

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES CHARNESKI

Appeal No. 1997-1131
Application No. 08/395,119

ON BRIEF

Before THOMAS, FLEMING, and RUGGIERO, Administrative Patent Judges.

RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1 through 20, all of the claims pending in the present application.

The disclosed invention relates to an ornamental display of symbols for LED digital wrist watch and computer CRT faces. More particularly, Appellant indicates at pages 4 and 5 of the specification that displayed symbols are formed as a combination

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of first and second boxes and are arranged in juxtaposed rows. The first and second boxes share border defining elements and various display elements of the boxes are illuminated to jointly define the displayed symbols.

Claim 1 is illustrative of the invention and reads as follows:

1. A display device for a selected symbol formed with a first box having border defining elements, and with a second box having border defining elements, various ones of the elements of each of the two boxes being illumined or darkened to define jointly the symbol.

The Examiner relies on the following prior art:

Bailey et al. (Bailey) 4,039,890 Aug. 02, 1977

Claims 1 through 18 stand finally rejected under 35 U.S.C. § 102(b) as being anticipated by Bailey. Claims 19 and 20 stand finally rejected under 35 U.S.C. § 103 as being unpatentable over Bailey.

Rather than reiterate the arguments of Appellant and the Examiner, reference is made to the Briefs¹ and Answer for the respective details.

¹ The Appeal Brief was filed September 19, 1996. In response to the Examiner's Answer dated January 21, 1997, a Reply Brief was filed March 18, 1997 which was acknowledged and entered by the Examiner without further comment on April 15, 1997.

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OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the Examiner and the evidence of anticipation and obviousness relied upon by the Examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellant's arguments set forth in the Briefs 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 Bailey does not fully meet the invention as set forth in claims 1 through 18. We are also of the view 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 recited in claims 19 and 20. Accordingly, we reverse.

We also use our authority under 37 CFR § 1.196(b) to enter a new ground of rejection of independent claim 1. The basis for these conclusions will be set forth in detail below.

We consider first the rejection of claims 1 through 18 under 35 U.S.C. § 102(b) as being anticipated by Bailey. Anticipation is established only when a single prior art reference discloses,

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expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.); cert. dismissed, 468 U.S. 1228 (1984); W.L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

Our review of the record before us indicates that the Examiner, despite asserting the anticipatory nature of the disclosure of Bailey with respect to the appealed claims, has never attempted to show how each of the claimed limitations is met by the prior art. Instead, the Examiner has made a vague reference to Figure 1 of Bailey which illustrates a block diagram of an X-Y matrix of light emitting devices and draws the conclusion as stated at page 2 of the Answer that:

“... one can readily draw or activate any number of boxes filling the claimed requirements from the display of Bailey et al.

We find such assertion to be totally lacking of any support on the record. Our review of Bailey indicates no disclosure of the generation of symbols or digits of any kind, let alone the specific arrangement recited in the claims. We are not inclined

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to dispense with proof by evidence when the proposition at issue is not supported by a teaching in a prior art reference, common knowledge or capable of unquestionable demonstration. Our reviewing court requires this evidence in order to establish a prima facie case. In re Knapp-Monarch Co., 296 F.2d 230, 232, 132 USPQ 6, 8 (CCPA 1961); In re Cofer, 354 F.2d 664, 668, 148 USPQ 268, 271-72 (CCPA 1966).

Further, to the extent that the Examiner is relying on the unstated principle of inherency to support the contention that the claimed symbol defining boxes and border defining elements are disclosed by the LED matrix of Bailey, we reject this contention as well. To establish inherency, evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference and would be recognized as such by persons of ordinary skill. In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) citing Continental Can Co. v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." Id. citing Continental, 948 F.2d at 1269, 20 USPQ2d at 1749.

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In view of the above discussion, since all of the claimed limitations are not disclosed by Bailey, we do not sustain the Examiner's 35 U.S.C. § 102(b) rejection of claims 1 through 18.

Turning to a consideration of the obviousness rejection of claims 19 and 20 based on Bailey, we do not sustain this rejection as well. At page 3 of the Answer, the Examiner sets forth the rejection as follows:

... it would thus have been obvious at the time the invention was made to adapt aaa [sic] to include arranging the digits as claimed or using a computer or watch to generate the desired visual images using the LEDs or a Lcd screen.

As with the 35 U.S.C. § 102(b) rejection discussed supra, the Examiner has provided no support on the record to support such a conclusion. Even assuming arguendo that the LED matrix array of elements in Bailey could be illuminated to provide a particular display design as desired, there is no evidence to indicate that the skilled artisan would have found it obvious to produce the specific display arrangement recited in the appealed claims. The 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, 23 USPQ2d 1780 (Fed.

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Cir. 1992). Since, in our view, the Examiner's line of reasoning does not establish a prima facie case of motivation, the Examiner's 35 U.S.C. § 103 rejection of claims 19 and 20 is not sustained.

Rejection under 37 CFR § 1.196(b)

We make the following new ground of rejection using our authority under 37 CFR § 1.196(b) relying on the following prior art:

Stano et al. (Stano) 4,797,864 Jan. 10, 1989

Claim 1 is rejected under 35 U.S.C. § 102(b) as being anticipated by Stano. Stano illustrates in the upper right portion of Figure 3 a seven segment display in which the display elements can be selectively illuminated to form various digits as described in the accompanying description at column 7, line 53 through column 8, line 32. All of the limitations of Appellant's claim 1 are disclosed by Stano since elements 212 and 210 form a first box and elements 214 and 216 form a second box, each with border defining elements. As described in the above referenced portion of Stano, the display elements are selectively illuminated or darkened to jointly define and form digits. For example, if all of the elements are illuminated, the numeral "8"

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would be formed with the boxes juxtaposed and sharing a common border element.

Although the Stano reference has been applied only against independent claim 1, this is not to be taken as an indication of the patentability of any of the other claims on appeal. In any resumption of the prosecution of this application before the Examiner, the Examiner should consider the applicability of Stano, and any other discovered prior art, to all of the pending claims. In making the determination of patentability, the Examiner should take note of the fact that Figure 1 of Stano illustrates a watch display with times displayed in a series of juxtaposed rows.

As a final note, the Examiner, in making a further prior art search, should consider the appropriate subclasses in Horology, Class 368 (e.g. subclasses 223+), and Selective Visual Display Systems, Class 345 (e.g. subclasses 33+), as well as Design Class D10 (e.g. subclass 15).

In summary, we have reversed the Examiner's 35 U.S.C. § 102(b) rejection of claims 1 through 18 as well as the 35 U.S.C. § 103 rejection of claims 19 and 20. We have entered a new ground of rejection against claim 1 under 37 CFR § 1.196(b).

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As indicated supra, 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. 53131, 53197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. 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 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. . . .

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No 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)

JAMES D. THOMAS)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
MICHAEL R. FLEMING)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
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JOSEPH F. RUGGIERO)	
Administrative Patent Judge)	

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APJ RUGGIERO

APJ FLEMING

APJ THOMAS

DECISION: REVERSED; 196(b)
Send Reference(s): Yes No
or Translation (s)
Panel Change: Yes No
Index Sheet-2901 Rejection(s):

Prepared: June 18, 2003

Draft Final

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OB/HD GAU

PALM / ACTS 2 / BOOK
DISK (FOIA) / REPORT