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 WOLFGANG WEBER and MANFRED BACHHUBER

Appeal No. 2001-2526
Application No. 08/823,183

Heard: January 7, 2003

Before HAIRSTON, DIXON, and SAADAT, **Administrative Patent Judges**.

DIXON, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-22, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

Appellants' invention relates to a device for identifying objects undergoing a machining process. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

> 1. A device for identifying an object undergoing machining processes, the device comprising:
>
> a conveyor line;
>
> a carrier mechanically linked to and moved along the conveyor line, said object undergoing machining processes being located on the carrier;
>
> a marking carrier mounted on the carrier such that it is associated with the object;
>
> an optical imaging device located below said conveyor line; and
>
> a transparent plate arranged between the optical imaging device and the marking carrier, the optical imaging device being directed upwardly at the marking carrier mounted on the carrier to form a visual link through the transparent plate.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

McJohnson et al. (McJohnson)	4,644,143	Feb. 17, 1987
Abe et al. (Abe)	4,837,904	Jun. 13, 1989
Nakamura et al. (Nakamura)	5,347,463	Sep. 13, 1994

Claims 1, 2, 5, 6, 9, 10, 13-17, and 19-22 stand rejected under 35 U.S.C. § 103 as being unpatentable over Nakamura in view of McJohnson. Claims 3, 4, 7, 8, 11, 12,

and 18 stand rejected under 35 U.S.C. § 103 as being unpatentable over Nakamura in view of McJohnson further in view of Abe.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 23, mailed Apr. 11, 2001) for the examiner's reasoning in support of the rejections, and to appellants' brief (Paper No. 22, filed Dec. 26, 2000) and reply brief (Paper No. 24, filed May 22, 2001) for appellants' arguments thereagainst.

OPINION

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

With respect to independent claim 1, the examiner maintains that Nakamura teaches the basic system of the claimed invention, but does not teach the use of a transparent plate used with the imaging system and the optical imaging device directed upwardly at the marking carrier mounted on the carrier to form a visual link through the transparent plate. The examiner maintains that McJohnson teaches the use of a barcode reading device for objects mounted on a carrier which are undergoing machining operations. Additionally, the examiner maintains that a transparent plate is

used and the imaging system is directed upward through the plate to form an optical link.

We note that the examiner asserts that "except for certain details, the claim departs little from a grocery check-out scanner." (See answer at page 6.) Additionally, the examiner maintains that "Appellant's figure 1 resembles a very large grocery store scanner system used for full size cars." (See answer at page 6.) While this may or may not be true, the examiner has not expressly set forth a rejection based upon a grocery store check-out system and has cited and applied no prior art beyond the teachings of McJohnson in the background discussion of the prior art. Therefore, we will not address arguments thereto. In the discussion in the arguments section, the examiner mentions the Tooley reference (5,252,814) and Gitin (5,406,060) but states that they were not relied upon because the examiner deemed it unnecessary. (See answer at page 10.) Since the examiner has not deemed it necessary to apply these references, we will not address any relevance of these references to the claimed invention.

Appellants argue that it is not sufficient for the examiner to pick and choose among various references to arrive at the claimed invention and that the examiner has relied upon improper hindsight to reconstruct the claimed invention. (See brief at pages 4-5.) We agree with appellants. Appellants argue that Nakamura teaches a conventional vehicle body manufacturing system with the photocell hanger reader

located on the side of the conveyer system and suffers from the disadvantages discussed by appellants' background section. From our review of Nakamura, we agree with appellants that Nakamura teaches the mounting of the tag so as to be read from the side by a sensor. Appellants argue that the reader of McJohnson is for a static bar code reader and that McJohnson teaches the use of a system for reading where movement of the boxes and barcodes would generate dust particles and would interfere with the manufacturing process. (McJohnson at column 1.) Additionally appellants argue that neither imaging system of Nakamura and McJohnson teaches to direct upwardly its imaging device. (See brief at pages 6-7.) Appellants argue that the imaging device in McJohnson is a CCD element which is arranged to receive horizontal light. We agree with appellants on all of the above arguments.

Additionally, appellants argue that there is no suggestion or motivation to combine the teachings of Nakamura and McJohnson. (See brief at pages 5-7.) We agree with appellants, that the examiner has not adequately set forth a convincing motivation, suggestion or line of reasoning for combining the teachings of McJohnson with those of Nakamura. From our review of the examiner's answer, we find no statement by the examiner in the statement of the rejection of a convincing motivation, suggestion or line of reasoning for combining the teachings of McJohnson with those of Nakamura.

At pages 6-7 of the answer, the examiner goes on at length about his predisposition toward the obviousness of the claimed invention and its remarkable similarity to a grocery store checkout. While this similarity may be true, the examiner has not set forth a rejection and has relied upon no tangible piece of evidence/teaching to support such a conclusion. Therefore, we have no evidence to evaluate and no teaching to which appellants may evaluate and rebut. As to such a rejection, we make no express findings, but we do note that Tooley (5,252,814) teaches and suggests the use of automated scanning from beneath of articles being conveyed in the checkout.

The examiner maintains that the hindsight argument should be the last line of defense/argument for appellants and addresses it last. (See answer at page 7.) While this may be true in most cases, it is appellants' decision as to which argument(s) to advance, and in light of a lack of an express statement of motivation for the combination, we do not find that it is a last line of defense, but an attempt to show that the examiner has not set forth a ***prima facie*** case of obviousness. The examiner goes on at length about the combination of Nakamura and McJohnson at pages 8-10 of the answer, but still does not address why it would have been obvious to one of ordinary skill in the art at the time of the invention, to move the sensor from the side of the carrier and conveyer and to position the imaging sensor so as to be "directed upwardly at the marking carrier" as recited in independent claim 1. The reason for the position of the sensor in McJohnson is due to the stationary placement of the bins of product

and a desire to limit movement in that manufacturing environment. In the system and environment of Nakamura, there is no such motivation, and we find that the examiner has not addressed this change. The examiner concludes at page 10 of the answer that McJohnson teaches the details of the scanner and that McJohnson is not an isolated teaching of the details of the scanner. While we agree with the examiner, it is the details of McJohnson that we are limited to address in the combination. If the examiner desired additional details and motivations, then the examiner is required to apply them in the combination so that appellants may clearly address them and attempt to rebut their teachings and the combination thereof .

The examiner seems to suggest that the height of the scanner is not shown in Figure 9 of Nakamura and Figure 8 more clearly shows the height of the scanner. With the specific placement of the scanner unclear, the examiner concludes the discussion by stating that both Figures are schematics that are subject to obvious variations and are equivalent configurations. Here, we are again left wondering what was the examiner's point, and it appears that it is the examiner's predisposition rather than the teachings of the references that are driving the rejection. Therefore, we agree with appellants that the examiner has neither set forth an adequate statement of motivation for the combination of teachings nor a convincing line of reasoning for the combination of teachings of Nakamura and McJohnson. Therefore, the examiner has not set forth a ***prima facie*** case of obviousness, and we will not sustain the rejection of independent claims 1, 9, 13, and 14 and their respective dependent claims.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-22 under 35 U.S.C. § 103 is reversed.

REVERSED

KENNETH W. HAIRSTON Administrative Patent Judge	)
JOSEPH L. DIXON Administrative Patent Judge	) BOARD OF PATENT) APPEALS) AND) INTERFERENCES
MAHSHID D. SAADAT Administrative Patent Judge	)

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