

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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 CHRISTER HILLMERING

Appeal No. 2001-1602
Application No. 08/973,003

ON BRIEF

Before SMITH, FLEMING, and LALL, ***Administrative Patent Judges.***
FLEMING, ***Administrative Patent Judge.***

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-7.

The invention is an alphanumeric keyboard which is programmed such that an alpha-character is generated only when two adjacent keys are simultaneously depressed. A numeral is generated only when a single key is depressed.

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Independent claim 1 present in the application is reproduced as follows:

1. An alphanumerical keyboard comprising a plurality of numeral keys and function keys,

wherein the keyboard is programmed so that only simultaneous depression of exactly two mutually adjacent keys will generate an alpha-character and so that only depression of solely one numeral key will generate a numeral,

wherein simultaneous depression requires both of the exactly two mutually adjacent keys to be in a depressed state at the same time.

References

The references relied on by the Examiner are as follows:

Prame	4,381,502	Apr. 26, 1983
Beers	5,007,008	Apr. 9, 1991
Danish	5,117,455	May 26, 1992

Rejections at Issue

Claims 1, 3, 5, and 7 stand rejected under 35 U.S.C. § 103 as being unpatentable over Danish and Prame.

Claims 2, 4, and 6 stand rejected under 35 U.S.C. § 103 as being unpatentable over Danish, Prame and Beers.

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Rather than repeat the arguments of Appellant or the Examiner, we make reference to the brief¹ and the answer² for the details thereof.

OPINION

We will reverse the rejection of claims 1-7.

With regard to independent claims 1 and 7, Appellant argues that Danish does not disclose that only the depression of exactly two mutually adjacent keys will generate an alpha-character. See Brief, page 4, lines 17-19. Appellant argues that since only some of the Danish's alpha-characters are generated using two keys, Danish does not disclose a keyboard where an alpha-character is always and only generated by depressing two mutually adjacent keys. See Brief, page 5, lines 7-8 and 14-17.

The Examiner argues that the Danish keyboard could be modified by one of ordinary skill in the art to allow all the alpha-characters to be generated using two adjacent keys. The

¹ Appellant filed an Appeal Brief on October 20, 2000. We will refer to this appeal brief as simply the Brief. Appellant filed a reply brief on April 9, 2001. We will refer to this reply brief as the Reply Brief.

² The Examiner responded to Appellant's Appeal Brief on February 9, 2001. We will refer to this answer as simply the Answer.

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Examiner relies upon the following language in Danish to provide evidence for motivation:

It will be recognized by those skilled in the art that other key pad arrangements are used and that the matrix or the present invention may be adapted for use with other keypad configurations.

See Answer, page 8, lines 14-16. This language, contends the Examiner, constitutes a suggestion for the modification of the Danish keypad by using other keypad arrangements and configurations. See Answer, page 8, lines 16-18.

In response to the Examiner's argument that the Danish keyboard could be modified to form the claimed invention, Appellant argues that there is no teaching or suggestion available in Danish for the modification. See Brief, page 7, lines 14-18. Appellant argues that since Danish teaches a 12 key keyboard and that the keyboard of the claimed invention, as shown in Appellant's Figure 1, has 20 keys, there is no motivation for one of ordinary skill in the art to increase the number of keys without a clear advantage being present. See Brief, page 8, lines 1-7.

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or

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motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. The Federal Circuit has stated 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 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).

We agree with Appellant that the Examiner has failed to point to any teachings in Danish that would suggest the desirability of the modification to the Danish keyboard to achieve the limitations of claims 1 and 7. Although we agree with the Examiner that Danish suggests the modification of its keypad, we do not find any suggestion in Danish to modify its keypad to that of the claimed invention, wherein generation of alpha-characters is limited to always depressing exactly two adjacent keys.

The first step in our analysis is determining the scope of Appellant's claim. As the Federal Circuit has pointed out, "the name of the game is the claim." *In re Hiniker Co.*, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998).

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In determining the scope of Appellant's claim, we find that the only embodiment disclosed by the Appellant is a keyboard that has twenty keys in order to implement a keyboard as claimed. This finding is strengthened by Appellant's argument that the keyboard of the claimed invention, as shown in Appellant's Figure 1, has 20 keys. See Brief, page 8, lines 1-3. Thus, we find that the scope of Appellant's claim would not allow a reading on a standard telephone keypad with twelve keys, such that simultaneous depression of exactly two mutually adjacent keys generates an alpha-character.

Next, we must determine whether Danish provides the requisite hint or suggestion for modification to the claimed invention. The objective of Danish is to improve upon the standard telephone keypad, which has twelve keys, by providing a method for entering both alphabetical and numerical characters using the same set of keys. We find that Danish actually teaches away from modifying the standard telephone keypad in order to achieve the keyboard of the claimed invention, because the modification would increase the number of keys from twelve, such that the keyboard no longer would be a standard telephone keypad.

Thus, we agree with Appellant that there is no motivation, implicit or explicit in Danish, to modify the

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standard telephone keypads by substantially increasing its number of keys as well as by re-arranging the key layout, so as to provide generation of alpha-characters by depressing exactly two adjacent keys. As such, we cannot sustain the Examiner's rejection of claims 1 and 7 as being unpatentable under 35 U.S.C. § 103 in view of Danish and Prame.

In view of the foregoing, the decision of the Examiner rejecting claims 1 and 7 and dependent claims 2-6 under 35 U.S.C. § 103 is reversed.

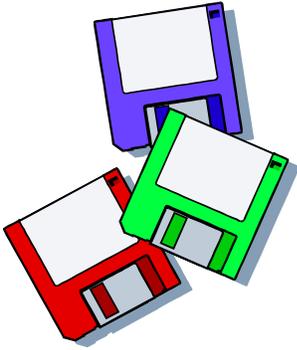
REVERSED

JERRY SMITH)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
MICHAEL R. FLEMING)	APPEALS
Administrative Patent Judge)	AND
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DECISION: REVERSED

Prepared: September 22, 2003

Draft Final

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