

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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***Ex parte*** ROBERT R. R. RODITE

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Appeal No. 1997-1382  
Application No. 08/478,172<sup>1</sup>

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ON BRIEF<sup>2</sup>

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Before THOMAS, HAIRSTON, and DIXON, **Administrative Patent Judges**.  
DIXON, **Administrative Patent Judge**.

**DECISION ON APPEAL**

This is a decision on appeal from the Examiner 's final rejection of claims 1-9, which are all of the claims pending in this application.

We REVERSE.

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<sup>1</sup> Application for patent filed June 7, 1995. According to appellant, this application is divisional application of serial number 08/076,504, filed June 14, 1993, which is a continuation-in-part of serial number 07/732,014, filed July 18, 1991.

<sup>2</sup> The oral hearing was waived in a letter filed October 11, 1999.

## BACKGROUND

The appellant's invention relates to a two-pass document image processing method and system using a repeatable unique image signature to identify each document. During the second pass through the document processing system, completed stored information is used in place of the incomplete imaged/scanned data to process the document. An understanding of the invention can be derived from a reading of exemplary claim 9, which is reproduced below.

9. A method of processing documents comprising the steps of:

reading an image signature, wherein said image signature is created from at least some portion of an image, from each document during a pass of the document through a document processor;

attempting to match uniquely the image signature from each document during the pass with a previously stored image signature;

recalling a stored record corresponding to the matched image signature for the document when the image signature from the pass matches the previously stored image signature; and

printing information from the stored record on the document.

The prior art reference of record relied upon by the in rejecting the appealed claims is:

Cain	4,523,330	Jun. 11, 1985
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Claims 1-9 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Cain.

Appeal No. 1997-1382  
Application No. 08/478,172

Rather than reiterate the conflicting viewpoints advanced by the Examiner and the appellant regarding the above-noted rejections, we make reference to the Examiner's answer (Paper No. 10, mailed Oct. 29, 1996) for the Examiner's reasoning in support of the rejection, and to the appellant's brief (Paper No. 9, filed Aug. 7, 1996) for the appellant's arguments thereagainst.

### **OPINION**

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art reference, and to the respective positions articulated by the appellant and the Examiner. As a consequence of our review, we make the determinations which follow.

Appellant argues that Cain does not teach a second pass through the document processor and for associating an image signature read from that document with an image signature previously stored in the record storage. (See Brief at pages 6-7.) We agree with appellant. While not all the independent claims recite the second pass through the document processing system, claims 1, 3, 8 and 9 include limitations that an image signature is compared to a previously stored image signature, recalling

Appeal No. 1997-1382  
Application No. 08/478,172

data and using data associated with the stored image signature to perform some processing. Cain clearly does not teach this comparison. The Examiner argues at length that the use of the MICR reader would be the second pass and that the data read therefrom would have been a unique identifier to identify the document and used to compare. We disagree. The Examiner has not identified a clear teaching within the four corners of the reference that show the limitation pertaining to "attempting to match uniquely the image signature from each document during the pass with a previously stored image signature; recalling a stored record corresponding to the matched image signature for the document when the image signature from the pass matches the previously stored image signature." Therefore, we will not sustain the rejection of claims 1-9 under 35 U.S.C. § 102<sup>3</sup>.

#### **REJECTION UNDER 37 CFR 1.196(b)**

An obviousness type double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and the possible harassment by multiple assignees. **In re Goodman**, 11 F.3d 1046, 29

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<sup>3</sup> We make no finding whether the claimed invention would have been obvious over Cain since this issue is not before the Board.

Appeal No. 1997-1382  
Application No. 08/478,172

USPQ2d 2010 (Fed. Cir. 1993); **In re Longi** , 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); **In re Van Ornum**, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); **In re Vogel**, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and **In re Thorington**, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321 (c) may be used to overcome an actual or provisional rejection based on an obviousness type double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78(d).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b)

Claims 1-9 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of copending Application No. 08/076,504 (which is the parent application of the present application). Although the conflicting claims are not identical, they are not patentably distinct from each other because the additional claim limitation “wherein said image signature is created from at least some portion of said image” in the present claims would have been an obvious variation of the generic image signature claimed in the parent application.

Appeal No. 1997-1382  
Application No. 08/478,172

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### **CONCLUSION**

To summarize, the decision of the to reject claims 1-9 under 35 U.S.C. § 102 is reversed.

In addition to reversing the 's rejection of all of the claims, this decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

Appeal No. 1997-1382  
Application No. 08/478,172

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

**REVERSED - 37 CFR 1.196(b)**

JAMES D. THOMAS	)	
Administrative Patent Judge	)	
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	)	
	)	
	)	BOARD OF PATENT
KENNETH W. HAIRSTON	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
JOSEPH L. DIXON	)	
Administrative Patent Judge	)	

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Appeal No. 1997-1382  
Application No. 08/478,172

A. P. TENNENT  
IBM CORPORATION  
INTELLECTUAL PROPERTY LAW  
DEPT. QPZA/BLDG. 204-3 MAIL STOP 90  
8501 IBM DRIVE  
CHARLOTTE, NC 28262-8563