

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(2) is not binding precedent of the Board.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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ARNE L. DUWAER,
ANTONIUS J.M. HAFKAMP, and CHRISTIAN KREXNER

Appeal No. 1997-2760
Application No. 08/302,133

ON BRIEF

Before HAIRSTON, 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 2-5, 7, and 10-14, all of the claims pending in the application. Claims 1, 6, 8, and 9 have been canceled. An amendment after final rejection filed May 15, 1996 was denied

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entry by the Examiner. Entry of the amendment after final rejection filed July 5, 1996, concurrently with the Appeal Brief, was approved by the Examiner.¹

The claimed invention relates to a telephone set including a control panel which is detachable from a base station. More particularly, the control panel includes an interactive display panel with a touch screen and a graphic tablet and further includes an antenna for communicating cordlessly with the base station. Appellants further indicate at page 4 of the specification that, in addition to the cordless communication mode, communication between the base station and control panel is provided by mounting the control base to connectors on the base station.

Claim 10 is illustrative of the invention and reads as follows:

10. A telephone set including a base station and a control [panel] detachable therefrom, characterized in that:

the telephone set comprises means for communication between the base station and the control panel, operable independently of the detachment and movement of the control panel remotely from the base station, and

¹ This amendment corrected an antecedent basis deficiency by adding the word "panel" to line 1 of claim 13. A similar, uncorrected deficiency exists in line 1 of claim 10.

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the control panel comprises an interactive display panel including a touch screen and a graphic tablet, and control electronics for the display panel.

The Examiner relies on the following prior art

references:²

Nash et al. (Nash) 1991	5,010,565	Apr. 23,
Takahashi et al. (Takahashi) 30, 1992	5,127,050	Jun.
Krisbergh et al. (Krisbergh) 11, 1992	5,138,649	Aug.
Yaniv (European) 1992	0 499 012	Aug. 19,

Claims 2-5, 7, and 10-14 stand rejected under 35 U.S.C. § 112, first paragraph, as being based on an inadequate disclosure.³ Claims 2-5, 7, and 10-14 also stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the Examiner offers Takahashi in view of the admitted prior art with respect to claims 5 and 10-14. Yaniv is added to the basic combination with respect to claims 2 and 3, Krisbergh is

² In addition, the Examiner relies on Appellants' admissions as to the prior art at pages 2 and 4 of the specification.

³ As indicated at page 2 of the Answer, the 35 U.S.C. § 112, second paragraph, rejection of the appealed claims has been withdrawn.

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added to the basic combination with respect to claim 4, and Nash is added to the basic combination with respect to claim 7.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Briefs⁴ and Answers for the respective details.

OPINION

Initially, we note that Appellants have provided arguments as to the sufficiency of the drawings. However, the issue of the sufficiency of the drawings relates to a petitionable matter and not to an appealable matter. See Manual of Patent Examining Procedure (MPEP) §§ 1002 and 1201. Accordingly, we will not review the issue raised by Appellants on page 14 of the Brief.

We have carefully considered the subject matter on appeal, the rejections advanced by the Examiner, the arguments in support of the rejections and the evidence of obviousness relied upon by the Examiner as support for the obviousness

⁴ The Appeal Brief was filed July 5, 1996. In response to the Examiner's Answer dated October 1, 1996, a Reply Brief was filed December 9, 1996 to which the Examiner responded with a Supplemental Examiner's Answer dated February 13, 1997.

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rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellants' 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 Answers.

It is our view, after consideration of the record before us, that Appellants' specification in this application describes the claimed invention in a manner which complies with the requirements of 35 U.S.C. § 112. 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 set forth in claims 2-5, 7, and 10-14. Accordingly, we reverse.

We consider first the rejection of claims 2-5, 7, and 10-14 under the written description requirement of the first paragraph of 35 U.S.C. § 112. "The function of the description requirement [of the first paragraph of 35 U.S.C. § 112] is to ensure that the inventor had possession, as of the filing date of the application relied on, of the specific subject matter later claimed by him." In re Wertheim, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976). "It is not

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necessary that the application describe the claim limitations exactly, . . . but only so clearly that persons of ordinary skill in the art will recognize from the disclosure that appellants invented processes including those limitations." Wertheim, 541 F.2d at 262, 191 USPQ at 96 citing In re Smythe, 480 F.2d 1376, 1382, 178 USPQ 279, 284 (CCPA 1973). Furthermore, the Federal Circuit points out that "[i]t is not necessary that the claimed subject matter be described identically, but the disclosure originally filed must convey to those skilled in the art that applicant had invented the subject matter later claimed." In re Wilder, 736 F.2d 1516, 1520, 222 USPQ 369, 372 (Fed. Cir. 1984), cert. denied, 469 U.S. 1209 (1985), citing In re Kaslow, 707 F.2d 1366, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983).

We note initially that we find Appellants' argument (Brief, pages 5 and 6) that the present disclosure is "enabling" to be misplaced. Our reviewing court has made it clear that written description and enablement are separate requirements under the first paragraph of 35 U.S.C. § 112. Vas-Cath Inc. v. Mahurkar, 935 F. 2d 1555, 1560, 19 USPQ 2d

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1111, 1114 (Fed. Cir. 1991). In establishing a basis for a rejection under the written description requirement of the statute, the Examiner has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims. Wertheim, 541 F.2d at 265, 191 USPQ at 98. Despite Appellant's lack of arguments directed to the "written description" issue raised by the Examiner, it is our opinion that the Examiner has not provided sufficient reasons or evidence to satisfy such burden. The Examiner asserts (Answer, page 4) a lack of description of the claimed interactive display panel, graphic tablet, and control electronics. Our review of Appellants' disclosure, however, reveals that the illustration in the sole drawing figure and the accompanying description at page 4 of the specification provide a clear description of the display panel and associated graphic tablet and control as claimed. In our opinion, under the factual situation presented in the present case, Appellants have satisfied the statutory written description requirement because they were clearly in possession of the invention at the time of filing of the

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application. Therefore, we do not sustain the rejection of claims 2-5, 7, and 10-14 under the first paragraph of 35 U.S.C. § 112.

We will also not sustain the rejection of claims 2-5, 7, and 10-14 under 35 U.S.C. § 103. The Examiner has failed to set forth a prima facie case of obviousness. 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 (CCPA 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

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& 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).

Appellants' primary argument in the Briefs centers on the contention that the Takahashi reference does not disclose a communication connection between a control panel and telephone base which is independent of the attachment of the control panel to the base. After careful review of Takahashi in light of the arguments of record, we are in agreement with Appellants' position as stated in the Briefs. We note that the relevant portion of independent claim 10 recites:⁵

the telephone set comprises means for communication between the base station and the control panel, operable independently of the detachment and movement of the control panel remotely from the base station, ...

⁵ Similar recitations appear in claims 13 and 14, the other independent claims on appeal.

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Our interpretation of the disclosure of Takahashi coincides with that of Appellants, i.e. there is communication between the control apparatus 1 and the base station 2 only when the signal window 8 of the control apparatus is mounted on the base in mating relationship with signal window 107. As such, there is no communication between the control apparatus 1 and the base 2 in Takahashi that is independent of the attachment or detachment of the apparatus from the base as required by the language of the claims on appeal.

We take note of the Examiner's differing interpretation of the language of the appealed claims; it is our view, however, that such interpretation is not supported by the present factual situation. The Examiner, in interpreting the critical language from claim 10 reproduced in the excerpt cited supra, has treated the language "operable independently of" as a modifier of the language "the telephone set" rather than "means for communication". While the Examiner is correct that claims are to be given their broadest possible interpretation, any such interpretation must be consistent with the specification. It is apparent from our reading of Appellant's specification that the claim language "operable

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independently" is intended to describe the communication between the control panel and the base station, and not the operation of the telephone set as urged by the Examiner.

We further agree with Appellants that proper English rules of syntax support the interpretation that the term "operable independently", preceded by a comma, must modify the term "means" and not the noun phrase "telephone set" farther back in the sentence. The Examiner's dictionary citation (Supplemental Answer, page 14) of proper comma usage is not persuasive since the terms in question are not coordinate adjectives.

Since all of the claim limitations are not taught or suggested by the applied prior art, it is our opinion that the Examiner has not established a prima facie case of obviousness with respect to the claims on appeal. Accordingly, we do not sustain the Examiner's 35 U.S.C. § 103 rejection of independent claims 10, 13, and 14, nor of claims 2-5, 7, 11, and 12 dependent thereon.

Finally, we have reviewed the disclosures of Yaniv, Krisbergh, and Nash, applied by the Examiner to address various features of the appealed dependent claims. We find

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nothing in these disclosures which would overcome the innate deficiencies of Takahashi discussed supra.

In summary, we have not sustained any of the Examiner's rejections of the claims on appeal. Therefore, the decision of the Examiner rejecting claims 2-5, 7, and 10-14 is reversed.

REVERSED

	Kenneth W. Hairston)	
	Administrative Patent Judge)	
)	
)	
	Michael R. Fleming)	BOARD OF
PATENT	Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
	Joseph F. Ruggiero)	
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JFR:tdl

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