

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KATSUNORI OKUDA,
ISAMU HANEDA,
YOSHIHIRO SHINTAKU,
KENICHI INUI,
MASAYUKI KONISHI,
NAOKI SHIRAISHI,
and CHIEJI KATOH

Appeal No. 1997-4071
Application No. 08/047,511

HEARD: FEBRUARY 23, 2000

Before HAIRSTON, FLEMING, and DIXON, **Administrative Patent Judges**

FLEMING, **Administrative Patent Judge.**

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 20 through 34, all of the claims pending in the present

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application. Claims 1 through 19 have been canceled.

The invention relates to a data processor permitting character strings to be readily processed. Appellants disclose on page 7 of the specification and Fig. 6 that the memory is divided into a plurality of sections, each section being associated with a specific data processing function for selectively storing sentence entries in each of the memory sections in accordance with the specific data processing function used to generate each sentence entry.

Independent claim 20 is reproduced as follow:

20. A data processor, comprising:

a memory divided into plural sections, each section being associated with a specific data processing function, for selectively storing sentence entries in each of the memory sections in accordance with the specific data processing function used to generate each sentence entry;

an input device operated by a user to input a character string and select one or more the specific data processing functions;

a display for displaying the input character string and the selected data processing functions;

a computer for performing the tasks of:

locating and retrieving an initial portion of each sentence entry that includes the character string and that is

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stored in the memory section corresponding to the selected one
or more specific data processing functions;

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displaying on the display the retrieved initial portions of sentence entries; and

in response to the user selecting one of the displayed initial portions of sentence entries, displaying on the display a complete sentence entry corresponding to the selected one of the displayed initial portions of sentence entries.

The Examiner relies on the following reference:

Stinson et al. (Stinson), "Getting the Most Out of IBM Current," 1990.

Claims 20-34 stand rejected under 35 U.S.C. § 103 as being unpatentable over Stinson.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the briefs¹ and answers² for the respective details thereof.

OPINION

We will not sustain the rejection of claims 20-34

¹ Appellants filed an appeal brief on September 16, 1996. Appellants filed a reply brief on January 27, 1997. The Examiner responded with a Supplemental Examiner's Answer on March 13, 1997, thereby entering the reply brief into the record.

² The Examiner mailed an Examiner's Answer on December 5, 1996. The Examiner mailed a Supplemental Examiner's Answer on March 13, 1997.

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under 35 U.S.C. § 103.

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The Examiner has failed to set forth a *prima facie* case. It is the burden of the Examiner to establish why one having ordinary skill in the art would have been led to the claimed invention by the express teachings or suggestions found in the prior art, or by implications contained in such teachings or suggestions. *In re Sernaker*, 702 F.2d 989, 995, 217 USPQ 1, 6 (Fed. Cir. 1983). "Additionally, when determining obviousness, the claimed invention should be considered as a whole; there is no legally recognizable 'heart' of the invention." *Para-Ordnance Mfg. v. SGS Importers Int'l, Inc.*, 73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995)(*citing W. L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1548, 220 USPQ 303, 309 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984)).

Appellants argue on page 8 of the appeal brief, that Stinson, although having some sort of memory, fails to disclose or suggest a memory which is divided into plural sections, each section being associated with a specific data processing function. Appellants further argue that Stinson fails to disclose or suggest storing sentence entries in each

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of the memory sections in accordance with the specific data processing function to generate each sentence entry.

On page 6 of the answer, the Examiner argues that Stinson's memory inherently must have stored a function and must have a memory section associated with each function data. The Examiner argues that because sentences are stored by various functions by virtue of the notes as taught by Stinson, each sentence is associated with the function producing the sentence.

As pointed out by our reviewing court, we must first determine the scope of the claim. [T]he name of the game is the claim." **In re Hiniker Co.**, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998).

We note that Appellants' claims recite more than having a function being associated with data. For example, Appellants' claim 20 requires

a memory divided into plural sections, each section being associated with a specific data processing function, for selectively storing sentence **entries** in each of the memory sections in accordance with the specific data processing function used to generate each sentence entry (emphasis added).

Thus, Appellants' claim requires that the memory is divided

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into sections in which many entries are entered which is
associated with one function. We further note that
Appellants' independent

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claim 27 also requires a plurality of entries being entered into a particular part of memory that is associated with a processing function. In particular, Appellants' claim 27 recites

classifying strings of character data as corresponding to one of a plurality of different character processing functions; storing the classified input character data in a corresponding one of plural memory areas, each memory area being specifically allocated to one of the different character processing functions.

"Inherency and obviousness are distinct concepts." **W. L. Gore & Associates, Inc. v. Garlock, Inc.**, 721 F.2d 1540, 1555, 220 USPQ 303, 314 (Fed. Cir. 1983) *citing In re Spormann*, 363 F.2d 444, 448, 150 USPQ 449, 452 (CCPA 1966). Furthermore, "[t]o establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by person 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.3d 1264, 1268, 20 U.S.P.Q.2d 1746, 1749 (Fed. Cir. 1991).

"Inherency, however, may not be established by probabilities

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or possibilities. The mere fact that a certain thing may
result for a given set of

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circumstances is not sufficient." *Id. citing Continental Can Co v. Monsanto Co.*, 948 F.3d 1264, 1269, 20 U.S.P.Q.2d 1746, 1749 (Fed. Cir. 1991).

We fail to find that Stinson discloses or suggests a memory divided into a plurality of sections, each section being associated with a specific data processing function for selectively storing sentence entries in each of the memory sections in accordance with the specific data processing function used to generate each sentence entry as required by Appellants' claims. We fail to find that the Examiner has shown that it would be necessary for Stinson to partition Stinson's memory in this way. Therefore, we will not sustain the Examiner's rejection of Appellants' claims.

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In view of the foregoing, we have not sustained the rejection of claims 20-34 under 35 U.S.C. § 103. Accordingly, the Examiner's decision is reversed.

REVERSED

KENNETH W. HAIRSTON)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
MICHAEL R. FLEMING)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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