

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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 CRAIG A. SMITH, WILLIAM R. HARTMAN,
MARK A. BYERS and MICHAEL B. NEARY

Appeal No. 2001-0813
Application No. 08/825,994

ON BRIEF

Before HAIRSTON, JERRY SMITH, and FLEMING, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-20, which constitute all the claims in the application.

The disclosed invention pertains to a supplemental information support system that can be used to enhance the user interface capabilities of a photocopier.

Representative claim 1 is reproduced as follows:

1. A supplemental information support system for a copier system having a central controller coupled to a user interface facility including a display device, said supplemental information support system comprising:

a stand-alone memory device storing user reference information;

a display controller coupled to the display device of the copier system;

and

a control device coupled to the central controller of the copier system, said control device including a microprocessor-based controller, a memory controller coupled to said stand-alone memory device and a control interface coupled to said display controller, wherein said control device is programmed to selectively provide said supplemental information support system with exclusive control over the display device to present user reference information from said stand-alone memory device in response to at least one of a user input, a user action, or an operating condition of the copier system.

The examiner relies on the following references:

Ito et al. (Ito)	4,682,158	July 21, 1987
Filion et al. (Filion)	5,036,361	July 30, 1991
Inoue et al. (Inoue)	5,159,546	Oct. 27, 1992

Watanabe et al. (Watanabe) EP 0 301 788 Feb. 01, 1989

Cummings, "Optical's Vast Expanses," PC Week, Vol. 5, No. 11, March 15, 1988, pages 5/17, 5/19, 5/22 and 5/23.

Claims 1-20 stand rejected under 35 U.S.C. § 103. As evidence of obviousness the examiner offers Watanabe taken alone with respect to claims 1-5 and 16-19, Watanabe in view of Filion with respect to claims 6-14, Watanabe in view of Cummings with respect to claim 15, and Watanabe in view of Cummings, Ito and Inoue with respect to claim 20.

Rather than repeat the arguments of appellants or the examiner, we make reference to the brief and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the brief along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 1-20. Accordingly, we reverse.

Even though the examiner has applied four different groupings of references to reject all the claims on appeal, appellants have, nevertheless, indicated that the claims should stand or fall together in only two groups. Specifically, appellants have indicated that claims 1-18 stand or fall together as a first group, and claims 19 and 20 stand or fall separately as a second group [brief, page 6]. Since appellants have not argued each of the rejections independently, we will consider the rejections against claims 1 and 19 as representative of all the claims on appeal. Note In re King, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986); In re Sernaker, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983).

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745

F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered and are deemed to be waived by appellants [see 37 CFR § 1.192(a)].

With respect to representative, independent claim 1, the examiner's rejection is set forth on pages 3-5 of the examiner's answer. The rejection essentially finds that Watanabe either explicitly teaches or inherently teaches all the features of claim 1 except for the control device being a microprocessor-based controller and that the control device is separate from the central controller. The examiner takes "Official Notice" that microprocessor-based controllers were well known in the art. The examiner also finds that Watanabe teaches that memory 6 can incorporate its own (separate) controller. The examiner also notes that it would have been obvious to provide a separate control device in order to lighten the burden on the main computer. With respect to representative, independent claim 19, the examiner additionally finds that Watanabe teaches the additionally claimed expert system.

With respect to claims 1 and 19, appellants argue that Watanabe lacks any teaching of the features of claims 1 and 19 directed to providing the information support system with exclusive control over the copier's display. Appellants argue that the examiner's finding that such a control device is inherent is erroneous because controller

17 controls the operation of display 32 regardless of whether the data is drawn from ROM 18 or from IC card 6. In other words, appellants argue that IC card 6 is not capable of exerting any type of control over the display device. Appellants also argue that the CPU of IC card 6 is not disclosed as exerting any control over the display [brief, pages 7-10].

The examiner responds that Appellants' arguments are not commensurate in scope with the claimed invention. Specifically, the examiner asserts that appellants are arguing the presence of two separate data sources and controllers which can each exert exclusive control over the display, whereas, claims 1 and 19 only recite a single such controller. The examiner finds that a controller is inherently present to retrieve the messages stored in memory 6 and to communicate with main controller 9. The position of the examiner is that when memory 6 is attached in Watanabe, the display is exclusively controlled by display controller 17 and the messages in memory 6. Therefore, the examiner finds that display controller 17 and memory 6 have exclusive control over display 32.

We will not sustain the examiner's rejection of claims 1-20 because the examiner has failed to establish a prima facie case of obviousness. The examiner's rejection relies on findings which are unsupported and speculative. More particularly, the rejection reads the claimed central controller on control part 9 of Watanabe, the user interface on display part 3 of Watanabe, and the claimed display controller on CPU 17

of Watanabe [answer, page 4]. The major element of claim 1 is the control device. This element has not been specifically read on any element of Watanabe. Instead, the examiner asserts that the claimed control device is inherently present in Watanabe and connected to control part 9. The examiner also asserts that the claimed memory controller and the claimed control interface are also inherent in Watanabe. The examiner then takes "Official Notice" that this inherent control device could obviously be a microprocessor-based controller as claimed. Finally, the examiner asserts that this microprocessor-based inherent control device has its own CPU which could obviously be programmed to take exclusive control of the display device when the memory 6 of Watanabe is attached [id., pages 4-5].

It is apparent from this rejection that the examiner's finding that the claimed control device is taught by Watanabe is based on a chain of speculative assumptions that are not found anywhere in Watanabe. We agree with appellants that a control device having the properties recited in claim 1 is not taught by Watanabe. We also agree with appellants that even if a control device is present somewhere in Watanabe, there is no teaching that this control device is programmed to selectively provide the supplemental information support system with exclusive control over the display device as claimed. Although the data displayed in Watanabe may come from memory 6 when memory 6 is attached, that description does not teach or suggest that memory 6 has exclusive control over the display device as claimed.

In summary, we have not sustained the examiner's rejection of independent claims 1 and 19 on appeal. Therefore, we also do not sustain the examiner's rejection of dependent claims 2-5 and 16-18. Although the remaining dependent claims are rejected based on Watanabe and additional teachings of Fillion, Cummings, Ito and/or Inoue, none of these additional references overcome the deficiencies of Watanabe

discussed above. Therefore, we also do not sustain the examiner's rejection of dependent claims 6-15 and 20. Accordingly, the decision of the examiner rejecting claims 1-20 is reversed.

REVERSED

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