

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte TOSHIMASA NAGAOKA

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Appeal No. 2003-0037  
Application 08/924,681

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ON BRIEF

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Before COHEN, MCQUADE, and BAHR, Administrative Patent Judges.

MCQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Toshimasa Nagaoka originally took this appeal from the final rejection (Paper No. 9) of claims 1 through 14 and 16 through 22, all of the claims pending in the application. Upon consideration of the appellant's main brief (Paper No. 18), the examiner issued an Office action (Paper No. 19) reopening prosecution and entering new superseding rejections of claims 1 through 14 and 16 through 22. Pursuant to 37 CFR § 1.193(b)(2)(ii), the appellant then filed a supplemental brief (Paper No. 20) and requested that the appeal be reinstated. Implicitly granting the request, the

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examiner entered an answer (Paper No. 23), noted a reply brief (Paper No. 24) filed by the appellant and forwarded the application to this Board for review of the new rejections.

THE INVENTION

The invention relates to "an input pen for use in a pressure sensitive handwriting input unit" (specification, page 1).

Representative claim 1 reads as follows:

1. An input pen for use in a pressure sensitive handwriting input unit, comprising:  
a pen cylinder having a front end and a rear end;<sup>1</sup>

a front input member disposed on said front end of said pen cylinder and having an input portion used for input operations, said front input member being made of a synthetic resin; and

a rear input member disposed on said rear end of said pen cylinder and having an input portion used for input operations, said rear input member being made of an elastic material softer than said synthetic resin.

THE PRIOR ART

The references relied on by the examiner to support the rejections on appeal are:

Verrier et al. (Verrier)	5,475,401	Dec. 12, 1995
Takahashi et al. (Takahashi)	5,638,093	Jun. 10, 1997
Yoshimura	5,850,059	Dec. 15, 1998

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<sup>1</sup> The above noted informality in claim 1 is deserving of correction upon return of the application to the technology center.

THE REJECTIONS

Claims 1, 4 through 13, 16, 17 and 19 through 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Verrier in view of Takahashi.

Claims 2, 3, 14 and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Verrier in view of Takahashi and Yoshimura.

Attention is directed to the appellant's main, supplemental and reply briefs (Paper Nos. 18, 20 and 24) and to the examiner's answer (Paper No. 23) for the respective positions of the appellant and examiner regarding the merits of these rejections.

DISCUSSION

Verrier, the examiner's primary reference, discloses a stylus 20 for use with a digitizing display 22 in a pen-based computer system. The stylus 20 comprises a writing end contacting portion 38 and an erasing end contacting portion 38' having similar constructions. As shown in Figures 2A and 2B, each end contacting portion includes a longitudinally displaceable tip 4, 4' for making mechanical contact with the digitizing display, an antenna 29, 29' for picking up electromagnetic positional signals from the digitizing display, a pressure transducer 10, 10' for sensing the pressure with which

the tip contacts the display, a printed circuit board 11, 11', a tetrafluoroethylene bushing 8, 8', and a tip-loading rubber gasket 6, 6'.

Applying Verrier against independent claim 1 (see page 3 in the answer), the examiner finds that the tips 4 and 4' on Verrier's stylus constitute front and rear input members, and that while tip 4 meets the claim limitation requiring the front input member to be made of a synthetic resin, tip 4' does not meet the claim limitation requiring the rear input member to be made of an elastic material softer than the synthetic resin. To overcome this deficiency, the examiner looks to Takahashi.

Takahashi discloses a touch panel input device which includes an input pen 13 and a deletion pen 12 for contacting the panel and attenuating acoustic waves traveling therethrough. The input pen has a writing tip thickness  $W1$  and the deletion pen has a writing tip thickness  $W2$ , wherein  $W1$  is less than  $W2$ . When the touch panel is contacted by one of these pens, it determines the width of the writing tip, and hence the identity (input or deletion) of the pen, and functions accordingly in an input mode or a deletion mode. Of particular interest is Takahashi's teaching that "[o]ne of the pens having a greater thickness

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[i.e., the deletion pen], can be replaced with an eraser having an elastic tip" (column 7, lines 6 through 8).

In proposing to combine Verrier and Takahashi to reject claim 1 under § 103(a), the examiner concludes that it would have been obvious at the time the invention was made to a person having ordinary skill in the art

to substitute an elastic material softer than the synthetic resin as taught by Takahashi et al. to the rear input member on the input device as taught by Verrier because this would help the user to easily distinguish between writing or erasing based on the different materials on each tip of the pen [answer, page 3].

Even if the Verrier reference is assumed to be analogous art (the appellant argues that it is not), the examiner's position here is unsound for at least two reasons.

To begin with, Verrier does not provide any factual basis for the examiner's finding that the "front" tip or input member 4 is made of a synthetic resin as required by claim 1. The passage at lines 1 through 19 of column 9 in the Verrier reference, which the examiner relies on to support this finding, specifies the materials from which the bushings 8, 8' and gaskets 6, 6' are made, but makes no mention of the material from which the tips 4, 4' are made.

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Furthermore, the fair teachings of Verrier and Takahashi do not justify the selective combination thereof proposed by the examiner. Considered collectively, these references are devoid of any indication that a user might encounter difficulty distinguishing between Verrier's writing and erasing ends, or that the proposed modification of Verrier in view of Takahashi would solve this problem even if it did exist. Moreover, the respective styluses or pens disclosed by Verrier and Takahashi are quite disparate in nature, with Verrier's pressure-sensitive erasing end contacting portion 38' being far more complex than Takahashi's rather simple wave-attenuating eraser with an elastic tip. The two constructions have little practical relevance to one another, and the proposed modification of Verrier's "rear" tip 4' by making it of an elastic material softer than the material of the "front" tip 4 seemingly would hinder accurate operation of the pressure-sensitive erasing portion 38'. In this light, it is evident that the only suggestion for combining Verrier and Takahashi so as to arrive at the subject matter recited in claim 1 stems from hindsight knowledge impermissibly derived from the appellant's disclosure.

Thus, the combined teachings of Verrier and Takahashi do not warrant a conclusion that the differences between the subject

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matter recited in independent claim 1 and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art. Accordingly, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of claim 1, and dependent claims 4 through 13, 16, 17 and 19 through 22, as being unpatentable over Verrier in view of Takahashi.

As Yoshimura does not cure the foregoing shortcomings of Verrier and Takahashi relative to the subject matter recited in parent claim 1, we also shall not sustain the standing 35 U.S.C. § 103(a) rejection of dependent claims 2, 3, 14 and 18 as being unpatentable over Verrier in view of Takahashi and Yoshimura.

#### SUMMARY

The decision of the examiner to reject claims 1 through 14 and 16 through 22 is reversed.

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REVERSED

IRWIN CHARLES COHEN	)	
Administrative Patent Judge	)	
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JOHN P. MCQUADE	)	
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JENNIFER D. BAHR	)	
Administrative Patent Judge	)	

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