

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 44

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MASAHIKO KATSURABAYASHI, SUSUMU YAMAMOTO,
TADAHIKO IKEGAYA and NOBUYUKI SHIGEEDA

Appeal No. 1998-0874
Application 08/318,513

ON BRIEF

Before JERRY SMITH, JOSEPH F. RUGGIERO, and JOSEPH L. DIXON,
Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-3 and 6-29, which constitute all the claims remaining in the application.

The disclosed invention pertains to the field of information entry systems for machines such as copying machines, facsimile machines and so forth. More specifically, the invention is directed to apparatus for freely setting an area of a coordinate input device in response to indication of size determining points within a continuous range of variation. The user may freely determine which input functions will correspond to different areas of the coordinate input device.

Representative claim 1 is reproduced as follows:

1. An apparatus for registering an operation key on a coordinate input surface of a coordinate input device, the coordinate input surface having a fixed key area and a freely set key area, comprising:

means for storing a fixed key table which correlates operation key information representing a function of a specified operation key with fixed area information representing a specified area of the fixed key area of the coordinate input surface, said specified operation key being a fixed operation key;

means for selecting a registering mode;

means for specifying the operation key;

means for specifying a freely set sub-area of the freely set key area in response to an indication of one or two size-determining points on the coordinate input surface within a continuous range of variation; and

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means for producing a freely set key table that correlates operation key information representing a function of the specified operation key and further area information representing the freely set sub-area of the freely set key area of the coordinate input surface.

The examiner relies on the following references:

Flurry	4,633,436	Dec. 30, 1986
Day, Jr. et al. (Day)	4,763,356	Aug. 09, 1988
Todome	4,937,762	June 26, 1990
Hube et al. (Hube)	5,119,079	June 02, 1992 (filed Sep. 17, 1990)
Okada	5,208,683	May 04, 1993 (filed July 24, 1989)

R. N. Wolfe, "Keyboard for Electronic Tablet or Digitizer," IBM Technical Disclosure Bulletin, Vol. 14, No. 3, August 1971, pages 807-808.

The following rejections are before us on appeal:

1. Claims 1 and 3 stand rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of Todome, Okada and

Hube. 2. Claims 2, 6, 7, 9 and 11 stand rejected under

35 U.S.C. § 103 as being unpatentable over the teachings of Todome, Okada, Hube and Wolfe.

3. Claim 10 stands rejected under 35 U.S.C. § 103 as

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being unpatentable over the teachings of Todome, Okada, Hube and Flurry.

4. Claim 8 stands rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of Todome, Okada, Hube, Wolfe and Flurry.

5. Claims 12, 14, 20, 21, 23 and 29 stand rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of Day and Hube.

6. Claims 13, 15-19, 22 and 24-28 stand rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of Day, Hube and Wolfe.

Rather than repeat the arguments of appellants or the examiner, we make reference to the brief and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the

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evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the brief 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 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 1-3 and 6-29. Accordingly, we reverse.

Appellants have indicated that for purposes of this appeal the claims will all stand or fall together as a single group [brief, page 5]. Since there are several rejections before us, appellants' grouping will be accepted as a representation that all the claims within each rejection will stand or fall together. Note In re King, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986); In re Sernaker, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983). Accordingly, we

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will only consider the rejections against a single claim from each separate rejection as representative of all the claims on appeal.

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 (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.

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825 (1988); Ashland Oil, Inc. v. Delta Resins & 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). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the

arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could

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have made but chose not to make in the brief have not been considered [see 37 CFR § 1.192(a)].

We consider first the rejection of claims 1 and 3 based on the collective teachings of Todome, Okada and Hube only. The examiner's analysis of the references and reasons for determining obviousness of the claimed invention are set forth on pages 5-6 of the answer. With respect to representative, independent claim 1, appellants argue that the examiner has incorrectly asserted that Hube teaches the "continuous range of variation" as recited in claim 1. More specifically, appellants argue that the collective teachings of the applied references do not suggest a continuous range of variation of the sub-area according to one or two size-determining points [brief, pages 5-7]. The examiner responds that the limitation "continuous range of variation" reads on the teaching of Hube [answer, page 13].

We agree with the position argued by appellants. Although we find the examiner's combination of Todome, Okada

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and Hube to be a hindsight reconstruction at best, appellants have not argued the lack of motivation for combining these references. Nevertheless, we agree with appellants' limited argument that Hube does not meet the recitation of a continuous range of variation responsive to one or two size-determining points on the coordinate input surface. There is nothing in Hube which supports the examiner's assertion that the expanded areas 310' to 313' are variable in size over a continuous range. Hube does not teach or suggest that the value of "e" can be set or changed by the user. Therefore, with respect to the limited feature argued by appellants, we agree that the collective teachings of Todome, Okada and Hube do not suggest the invention of claim 1 within the meaning of 35 U.S.C. § 103.

With respect to the six rejections on appeal cited above, each of them relies on Hube for meeting the feature just discussed. Each of the other independent claims on appeal has the feature of claim 1 just discussed or a similarly defined feature. Therefore, Hube fails to support the rejection of any of these claims. Although different claims are also

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rejected under prior art combinations which include Wolfe,
Flurry and Day, neither of these references overcomes the
deficiency we have

noted in Hube. Therefore, we do not sustain any of the
examiner's rejections of the appealed claims based on the
prior art applied by the examiner.

The decision of the examiner rejecting claims 1-3 and 6-
29 is reversed.

REVERSED

JERRY SMITH)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
JOSEPH F. RUGGIERO)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
JOSEPH L. DIXON)	
Administrative Patent Judge)	

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