

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(2) is not binding precedent of the Board.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. 34

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte NAE YASUHARA,
MIYUKI MARUSAWA and JO WADA

Appeal No. 96-1614
Application 08/236,660¹

HEARD: APRIL 08, 1999

Before KRASS, JERRY SMITH, and RUGGIERO, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134

¹ Application for patent filed April 29, 1994

Appeal No. 96-1614
Application No. 08/236,660

from the examiner's rejection of claims 3-6, 8-24 and 35-46, which constitute all the claims remaining in the application. An amendment after final rejection was filed on July 19, 1995 concurrently with the appeal brief but was denied entry by the examiner [answer, page 1].

The disclosed invention pertains to a portable or graphic computer apparatus suitable for use by children to draw pictures and the like. More particularly, the invention consists of a graphic input device connected to a television receiver. The user enters drawing commands at the input device which then appear to the user on the television. The invention is primarily directed to various aspects of the input device.

Representative claims 21 and 37 are reproduced as follows:

21. A tracing sheet adapted to be mounted on a tablet of a portable graphic computer apparatus which is comprised of a tablet, for inputting coordinates data, a cabinet for accommodating therein said tablet and slots formed on peripheral portions of said cabinet in said tablet, said tracing sheet comprising:

inserting portions which are inserted into said grooves of said cabinet formed at the peripheral portions of said tablet.

37. A portable graphic computer system comprising:

- a tablet for inputting coordinates data;
- detecting means for detecting the coordinates data inputted by said tablet;
- a cabinet having upper and lower portions for accommodating therein at least said tablet and said detecting means;
- said tablet being mounted under said upper portion of said cabinet;
- video image data forming means connected to said detecting means for forming video image data corresponding to input coordinates based on coordinates data corresponding to an output signal from said detecting means;
- a memory connected to said video image data forming means for storing said video image data;
- video signal generating means connected to said memory for generating a video signal from said video image data;
- a plurality of selecting buttons formed on said tablet for selecting displayed functions for said video image data;
- a perforated portion formed on said upper portion of said cabinet for defining and for access to said selecting buttons;
- said perforated portion having a step between a surface of said upper portion and the surface of said tablet corresponding to the thickness of said upper section;
- an executing button for issuing a command to cause said video image data to be formed at a location corresponding to the coordinates data inputted by said tablet;
- output means connected to said video signal generating means for outputting said video signal; and

Appeal No. 96-1614
Application No. 08/236,660

a transmission line for transmitting said video signal to display means.

The examiner relies on the following references:

Smalligan	3,778,910	Dec. 18, 1973
Popowski et al. (Popowski)	4,709,230	Nov. 24, 1987
Wickstead et al. (Wickstead)	4,764,763	Aug. 16, 1988
Fong et al. (Fong)	5,009,603	Apr. 23, 1991

(filed Aug. 19, 1988)

The following rejections have been made against the claims:

1. Claims 37-46 stand rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of Fong.

2. Claims 3-6, 8-18, 35 and 36 stand rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of Fong in view of Popowski.

3. Claims 22-24 stand rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of Fong in view of Wickstead.

4. Claims 19-21 stand rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of Fong in view of Smalligan.

Appeal No. 96-1614
Application No. 08/236,660

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 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 have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 3-6, 8-18, 22-24 and 35-46. We reach the opposite conclusion with respect to claims 19-21. Accordingly, we affirm-in-part.

Appellants have nominally indicated that the claims are independently patentable [brief, page 3], but they have

Appeal No. 96-1614
Application No. 08/236,660

not specifically argued the limitations of each of the claims. The extent of appellants' arguments, with respect to the claims within each rejection, appears in the brief as a statement of what is recited in each of the claims along with a bald assertion that the prior art does not teach or suggest the features of these claims with no analysis or discussion of obviousness whatsoever. Simply pointing out what a claim requires with no attempt to point out how the claims patentably distinguish over the prior art does not amount to a separate argument for patentability. See In re Nielson, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987). At the time appellants' brief was filed, 37 C.F.R. § 1.192(c)(7) required that the argument explain "why the claims...are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable." Appellants' arguments fail to satisfy this requirement as a basis to have the claims considered separately for patentability. Since appellants are considered to have made no separate arguments for patentability, all claims within each separate rejection will stand or fall together. Note In re King, 801 F.2d 1324,

Appeal No. 96-1614
Application No. 08/236,660

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 will consider a single claim from each rejection as representative of all the claims within that rejection. Although appellants' representative addressed some different claims within each rejection at the oral hearing, the arguments for separate patentability must appear in the brief in order to obtain the benefits of separate patentability.

As a general proposition in an appeal involving a rejection under 35 U.S.C. § 103, an examiner is under a burden to make out a prima facie case of obviousness. If that burden is met, the burden of going forward 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 In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); 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

Appeal No. 96-1614
Application No. 08/236,660

those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered [see 37 CFR § 1.192(a)].

With respect to each of the rejections before us, the examiner has pointed out the teachings of Fong, has pointed out the perceived differences between Fong and the claimed invention, and has indicated how and why Fong would have been modified and/or combined with the teachings of Popowski, Wickstead or Smalligan to arrive at the claimed invention. In our view, the examiner's analysis is sufficiently reasonable that we find that the examiner has satisfied the burden of presenting a prima facie case of obviousness. That is, the examiner's analysis, if left unrebutted, would be sufficient to support a rejection under 35 U.S.C. § 103. The burden is, therefore, upon appellants to come forward with evidence or arguments which persuasively rebut the examiner's prima facie case of obviousness. Appellants have presented several substantive arguments in response to the examiner's rejection. Therefore, we consider

Appeal No. 96-1614
Application No. 08/236,660

obviousness based upon the totality of the evidence and the relative persuasiveness of the arguments.

We consider first the rejection of claims 37-46 as unpatentable over the teachings of Fong taken alone. We will consider the rejection with respect to claim 37 as representative of all the claims within this group. This rejection is set forth on page 4 of the answer. The rejection identifies the perforated portion as the difference between Fong and the invention of claim 37, and the rejection explains the obviousness of this feature.

Appellants have offered only a single argument against this rejection. Specifically, appellants argue that Fong "lacks the perforated portions of the present invention, which are specifically recited in claims 37-39" [brief, page 4]. Appellants point out benefits of these perforated portions and argue that the skilled artisan would not have appreciated the desirable advantages of these perforated portions [id.].

The examiner adopted an essentially new position in the response to argument section of the answer wherein he explained why the touch sensitive area of Fong's Figure 13 would be a perforated area [answer, page 7]. Appellants did

Appeal No. 96-1614
Application No. 08/236,660

not reply to this new position of the examiner.

In view of the paucity of arguments with respect to this rejection, the only question is whether the examiner has made a case that Fong teaches a "perforated portion having a step" as recited in claim 37. Appellants' Figure 2 shows a first "perforated portion" 10c which is made up of holes 14-20 and a second "perforated portion" 10b which is a single large opening called the drawing area. Thus, appellants' own disclosure supports the definition that a perforated area can be a single large area surrounded by an opening "step" of raised material.

The examiner has interpreted the touch sensitive device shown in Fong's Figure 13 as meeting this same definition of a perforated portion as appellants' area 10b. More particularly, the examiner views the touch sensitive surface 301 of Fong as being surrounded by the raised collar of the device 300. Thus, the examiner views the area of Fong which includes writing surface 309 and inputs 306-308 as being a perforated portion in the same manner as appellants' area 10b.

Although we agree with appellants that Fong does not

Appeal No. 96-1614
Application No. 08/236,660

have "perforated portions" in the manner intended by appellants' disclosed invention, we agree with the examiner that the surface 301 in Fong's device is every bit as much of a perforated portion as appellant's area 10b is. Since appellants have disclosed that area 10b is a perforated portion, we must conclude that Fong's Figure 13 also discloses a perforated portion. As noted above, appellants have offered no reply to this position of the examiner. Since we agree with the examiner's position and since appellants' brief offers no convincing arguments of error in the examiner's position, we sustain the examiner's rejection of claims 37-46.

We now consider the rejection of claims 3-6, 8-18, 35 and 36 as unpatentable over the teachings of Fong in view of Popowski. We will consider this rejection with respect to claim 35 as representative of all the claims within this group. This rejection is set forth on pages 4-5 of the answer. The rejection identifies the color selecting buttons as the difference between Fong and the invention of claim 35. The examiner cites Popowski as teaching this feature and the rejection explains the obviousness of adding this feature to Fong's touch sensitive input device.

Appeal No. 96-1614
Application No. 08/236,660

Appellants again make only a single argument against this rejection. Specifically, appellants argue that Popowski "does not describe or suggest the perforated areas lacking in the Fong et al. patent as described above, nor any other means for facilitating operation of drawing apparatus by a child" [brief, page 6].

This argument is not persuasive because it is completely unrelated to the claimed invention. Representative claim 35 recites no perforated areas even though Fong teaches a perforated area as discussed above. We also find no language within claim 35 which requires a consideration of how use of the claimed invention by a child is facilitated. Since appellants have offered no arguments which are persuasive of error in the examiner's rejection, we sustain the examiner's rejection of claims 3-6, 8-18, 35 and 36.

We now consider the rejection of claims 22-24 as unpatentable over the teachings of Fong in view of Wickstead. We will consider this rejection with respect to claim 22 as representative of all the claims within this group. This

Appeal No. 96-1614
Application No. 08/236,660

rejection is set forth on pages 5-6 of the answer. The rejection identifies the time detecting circuit as the difference between Fong and the invention of claim 22. The examiner cites Wickstead as teaching this feature and the rejection explains the

obviousness of adding this feature to Fong's touch sensitive input device.

Appellants argue that Wickstead offers "no description or suggestion of the timing device claimed in claims 22-24, where the time detecting means is used to operate a sound producing device, as claimed in claims 22-23, or to initiate a demonstration program, as claimed in claim 24" [brief, page 9]. The examiner responds that Fong teaches a sound producing device as well as a demonstration mode. The examiner asserts that it would have been obvious to activate Fong's demonstration mode after a predetermined time of no activity as suggested by Wickstead [answer, pages 10-11]. Appellants did not reply to this assertion of the examiner.

The scope of claim 22 only requires that we consider the obviousness of producing a sound in the Fong device when

Appeal No. 96-1614
Application No. 08/236,660

it is being shut down due to inactivity as taught by Wickstead. In other words, Wickstead basically teaches the obviousness of taking action in any electronic device based on a time interval of inactivity. The question is whether the artisan would have considered it obvious within the meaning of 35 U.S.C. § 103 to take an audible action in Fong in view of the collective teachings of the references and the level of skill in the art. We are of the view that the broad recitation of emanating a sound when a predetermined time interval of inactivity has expired would have been obvious to one having ordinary skill in the art of consumer electronics. Therefore, we sustain the rejection of claims 22-24 under 35 U.S.C. § 103.

We now consider the rejection of claims 19-21 as unpatentable over the teachings of Fong in view of Smalligan. We will consider this rejection with respect to claim 21 as representative of all the claims within this group. This rejection is set forth on page 6 of the answer. The rejection identifies the tracing sheet mounted on the tablet as the difference between Fong and the invention of claim 21. The examiner cites Smalligan as teaching this feature and the

Appeal No. 96-1614
Application No. 08/236,660

rejection explains the obviousness of adding this feature to Fong's touch sensitive input device.

Appellants argue that in Smalligan, "[t]here is no recess provided, for selectively receiving and holding the stencils in place, nor is there any suggestion that the pencil or pen writing device of Smalligan may have application to an electronic picture drawing device as in the present invention" [brief, page 9]. The examiner responds that it would have been obvious to have placed a tracing sheet on the top of the drawing area in Fong's device [answer, page 11]. There is no discussion by the examiner on the manner in which the stencils are mounted in the combined device of Fong and Smalligan.

We will not sustain this rejection because the examiner has failed to properly identify the difference between the claimed invention and the teachings of the references. Each of claims 19, 20 and 21 recites in some form the manner in which a tracing sheet is mounted onto the tablet. The examiner never addresses this aspect of the claimed invention. The rejection simply addresses the obviousness of using tracing sheets with the Fong device but does not consider the manner in which the tracing sheets would

Appeal No. 96-1614
Application No. 08/236,660

be attached. Therefore, the rejection fails to correctly identify the differences between the claimed invention and the teachings of the applied prior art. Since the differences between the invention of claims 19-21 and the prior art have not been properly identified, the obviousness of these differences has not been established by the examiner.

We also note with respect to this rejection that the combination of the teachings of Fong with Wickstead appears to be based entirely on a desire to reconstruct the claimed invention in hindsight. We can see no reason why the artisan would look to Wickstead to modify the Fong device. These references have no relationship to each other except in the examiner's hindsight reconstruction of the invention. Therefore, we do not sustain the examiner's rejection of claims 19-21 under 35 U.S.C. § 103.

In summary, appellants have not satisfied the requirements of 37 CFR § 1.192 to have the claims considered separately for patentability. We have sustained the individual rejections of claims 37-46, claims 3-6, 8-18, 35 and 36, and claims 22-24. We have not sustained the rejection of claims

Appeal No. 96-1614
Application No. 08/236,660

19-21. Accordingly, the decision of the examiner rejecting claims 3-6, 8-24 and 35-46 is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

Appeal No. 96-1614
Application No. 08/236,660

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