

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. 10

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEROME SIMONOFF

Appeal No. 1998-0624
Application No. 08/373,118

ON BRIEF

Before KRASS, BARRETT and HECKER, ***Administrative Patent Judges.***

HECKER, ***Administrative Patent Judge.***

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1 through 10, all claims pending in this application.

The invention relates to a method of accurately and properly printing a check on a blank paper sheet based on a graphic image representation of an original check. The laser printed check includes the proper and accurate positioning of specific magnetic ink characters on its face.

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Representative independent claim 1 is reproduced as follows:

1. A method for the printing of a check based on an original graphic image of a check that includes MICR codes which method comprises the steps of:

inputting said original graphic image into a computer;

scanning said graphic image within computer memory using an OCR program;

identifying said MICR codes and their respective locations;

laser printing on a blank sheet said MICR codes with magnetic ink, using stored MICR fonts, in accordance with positioning instructions to thereby print in the MICR "clear band"; and,

reformatting said graphic image based on the identified respective locations without said MICR codes for the purpose of printing said reformatted graphic image above said "clear band".

The Examiner relies on the following references:

Hanson et al. (Hanson)	5,030,977	Jul. 9, 1991
Blaylock et al. (Blaylock)	5,550,932	Aug. 27, 1996
		(filed Jun. 19,
		1992)

Claims 1 through 10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hanson in view of Blaylock.

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Rather than reiterate the arguments of Appellant and the Examiner, reference is made to the brief and answer for the respective details thereof.

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OPINION

After a careful review of the evidence before us, we will not sustain the rejection of claims 1 through 10 under 35 U.S.C. § 103.

The Examiner has failed to set forth a *prima facie* case. It is the burden of the Examiner to establish why one having ordinary skill in the art would have been led to the claimed invention by the reasonable teachings or suggestions found in the prior art, or by a reasonable inference to the artisan contained in such teachings or suggestions. *In re Sernaker*, 702 F.2d 989, 995, 217 USPQ 1, 6 (Fed. Cir. 1983).

"Additionally, when determining obviousness, the claimed invention should be considered as a whole; there is no legally recognizable 'heart' of the invention." *Para-Ordnance Mfg. v. SGS Importers Int'l, Inc.*, 73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995) (*citing W. L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1548, 220 USPQ 303, 309 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984)).

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The Examiner reasons that Hanson discloses the claimed invention (inherently containing an original graphic image) except for an optical character recognition (OCR) program to scan image data, identifying magnetic ink character recognition (MICR) codes and their respective locations, use of MICR font, and resizing the graphic image. However, the Examiner contends Blaylock teaches these elements, and

It would have been obvious to one of ordinary skill in the art that Hanson can scan image data with OCR program, identify MICR codes, use MICR font card, and resize the graphic image for printing the MICR documents as taught by Blaylock because both references are related to the MICR document printing and combining them would effectively enhance the printing quality control. [Answer-page 4.]

The first step of claim 1 recites "inputting said original graphic image into a computer." Applicant argues "Hanson et al does not teach or disclose 'inputting an original graphic image.' At best Hanson et al suggests inputting data to thereafter form a check image." (Brief-page 7.)

The Examiner's rejection stated that data is applied to Hanson's input 64, and controller **42 (which would be a computer)** constructs a logical page comprising check(s) that

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inherently contain an original graphic image (answer-page 3). Now, in response to Appellant's argument, the Examiner contends that controller 42 constructs a logical page comprising checks (i.e., an original graphic image) which is then sent to Raster Image Processor **62 which is a computer** (answer-page 7).

We are not convinced by the Examiner regardless of whether 42 is considered to be the computer, or the new contention that 62 is now considered to be the computer. The claim clearly requires an **original graphic image** input into a computer. The Examiner's proposed inherent or constructed graphic image is not the original graphic image required by the claim.

The next step of claim 1 recites "scanning of said graphic image within computer memory using an OCR program." Appellant argues "Appellant scans and analyzes an already formed image while Hanson et al produces a latent image which is subsequently developed. Appellant's scanning contemplates the examination in sequential fashion of the image in computer memory by an OCR program." (Brief-page 9.)

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Initially the Examiner's rejection indicated that scanning was accomplished by Hanson's scanner 15 (answer-page 3). Now, in response to Applicant's argument, the Examiner contends, "the created graphic image (i.e., a check) from controller 42 is inputted into RIP 62 in which certain page formats stored in memory 61 are used (col. 5, lines 38-47)." (Answer-page 8.)

Again, we are not convinced by the Examiner regardless of whether 15 is considered to be the scanner, or the new contention that 62 is now considered to be the scanner. In both renditions of the Examiner's explanation of scanning, we see no mention of the scanning being done using an OCR program as claimed. We also note that the Examiner considered 62 to be the computer for purposes of inputting an original graphic image supra. Although the Examiner points to Blaylock for the use of OCR, Blaylock's statement "But the invention has equal application with CMC7 or OCR applications," is too vague to suggest how OCR might be used in Hanson.

The fact that the Examiner changes and adapts the application of the cited art, based upon Appellant's

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arguments, is a clear indication of the deficiencies of the rejection. As noted supra, the applied art does not meet the claim 1 limitations with respect to the required **original graphic image** and the scanning using OCR, for all proffered, and sometimes inconsistent, explanations. Although there is no need to elaborate, we also find deficiencies in meeting claim 1's reformatting step, and a sufficient motivation to combine Hanson and Blaylock.

The Federal Circuit states that "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." **In re Fritch**, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992), **citing In re Gordon**, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). "Obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor." **Para-Ordnance Mfg. v. SGS Importers Int'l**, 73 F.3d at 1087, 37 USPQ2d at 1239, **citing W. L. Gore & Assocs., Inc. v. Garlock, Inc.**, 721 F.2d at 1551, 1553, 220 USPQ at 311, 312-13.

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As pointed out above, although the references may recite relevant claim language such as image, computer, scanning and OCR, they do not meet the requirements set forth in the claims, and have not been combined in a convincing manner.

Claim 8, the other independent claim, recites the same unmet limitations as noted with respect to claim 1.¹ Thus, we will not sustain the Examiner's rejection of claims 1 and 8.

The remaining claims on appeal also contain the above limitations discussed in regard to claim 1 and 8 and thereby, we will not sustain the rejection as to these claims.

We have not sustained the rejection of claims 1 through 10 under 35 U.S.C. § 103. Accordingly, the Examiner's decision is reversed.

REVERSED

¹ Claim 1 does not require identification of MICR codes and their locations by OCR scanning, thus such identification reads on the applied art. However, claim 8 ties this identification to the OCR scanning and is not considered to be met by the references.

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