

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(2) is not binding precedent of the Board.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. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KAZUO DEGUCHI

Appeal No. 1998-1320
Application No. 08/305,643

ON BRIEF

Before BARRETT, RUGGIERO and BARRY, Administrative Patent Judges.

RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-18, all of the claims pending in the present application.

The claimed invention relates to a display for a mobile radio telephone apparatus in which a single 7, 8 segment

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light-emitting diode (LED) display is utilized to display alphanumeric characters one at a time in sequence as dialed. The single display also provides indications of various operating parameters of the telephone apparatus by using predetermined ones of the same segments used to display the alphanumeric characters. Appellant asserts at page 2 of the specification that the use of a single 7, 8 segment display in place of conventional multiple digit display results in a saving in cost and complexity.

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

1. A display for a mobile radio telephone apparatus, comprising:

a single 7, 8 segment LED display having seven segments for representation of alphanumeric characters through selective activation of various combinations of said seven segments, and an eighth segment for representation of an operational parameter of said apparatus;

means for designating predetermined ones of said seven segments for representation of other operational parameters of said apparatus; and

means for controlling selective activation of said 7, 8 segment LED display in response to signals from circuitry of said apparatus

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so as to selectively represent alphanumeric
characters and operational parameters
of said apparatus.

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relied upon by the Examiner as support for the rejection. We
have, likewise, reviewed and taken into consideration, in
reaching our decision,

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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 Answers.

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 invention set forth in claims 1-18. Accordingly, we reverse.

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

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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 & 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).

With respect to independent claims 1, 7, and 13, the Examiner, as the basis for the obviousness rejection, proposes to modify the mobile radio telephone display described as

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admitted prior art at page 1 of Appellant's specification. This admitted prior art, illustrated in Appellant's Figure 1, describes plural segmented digit displays for representing alphanumeric characters and further includes indicator display components for displaying the status of various system operational parameters, but lacks a teaching of utilizing predetermined ones of the alphanumeric display segments for representing the system operational parameters. To address this deficiency, the Examiner turns to Null which discloses plural segmented digital displays for a radio in which predetermined ones of the segments that make up each display are utilized to represent other operational parameters of the system as illustrated in Figures 5A-5D of Null. In the Examiner's view (Answer, page 4), the skilled artisan would have found it obvious to incorporate Null's feature of utilizing various segments of a segmented numeric display for representing other system parameters in the system of the admitted prior art in order to eliminate the need for separate operational status indicators.

The Examiner further adds the Digi-Key reference to the combination of the admitted prior art and Null as providing a

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teaching of a single 7, 8 segment LED display, suggesting that one of ordinary skill would recognize the cost savings of a single as opposed to plural segmented digital displays. To bolster his position, the Examiner cites In re Karlson, 311 F.2d 581, 136 USPQ 184 (CCPA 1963), which the Examiner asserts (Answer, page 5) stands for the principle that omission of an element and its function in a combination where the remaining elements perform the same functions involves only routine skill in the art.

In response, Appellant's arguments (Brief, page 7) primarily focus on the contention that the teachings of the Digi-Key reference are insufficient to establish a prima facie case of obviousness for modifying the plural displays of either the admitted prior art system or Null to meet the claimed requirement of a single 7, 8 segment LED display, a feature in each of the independent claims. Upon careful review of the applied prior art in light of the arguments of record, we are in agreement with Appellant's position as stated in the Briefs. Our interpretation of the disclosure of Digi-Key coincides with that of Appellant, i.e., this reference teaches nothing more than that single digit displays

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exist. While it is reasonable to assume that a single 7, 8 segment LED display would be less expensive than multiple 7, 8 segment displays, as asserted by the Examiner, this fact alone does not, in our view, establish that a skilled artisan would have found it obvious to reconfigure the multiple digit displays of either the admitted prior art or Null to provide all of the claimed indicator functions in a single segmented LED display. 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, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992).

We further agree with Appellant that the Examiner's reliance on In re Karlson, id., is misplaced with regard to the present factual situation. Contrary to the facts presented in Karlson in which certain elements and their functions are removed and the retained elements perform the same functions as before, the

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functions of each of the omitted segmented displays in Appellant's claimed system are retained. In other words, Appellant's claimed system is reconfigured to perform the functions of the removed displays by providing for display of alphanumeric characters and system parameters by the single 7, 8 segment display. Our reviewing authority has held that the omission of an element and the retention of its function is an indicia of unobviousness. In re Edge, 359 F.2d 896, 899, 149 USPQ 556, 557 (CCPA 1966).

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For the reasons discussed supra, it is our opinion that, since the Examiner has not established a prima facie case of obviousness, the 35 U.S.C. § 103 rejection of independent claims 1, 7, and 13, as well as claims 2-6, 8-12, and 14-18 dependent thereon, cannot be sustained. Accordingly, the decision of the Examiner rejecting claims 1-18 is reversed.

REVERSED

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LEE E. BARRETT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JOSEPH F. RUGGIERO)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
LANCE LEONARD BARRY)	
Administrative Patent Judge)	

JFR:hh

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ROTHWELL, FIGG, ERNST & KURZ
SUITE 701 E
555 13TH STREET N.W.
WASHINGTON, D.C. 20004