

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte SRINIVASAN KESHAV

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Appeal No. 1998-1926  
Application 08/333,829

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ON BRIEF

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Before JERRY SMITH, BARRY and BLANKENSHIP, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-20, which constitute all the claims in the application.

The disclosed invention pertains to a method and apparatus for authenticating a unique article by creating a unique data signature for the article.

Representative claim 1 is reproduced as follows:

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1. A method for authenticating a unique article by creating a unique data signature for the unique article, said method comprising the steps of:

receiving a data set including at least one data subset wherein a first data subset is representative of a unique identification number fixed to a surface of a substantially unforgeable document;

encrypting said input data set to generate a unique data signature and fixing said unique data signature to at least one of said unique article and a verification certificate, to thereby authenticate said unique article; and

utilizing the substantially unforgeable document and said unique data signature together for subsequent proof of authenticity of the unique article.

The examiner relies on the following references:

Stambler	5,267,314	Nov. 30, 1993
Haber et al. (Haber)	5,373,561	Dec. 13, 1994
		(filed Dec. 21, 1992)

Schneier, "Untangling Public-Key Cryptography," Dr. Dobb's Journal, Vol. 17, Issue 5, May 1992, pages 16-28.

The following rejections are on appeal before us:

1. Claims 1-3, 5-7, 13, 14, 16 and 17 stand rejected under 35 U.S.C. § 102 (a) and (e) as being anticipated by the disclosure of Stambler.

2. Claims 4, 8-11 and 15 stand rejected under 35 U.S.C.

§ 103 as being unpatentable over the teachings of Stambler in

view of Schneier.

3. Claims 18-20 stand rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of Stambler in view of Haber.

4. Claim 12 stands rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of Stambler in view of Schneier and further in view of Haber.

Rather than repeat the arguments of appellant or the examiner, we make reference to the briefs and the answers for the respective details thereof.

#### OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of anticipation and obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellant's arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answers.

It is our view, after consideration of the record

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before us, that the evidence relied upon does not support any of the prior art rejections made by the examiner.

Accordingly, we reverse.

We consider first the rejection of claims 1-3, 5-7, 13, 14, 16 and 17 under 35 U.S.C. § 102 as being anticipated by the disclosure of Stambler. Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.); cert. dismissed, 468 U.S. 1228 (1984); W.L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

With respect to independent claims 1, 8 and 13, the examiner notes that Stambler discloses a method and apparatus for authenticating a document or a transaction. The examiner also notes that Stambler uses information from the document or transaction and applies an encryption process to this information to derive a variable authentication number which

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is affixed to the document or the transaction [final rejection, page 2].

Appellant argues that Stambler does not teach a method for authenticating a unique article or an original work of authorship. Appellant also argues that Stambler has no verification certificate, and Stambler does not encrypt input data including data representative of a unique identification number fixed to a surface of a substantially unforgeable document [brief, pages 7-10].

The examiner responds that a substantially unforgeable document includes personal checks which are within the definition as set forth in appellant's specification [answer, pages 5-6]. Appellant responds that the examiner has ignored a portion of the definition set forth in his specification which would preclude conventional personal checks [reply brief].

We agree partially with appellant's position. As pointed out by appellant, the specification describes a substantially unforgeable document as "any unique certificate, charter, license, chronicle, record, deed, draft, bill, or the like, which has been produced in a manner to prevent, inhibit,

discourage, etc. the fraudulent reproduction or alteration of same with an intent to prejudice the rights of another, such as, for example, a currency note or other similar instrument" [page 5, lines 22-27]. As pointed out by appellant in the briefs, a personal check may be designed to be "substantially unforgeable," but not all personal checks are so designed. Nevertheless, we find that the typical conventional personal check is designed to prevent, inhibit or at least discourage the fraudulent reproduction thereof. Thus, we agree with the examiner that a personal check is a substantially unforgeable document within the definition set forth in appellant's specification.

Of more importance to us in determining whether Stambler anticipates the claimed invention is the recitation in each of the independent claims that the unique signature is computed from a unique identification number which is fixed on the document. Stambler does not generate a signature using a unique identification number of the document. Stambler discloses that the information entered relates to the transaction such as check number, check amount, etc. [column 5, lines 17-20]. These are not data sets which represent a

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unique identification number of a document.

Since we agree with appellant that Stambler does not contain every feature of independent claims 1, 8 and 13, the rejection of these independent claims under 35 U.S.C. § 102 is improper. Therefore, we do not sustain the rejection of any of claims 1-3, 5-7, 13, 14, 16 and 17 as anticipated by the disclosure of Stambler.

We now consider the rejections under 35 U.S.C. § 103. In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in

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the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered [see 37 CFR § 1.192(a)].

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Each of the examiner's rejections of the claims under 35 U.S.C. § 103 fundamentally relies on the examiner's incorrect position that Stambler fully meets the invention of the independent claims. There are differences between the claimed invention and the teachings of Stambler (for example, the use of a unique identification number) which have not been addressed by the examiner. The additional citation of Schneier and Haber does not overcome the deficiencies in Stambler noted above. Since the examiner has not properly addressed the differences between the claimed invention and the applied prior art, the examiner has failed to establish a prima facie case of the obviousness of the claimed invention. Therefore, we do not sustain the examiner's rejection of claims 4, 8-12, 15 and 18-20.

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In summary, we have not sustained any of the  
examiner's prior art rejections. Therefore, the decision of  
the examiner rejecting claims 1-20 is reversed.

REVERSED

	)	
JERRY SMITH	)	
Administrative Patent Judge	)	
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	)	
	)	BOARD OF PATENT
LANCE LEONARD BARRY	)	)
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
	)	
HOWARD B. BLANKENSHIP	)	
Administrative Patent Judge	)	

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