

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HOWARD E. WULFORST

Appeal No. 96-2376
Application No. 08/195,341¹

ON BRIEF

Before KRASS, BARRETT and CARMICHAEL, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 4 and 5. Claim 6 has been withdrawn by appellant and

¹ Application for patent filed February 8, 1994.

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the examiner has withdrawn the prior art rejection of claims 1 through 4² and 7.

The invention pertains to the duplicating of an original document. After duplication of an original document at a remote location, verification is transmitted back to the originating station and the original document is destroyed. Claim 5, the only independent claim left before us on appeal, however, requires no transmission to a remote location nor does it require a destruction of the original document.

Independent claim 5 is reproduced as follows:

5. Apparatus for duplicating an original document comprising in cooperative relationship: a computer; a scanner cooperative with said computer; a printer cooperative with said computer; a document transport mechanism cooperative with said scanner so as to transport a scanned document to a viewing location; a computer monitor cooperative with said viewing location so as to display information which has been scanned which is in the computer memory with the transported document; and a security area to which the scanned document may be transported.

The examiner relies on the following references:

Ijuin et al. (Ijuin)	5,014,135	May 7,
1991		

² A rejection of claim 4 under 35 U.S.C. 112, second paragraph, remains.

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Ogata
1994

5,283,665

Feb. 1,

Claim 4 stands rejected under 35 U.S.C. 112, second paragraph, as being indefinite, the examiner contending that "the validated document" on line 1 should be "the validated verified printed information" and that "the original," on line 3, should be "the original document."

Claim 5 stands rejected under 35 U.S.C. 103 as unpatentable over Ogata in view of Ijuin.

Reference is made to the brief and answer for the respective positions of appellant and the examiner.

OPINION

Turning first to the rejection of claim 4 under 35 U.S.C. 112, second paragraph, we will summarily sustain this rejection as appellant concedes the propriety of the rejection at page 3 of the brief.

We now turn to the rejection of claim 5 under 35 U.S.C. 103.

We will also sustain this rejection. Appellant does not dispute the substance of the rejection regarding the alleged

teachings of the applied references and how such is applied to the claimed subject matter. Rather, appellant contends first that the Ogata patent is invalid and is, therefore, not a proper reference. Further, appellant contends that since Ogata was filed July 19, 1990 and Ijuin did not issue until ten months later, on May 7, 1991, Ogata could not have relied on Ijuin which did not exist, at the time of Ogata's filing.

Appellant's reasoning is misplaced. Issued United States patents possess a presumption of validity.³ A mere allegation of invalidity, by appellant, without a proffer of any evidence, falls far short of overcoming the statutory presumption of validity. In any event, a reference, even an invalid patent, is still a good reference against a claim for all that it does show. The examiner has explained that Ogata discloses the subject matter of claim 5 but for the "document transport mechanism." However, the examiner has explained that while not shown, Ogata would have inherently included a document transport mechanism in the disclosed facsimile device. If necessary, the examiner points to Ijuin for a

³ 35 U.S.C. § 282.

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showing of the notoriety of document transport mechanisms in facsimile devices. Accordingly, while appellant argues that the Ogata patent is "void" because the examiner states that it lacks a document transport mechanism and therefore, according to appellant, describes an "inoperative mechanism" [brief - pages 4-5], on the contrary, the examiner is alleging that a document transport mechanism, although not described in Ogata, was so well known to artisans that Ogata did not need to describe such and that such a mechanism would have been "inherent" in Ogata. Therefore, to whatever extent appellant's argument in this regard is even relevant to the rejection, there is clearly no evidence on this record which is indicative of any inoperability of the Ogata device.

Also misplaced is appellant's argument that somehow the references are not combinable because the patent to Ijuin was issued ten months after the filing date of the Ogata patent. Appellant appears to be stating a new test for obviousness under 35 U.S.C. 103; that is, that patent references may not be combined unless the patentee, or inventor, on one of two references actually knew about the work of the patentee, or inventor, of the other reference. The ludicrousness of this

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test is clear since, when dealing with two patent references, one reference will almost always have a patent date subsequent to the other.

The test for obviousness under 35 U.S.C. 103 does not depend on what the actual inventors of the devices which are the subject of the applied references knew or did not know. Rather, the test is what the *hypothetical* artisan skilled in the art and having the applied references before him/her would have known. Further, the critical date of interest is not the filing date or the patented date of the references, vis à vis each other, but, rather, the effective filing date of the application under examination. If the filing dates or the patented dates of the applied references make those references viable references, within 35 U.S.C. 102, based on the effective filing date of the application under examination, then the time interval between the filing date of one of the references and the patented date of another reference has little relevance, if any, to a determination of obviousness, within the meaning of 35 U.S.C. 103, of subject matter claimed in the pending application.

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In the instant case, the effective filing date of the application under examination is February 8, 1994. Both Ogata (February 1, 1994) and Ijuin (May 7, 1991) were patented prior to the filing of the instant application. Accordingly, Ogata and Ijuin are both viable references under 35 U.S.C. 103. It may very well be that, since Ogata's patented date does not constitute a statutory bar under 35 U.S.C. 102(b), appellant might be able to swear behind the reference with an affidavit or declaration, in accordance with 37 CFR 1.131. However, appellant has presented no such affidavit or declaration.

The examiner has established a prima facie case of obviousness under 35 U.S.C. 103 with regard to claim 5 and appellant has presented no evidence or convincing argument to overcome the prima facie case. Further, appellant has conceded that the examiner's rejection of claim 4 under 35 U.S.C. 112, second paragraph, was correct.

Accordingly, the examiner's decision is affirmed.

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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AFFIRMED

ERROL A. KRASS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
LEE E. BARRETT)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JAMES T. CARMICHAEL)	
Administrative Patent Judge)	

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