-29, page 4, lines 14-18 and associated figure 1. The counterpart (16) is designed to receive emissions at one particular pulse number (28) following its emitted irregularity and no other; if the other counterpart's emitted irregularity occurs at that one pulse number (28), identity is established by the reception of emissions to the counterpart (16); and after which, the counterparts (16,18) have means to indicate emissions have been sent and received, whereby identification has been validated. See Appellant's specification on page 3, lines 26-35, page 4, lines 14-16 and 26-30 and associated figure 1.

Representative independent claim 1 is present in the application is reproduced as follows:

1. An identification system comprising: Counterparts with electrical circuits in them; some of said Counterparts are attached to things; a Counterpart, which has a known identity, is within range of electromagnetic emissions from some of the Counterparts attached to said things and it emits an electromagnetic code which identifies the category the Counterpart belongs in; and some of said other Counterparts start to pulsate in unison because the emitted code matches their category code thereby activating their inductive pulse circuits; and following the category match the Counterpart with the known identity emits a momentary irregularity in its pulsing emission; after a varied number of pulses the said other Counterparts emit irregularities in their inductively pulsing circuits; said Counterpart of known identity is designed to receive emissions at one particular pulse number following its emitted irregularity and no other; and if said other Counterpart's emitted irregularity occurs at that one pulse number identity is established by the reception of emissions to said Counterpart of known identity after which the Counterparts have means to indicate emissions have been sent and received, whereby identification has been validated.

#### **References**

The references relied on by the Examiner are as follows:

Katzenstein	4,752,776	Jun. 21, 1988
Reitboeck et al. (Reitboeck)	3,832,530	Aug. 27, 1974

#### **Rejections at Issue**

Claims 1-22 stand rejected under 35 U.S.C. § 103 as being unpatentable over Katzenstein in view of Reitboeck and that which is known in the art.

Rather than repeat the arguments of Appellant or the Examiner, we make reference to the Briefs<sup>2</sup> and the Answer for the respective details thereof.

### I. OPINION

With full consideration being given to the subject matter on appeal, the Examiner's rejections and the arguments of Appellant and Examiner, for the reasons stated *infra*, we reverse the Examiner's rejection of claims 1-22 under 35 U.S.C. § 103.

We first address the rejection of claims 1-16 over Katzenstein in view of Reitboeck and that which is known in the art under 35 U.S.C. § 103. In formulating the art rejection, the Examiner has relied on Katzenstein for all the elements of independent claim 1, except for the limitation of identifying objects by counting the number of pulses transmitted. See page 4, lines 4-16 of Examiner's Answer. The Examiner cited Reitboeck

---

<sup>2</sup> Appellant filed an appeal brief on January 13, 2000, Paper No. 16. Notice of defective brief was sent to Appellant on April 12, 2000, Paper No. 18. Appellant filed a Supplemental Appeal Brief, Paper No. 20, May 6, 2000, in response to the notice. Appellant also filed a Reply Brief, Paper No. 25, on November 29, 2001, in response to the Examiner's Answer, Paper No. 21, mailed May 22, 2000 and a miscellaneous office action, Paper No. 24, mailed November 29, 2001, to include the Appendix of the claims on appeal. The Examiner stated that the reply brief has been considered and entered in Paper No. 26, mailed December 13, 2001. However as stated in footnote 1, claim 23 was canceled in Paper No. 7 and is not part of the appeal.

and well-known commercially available pulse counters discussed on page 4, lines 10-11 of Appellant's specification to teach the missing limitation of identifying objects by counting the number of pulses transmitted. See page 4, line 17 through page 5, line 2 of Examiner's Answer. The motivation provided by the Examiner to combine these references is the desirability to simplify Katzenstein's system and to make the system more reliable. See page 5, lines 2-6 of Examiner's Answer.

Appellant argues that neither Katzenstein nor Reitboeck teach the recited identification system of claim 1. Appellant states that the recited device has a source and receiver that are identified as counterparts of each other if "the RECEIVER's single emission at one pulse number occurs when the SOURCE's single receptive pulse number occurs." See page 3, line 21 through page 4, line 2 of Supplemental Appeal Brief. Appellant states that the cyclic interactions and series of signals in Katzenstein do not disclose or teach the irregular emission of one counterpart (the receiver) at a pulse number occurs when the other counterpart's (the source) single receptive pulse number occurs as recited in claim 1. See page 4, lines 1-2 of Supplemental Appeal Brief. Additionally, Appellant asserts that Reitboeck's identification system uses succession of pulses to

Appeal No. 2000-2074  
Application 09/178,070

serve as code unlike Appellant's system, which "identifies by emission of an irregularity and reception of that irregularity when its counterparts are at the one pulse number[.]" See page 4, lines 15-17 of Supplemental Appeal Brief.

As pointed out by our reviewing court, we must first determine the scope of the claim. "[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). In addition, claims are to be interpreted as the terms reasonably allow. *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). Also, "[i]t is axiomatic that, in proceedings before the PTO, . . . that claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art." *In re Sneed*, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983).

Claim 1 recites "Counterpart of known identity is designed to receive emissions at one particular pulse number following its emitted irregularity and no other; and if said other Counterpart's emitted irregularity occurs at the one pulse number, identity is established by the reception of emissions to said Counterpart of known identity after which the Counterparts have means to indicate emissions have been sent and received,

Appeal No. 2000-2074  
Application 09/178,070

whereby Identification has been validated." Taking a reasonably broad interpretation, claim 1 requires the counterpart of known identity to be designed to receive emissions at one particular pulse number *and no other* after an irregularity has been emitted from the counterpart and if the other counterpart's emitted irregularity occurs at the pulse number, identification between the counterparts is established. Additionally when reading the limitation, "Counterpart of known identity is designed to receive emissions at one particular pulse number and no other," in light of Appellant's specification, page 3, lines 33 through 35 describe the one pulse number to be the number of pulses for a particular category of things. Thus, the phrase, "Counterpart of known identity is designed to receive emissions at one particular pulse number . . . and no other" in claim 1, would be interpreted by one of ordinary skill in the art as being designed to receive emission at a particular number of pulses and no other number of pulses.

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a *prima facie* case of obviousness. **In re Oetiker**, 977 F.2d 1443, 1445, 24 USPQ 1443, 1444 (Fed Cir. 1992). See also **In re Piasecki**, 745 F.2d 1468,

Appeal No. 2000-2074  
Application 09/178,070

1472, 223 USPQ 785, 788 (Fed Cir. 1984). The Examiner can satisfy this burden by showing that some objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art suggests the claimed subject matter. **In re Fine**, 87 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the Appellants. **Oetiker**, 977 F.2d at 1445, 24 USPQ at 1444. See also **Piasecki**, 745 F.2d at 1472, 223 USPQ at 788.

An obviousness analysis commences with a review and consideration of all the pertinent evidence and arguments. "In reviewing the [E]xaminer's decision on appeal, the Board must necessarily weigh all the evidence and arguments." **In re Oetiker**, 977 F.2d at 1445, 24 USPQ2d at 1444. "[T]he Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion." **In re Lee**, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002). With these principles in mind, we commence review of the pertinent evidence and arguments of Appellant and Examiner.

Upon consideration, we fail to find that Katzenstein, Reitboeck or that which is known in the art teach the limitation, "Counterpart of known identity is designed to receive emissions at one particular pulse number . . . and no other; and if said other Counterpart's emitted irregularity occurs at that one pulse number identity is established by the reception of emissions to said Counterpart of known identity after which the Counterparts have means to indicate emissions have been sent and received, whereby Identification has been validated" found in claim 1. The Examiner states that Katzenstein does not disclose this limitation by acknowledging that the device does not identify objects by counting the number of pulses. Thus, our analysis turns on whether Reitboeck or that which is known in the art teach the missing element of claim 1.

Reitboeck teaches an identification system that does count the number of pulses and does use the number of pulses to constitute an identifying code. See Abstract, lines 19-20 and column 2, lines 5-8 and 53-59 of Reitboeck. However, Reitboeck teaches counting and receiving any number of pulses that serve as code for identifying objects and not to receive one and no other number of pulses. On the other hand, the recited claim requires the counterpart of known identity to be designed to receive

Appeal No. 2000-2074  
Application 09/178,070

emission "at *one particular pulse number and no other*" (emphasis added). Therefore, we do not find that Reitboeck teaches an identification system with the limitation, "Counterpart of known identity is designed to receive emissions at one particular pulse number . . . and no other."

Additionally, the known prior art described on page 4, lines 10 through 11 of Appellant's specification does not teach or suggest that a counterpart is designed to receive emissions at only one particular pulse number or number of pulses and no other. This description is only a general teaching that pulse counters are well known technology.

Since we do not sustain the rejection of claim 1, the rejection of dependent claims 2-16 is also not sustainable.

We next turn to the rejection of claims 17-22 also rejected under 35 U.S.C. § 103 as being obvious over Katzenstein in view of Reitboeck and that which is known in the art. Independent claim 17 also includes the limitation, "Counterpart of known identity is designed to receive emissions at one particular pulse number . . . and no other; and if said other Counterpart's emitted irregularity occurs at the one pulse number, identity is established by the reception of emissions to said Counterpart of known identity after which the Counterparts have means to

Appeal No. 2000-2074  
Application 09/178,070

indicate emissions have been sent and received, whereby Identification has been validated." Thus for the same reasons, we fail to sustain the rejection of claim 17 under 35 U.S.C. § 103. In accordance, the rejections of dependent claims 18-22 are also not upheld.

As such, we find that the Examiner has not met the burden for establishing a ***prima facie*** case of obviousness of claims 1 through 22 based on the combination of Katzenstein, Reitboeck and admitted prior art. None of the references provide the requisite findings or reasons by which the findings support the conclusion that the references teach limitation of a "Counterpart of known identity is designed to receive emissions at one particular pulse number . . . and no other; and if said other Counterpart's emitted irregularity occurs at the one pulse number, identity is established by the reception of emissions to said Counterpart of known identity after which the Counterparts have means to indicate emissions have been sent and received, whereby Identification has been validated."

Appellant also states that the Examiner erred by refusing entry of an amendment after final on the basis that the amendments raise new issues and the question of new matter. See page 3, lines 4-6 and page 4, lines 3-6 of Supplemental Appeal

Appeal No. 2000-2074  
Application 09/178,070

Brief. We find that Appellant's concern with the entrance of an amendment after final rejection are not appropriate for the Board to consider and are directed toward petitionable subject matter. Therefore, this issue will not be further considered.

In view of the foregoing, the decision of the Examiner rejecting claims 1-22 under 35 U.S.C. § 103 is reversed.

**REVERSED**

MICHAEL R. FLEMING	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
JOSEPH F. RUGGIERO	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
	)	
PARSHOTAM S. LALL	)	
Administrative Patent Judge	)	

MRF:pgg  
Burton A. Rosenberg  
1053 marina Heights Road

Appeal No. 2000-2074  
Application 09/178,070

Brookings OR 97415