

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PAUL STOLIS, JOHN D. VALA
CLIVE E. CATCHPOLE,
JOHAN P. BAKKER,
GARY B. COPENHAVER,
DAVID J. CONCANNON,
ROBERT T. ROURKE,
and DAVID J. VALICE

Appeal No. 94-3631
Application 07/883,513¹

ON BRIEF

Before HAIRSTON, JERRY SMITH and CARMICHAEL, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-15 and 22-33, which constitute all the claims remaining in the application.

The claimed invention pertains to an image source means for use in taking pictures of checks

¹ Application for patent filed May 15, 1992.

which are rapidly being transported in a check processing system. More particularly, the invention is directed to an integrated vessel which contains a light source and has interior surfaces designed to project a highly-uniform, yet highly diffuse illumination beam.

Representative claims 1 and 22 are reproduced as follows:

1. An arrangement for illuminating and imaging checks in a check-processing system wherein a large number of checks are rapidly, continuously transported past one or more imaging stations, each station having a prescribed source means comprising a Lambertian integrating cylinder which projects a highly-uniform, yet highly diffuse illumination-beam.

22. An arrangement for illuminating and recording the printing on documents in a document-processing system wherein a large number of documents are rapidly, continuously transported past one or more imaging stations, each station having a prescribed illumination source means comprising one or more lamp means in an integrating housing which is characterized by reflecting surfaces which are treated to be highly-diffusive and by slit means which thus projects a highly-uniform, yet highly diffuse illumination-beam.

The examiner relies on the following references:

Chadwick et al. (Chadwick)	5,131,755	July 21, 1992 (filed Oct. 31, 1989)
Concannon et al. (Concannon)	5,155,776	Oct. 13, 1992 (filed Oct. 10, 1989)

Claims 1-15 stand rejected under 35 U.S.C. § 103. As evidence of obviousness the examiner offers Concannon in view of Chadwick. Claims 22-33 stand rejected under 35 U.S.C. § 102(e) as being anticipated by the disclosure of Concannon.

Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

Appeal No. 94-3631
Application 07/883,513

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of obviousness and anticipation relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the collective evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 1-15. We are also of the view that the disclosure of Concannon does not anticipate the invention of claims 22-33. Accordingly, we reverse.

At the outset, we note that appellants attempted to amend the specification of this application after final rejection to indicate that this application was a continuation-in-part application of an application by Copenhaver et al. (Copenhaver) which matured into U. S. Patent No. 5,146,362. The Copenhaver patent has essentially the exact same disclosure as the Concannon reference patent and has the exact same U. S. filing date. According to appellants, the amendment of this application to make it a continuation-in-part of the Copenhaver application would have removed Concannon as a valid reference against the invention of this application. The examiner refused to permit entry of this amendment [Advisory Actions, Paper Nos. 10 and 12]. Appellants have asked us in their brief to reconsider the facts of this case and to treat this application as a continuation-in-part application of Copenhaver, which would render the art

Appeal No. 94-3631
Application 07/883,513

rejections moot [brief, page 6]. We are without authority to grant this request. In order to obtain priority benefits under 35 U.S.C. § 120, there must be a specific reference to the earlier application in the specification of the application requesting the priority benefit. Although appellants have attempted to amend the specification of this application to meet this requirement, the examiner has denied entry of the amendment. We are without authority to enter papers which have been denied entry by the examiner. The appropriate path to get the amendment entered would have been by petition to the Commissioner under 37 CFR § 1.181 to compel entry of the amendment by the examiner. Appellants elected not to follow this path, and instead, ask us to enter the amendment. As we noted above, we do not have this authority.

Since the amendment to secure priority benefits under 35 U.S.C. § 120 has not been entered, all arguments relating to the priority benefits appellants are entitled to are not properly before us, and we will have no further comments on this issue.

We now consider the rejection of claims 1-15 under 35 U.S.C. § 103 as being unpatentable over the teachings of Concannon in view of Chadwick. In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some

Appeal No. 94-3631
Application 07/883,513

teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

The examiner's position with respect to claims 1-15 is that Concannon teaches a check processing system which has every feature of these claims except for the illumination source being a Lambertian illumination source. The examiner finds that Concannon suggests that other illumination sources may be used [answer, page 3]. Chadwick teaches the use of a quasi-Lambertian illumination source in a device for optically inspecting printed wiring boards. The examiner concludes that it would have been obvious to use the Chadwick Lambertian illumination source in the Concannon check processing system because "both systems are primarily concerned with obtaining images, comparing images and for having a uniform illumination of the object," and such modification would have been a routine design choice [answer, pages 3-4].

Appellants respond that the examiner has ignored several specific recitations of these claims, and that there is no teaching on how to combine Concannon and Chadwick. According to appellants, the artisan looking for an alternative light source in Concannon would never turn to

Chadwick for such a teaching [brief, pages 8-10]. We find ourselves in agreement with appellants.

The optical inspection of printed wiring boards in Chadwick is nothing like the imaging of checks in Concannon. Chadwick teaches that the roughness and changes in the surface textures of printed wiring boards give rise to a mottled appearance when such printed wiring boards are illuminated by brightfield vertical illumination. It is precisely the roughness of the surface that gives rise to this effect [column 2, lines 3-7]. Chadwick teaches that a quasi-Lambertian illumination source reduces the effect of mottling caused by the roughness of surface textures. A check to be imaged, however, has no uneven surface textures so that the type of mottling found in Chadwick would never be a problem. There is no basis on this record to conclude that the artisan would find any motivation to use the quasi-Lambertian illumination source of Chadwick for illuminating checks. The examiner has simply combined the teachings of two different,

Appeal No. 94-3631
Application 07/883,513

disparate prior art concepts in Concannon and Chadwick, but the examiner has pointed to no suggestion in the references themselves which would lead the artisan to make the proposed modification.

Since we agree with appellants that there is no basis on this record to use the Chadwick Lambertian illuminating source with the Concannon check processing system, we do not sustain the rejection of claims 1-15 under 35 U.S.C. § 103.

We now consider the rejection of claims 22-33 under 35 U.S.C. § 102(e) as being anticipated by the disclosure of Concannon. 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 as well as disclosing structure which is capable of performing the recited functional limitations. RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.); cert. dismissed, 468 U.S. 1228 (1984); W.L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

The examiner has made an effort to read these claims on the Concannon disclosure [answer, pages 4-5]. Appellants respond that there are several elements of claims 22-33 which are not present in Concannon despite the examiner's attempt to assert that they are present in Concannon. Of most concern to appellants is that Concannon has no source means comprising an integrated vessel or housing as required by the claims, and that Concannon does not disclose that the inner surfaces of this vessel or housing should be treated to project light beams which are highly-

uniform, yet highly diffuse [brief, pages 11-12]. The examiner replies that the lamp in Concannon is in the integrated environment of many other modules and subunits, and that the treatment of the surfaces to be highly diffusive is inherent [answer, pages 8-9]. Once again, we find ourselves in agreement with the position taken by appellants.

The claims recite that the illumination source means has the lamp means and the reflecting-diffusive surfaces as part of an integrated housing or vessel. Concannon has no such housing or vessel which integrates the lamp means and the reflecting-diffusive surfaces. It is error to consider everything in the Concannon imaging unit as meeting the claimed integrated housing or vessel. The lamp means and the reflecting-diffusive surfaces must be separately contained in an integrated housing or vessel. Concannon does not meet this limitation.

We also agree with appellants that the examiner erred in finding that every lamp generates a highly-uniform, yet highly diffuse illumination beam, and that the surfaces of Concannon are inherently diffusive. There is nothing on this record to support these positions of the examiner.

Since Concannon does not disclose every limitation of claims 22-33, we do not sustain the rejection of these claims under 35 U.S.C. § 102.

Appeal No. 94-3631
Application 07/883,513

In summary, we have not sustained either of the examiner's rejections of claims 1-15 and 22-33. Therefore, the decision of the examiner rejecting claims 1-15 and 22-33 is reversed.

REVERSED

KENNETH W. HAIRSTON
Administrative Patent Judge

JERRY SMITH
Administrative Patent Judge

JAMES T. CARMICHAEL
Administrative Patent Judge

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Appeal No. 94-3631
Application 07/883,513

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