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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte BLAKE MARTIN LANGLEY and
WENDELL WAYNE BAGLEY

Appeal 2014-005383
Application 13/083,821
Technology Center 2800

Before ADRIENE LEPIANE HANLON, TERRY J. OWENS, and
ROMULO H. DELMENDO, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1–25. We have jurisdiction under 35 U.S.C. § 6(b).

The Invention

The Appellants claim an encoded identification device and a method for using it to protect a child. Claims 1 and 9 are illustrative:

1. An encoded identification device, comprising:
a substrate having a surface; and
visual coded information disposed upon said surface;
wherein said visual coded information encodes a
communication address and a unique serial number distinct
from said communication address.

The Appellants' claims 1 and 18 require that visual coded information encodes a (claim 1) or at least a (claim 18) communication address and a unique serial number distinct from the communication address.

Bushman discloses a wearable item comprising an image which encodes a voice message and communication data and can be received optically by a wireless communication device which, after receipt and processing of the image, transmits the voice message based on the communication data (col. 1, ll. 25–32, 56–67). The communication data “could be a telephone number, email address, uniform resource locator, Internet address or some other communication code” (col. 2, ll. 1–3). The wireless communication device might call a telephone number specified by the communication data and then play a voice message over the call connection or might transfer a voice file containing a voice message to an Internet address or uniform resource locator specified by the communication data (col. 2, ll. 61–67).

The Examiner relies upon Bushman's telephone number communication data (col. 2, l. 1) as corresponding to the Appellants' unique serial number (Ans. 4). The Examiner, however, does not establish that Bushman discloses encoding both the telephone number and a communication address which is distinct from the telephone number. The Examiner lists Bushman's communication data types (Ans. 2) but fails to state that the communication data types are disclosed in the alternative (col. 2, ll. 1–3). The Examiner does not establish that Bushman discloses using them in combination. The Examiner also cites to Bushman's column 4, line 21, *et seq.* (Ans. 2; Final Act. 2) but does not show that the

disclosure describes visually coded information encoding a communication address and a unique serial number, as required by claim 1.

Thus, the Examiner has not established a prima facie case of anticipation by Bushman of the devices claimed in the Appellants' independent claims 1 and 18 and their dependent claims.

Rejection under 35 U.S.C. § 103 (claim 9)

Claim 9 requires that “visual coded information encodes a communication address and a unique serial number” and further requires entering into a database the unique serial number and, linked thereto, a child's parent's contact information.

The Examiner asserts that “[w]ith respect to the specific use [protecting a child], it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus satisfying the claimed structural limitations” (Ans. 3).

That assertion is not well taken because the Appellants' claim 9 claims a method, not an apparatus.

The Examiner asserts that Bushman fails to disclose “additional communication information (i.e. website address), and the specific method of use. However, these limitations are well within the imagination of an ordinary artisan within the art” (Ans. 3).

Setting forth a prima facie case of obviousness requires establishing that the applied prior art would have provided one of ordinary skill in the art with an apparent reason to modify the prior art to arrive at the claimed invention. *See KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007).

The Examiner does not establish that Bushman would have provided one of ordinary skill in the art with an apparent reason to encode a communication address and a unique serial number or to enter into a database the unique serial number and a child's parent's contact information linked thereto. The Examiner's mere assertion that doing so is well within the imagination of an ordinary artisan (Ans. 3) does not meet that burden.

The Examiner, therefore, has not established a prima facie case of obviousness of the method claimed in the Appellants' claim 9 or its dependent claims.

New ground of rejection

Claim 1 is rejected under 35 U.S.C. § 102(b) as anticipated by Boswell.¹

Boswell discloses an encoded identification device comprising a substrate (driver's license or identification card substrate) and visual coded information on the substrate's surface (2-D bar code including the cardholder's information printed on the face of the card), wherein the visual coded information encodes a communication address (street address) and a unique serial number (driver's license or identification card number) distinct from the communication address. Consequently, Boswell anticipates the device claimed in the Appellants' claim 1.²

¹ Donald L. Boswell, *Letter to DMV Stakeholder* (Commonwealth of Virginia Department of Motor Vehicles, May 20, 2009). The Boswell reference has been added to the official record.

² We leave it to the Examiner to address the other claims. The Examiner and the Appellants should consider whether, in view of *Bilski v. Kappos*, 561 U.S. 593 (2010) and *Alice Corp. v. CLS Bank International*, 134 S. Ct. 2347 (2014), claim 9 claims patentable subject matter under 35 U.S.C. § 101.

DECISION/ORDER

The rejections over Bushman of claims 1, 2, 5–7, 18, 19, and 22–24 under 35 U.S.C. § 102(e) and claims 3, 4, 8–17, 20, 21, and 25 under 35 U.S.C. § 103 are reversed. A new ground of rejection of claim 1 has been entered.

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b).

37 C.F.R. § 41.50(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 the appeal as to the rejected claims:

(1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the prosecution will be remanded to the examiner. . . .

(2) *Request rehearing*. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

It is ordered that the Examiner's decision is reversed.

REVERSED