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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
11/425,224	06/20/2006	Dean R. Hill	200007-01054	8913
	7590	02/15/2013	EXAMINER	
Grant E. Coffield Eckert Seamans Cherin & Mellott, LLC 44th Floor 600 Grant Street Pittsburgh, PA 15219			ALLEN, STEPHONE B	
			ART UNIT	PAPER NUMBER
			2872	
			MAIL DATE	DELIVERY MODE
			02/15/2013	PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DEAN R. HILL, ROBERT E. RENTON, ANDREW K. ROWE,
and PAUL DUNN

Appeal 2010-009460¹
Application 11/425,224
Technology Center 2800

Before JEAN R. HOMERE, JASON V. MORGAN, BRYAN F. MOORE,
Administrative Patent Judges.

HOMERE, *Administrative Patent Judge.*

DECISION ON APPEAL

¹ The real party in interest is OpSec Security Group, Inc. (App. Br. 2.)

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1-17. Claims 18-27 have been cancelled. (App. Br. 2.) We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

Appellants' Invention

Appellants invented an optically variable device (OVD) (1) with diffraction-based micro-optics (18) for magnifying the visual representation of a micro-object (14) viewed from a relative point of observation (26). (Figure 1, Specification 1, ll. 7-10.) In particular, the micro-object (14) is disposed in a first portion (6) of the OVD substrate (4) between the diffractive structure (18) in a second portion (8) of the OVD substrate (4) and the observation point (26). (*Id.* at 4, ll. 3-22.)

Illustrative Claim

Independent claim 1 further illustrates the invention as follows:

1. An optically variable device comprising:
a substrate including a first portion and a second portion;
at least one micro-object disposed on the first portion of said substrate;
and
a diffractive structure disposed on the second portion of said substrate,
wherein at least one magnified visual representation of said micro-object is observed when said optically variable device is observed from a predetermined relative observation point and said micro-object is disposed between said diffractive structure and said observation point.

Prior Art Relied Upon

The Examiner relies on the following prior art as evidence of unpatentability:

Phillips	US 2005/0128543 A1	Jun. 16, 2005
Thompkin	WO 97/19820	Jun. 5, 1997

Rejections on Appeal

The Examiner rejects the claims on appeal as follows:

1. Claims 1-6, and 8-17 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Tompkin.
2. Claim 7 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Tompkin and Phillips.

ANALYSIS

We consider Appellants' arguments *seriatim* as they are presented in the Appeal Brief, pages 7-11 and the Reply Brief, pages 2-8.

Dispositive Issue: Have Appellants shown the Examiner erred in finding that Tompkin describes *a magnified visual representation of a micro-object being disposed between a diffractive structure and an observation point*, as recited claim 1?

Appellants argue that Tompkin does not describe the disputed limitations emphasized above. In particular, Appellants argue that Tompkin discloses placing a microlens between an observation point and microscopic relief structures to thereby display traditional moire color changing effects caused by altering the direction of incidence of light onto effective structures

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of a foil. (App. Br. 7-9.) However, Appellants argue that Tompkin's disclosure of a color shift does not describe the magnification of a visual representation of a micro-object, as claimed. (*Id.* at 8.) Further, Appellants argue that Tompkin's teaching does not describe the object being disposed between a diffractive structure and an observation point. (*Id.* at 9.)

In response, the Examiner concludes that because claim 1 is directed to an apparatus, the functional limitation whereby the magnified representation of a micro-object is observed cannot be properly relied upon to distinguish the claim over the Tompkin reference. (Ans. 7.) Rather, the apparatus claim must be distinguished from the cited prior art by what it is as opposed to what it does. (*Id.*) Further, the Examiner finds that even if the functional limitation were given patentable weight, Tompkin's disclosure of microstructures that interact with a symbol representation to thereby make the symbol visible teaches the disputed limitations. (*Id.* at 8-9.)

On the record before us, we do not agree with the Examiner's finding of anticipation. First, while the Examiner correctly points out that an apparatus claim cannot be distinguished from the prior art solely based upon a functional limitation recited therein, the functional limitation cannot be ignored outright. That is, there must be a showing that the equivalent structure recited in the prior art is capable of performing the recited

function.² As argued by Appellants, Tompkin's optical information carrier is not capable of performing the recited functions set forth above. In particular, we agree with Appellants that while the microstructures are not perceptible to the naked eye, those relief structures are mere gratings through which diffracted lights to shine to illuminate a partially covered layer mounted thereon containing the symbol "VALID." (Tompkin, 11, ll. 1-12, Reply Br. 3-4.) Thus, we echo Appellants' argument that while Tompkin discloses using a diffracted light to make the microstructures and the representative symbol visible to the naked eye, neither of the structures nor the symbol is magnified or enlarged (as per the Examiner's claim interpretation, Ans. 8.) Because Appellants have shown at least one error in the Examiner's anticipation rejection, we need not reach Appellants' remaining arguments. It follows that Appellants have shown error in the Examiner's rejection of claim 1.

² Claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function, *see, e.g., In re Schreiber*, 128 F.3d 1473, 1477-78 (Fed. Cir. 1997), in order to satisfy the functional limitations in an apparatus claim, however, the prior art apparatus must be capable of performing the claimed function. *Id.* at 1478. The prior art structure must be capable of performing the function without further programming. *Typhoon Touch Techs., Inc. v. Dell, Inc.*, 659 F.3d 1376, 1380 (Fed. Cir. 2011) (discussing *Microprocessor Enhancement Corp. v. Texas Instruments, Inc.*, 520 F.3d 1367 (Fed.Cir.2008)). When the functional language is associated with programming or some other structure required to perform the function, that programming or structure must be present in order to meet the claim limitation. *Id.*

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Because claims 2-17 recite the disputed limitations above, Appellants have similarly shown error in the rejections of claims 2-17.

DECISION

We reverse the Examiner's rejections of claims 1-17 as set forth above.

REVERSED

ELD