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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MICHEAL L. GIFFORD

Appeal 2019-002561
Application 15/134,384
Technology Center 2800

Before JOHN A. EVANS, JOHN P. PINKERTON, and
MICHAEL M. BARRY, *Administrative Patent Judges*.

EVANS, *Administrative Patent Judge*.

DECISION ON APPEAL
STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from the Examiner’s decision to reject claims 13–23. Appeal Br. 5, 9. Claim 1 is cancelled, and claims 2–12 are withdrawn from consideration. *Id.* at 5. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.²

¹ We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies the real party in interest as “Socket Mobile, Inc.” Appeal Br. 3.

² Rather than reiterate the arguments of Appellant and the Examiner, we refer to the Appeal Brief (filed October 13, 2018, “Appeal Br.”), the Reply Brief (filed February 10, 2019, “Reply Br.”), the Examiner’s Answer

CLAIMED SUBJECT MATTER

The claims relate to an optical beam transformer, i.e., aimer, that uses a smart phone's flash illumination, controlled by a smart phone software application, to provide an aimer beam to assist in properly orienting and distancing the smart phone camera with respect to a printed barcode. Spec. ¶ 10.

CLAIMS

Claims 13 and 18 are independent. An understanding of the invention can be derived from a reading of illustrative claim 18, which is reproduced below with some formatting added:

18. A method comprising:

transforming an optical beam via an optical beam transformer;

maintaining alignment of the optical beam transformer to a removable enclosure usable to enclose a smart phone;

wherein the smart phone is a standard smart phone not having any barcode imaging application-specific hardware, is enabled to support general purpose mobile applications, and has a built-in flash and a built-in digital camera enabled to support general purpose photography;

wherein the smart phone is enabled to execute a barcode software application to control the built-in flash, to control the built-in digital camera to capture an image of a barcode, to convert the captured barcode image to an internal form, and to store the internal form in a data file;

(mailed December 10, 2018, "Ans."), the Final Office Action (mailed September 18, 2017, "Final"), and the Specification (filed April 21, 2016, "Spec.") for their respective details.

wherein the maintaining alignment is via at least one surface shaped to be compatible with removable attachment of the optical beam transformer to an external surface of the removable enclosure and formed to retain the optical beam transformer in alignment with an aperture of the built-in flash when the smart phone is inserted in the removable enclosure;

wherein the optical beam transformer has an optical input to receive light from the built-in flash aperture and an optical output to provide a transformation of the received light into an aiming pattern, the aiming pattern enabling a user to distance the smart phone in accordance with optimum speed focusing of the built-in digital camera; and

wherein the aiming pattern assisted distancing enables the user to more rapidly process the barcode than possible with the smart phone alone.

Appeal Br. 20 (Claims App.).

REFERENCES

Name	Reference	Date
Jovanovski et al. (Jovanovski)	US 2012/0224083 A1	Sept. 6, 2012
Drake et al. (Drake)	US 2007/0280677 A1	Dec. 6, 2007

REJECTION

Claims 13–23 stand rejected under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over Jovanovski and Drake. Final 2–5.

ANALYSIS

CLAIMS 13–23:

OBVIOUSNESS OVER JOVANOVSKI AND DRAKE.

The Examiner relies on Jovanovski for teaching all of claim 13 except “wherein the maintaining alignment is via at least one surface shaped to be compatible with removable attachment of the optical beam transformer to an external surface of the smart phone and formed to retain the optical beam transformer in alignment with an aperture of the built-in flash,” for which the Examiner cites Drake. Final 2–4 (citing Jovanovski ¶¶ 21, 22, 24, 43, 50; Drake Figs. 1, 3); *see also id.* at 5 (additionally citing Jovanovski ¶¶ 40, 58); Ans. 5–7 (additionally citing Jovanovski ¶¶ 45, 46, Fig. 3).

Appellant disputes the Examiner’s findings (Appeal Br. 10–15; Reply Br. 2–3), including those for claim 13’s requirement of a smart phone that “is a standard smart phone not having any barcode imaging application-specific hardware, is enabled to support general purpose mobile applications, and has **a built-in flash** and a built-in digital camera **enabled to support general purpose photography.**” *See, e.g.,* Appeal Br. 13–15; Reply Br. 3.

The burden is on the Examiner to set forth a prima facie case of obviousness. *See, e.g., In re Glaug*, 283 F.3d 1335, 1338 (Fed. Cir. 2002). We determine the Examiner’s evidence does not adequately support a prima facie case of obviousness. “[O]bviousness requires a suggestion of all limitations in a claim.” *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) (citing *In re Royka*, 490 F.2d 981, 985 (CCPA 1974)).

In particular, the Examiner has not provided adequate evidence that the cited prior art teaches or suggests a smartphone that is “a standard smart phone not having any barcode imaging application-specific hardware.”

Appeal Br. 13; Reply Br. 3. To the contrary, Jovanovski describes its indicia reading device (“smartphone”) as containing an imaging module (“barcode imaging application-specific hardware”) for reading indicia (“barcode”) on a substrate. *See, e.g.*, Jovanovski ¶¶ 17–23, Fig. 1 (showing smartphone including imaging module 299), Fig. 2 (showing the hardware components of imaging module 299), Fig. 3 (showing how imaging module 299 may be used to capture image of barcode). The cited disclosures of Drake, which pertain to a portable photographic lens, similarly do not teach or suggest the disputed limitation. *See* Final Act. 4–5 (citing Drake Figs. 1, 3). Nor does the Examiner provide any persuasive reasoning or rationale to fill the gaps of the rejection.

Therefore, on this record, we determine the Examiner failed to establish a *prima facie* case of obviousness over Jovanovski and Drake for independent claim 13. Accordingly, we decline to sustain the Examiner’s rejection of independent claim 13. We likewise decline to sustain the Examiner’s rejection of independent claim 18, which recites a similar limitation for which the Examiner relies on the same deficient findings and reasoning. *See* Final 2–4. For similar reasons, we also decline to sustain the Examiner’s § 103 rejections of dependent claims 14–17 and 19–23, for which the Examiner fails to provide any finding or reasoning that cures the above deficiency. *See id.* at 4–5.

CONCLUSION

We reverse the Examiner’s rejection of claims 13–23 under pre-AIA 35 U.S.C. § 103(a).

Appeal 2019-002561
Application 15/134,384

In summary:

Claims Rejected	35 U.S.C. §	Basis	Affirmed	Reversed
13-23	103(a)	Jovanovski, Drake		13-23

REVERSED