

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(2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WALTER A. L. JOHNSON,
BALDO A. FAIETA, HERBERT D. JELLINEK
and Z. EROL SMITH, III

Appeal No. 96-2739
Application 08/185,320¹

ON BRIEF

Before THOMAS, FLEMING and HECKER, **Administrative Patent Judges.**

HECKER, *Administrative Patent Judge.*

¹ Application for patent filed March 19, 1993. According to appellants, this application is a continuation of Application 07/738,659, filed July 31, 1991, which is a division of Application 07/530,753, filed May 30, 1990, now Patent No. 5,060,980, granted October 29, 1991.

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DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the rejection of claims 7 through 9 and 15 through 18, all the claims in the application, the claims having been twice rejected.²

Appellant's invention relates to a system for creating and interpreting machine readable forms. The form may contain regions of arbitrary text, arbitrary graphics, and fields. The form generation portion of the system automatically encodes information about the fields as the form is being created, and integrates that encoded information into the electronic and printed representations of the form. The forms interpreter portion of the system may then read the form's field description from the form itself and, based on this description, interpret the form. By locating encoded information about form fields directly on the form, the form interpreter may be automatically programmed for that particular form. The form may be structured in virtually any

² Appellants' notice of appeal indicates this appeal is from a final rejection mailed March 15, 1995. That office action was not a final rejection, however, the Board of Patent Appeals and Interferences has jurisdiction under 35 U.S.C. § 134, *Ex parte Lemoine*, 46 USPQ2d 1420 (Bd. Pat. App. & Int. 1994).

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manner, and may be searched for its location of the encoded information (specification at pages 5 and 6).

On page 8 **et seq.** of the specification and Figure 1, Appellants disclose a blank form 10 which includes arbitrary text 12 such as document or field titles and arbitrary graphics 14 such as graphical symbols. The form interpreter will ignore the arbitrary text 12 and arbitrary graphics 14 in favor of the contents of certain fields and encoded information regions.

In order to facilitate locating regions of form 10 marked for reading, i.e., fields, form 10 includes a reference point 16 from which the layout of the remainder of the form is calculated. The form interpreter locates this point, and measures the position of the contents of the fields to be read therefrom. A convenient location for reference point 16 is the upper left-hand corner of the form. Thus, the location of a field may be described in terms of horizontal and vertical displacements from the reference point.

Form 10 includes one or more fields such as check boxes 18, numeric or alphanumeric fields 20, multi-character alpha field 22, and image fields 24.

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A region of encoded information 26 which represents a structural description of form 10, as well as other selected information, will be located on the form itself. The encoded information region 26 includes the complete description of the location of the fields on the form which enables arbitrary placement of the fields on the form. Region 26 need not be physically or logically placed on form 10 with reference to the fields. The form may be searched for region 26 based on data type, format, etc. Once located, the information contained in region 26 may be read by a scanner and decoded by appropriate decoding means to provide the position information needed to read and process the remainder of the form 10. At a minimum, the encoded information in region 26 will include a description of the physical location of one or more fields on form 10, relative to reference point 16, and a description of the type of that one or more fields. Region 26 may also carry instructions to a processor for specific processing of selected data in a field.

By providing region 26, a form may be provided that is a direct path between user and form interpreter, with no preprogramming of the form interpreter and/or processing

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OPINION

After a careful review of the evidence before us, we will not sustain the Examiner's rejection of claims 7 through 9 and 15 through 18 under 35 U.S.C. § 102.

For purposes of this appeal, we will treat claim 17 as the representative claim.

It is axiomatic that anticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim. **See *In re King***, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986) and ***Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.***, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984). "Anticipation is established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention." ***RCA Corp. v. Applied Digital Data Sys., Inc.***, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984), ***cert. dismissed***, 468 U.S. 1228 (1984), ***citing Kalman v. Kimberly-Clark Corp.***, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983).

Appellants argue on page 8, first paragraph of the brief,

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that Shepard "does not teach or suggest an arbitrarily located encoded information region with encoded information representing location information for field data." Appellants point out that the ID number of Shepard, which describes the location of field data, appears in a "**predetermined specific position**", Shepard at column 5, lines 22 through 24.

We note that Appellants' claim 17 recites "at an unspecified arbitrary location an encoded information region, the information in said region including a complete encoded description of the location of the field data." This language is located in the preamble of the claim. Although no "litmus test" exists as to what effect should be accorded to words contained in a preamble, review of a patent in its entirety should be made to determine whether the inventors intended such language to represent an additional structural limitation or mere introductory language. **Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.**, 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989); **In re Stencel**, 828 F.2d 751, 754, 4 USPQ2d 1071, 1073 (Fed. Cir. 1987). Further, we note that determination of preamble language if further limiting turns on whether the language "breathes life

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and meaning into the claims and hence is a necessary limitation to them" *Loctite Corp. v. Ultraseal, Ltd.*, 781 F.2d 861, 866, 228 USPQ 90, 92 (Fed. Cir. 1984).

In this instance, we find that claim 17 recites in the body of the claim, "the arbitrarily located encoded information region" (emphasis added), thus directly referring back to the preamble language recited *supra*, and allowing the preamble language to "breath life and meaning" into the claim as a whole. Thus, the "unspecified arbitrary location" where the "description of the location of the field data", recited in the preamble, is considered to represent an additional structural limitation rather than mere introductory language.

In response, the Examiner states that "figure 2 of Shepard clearly shows the document form 100 that includes the ID number 102 arbitrarily located in the upper left corner."

If one were to read Shepard as "arbitrarily" locating the ID number in the upper left corner to meet Appellants' claim language, we are at a loss to find how this location is also "unspecified" as claimed. To the contrary, Shepard has

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"specified" the location of the ID number, as recited at column 9 lines 64 through 66, stating "the ID Number 102 possesses the distinguishing characteristic of a **special location** on the document 100" (emphasis added).

Therefore, we find that Shepard does not teach "an unspecified arbitrary location" for the information region including the location of the field data as claimed.

The remaining claims on appeal also contain the above limitations discussed in regard to claim 17 and thereby, we will not sustain the rejection as to these claims.

Claim body recitation of "the arbitrarily located encoded information region" (emphasis added), directly refers back to the preamble of each independent claim 7, 8 and 16, as in representative claim 17.

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In view of the foregoing, the decision of the Examiner
rejecting claims 7 through 9 and 15 through 18 under 35 U.S.C.
§ 102 is reversed.

REVERSED

JAMES D. THOMAS)	
Administrative Patent Judge)	
)	
)	
)	
MICHAEL R. FLEMING)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
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STUART N. HECKER)	
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