

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN J. TRAINOR, CARL J. LAPLACE,
MICHAEL A. BELLIN and MARK R. HOFFMANN

Appeal No. 95-2631
Application 07/950,402¹

ON BRIEF

Before ABRAMS, STAAB and JERRY SMITH, *Administrative Patent Judges*.

STAAB, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 1-10, all the claims in the application.

Appellants' invention pertains to an interface for a controller of a voltage regulator of an electrical power

¹ Application for patent filed September 23, 1992.

Appeal No. 95-2631
Application 07/950,402

distribution system. The interface is mounted on a panel face of the controller and enables a user to easily display and control selected parameters of the system. The interface includes *inter alia* a keypad having a plurality of buttons, a display screen that, due to its operating environment, is not large enough to display simultaneously all display screen operational information, and a computer means for controlling the display in response to input entered at the interface. As explained on page 6 of the specification,

The buttons towards the bottom of the keypad . . . are dedicated function keys. They permit single-key access to the most commonly used functions. The buttons at the top of the display . . . are configuration/select or menu navigation keys. They permit access (through menu screens) to all of the control features, including those that can be accessed by a single keystroke of one of the dedicated function keys.

Independent claim 1 is illustrative of the appealed subject matter and reads as follows:

1. Apparatus for controlling an electrical power distribution mains system step voltage regulator, said apparatus comprising:

input means for designating for display selected operating parameters of an electrical power distribution mains system step voltage regulator, said input means being formed with a dedicated function portion and a menu navigation portion and said parameters being divided into first and second categories, respectively;

Appeal No. 95-2631
Application 07/950,402

display means for simultaneously displaying only a portion of less than the whole of all of said first and second category parameters; and

computer means connected to said input means and said display means for controlling said display means in response to activation of said input means;

said apparatus being constructed so that any parameter in said first category can be displayed on said display means by activation of said dedicated function portion and any parameter in said second category can be selected for display on said display means by activation of said menu navigation portion.

The references of record relied upon by the examiner in support of rejections under 35 U.S.C. § 103 are:

Morrison	3,906,482	Sept. 16, 1975
Kinoshita et al. (Kinoshita)	4,685,064	Aug. 4, 1987
Yoshiura et al. (Yoshiura) ² (Japanese Patent)	63-294235	Nov. 30, 1988

The following new reference of record is relied upon by this merits panel of the Board in support of a new ground of rejection pursuant to 37 CFR § 1.196(b):

Jindrick et al. (Jindrick)	4,419,619	Dec. 6, 1983
----------------------------	-----------	--------------

Claims 1-5, 8 and 10 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kinoshita in view of Yoshiura.

Claims 6, 7 and 9 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kinoshita in view of Yoshiura as set

² Our understanding of this Japanese language reference is derived from a translation prepared in the Patent and Trademark Office. A copy of the translation is attached to this opinion.

Appeal No. 95-2631
Application 07/950,402

forth in the rejection of claim 1 et al., and further in view of Morrison.

Kinoshita discloses, in pertinent part, an interface for a wire cut electric discharge machine. The interface includes a CRT display unit 5 for displaying various machining conditions, and a keypad 4 comprising a plurality of push buttons for presetting and updating the machining conditions. The push buttons include cursor position control buttons 6, 7 for shifting a cursor C appearing on the screen, buttons 8, 9 for, respectively, incrementing and decrementing a preset value, and buttons K0-K9 for directly inputting a numerical value. To preset a machining condition value or change a previously set machining condition value, the cursor position control buttons are utilized to select a particular displayed machining condition, e.g., VOLTAGE. Next, either the buttons 8, 9 are used to incrementally change the value of the selected machining condition, or the buttons K0-K9 are used to directly input a desired numerical value for the selected machining condition.

Yoshiura discloses a power system facility display device. With reference to Figure 4 of the translation of Yoshiura, the device displays the total system subject area A as a basic screen. When a user desires to investigate a particular area of

Appeal No. 95-2631
Application 07/950,402

the total system in greater detail, he specifies a location B on the total area basic screen that corresponds to the center of the area of interest. The user then specifies a magnification factor which determines the area surrounding the location B that will be displayed. Areas C and D of Figure 4 represent areas surrounding location B that correspond to two possible magnification factor choices. The display area E requested by the user, based on the specified location B and magnification factor, is then displayed on the screen.

Morrison relates to displays for time-varying binary-valued electric signals. The apparatus of Morrison

includes a display in which a plurality of electrically-controllable illuminative elements are arranged in a matrix having at least first and second rows and a plurality of columns. Advantageously, each element is a light-emitting diode. . . .

The apparatus includes display sweep circuitry that, in contrast to a conventional oscilloscope, is constructed of digital circuitry, there being no need to generate high voltage linear ramps according to the invention. [Column 2, lines 1-12.]

In rejecting claims 1-5, 8 and 10 as being unpatentable over Kinoshita in view of Yoshiura, the examiner, on pages 2-3 of the answer, took the positions that (1) because Kinoshita is directed to a means for regulating and distributing power to a matching system, it is directed to an apparatus for controlling an

Appeal No. 95-2631
Application 07/950,402

electrical power distribution system voltage regulator, (2) Kinoshita suggests at column 3, lines 41-43 and 60-91 that a portion of a display can be presented at one time, and (3) that Yoshiura suggests simultaneously displaying only a portion of a display. Based on the above, the examiner concluded that it would have been obvious to one of ordinary skill in the art to display a portion of the parameters in Kinoshita to enable more information to be called to the display. Implicit in the above is the examiner's position that the apparatus of Kinoshita modified in the proposed manner would correspond to the claimed subject matter in all respects.

We cannot support this rejection. Even if we were to agree with the examiner that Kinoshita is directed to an apparatus for controlling an electrical power distribution system voltage regulator and thus, contrary to appellants' argued position, constitutes analogous art, we are in accord with appellants that Kinoshita does not disclose, suggest or infer using the display unit 5 to display only a portion of the system's user settable operating parameters, as called for by each of independent claims 1, 8 and 10.³ With respect to the portions of Kinoshita's

³ In this regard, claim 1 calls for a "display means for simultaneously displaying only a portion of less than the whole of all of said first and second category parameters," claim 8

specification noted by the examiner, we understand these portions as merely referring to whether the present or the updated values of the parameters are displayed, and not to whether different parameters are displayed. As to Yoshiura, while we appreciate that this reference broadly teaches a display having the capacity to display less than all of the system parameters, there is no suggestion in either Kinoshita or Yoshiura, or need in view of their divergent objectives, for their combination. This is especially so in that Kinoshita's display is large enough to easily display all five of the system's settable parameters simultaneously. This constitutes a first reason necessitating reversal of the examiner's rejection of claims 1-5, 8 and 10.

We also see nothing whatsoever in the combined teachings of Kinoshita and Yoshiura which would have suggested to one of ordinary skill in the art the step of and/or means for selecting parameters for displaying on a display screen by activating a menu portion of the input means, as called for to one degree or

calls for the step of "providing display means for simultaneously displaying only a portion of less than the whole of all of the parameters," and claim 10 calls for the step of "selecting for display on the display device a portion of less than the whole of operational parameters set forth in a plurality of display menus"

another by each of independent claims 1, 8 and 10.⁴ The examiner's views to the contrary are based on a hindsight reading of the references, in our view. This constitutes an additional reason necessitating reversal of the examiner's rejection of claims 1-5, 8 and 10.

Turning to claims 6, 7 and 9, as with claims 1-5, 8 and 10, each of these claims also requires a display for displaying only a portion of the system's user settable operating parameters, and the step of and/or means for selecting parameters for displaying on a display screen by activating a menu portion of the input means. We have carefully considered the Morrison reference additionally relied upon by the examiner in rejecting these claims but find nothing therein which makes up for the deficiencies of Kinoshita and Yoshiura noted above. Accordingly, we also cannot support the examiner's rejection of these claims.

⁴ Claim 1 calls for "said apparatus being constructed so that . . . any parameter in said second category can be selected for display on said display means by activation of said menu navigation portion," claim 8 calls for the step of "activating the menu navigation portion to select for display only a portion of less than the whole of the parameters in the first or second category," and claim 10 calls for the step of "selecting for display on the display device a portion of less than the whole of operational parameters . . . by actuating menu navigation keys which cause the portion of operational parameters to be scrolled through the display."

Under the provisions of 37 CFR § 1.196(b), we enter the following new rejection.

Claim 10 is rejected under 35 U.S.C. § 102(b) as being anticipated by Jindrick, of record.⁵

At the outset, we observe that claim 10 is directed to a method for displaying operational parameters "comprising one of" the steps of "selecting for display . . . by actuating a dedicated input key" and "selecting for display . . . by actuating menu navigation keys. . . ." We interpret this claim language as being of such scope to encompass within its metes and bounds a method for displaying operational parameters by performing one of the selecting steps set forth in the body of the claims, regardless of whether said method also provides for displaying parameters by performing the other of said selecting steps.

In discussing prior art controllers of the type disclosed by Jindrick, appellants' Brief on page 4 contains the following candid statement:

In the past, step voltage regulator controllers have solved the problem of how to display a large variety of information on a limited size display by

⁵ This patent was cited by appellants in the information disclosure statement filed October 1, 1993 (Paper No. 5) and was mentioned on page 4 of appellants' Brief.

Appeal No. 95-2631
Application 07/950,402

requiring input of function codes through a keyboard panel or the like, *or by pressing a dedicated function key which calls up on the display that specific function.* See, e.g., cited art of record U.S. Patent No. 4,419,619 [Jindrick], Figs. 2B-3E and Column 8, lines 39-68. [Emphasis added.]

Given the scope of claim 10 as set forth above, the method of Jindrick for displaying operational parameters "by pressing a dedicated function key which calls up on the display that specific function" (Brief, page 4) fully anticipates claim 10.

In summary, the standing § 103 rejections of the appealed claims have been reversed, and a new rejection of claim 10 pursuant to our authority under 37 CFR § 1.196(b) has been made.

The decision of the examiner is reversed.

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also 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

Appeal No. 95-2631
Application 07/950,402

rejection to avoid termination of proceedings (§ 1.197(c)) as to
the rejected claims:

(1) Submit an appropriate amendment of the claims
so rejected or a showing of facts relating to the
claims so rejected, or both, and have the matter
reconsidered by the examiner, in which event the
application will be remanded to the examiner. . . .

(2) Request that the application be reheard under
§ 1.197(b) by the Board of Patent Appeals and
Interferences upon the same record. . . .

No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

REVERSED, 37 CFR § 1.196(b)

NEAL E. ABRAMS)	
Administrative Patent Judge)	
)	
)	
)	
LAWRENCE J. STAAB)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
JERRY SMITH)	
Administrative Patent Judge)	

Appeal No. 95-2631
Application 07/950,402

Siemens Corporation
Intellectual Property Dept.
186 Wood Avenue South
Iselin, NJ 08830