

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 28

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MANABU WAKABAYASHI, SHIGEYUKI ITOH, YUHEI ABE,
KAORU HARADA and ATSUHIKO URUSHIHARA

Appeal No. 1999-2849
Application No. 08/690,966

HEARD: March 19, 2002

Before JERRY SMITH, FLEMING, and GROSS, ***Administrative Patent Judges.***

FLEMING, ***Administrative Patent Judge.***

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1 through 13 and 20. Claims 14 through 19 have been canceled without prejudice as being directed to a non-elected invention.

The invention relates to a pocket-size information transfer apparatus in which information such as electronic

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money, name cards and short text is stored in an integrated circuit.

Independent claim 1 is reproduced as follows:

A pocket-size information transfer apparatus including two insertion slots into which IC cards for storing electronic information are inserted and reads and writes the electronic information in the two IC cards inserted into the insertion slots to thereby transfer the electronic information stored in the two IC cards, comprising:

two insertion slots provided in an owner side and an other party side respectively, and an IC card operation unit for reading and writing electronic information between two IC cards inserted into said two insertion slots in mutually different depths.

The Examiner relies on the following references:

Fujita et al. (Fujita) 1988	4,774,399	Sep. 27,
Kawana 1991	5,010,237	Apr. 23,
Rovin 1991	5,049,728	Sep. 17,
Storck et al. (Storck) 1995	5,434,395	Jul. 18,

Claims 1 through 7, 9 through 11 and 13 stand rejected under 35 U.S.C. § 103 as being unpatentable over Storck.

Claim 8 stands rejected under 35 U.S.C. § 103 as being unpatentable over Storck in view of Kawana.

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Claim 12 stands rejected under 35 U.S.C. § 103 as being unpatentable over Storck in view of Fujita.

Claim 20 stands rejected under 35 U.S.C. § 103 as being unpatentable over Storck in view of Rovin.

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

OPINION

After careful consideration of the evidence before us on the record, we will not sustain the Examiner's rejection of claims 1 through 13 and 20 under 35 U.S.C. § 103.

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a *prima facie* case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ 1443, 1444 (Fed. Cir. 1992). *See also In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The Examiner can satisfy this burden by showing that some

¹ Appellants filed an appeal brief on March 1, 1999. Appellants filed a reply brief on June 9, 1999. The Examiner mailed an office action on June 21, 1999 stating that the reply brief had been entered and considered.

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objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art suggests the claimed subject matter. ***In re Fine***, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the Appellants. ***Oetiker***, 977 F.2d at 1445, 24 USPQ at 1444. ***See also Piasecki***, 745 F.2d at 1472, 223 USPQ at 788.

An obviousness analysis commences with a review and consideration of all the pertinent evidence and arguments. "In reviewing the [E]xaminer's decision on appeal, the Board must necessarily weigh all of the evidence and arguments." ***In re Oetiker***, 977 F.2d at 1445, 24 USPQ2d at 1444. "[T]he Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion." ***In re Lee***, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002). With these principles in mind, we commence review of the pertinent evidence and arguments of the Appellants and the Examiner.

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We first turn to the rejection of claims 1 through 7, 9 through 11 and 13 as being unpatentable over Storck. On pages 8 through 10 of the brief, Appellants argue that Storck fails to teach or suggest "two insertion slots provided in an owner side and an other party side respectively, and an IC card operation unit for reading and writing electronic information between two IC cards inserted into said two insertion slots in mutually different depths" as recited in Appellants' independent claim 1.

The Federal Circuit states that "[t]he 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, 1783-24 n.14 (Fed. Cir. 1992), ***citing In re Gordon***, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). It is further established that "[s]uch a suggestion may come from the nature of the problem to be solved, leading inventors to look to references relating to possible solutions to that problem." ***Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.***, 75 F.3d

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1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), **citing In re Rinehart**, 531 F.2d 1048, 1054, 189 USPQ 143, 149 (CCPA 1976) (considering the problem to be solved in a determination of obviousness). The Federal Circuit reasons in **Para-Ordinance Mfg. Inc. v. SGS Importers Int'l Inc.**, 73 F.3d 1085, 1088-89, 37 USPQ2D 1237, 1239-40 (Fed. Cir. 1995), that for the determination of obviousness, the court must answer whether one of ordinary skill in the art who sets out to solve the problem and who had before him in his workshop the prior art, would have been reasonably expected to use the solution that is claimed by the Appellants.

In addition, our reviewing court requires the PTO to make specific findings on a suggestion to combine prior art references. **In re Dembiczak**, 175 F.3d 944, 1000-01, 50 USPQ2d 1614, 1617-19 (Fed. Cir. 1999). Our reviewing court states further that the "factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority." **In re Lee**, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002). It is improper, in determining whether a person of ordinary skill

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would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher."

W. L. Gore v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983).

Upon our review of Storck, we find that Storck teaches in column 8, line 63, through column 9, line 2, the following

The cards are inserted laterally from the left and the right, or from the top or bottom of the casing of the equipment **1** through an entry slot or throat **4** and **6** inside which they are guided, retained and locked in place by means that are not shown on this figure. The device is perfectly symmetrical and the cards can be inserted into either one of the two slots.

Furthermore, we find that Storck teaches in column 10, lines 51 through 56, the following:

Ranged in a symmetrical fashion in correspondence to each one of the slots **4** and **6** of FIG. **1**, the device includes elements **15a**, **15b**, **15c**; **15a'**, **15b'**, **15c'** fitted with contacts **16** designed to set up the electrical and transactional interface between each one of the cards **3** and **5**.

Thus, we find that Storck teaches symmetrical entry slots **4** and **6** which fully enclose the Storck microcircuit cards. We fail to find that Storck teaches or suggests the claimed limitation "two insertion slots provided in an owner side and

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an other party side respectively, and an IC card operation unit for reading and writing electronic information between two IC cards inserted in said two insertion slots in mutually different depths" as recited in claims 1 through 7, 9 through 11 and 13.

In regard to the rejections of claims 8 and 12 which depend on claim 1, we note that the Examiner relies on Storck for the above limitation. Therefore, we will not sustain the Examiner's rejection of these claims for the above reasons.

In regard to the rejection of claim 20, we note that claim 20 recites:

a pocket-size information transfer apparatus including two insertion slots provided in an owner side and an other party side respectively, and an IC card operation unit for reading and writing electronic information between two IC cards inserted into said two insertion slots in mutually different depths.

The Examiner relies on Storck for this limitation of two insertion slots in mutually different depths. We fail to find that Storck teaches or suggests the claimed limitation.

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In view of the foregoing, we have not sustained the rejection of claims 1 through 13 and 20 under 35 U.S.C. § 103. Accordingly, the Examiner's decision is reversed.

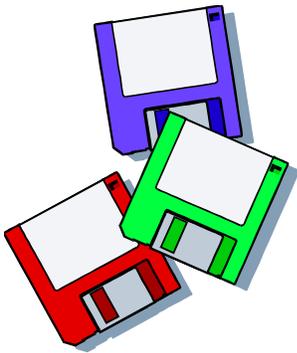
REVERSED

JERRY SMITH)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
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DECISION: REVERSED

Prepared: November 19, 2002

Draft Final

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