Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte BORIS METLITSKY, JEROME SWARTZ, and EDWARD BARKAN

Appeal No. 1999-1345
Application No. 08/482,556

HEARD: May 9, 2001

Before THOMAS, RUGGIERO, and BARRY, Administrative Patent Judges.

BARRY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the rejection of claims 33-36 and 40-43. We affirm-in-part.

BACKGROUND

The invention at issue in this appeal reads bar codes. Bar code readers operate by scanning an emitted light beam across a bar code symbol comprising light and dark bars. Because more light is reflected from the light bars than from

the dark bars, a detector in the reader can discriminate between the two types of bars. Information contained in the symbol is then extracted by a signal processor in the reader.

In a bar code reader, discriminating automatically between detected signals of higher and lower frequency is desirable. Figure 10 of the appellants' specification shows two bar code symbols, one above the other. The bars of the upper symbol are narrower and more closely spaced than those of the lower symbol. Given the same scanning speed for both symbols, transitions from light to dark occur at a higher frequency in a signal detected from the upper symbol than in a signal detected from the lower symbol. Consequently, the upper symbol produces a higher frequency detected signal than the lower symbol.

The invention at issue automatically discriminates between the higher and lower detected frequencies. Between a detector and processor, a differentiator is coupled to a low-pass filter of a selectable bandwidth. The bandwidth is

tuned, via feedback, to the lowest bandwidth sufficient to pass the frequency of the detected signal.

Claim 33, which is representative for our purposes, follows:

> 33. A system for detecting reflected light, comprising:
>
> a light source for generating a light beam;
>
> means for sweeping the light beam across an object;
>
> means for detecting light reflected by the object and for generating electrical signals indicative of the detected light; and
>
> circuitry means for discriminating the electrical signals, said circuitry means including
>
> means for filtering with a respective cutoff frequency each electrical signal to provide a respective output signal having a respective bandwidth, wherein the circuitry means includes
>
> a differentiator circuit, coupled to the detecting means, for generating a first derivative signal of each electrical signal.

The prior art applied in rejecting the claims follows:

Metlitsky et al. (Metlitsky) 5,151,580 Sep. 29, 1992
(filed Aug. 3, 1990)

Hebert et al. (Hebert) 4,000,397 Dec. 28, 1976.

Claims 33-36 and 40-43 stand rejected under "the judicially created doctrine of double patenting," (Examiner's Answer at 4), as being unpatentable over claims 1-30 of Metlitsky. Claims 33, 34, 40, and 41 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Hebert. Rather than reiterate the arguments of the appellants or examiner in toto, we refer the reader to the briefs and answer for the respective details thereof.

OPINION

In deciding this appeal, we considered the subject matter on appeal and the rejections of the examiner. Furthermore, we duly considered the arguments and evidence of the appellants and examiner. After considering the record, we are persuaded that the examiner erred in rejecting claims 33-36 and 40-43 as being unpatentable over the claims 1-30 of Metlitsky. We are also persuaded that she did not err, however, in rejecting

claims 33, 34, 40, and 41 as being anticipated by Hebert. Accordingly, we affirm-in-part. Our opinion addresses the double patenting rejection and anticipation rejections. We begin with the former rejection.

I. Double Patenting Rejection of Claims 33-36 and 40-43

The appellants argue, "the inventions claimed in the `580 patent and in the instant application are 'independent and distinct.' The former is directed to a novel optical arrangement of elements with general circuitry recited, and the latter is directed to a novel circuit arrangement, for use in a general optical system." (Reply Br. at 3.) The examiner's rejection is based on the plurality's opinion[1] in In re Schneller, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). "Schneller does not set forth another test for determining 'obviousness-type' double patenting." Ex parte Davis, 56 USPQ2d 1434, 1436 (Bd. Pat. App. & Int. 2000). "Schneller did not establish a rule of general application and thus is

[1] Because only two judges joined the principal opinion, while two others concurred in the result, and a fifth wrote a concurring opinion, Schneller lacked a majority opinion.

limited to the particular set of facts set forth in that decision." Id.[2]

Accordingly, we consider whether the claims of the instant application are patentably distinct from those of Metlitsky. Claims 33 and 40 specify in pertinent part the following limitations: "generating a first derivative signal ...." Furthermore, claims 34-36 and 41-43 specify in pertinent part the following limitations: "a low pass filter having a resistor in series with a first capacitor which is in parallel with a second capacitor in series with a switch."

The examiner fails to show a teaching or suggestion of the limitations in the claims of Metlitsky. To the contrary, she admits that the patent's "'signal processing means" ... does not recite all the details of the [instant applications] 'circuitry means' ...." (Examiner's Answer at 10.) Because

[2] The plurality's opinion cautioned "'against the tendency 'to freeze into rules of general application what, at best, are statements applicable to particular fact situations'." Schneller, 397 F.2d 350 at 355, 158 USPQ at 215 (quoting In re Riden, 318 F.2d 761, 763, 138 USPQ 112, 114 (CCPA 1963)).

the facts of the instant appeal differ sufficiently from those in Schneller, moreover, a double patenting rejection here is inappropriate. Therefore, we reverse the rejection of claims 33-36 and 40-43 as being unpatentable over claims 1-30 of Metlitsky. We proceed to the anticipation rejections.

II. Anticipation Rejection of Claims 33, 34, 40, and 41

We begin by noting the following principles from Rowe v. Dror, 112 F.3d 473, 478, 42 USPQ2d 1550, 1553 (Fed. Cir. 1997).

> A prior art reference anticipates a claim only if the reference discloses, either expressly or inherently, every limitation of the claim. See Verdegaal Bros., Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "[A]bsence from the reference of any claimed element negates anticipation." Kloster Speedsteel AB v. Crucible, Inc., 793 F.2d 1565, 1571, 230 USPQ 81, 84 (Fed. Cir. 1986).

Of course, "'[e]very patent application and reference relies to some extent upon knowledge of persons skilled in the art to complement that [which is] disclosed ....'" In re Bode, 550 F.2d 656, 660, 193 USPQ 12, 16 (CCPA 1977) (quoting In re Wiggins, 488 F.2d 538, 543, 179 USPQ 421, 424 (CCPA 1973)). Those persons "must be presumed to know something" about the

art "apart from what the references disclose." In re Jacoby, 309 F.2d 513, 516, 135 USPQ 317, 319 (CCPA 1962).

Furthermore, claims that are not argued separately stand or fall together. In re Kaslow, 707 F.2d 1366, 1376, 217 USPQ 1089, 1096 (Fed. Cir. 1983) (citing In re Burckel, 592 F.2d 1175, 201 USPQ 67 (CCPA 1979)). When the patentability of dependent is not argued separately, moreover, the claims stand or fall with the claims from which they depend. In re King, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986)(citing In re Sernaker, 702 F.2d 989, 217 USPQ 1 (Fed. Cir. 1983) and Burckel, 592 F.2d 1175, 201 USPQ 67.)

Here, the appellants assert, "[t]hese claims should be considered in two groups: Group I: 34 and 41; and Group II: 33 and 40." (Appeal Br. at 5.) Therefore, claims 33 and 40 stand or fall together in a first group, and claims 34 and 41 stand or fall together in a second group. We select claims 40 and 41 to represent the respective groups. With these principles and representation in mind, we address the first group of claims.

A. Claims 33 and 40

The appellants argue, “even if ... a first derivative signal is internally produced in element 11, it is a transitional or intermediate signal that exists solely for the purpose of generating the second derivative signal 34 or 35 to be used by other elements. Such an internally produced voltage cannot be said to be ‘generated,’ as the term is used in claims 33 and 40.” (Reply Br. at 5.)

“In the patentability context, claims are to be given their broadest reasonable interpretations. Limitations are not to be read into the claims from the specification.” In re Van Geuns, 988 F.2d 1181, 1184, 26 USPQ2d 1057, 1059 (Fed. Cir. 1993) (citing In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)). Here, representative claim 40 specifies in pertinent part the following limitations: "generating a first derivative signal ...." Those skilled in the art would have understood that “generate” is “to bring something into existence; produce.” American Heritage Dictionary 552 (2d college ed. 1982) (copy attached). Giving the claim its broadest reasonable interpretation in view of

this understanding, the limitations recite bringing into existence or producing a first derivative signal.

The prior art teaches the limitations. At oral hearing, the appellants' representative admitted that Hebert's signal processor produces a first derivative signal. Furthermore, the appellants characterize the first derivative as a signal "that exists .... " (Reply Br. at 5 (emphasis added).) Whatever the admission and characterization, the reference's "first differentiator[,]" col. 5, l. 39, necessarily brings into existence or produces a first derivative signal. Because Hebert's first differentiator brings into existence or produces a first derivative signal, we are persuaded that the reference discloses the limitations of "generating a first derivative signal ...." Therefore, we affirm the rejection of claims 33 and 40 as being anticipated by Hebert. We proceed to the second group of claims.

B. Claims 34 and 41

The appellants argue, “C13 is not in parallel with the series combination of C21 and Q4, because they are not connected between the same pair of nodes.” (Reply Br. at 4.) They further argue, “C14 is not in parallel with the series combination of C22 and Q5, because they are not connected between the same pair of nodes.” (Id. at 4.)

Here, representative claim 41 specifies in pertinent part the following limitations: “a first capacitor which is in parallel with a second capacitor in series with a switch.” The appellants admit that "’elements are connected in parallel when they are connected between the same pair of nodes.’" (Id. (citing The IEEE Standard Dictionary of Electrical and Electronics Terms 744 (6th ed. 1997)). Giving the claim its broadest reasonable interpretation in view of this understanding, the limitations recite a first capacitor connected between the same pair of nodes as a second capacitor in series with a switch.

The prior art teaches the limitations. Specifically, Figure 2 of Hebert depicts capacitor C13, capacitor C21, and

switch Q4. The appellants admit, “C13 and C21 have ... one node in common, ground.” (Reply Br. at 4.) Moreover, the Figure shows that capacitor C21 is in series with switch Q4 and that capacitor C13 and the combination of capacitor C21 and switch Q4 are both connected a node shown above resistor R20.

Cumulatively, the Figure also depicts capacitor C14, capacitor C22, and switch Q5. The appellants admit, “C14 and C22 have ... one node in common, ground.” (Id.) In addition, the Figure shows that capacitor C22 is in series with switch Q5 and that capacitor C13 and the combination of capacitor C22 and switch Q5 are both connected a node shown above resistor R21.

Because Hebert’s capacitor C13 and C14 are connected between the same pair of nodes as its capacitor C21 and C22, respectively, in series with switch Q4 and Q5, respectively, we are persuaded that the reference discloses the limitations of "a first capacitor which is in parallel with a second

capacitor in series with a switch." Therefore, we affirm the rejection of claims 34 and 41 as being anticipated by Hebert.

Our affirmances are based only on the arguments made in the briefs. Arguments not made therein are neither before us nor at issue but are considered waived.

CONCLUSION

In summary, the rejection of claims 33-36 and 40-43 under the judicially created doctrine of double patenting is reversed. The rejection of claims 33, 34, 40, and 41 under 35 U.S.C. § 102(b), however, is affirmed.

No time for taking any action in connected with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED-IN-PART

JAMES D. THOMAS Administrative Patent Judge	)
JOSEPH F. RUGGIERO Administrative Patent Judge	) BOARD OF PATENT APPEALS AND INTERFERENCES
LANCE LEONARD BARRY Administrative Patent Judge	)

LLB/kis
FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER
1300 I STREET, N.W.
7TH FLOOR
WASHINGTON, DC 20005