

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MASANORI HARA

Appeal No. 1998-3023
Application No. 08/339,731

ON BRIEF

Before HAIRSTON, HECKER, and BARRY, Administrative Patent Judges.

HAIRSTON, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1 to 26, all of the claims pending in the application.

BACKGROUND

The disclosed invention is directed to a fingerprint image cutout processing device and a method for use with tenprint cards that selects and inputs fingerprint images on a tenprint card. The tenprint cards contain twenty

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fingerprints - ten rolled and ten plain fingerprints.
An operator inputs the entire tenprint card image,
temporarily stores the image and displays it. The
operator views the image and identifies cutout regions
containing individual fingerprint images and the location
of each fingerprint image within each cutout region. The
operator then has the option of modifying the cutout
information to select cutout regions other than those
previously selected or outputting the selected cutout
regions containing the fingerprint images.

Representative independent claim 1 is reproduced as
follows:

1. A fingerprint image cutout processing device for
a tenprint card comprising:

image input means for inputting, on a card-by-card
basis, image data provided on a tenprint card containing
rolled fingerprints and plain fingerprints of ten
fingers;

image storage means for storing said image data
input by said image input means;

cutout information input means for accepting input
of fingerprint cutout information for each of said ten
fingers, said cutout information input means displaying
said tenprint

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image data and ten cutout frames in order to specify a cutout area of each fingerprint image to be superposed with each other; and

cutout means for cutting, on a finger-by-finger basis, fingerprint image data out of the tenprint image data of the tenprint card stored in said image storage means based on the tenprint cutout information input to said cutout information input means.

The examiner relies on the following references:

Brooks	4,607,384	Aug. 19, 1986
Tanaka et al. (Tanaka)	4,694,354	Sep. 15, 1987
Pieper 26, 1988	4,721,628	Jan.
Sparrow	4,817,183	Mar. 28, 1989

Claims 1 to 4, 9 to 11, 14 to 17 and 22 to 24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Sparrow, Tanaka, and Pieper.

Claims 5 to 8, 12, 13, 18 to 21, 25 and 26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Sparrow, Tanaka, Pieper, and Brooks.

Reference is made to the briefs (paper nos. 13 and 15) and the answer (paper no. 14) for the respective positions of appellant and the examiner.

OPINION

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According to the examiner (answer, page 6), "Sparrow shows image input means for inputting, on a card-by-card basis, image data provided on a tenprint card containing fingerprints of ten fingers (note Sparrow col. 2, lines 1-5 and col. 3, line 56 to col. 4, line 15)." The examiner readily admits that Sparrow does not disclose the use of cutout information input means for accepting input cutout information. The examiner attempts to address Sparrow's shortcomings by incorporating the video-editing technology of Tanaka (answer, page 6). The examiner contends that "Tanaka would have provided a reliable method for selecting and cutting out each of the fingerprint images by allowing the human operator to select and cut out the images" (answer, page 7). The appellant argues that neither Tanaka nor Sparrow provides motivation to combine the two references and that the examiner has employed impermissible hindsight (brief, page 8). With respect to appellant's hindsight argument, "[a]ny judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning, but so long as it takes into account only knowledge which was

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within the level of ordinary skill at the time the claimed invention was made and does not include knowledge gleaned only from applicant's disclosure, such a reconstruction is proper." In re McLaughlin, 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971). Did the examiner use knowledge gleaned only from the applicant's disclosure? We are of the opinion that the examiner did and, therefore, relied upon impermissible hindsight to combine the references to form the obviousness rejections. Tanaka is drawn to an apparatus that gives trimming instructions to a developer of photographs (column 1, lines 10 to 13). Tanaka is silent in regards to editing fingerprint images on tenprint cards. The examiner's motive is understandable; the claimed invention does utilize video to store, to display and to edit the cutout regions of the fingerprint images (e.g., as in claim 1) but, without the benefit of the appellant's disclosed and claimed invention, there would be no logical reason to combine the disparate technologies of the applied references. Stated differently, we do not agree with the examiner that

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Tanaka "logically would have commended itself to an inventor's attention in considering his problem" of how to edit fingerprint images. Wang Lab., Inc. v. Toshiba Corp., 993 F.2d 858, 864, 26 USPQ2d 1767, 1773 (Fed. Cir. 1993). Turning to the teachings of Pieper,

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we find that the tenprint card teachings of Pieper are merely cumulative to those already found in Sparrow.

In summary, the obviousness rejection of claims 1 to 4, 9 to 11, 14 to 17 and 22 to 24 is reversed because the examiner has failed to present a prima facie case of obviousness via a convincing line of reasoning for combining the applied references or by pointing to something in the references that would have suggested the proposed combination. The obviousness rejection of claims 5 to 8, 12, 13, 18 to 21, 25 and 26 is reversed because the fingerprint alignment teachings of Brooks do not cure the noted shortcoming in the proposed combination of references.

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