

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. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte URI BARAN and EDWIN TURNER

Appeal No. 1999-0537
Application 08/543,640

ON BRIEF

Before JERRY SMITH, FLEMING, and RUGGIERO, **Administrative Patent Judges**.

FLEMING, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 2-3 and 5-9, all the claims pending in the present application. Claims 1 and 4 have been canceled.

The invention relates generally to a computer system to detect and record security related events (specification, page

1,

lines 1-3). In particular, the computer system comprises a data transmission network (figure 1, item 12), a plurality of operator terminals (figure 1, item 10) connected to the network, a control computer (figure 1, item 13) connected to the network, and at least one closed circuit television camera (figure 1, item 15) and video recorder (figure 1, item 16) connected to the control computer. Each terminal includes means for generating event data (figure 1, item 24) and monitoring means (figure 1, item 27) for filtering event data to detect predetermined security-related events and, upon detection of such event, sending an alert message and the event data over the network to the control computer. The control computer responds to the alert message and activates the camera and recorder to record a view of the operator terminal, along with the event data (specification, pages 3-5).

Independent claim 7 is reproduced as follows:

7. A computer system comprising:

(a) a data transmission network;

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(b) a plurality of operator terminals connected to the network;

(c) a control computer connected to the network;
and

(d) at least one closed circuit television camera and video recorder connected to said control computer;

(e) wherein each of said terminals includes

(i) means for generating event data, and

(ii) monitoring means for filtering said event data to detect predetermined security-related events and, upon detection of such an event, for sending an alert message and said event data over the network to said control computer;

(f) and wherein said control computer includes means for responding to said alert message by activating said camera and recorder to record a view of the operator terminal, along with said event data.

The Examiner relies on the following references:

Clever	4,237,483	Dec. 02, 1980
May	GB 2 182 224	May 07, 1987

Sensormatic, publication¹ "POS/EM® Value, Point-Of-

¹ This reference was not of record in the Final Rejection, and was first noted by the Examiner in an Advisory Action (paper no. 8) by reference to a

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Sale, Exception Monitoring, RIVAL Series",
Sensormatic Electronics Corporation. pp. 1-4.
Claims 2 and 7-8 are rejected under 35 U.S.C. § 102(b) as
anticipated² by May.

Claims 3, 5-6 and 9 stand rejected under 35 U.S.C. § 103
as being unpatentable over May when taken Clever.

Claims 2, 3, 7 and 9 stand rejected under 35 U.S.C. § 103
as being unpatentable over Clever.

Claims 5, 6 and 8 stand rejected under 35 U.S.C. § 103 as
being unpatentable over Clever when taken with May.

Rather than reiterate the arguments of Appellants and the
Examiner, reference is made to the Brief³, Reply Brief⁴, and

PTO-892 form. Prior to the Examiner's Answer this reference was not applied to
any pending rejection.

We note *In re Hoch*, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 409 n.3 (CCPA
1970) ('Where a reference is relied upon to support a rejection, whether or
not in a 'minor capacity,' there would appear to be no excuse for not
positively including the reference in the statement of the rejection.');

E. I. du Pont de Nemours & Co. v. Berkley & Co., 620 F.2d 1247, 1266-67, 205 USPQ
1, 15-16 (8th Cir. 1980) ('The PTO's function entails a thorough scrutiny of
prior art references. ...'). Accordingly, we will not consider this
reference. as a basis for the Examiner's rejection.

² Although the Final Rejection at page 2, section 3, incorrectly bases
this rejection upon a public use or sale of the invention, Appellants have
correctly addressed the rejection (brief, page 4) as based upon prior
publication.

³ The Brief was received March 11, 1998.

⁴ The Reply Brief was received July 27, 1998.

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Examiner's Answer⁵, for the respective details thereof.

OPINION

After careful review of the evidence before us, we will not sustain any of the rejections.

A. Rejection of claims 2 and 7-8 under 35 U.S.C. § 102(b) as anticipated by May

We will not sustain the rejection of claims 2 and 7-8 under 35 U.S.C. § 102(b) as anticipated by May.

It is axiomatic that anticipation of a claim under 35 U.S.C. § 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

⁵ Mailed June 23, 1998.

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inherency, each and every element of a claimed invention."
RCA Corp. v. Applied Digital Data Systems, 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 submit⁶ that "there is clearly absolutely no
suggestion in UK'224 that the POS terminals 11 perform any
filtering of event data." (Appellants' emphasis). Furthermore,
Appellants contend that it is clear that in May each POS
terminal sends all its event data over the network without any
prior filtering, and that selection of event data occurs only
at the central processor 12. Therefore, Appellants assert⁷
that May does not teach or suggest any monitoring means for
filtering event data and for sending an alert message over the
network upon detection of such an event, as claimed.

As regards May's disclosure at page 2 lines 10 *et seq.*,

⁶ Brief, page 4.

⁷ Brief, page 5.

which is directed to switching to video recording upon the 'total' key being depressed or the accumulator reaching 10 pounds Sterling, Appellants assert that this operation is carried out by central processor 12 as described by May at page 2, lines 27-30.

The Examiner first points⁸ to May's⁹ statement that "monitoring a cash till at a retail checkout in which a video camera monitors events in the checkout area, events for monitoring being selected by cash till actuation" The Examiner also points to May's statement¹⁰ that "the recorder switched on to record (if it is not already) as soon as the 'total' key is pressed . . ." for a given action (Examiner's emphasis). Finally, the Examiner points¹¹ to May's statement¹² that, "The method may be applied to monitoring a cash till at a retail checkout in which a video camera monitors events in the checkout area, events for monitoring being selected by

⁸ Answer, page 4.

⁹ Page 1; see lines 94-97.

¹⁰ Page 2, [sic] lines 79 *et seq*; however, see lines 12-14.

¹¹ Answer, page 5.

¹² Page 2 [sic], lines 94 *et seq*.; see page 1, lines 94 *et seq*.

cash till actuation."

The Examiner then asserts¹³ that May thus discloses that actuation of the cash register till keys generates an alert message, which causes the control processor to activate the video camera and record the events, and that random or unelected events occurring at the till do not activate recording. Therefore, the Examiner finds¹⁴ that "the system (cash till) has filtered out the generation of an alert message for other key actions not of interest."

Turning to claim 7, we find that the subparagraph (e) thereof recites "wherein each of said terminals includes . . . (ii) monitoring means for filtering said event data to detect predetermined security-related events and, upon detection of such an event, for sending an alert message and said event data over the network to said control computer" (Emphasis added). Appellants' specification¹⁵ provides that the corresponding apparatus to the "monitoring means" is the security monitor 27, which filters the incoming data, looking

¹³ Answer, page 4.

¹⁴ Answer, pages 4-5.

¹⁵ Page 4, lines 25-29.

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for predetermined security-related events, and upon detection of such events sends an alert message over the LAN 12 to the control computer.

Considering all the citations from May which are relied upon by the Examiner, we fail to find the terminals including monitoring means for filtering event data to detect predetermined security-related events. While May provides that pressing the "total" key or having the accumulator reach 10 pounds Sterling would trigger recording, this does not provide monitoring means for filtering event data as claimed. Although other signals generated by the till may not trigger recording, there is no requirement or suggestion in May that they are actually filtered out.

As the terminals including monitoring means for filtering event data to detect predetermined security-related events as recited in independent claims 7 and 8 are not disclosed by May this rejection is reversed.

B. Rejection of claims 3, 5-6 and 9 under 35 U.S.C. § 103 as being unpatentable over May when taken Clever

We will not sustain the rejection of claims 3, 5-6 and 9

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under 35 U.S.C. § 103.

The Examiner has failed to set forth a *prima facie* case. It is the burden of the Examiner to establish why one having ordinary skill in the art would have been led to the claimed invention by the express teachings or suggestions found in the prior art, or by implications contained in such teachings or suggestions. *In re Sernaker*, 702 F.2d 989, 995, 217 USPQ 1, 6 (Fed. Cir. 1983).

Appellants assert¹⁶ that neither Clever nor May describes or suggest filtering of the event data at the terminal side of a network, rather than at the control computer side of the network.

The Examiner asserts¹⁷ that May discloses filtering at the till for the same reasons given in the rejection under 35 U.S.C. § 102(b).

In addition the Examiner's states¹⁸, as regards Clever "the Examiner has not relied upon this reference to teach the disclosed feature of filtering." However, the Examiner cites

¹⁶ Brief, page 8.

¹⁷ Answer, page 6.

¹⁸ Answer, page 5.

Clever's¹⁹ statements that a "surveillance system capable of storing video information which is edited in accordance with prescribed criteria." and²⁰ "an edited recording of salient or specific classes of transactions is developed by processing the data signal in accordance with certain criteria." The Examiner then points to Clever's suggestion²¹ that a control computer may be located at each terminal. The Examiner then states²² "The Examiner took official notice that the combined effects of placing a control computer at each electronic cash register for generating and filtering a selected criteria would have been obvious to one of ordinary skill in the art."

The Federal Circuit states that "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the

¹⁹ Column 2, line [sic] 60 *et seq*; see column 1, line 63 *et seq*.

²⁰ Column 2, lines 34 *et seq*.

²¹ Column 3, line 19 *et seq*.

²² Answer, page 5.

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prior art suggested the desirability of the modification." **In re Fritch**, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992), **citing In re Gordon**, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). "Obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor." **Para-Ordnance**, 73 F.3d at 1087, 37 USPQ2d at 1239, **citing W. L. Gore & Assocs.**, 721 F.2d at 1551, 1553, 220 USPQ at 311, 312-13. In addition, our reviewing court requires the PTO to make specific findings on a suggestion to combine prior art references. **In re Dembiczak**, 175 F.3d 994, 1000-01, 50 USPQ2d 1614, 1617-19 (Fed. Cir. 1999).

The Examiner has failed to provide any teaching or suggestion from the prior art to provide monitoring means for filtering of the event data at each terminal. Therefore, the rejection of claims 3, 5-6 and 9 under 35 U.S.C. § 103 is reversed.

C. Rejection of Claims 2-3, 7 and 9 under 35 U.S.C. § 103

over Clever

We will not sustain the rejections of claims 2-3, 7 and 9 under 35 U.S.C. § 103 over Clever.

Appellants assert²³ that in Clever neither the POS terminals 14 nor their associated control devices 27 perform any filtering of event data. Appellants contend that Clever does not describe using a signal from the cash register as an enabling signal for the activation of the surveillance system, but provides using the signals to form the selection or rejection identifiers which are recorded along with the video data. Thus Clever's surveillance system records all transactions, whether selected or not.

In addition, Appellants again argue²⁴ that Clever completely fails to disclose anything that would teach or suggest filtering of event data at the terminals.

The Examiner states²⁵ "Not explicitly taught is the terminal being composed of the monitoring (filtering) means which are performed by the computer control." The Examiner

²³ Brief, page 6.

²⁴ Brief, page 7.

²⁵ Final rejection, page 5, section a.

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then states

"The Examiner takes official notice of the benefits and motivations, for integrating a device which was off-chip, on-chip, and that this concept is notoriously well known in the data processing art. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify by integration, either firmware or software or hardware, the incorporation of the separate control devices (27) within each of the respective terminals. One of ordinary skill would have been motivated to perform such a modification, because one of ordinary skill would have readily realized that the functions of the control devices and the terminals are not affected by the location of the control device . . . "

The Examiner has failed to set forth a *prima facie* case. It is the burden of the Examiner to establish why one having ordinary skill in the art would have been led to the claimed invention by the express teachings or suggestions found in the prior art, or by implications contained in such teachings or suggestions. The Examiner has not set forth any

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evidentiary basis in the prior art for providing monitoring means for filtering of event data at the terminals.

Therefore, the rejection of claims 2-3, 7 and 9 under 35 U.S.C. § 103 over Clever is reversed.

D. Rejection of Claims 5, 6 and 8 under 35 U.S.C. § 103 over Clever and May

Appellants address²⁶ this rejection with the same arguments as those set forth regarding the rejection of claims 3, 5-6 and 9 over May when taken with Clever, as set forth in section B above.

The Examiner's Answer presents no additional arguments as regards this rejection, and the Final Rejection²⁷ does not provide any additional basis for finding obvious the claimed monitoring means for filtering of event data at the terminals.

Therefore, the rejection of claims 5, 6 and 8 under 35 U.S.C. § 103 over Clever and May is reversed for the reasons set forth *supra* in sections B and C, above.

²⁶ Brief, pages 7-8.

²⁷ Page 6, section 7.

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We have not sustained any of the rejections of claims 2-3 and 5-9. Accordingly, the Examiner's decision is reversed.

REVERSED

JERRY SMITH)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
MICHAEL R. FLEMING)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
)	
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