

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(2) is not binding precedent of the Board.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. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GUNTER ABERSFELDER,
STEFAN HAHN, STEFAN UHL
and
WINFRIED DEGEN

Appeal No. 96-3553
Application 08/324,476¹

HEARD: July 15, 1997

Before McCANDLISH, Senior Administrative Patent Judge, and
MEISTER and McQUADE, Administrative Patent Judges.

McQUADE, Administrative Patent Judge.

¹ Application for patent filed October 17, 1994.

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DECISION ON APPEAL

This appeal is from the final rejection of claims 1 through 8, all of the claims pending in the application.

The invention relates to an arrangement for marking motor vehicles with identification information to deter theft and/or unauthorized sale. Claims 1 and 8 are illustrative and read as follows:

1. Arrangement for preventing theft of a vehicle comprising:

microscopic information carriers having dimensions in the range of microns, each of said information carriers being encoded with identifying secondary information concerning the vehicle, said information carriers being contained in a vehicle coating of said vehicle at least at selected locations, said vehicle coating being selected from the group consisting of a top coating paint, an inner coating paint, an underseal coating and a protection wax coating;

whereby said secondary information encoded on said information carriers may be detected and compared with stored primary information concerning said vehicle to detect alteration of said secondary information.

8. Arrangement for marking of vehicles to hinder theft or unauthorized sale, comprising:

information carriers permanently applied to the vehicle, said information carriers being encoded with data in the form of secondary information which coincides with primary information concerning the identity of the vehicle, which primary information is stored in a manner that is not accessible to manipulation;

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wherein said information carriers are peptide chains having a composition from which the secondary information can be retrieved, the peptide chains being incorporated into at least portions of a vehicle coating.

The references relied upon by the examiner as evidence of obviousness are:

Dillon	4,243,734	Jan. 6, 1981
Schwartz et al. (Schwartz)	4,767,205	Aug. 30, 1988
Guinta et al. (Guinta)	5,083,814	Jan. 28, 1992
Butland	5,360,628	Nov. 1, 1994
		(filed Jan. 22, 1993)

The appealed claims stand rejected under 35 U.S.C.

§ 103 as follows:

a) claims 1 through 4 as being unpatentable over Dillon in view of Guinta;

b) claims 5 and 7 as being unpatentable over Dillon in view of Guinta and Schwartz; and

c) claims 6 and 8 as being unpatentable over Dillon in view of Guinta and Butland.

Reference is made to the appellants' brief (Paper No. 14) and to the examiner's answer (Paper No. 15) for the respective positions of the appellants and the examiner with regard to the propriety of these rejections.

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Turning first to the rejection of independent claim 1, Dillon relates to "the protection of articles through the identification thereof by micro-dots displaying indicia which identifies the owner, together with the method of preparing such micro-dots and using them for identification purposes" (column 1, lines 4 through 8). As described more specifically in Dillon's Abstract,

[t]he micro-dots are small pieces of foil of any of several shapes with square being the preferred shape, and having an area defined by sides having an extent in the nature of 0.007 inch. Printed on the area of each dot is indicia identifying a particular owner. The method consists essentially of printing the indicia in multiple units on a large plate with the images being reduced in size by step photographing process, which results in a glass slide having the negatives of the images developed thereon. These images are transferred photographically to a piece of film of the same size which is cut into the individual dots. It is then immersed in a fluid, such as a clear resin, and applied to an article that is to be protected. The article or any part thereof with the microdots thereon is retrieved and examined by a microscope to identify the owner.

The examiner concedes that Dillon does not meet the limitations in claim 1 requiring the microscopic information carriers, which correspond to Dillon's micro-dots, to be "contained in a vehicle coating . . . at least at selected

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locations, said vehicle coating being selected from the group consisting of a top coating paint, an inner coating paint, an underseal coating and a protective wax coating" (see page 4 in the answer). In this regard, Dillon does not expressly identify vehicles as being the sort of article which might be protected by the disclosed identification system.

Guinta discloses "an antitheft security system for automotive, marine, and other valuable personal articles, such as objects of art and valuable collectible objects, based upon a method involving the multiple and redundant application to an article, and limited access cataloging, of invisible, indelible registration code markings unique to each subscriber/property owner" (column 1, lines 41 through 47). The registration code markings may be composed of invisible inks or paints (see, for example, column 3, lines 6 through 9, and column 5, lines 23 through 26).

According to the examiner, it would have been obvious to one of ordinary skill in the art in view of the teachings of Guinta "to have marked a vehicle with micro dots, as taught by Dillon[,] in order to develop an identification system for a

vehicle that would aid in theft prevention of the vehicle"
(answer, page 5).

The combined teachings of Dillon and Guinta provide reasonable support for this conclusion. What is lacking in these combined teachings, however, is any suggestion of incorporating Dillon's micro-dots into a vehicle coating "selected from the group consisting of a top coating paint, an inner coating paint, an underseal coating and a protective wax coating" as recited in claim 1. The examiner's failure to respond to the appellants' arguments on this point (see the fifth through the eighth page in the brief²) is quite telling, but is certainly understandable given the noted deficiency in the references.

Therefore, we shall not sustain the standing 35 U.S.C. § 103 rejection of independent claim 1, or of claims 2 through 4 which depend therefrom, as being unpatentable over Dillon in view of Guinta.

Nor shall we sustain the standing 35 U.S.C. § 103 rejection of claims 5 and 7, which depend ultimately from claim 1, as being unpatentable over Dillon in view of Guinta

² The pages in the appellants' brief are not formally numbered.

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and Schwartz, or the standing 35 U.S.C. § 103 rejection of claim 6, which also depends ultimately from claim 1, as being unpatentable over Dillon in view of Guinta and Butland. In short, neither Schwartz nor Butland cures the above discussed shortcoming of the Dillon-Guinta combination with respect to the subject matter recited in parent claim 1.

We shall sustain, however, the standing 35 U.S.C. § 103 rejection of independent claim 8 as being unpatentable over Dillon in view of Guinta and Butland.

Butland discloses a system for labeling an object for its identification and/or verification. One embodiment of the system employs the use of biologic markers for this purpose (see column 3, lines 22 through 49). Among the biologic markers contemplated are synthetic polypeptides. As explained by Butland,

biologic markers may be incorporated into a visible or an invisible ink for use in labeling objects. It should be understood also that such biologic markers can be native or can be synthetic, including fragments, single chains, and a variety of additional forms currently developed or yet to be developed [column 3, lines 41 through 47].

The combined teachings of Dillon, Guinta and Butland would have suggested the vehicle marking arrangement recited in claim 8 to one of ordinary skill in the art. Of particular

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relevance here are Guinta's disclosure of the use of invisible inks or paints to mark a vehicle and Butland's disclosure of the incorporation of biologic markers such as synthetic polypeptides into invisible marker inks. The appellants have not disputed that Butland's disclosure in this regard meets or would have suggested the peptide chain information carriers required by claim 8. Moreover, the ink incorporating such polypeptide markers would constitute a vehicle coating, as broadly recited in claim 8, when applied to the surface of the vehicle. The

appellants' argument that "Butland is in no way related to the use of microfine information carriers which are incorporated into the paint of an automobile" (brief, tenth page) is not persuasive because it is not commensurate with the actual scope of claim 8 which makes no mention of paint or any other specific coating of the vehicle.

In summary, the decision of the examiner to reject claims 1 through 8 under 35 U.S.C. § 103 is reversed with respect to claims 1 through 7 and affirmed with respect to claim 8.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

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