

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 28

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PSYTRONICS ASSOCIATES

Appeal No. 97-2651
Reexamination 90/003,669¹

ON BRIEF

Before HAIRSTON, JERRY SMITH and TORCZON, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

¹ Reexamination request filed December 23, 1994. According to the appellant, this is a reexamination of 06/566,204, filed December 28, 1983, now U.S. Patent No. 4,540,292.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-131, which constitute all the claims in this reexamination application.

The disclosed invention pertains to an electronic display device which displays calendar data in a manner which is similar to the typical printed calendar. More particularly, the calendar data can be displayed as one month at a time or an entire year of twelve monthly displays can be shown. A particular feature of the invention is that the day columns of the calendar always appear in the same location even when a date change causes a change in month and/or year. Thus, Sunday, for example, always appears as the left-most column in the display.

Representative claim 1 is reproduced as follows:

1. A device for displaying calendar data, comprising:

a display for displaying data, comprising a first plurality of rows of discrete display elements, each display element in each row being in a respective column, each column always displaying a particular day of the week which is unique to that column such that each respective column always displays the same day of the week even when the data being displayed is changed by an updating circuit, each display

element being selectively activable to display one of a plurality of date symbols, each date symbol representing a day of a month, the rows being arranged parallel to each other for displaying the calendar weeks of a month; and

said updating circuit being for updating said display and for selectively activating the display elements to display the date symbols representing the days of each calendar week of the current month in a respective row and to display the date symbol representing each day of the current month in the column always displaying the day of the week on which that day falls, said updating circuit further being for automatically updating said display at the end of each current month to display the date symbols corresponding to the days of the following month.

The examiner relies on the following references:

Pitroda	3,999,050	Dec. 21, 1976
Weitzler	4,302,752	Nov. 24, 1981
Aizawa	4,303,995	Dec. 01, 1981
Maezawa	4,353,178	Oct. 12, 1982
Nomura (Japanese Kokai)	53-90970	Aug. 10, 1978
Ishikawa et al. (Ishikawa) (Japanese Kokai)	57-40682	Mar. 06, 1982

Claims 1-6, 8-11, 14, 15, 17-23, 25-28, 31, 32 and 34-36 stand rejected under 35 U.S.C. § 103 as unpatentable over the teachings of Ishikawa in view of Maezawa. Claims 7, 16, 24, 33, 37 and 38 stand rejected under 35 U.S.C. § 103 as unpatentable over the teachings of Ishikawa in view of Maezawa

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and further in view of Aizawa. Claims 12, 13, 29 and 30 stand rejected under 35 U.S.C. § 103 as unpatentable over the teachings of Ishikawa in view of Maezawa and further in view of Nomura. Claims 39 and 40 stand rejected under 35 U.S.C. § 103 as unpatentable over the teachings of Ishikawa in view of Maezawa and further in view of Pitroda. Finally, claim 41 stands rejected under 35 U.S.C. § 103 as unpatentable over the teachings of Ishikawa in view of Maezawa and further in view of Weitzler. Claims 42-131 stand rejected under 35 U.S.C. § 305 as improperly seeking to enlarge the scope of a claim in a reexamination proceeding.

Rather than repeat the arguments of appellant 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 prior art rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the

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appellant's 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 collective 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 1-41. We are also of the view that the examiner has correctly determined that the scope of the invention as set forth in claims 42-131 is broader than the claims of the original patent. Accordingly, we affirm both rejections.

We consider first the 35 U.S.C. § 103 rejection of claims 1-41. 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

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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).

The examiner has pointed out the teachings of Ishikawa and Maezawa, has pointed out the perceived differences between these references and the claimed invention, and has reasonably indicated how and why these references would have been modified and combined with each other as well as combined with the additional references to arrive at the claimed invention. The examiner has, therefore, at least satisfied the burden of presenting a prima facie case of obviousness. The burden is, therefore, upon appellant to come forward with evidence or arguments which persuasively rebut the examiner's prima facie case of obviousness. Appellant has presented several arguments in response to the examiner's rejection. Therefore, we consider obviousness based upon the totality of the evidence and the relative persuasiveness of the arguments.

We consider first the rejection of claims 1-6, 8-11, 14, 15, 17-23, 25-28, 31, 32 and 34-36 as unpatentable over

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the teachings of Ishikawa in view of Maezawa. These claims stand or fall together [brief, page 5], and we will consider the rejection as it applies to claim 1 as representative of all the claims subject to this rejection. The examiner basically cites Ishikawa as fully meeting the invention of claim 1 except for the automatic updating means [answer, page 4]. Maezawa is cited as a teaching in the automatic updating of an electronic monthly display. The examiner provides a clear analysis as to why the collective teachings of Ishikawa and Maezawa would have suggested to the artisan the obviousness of the invention recited in claim 1 [answer, pages 4-5].

Appellant's arguments begin by addressing the two applied references individually. Appellant notes that although Maezawa mentions automatic updating, it fails to appreciate or recognize the importance of this feature. We do not agree with this assessment by appellant for reasons which will become more apparent below. With respect to Ishikawa, appellant argues that it fails to teach a permanent storage of calendar data that is used in updating the display at the end of the current month. On this point we observe that Maezawa

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has been cited for the updating function, and representative claim 1 does not recite any lookup table or storage means so that no such teaching is required in the applied references.

Appellant argues that the combination of Ishikawa and Maezawa is improper. Appellant's basic position in support of this argument is that Maezawa barely touches on the automatic updating feature and fails to attach any significance to it [brief, page 9]. We do not agree. Maezawa notes the following in describing his invention:

This display will have its greatest utility when it is embodied in a quartz crystal timepiece whereby synchronization of the monthly calendar changes to the hour and the date is readily achieved. When the calendar display is used independently of a timepiece, other means, usually external, are required to change the display from month to month [column 4, lines 48-54].

This passage, in our view, clearly suggests to the artisan that the timepiece would be used to automatically adjust the calendar display without requiring any external input.

Maezawa also states that "[a]t the end of the last day of the month, a signal from the calendar-measuring circuits 52 advance the memory 53 to output data of the next month"

[column 7, lines 4-7, emphasis added]. This signal from circuits 52 is clearly an electronic signal which is automatically generated and used to adjust the calendar display. Thus, we see no merit in appellant's argument that Maezawa does not recognize or appreciate the significance of this feature.

We also agree with the examiner that it is not necessary for Maezawa to celebrate the advantages of automatic updating in order for the teaching to be available under 35 U.S.C. § 103. Maezawa clearly recognizes the possibility of automatic updating, and appellant admits as much. All that matters is that the description in Maezawa would have suggested to the artisan the obviousness of automatically updating an electronic calendar display.

Appellant argues that "[m]ost importantly, neither Ishikawa nor Maezawa teach or suggest any other functions, much less the many functions disclosed by appellant, including the 'memo' feature. In combination with the other disclosed features, this 'memo' feature transforms appellant's device from the simple calendars of Ishikawa and Maezawa into the first true electronic diary" [brief, page 9]. We do not see

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the relevance of this argument because there is no recitation of any memo function or structure in representative claim 1.

Appellant argues that the examiner has used an improper "obvious to try" standard for obviousness. We do not agree. This is not a situation where there are a large number of possibilities with no expectation of success. Maezawa would have suggested a single modification to Ishikawa with a high expectation of success. Thus, even though we believe that the argument is misplaced according to the facts here, "obvious to try" is permitted within 35 U.S.C. § 103 as long as the prior art provides a reasonable expectation of success. In re O'Farrell, 853 F.2d 894, 7 USPQ2d 1673 (Fed. Cir. 1988).

Appellant complains that it would not have been obvious to modify Ishikawa with Maezawa's teachings because Maezawa was filed first [brief, page 10]. The examiner has correctly responded that obviousness is based on the collective teachings of the references, and neither reference needs to be considered as the primary reference. In any event, we are of the view that an equally proper rejection by the examiner could have been made by modifying the Maezawa teachings with those of Ishikawa rather than the order

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selected by the examiner. The examiner has properly addressed the issue as to what would have been obvious to the artisan at the time the invention was made in view of the known teachings of Ishikawa and Maezawa.

Appellant argues that the automatic update feature of Maezawa could not have been obvious to the artisan because Ishikawa chose not to incorporate the feature in his later-filed patent application. The question of why a particular prior art teaching did or did not use other features of the prior art cannot per se establish whether a specific feature would have been nonobvious. There can be reasons unrelated to the legal standard of obviousness which determine what features are built into a prior art device. This is a factual consideration which would fall into the category of secondary considerations of obviousness which we will consider in more detail below. In a similar vein, appellant's assertion that the number of products subsequently made which did not incorporate the automatic updating feature should be evidence of nonobviousness is a secondary consideration which must be considered on separate evidence.

Finally, appellant argues that the examiner has ignored the "overwhelming evidence of commercial success" [brief, pages 14-16]. We agree with appellant that evidence tending to show the nonobviousness of the claimed invention must be considered by the examiner. However, appellant has submitted no evidence of commercial success. Appellant's "evidence" consists of bare assertions by appellant's representative that the invention has been a commercial success. Arguments of attorneys cannot take the place of evidence lacking in the record. The examiner correctly indicated that any evidence on this point must demonstrate that the commercial success was due to the claimed invention. We have no such evidentiary showing in this case.

In summary, we are of the view that the collective teachings of Ishikawa and Maezawa would have suggested the obviousness of claim 1 within the meaning of 35 U.S.C. § 103. Appellant's arguments regarding the teachings of the references are, in our view, either simply incorrect or are not persuasive of error in the rejection set forth by the examiner. Additionally, the arguments of commercial success are unsupported by evidence in the record. Therefore, we

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sustain the rejection of claims 1-6, 8-11, 14, 15, 17-23, 25-28, 31, 32 and 34-36 as unpatentable over the teachings of Ishikawa and Maezawa.

Although the rejections of the remaining claims which were rejected under 35 U.S.C. § 103 included an additional prior art reference to those discussed above, appellant has made no separate arguments with respect to the patentability of these claims. In fact, the brief clearly states that claims 1-41, which are all the claims rejected on prior art, stand or fall together as a single group [brief, page 5]. Appellant's only observation is that these additional prior art references do not supply the missing teaching of automatically updating the calendar display. Since we have determined that Maezawa does provide this teaching as asserted by the examiner, we conclude that appellant has failed to present any arguments which would demonstrate error in the examiner's prior art rejections. Therefore, we also sustain the Section 103 rejections of claims 7, 12, 13, 16, 24, 29, 30, 33 and 37-41.

We now consider the rejection of claims 42-131 under 35 U.S.C. § 305 as improperly broadening claims in a

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reexamination proceeding. These claims stand or fall together in a single group [brief, page 5], and we will consider the rejection against claim 42 as representative of all the claims subject to this rejection. The examiner asserts that since these claims omit features from the patent claims, they are broader and improper.

Appellant argues that these claims have only been made clearer, not broader. Appellant asserts that the new claims "merely clarify and do not encompass any apparatus or process which would not have infringed the original patent" [brief, page 16]. We again find ourselves in agreement with the position taken by the examiner.

Although neither the examiner nor the appellant has provided any details in support of their respective positions on this issue, our independent analysis of claim 42 is that it conceivably can be infringed by a device which would not have infringed the claims of the original patent. More specifically, the claims of the original patent set forth that the calendar display had a plurality of rows and columns in a matrix form such as appears on a conventional printed calendar. Claim 42 merely recites that each day of the week

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is displayed in a column. It appears to us that a calendar display in which each of the days of the week was vertically mounted one over the other would infringe the display of claim 42 but would not have infringed the display of claim 1. While such a calendar display might be unusual, we are only concerned with whether the scope of claim 42 can be considered broader than the scope of the original patent claims. For the reasons just discussed, we agree with the examiner that claims 42-131 improperly enlarge the scope of claims in a reexamination proceeding. Therefore, we sustain this rejection of claims 42-131.

In conclusion, we have sustained each of the examiner's rejections of the claims. Accordingly, the decision of the examiner rejecting claims 1-131 is affirmed.

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

AFFIRMED

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KENNETH W. HAIRSTON))
Administrative Patent Judge)	
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)	BOARD OF PATENT
JERRY SMITH)	
Administrative Patent Judge)	APPEALS AND
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)	INTERFERENCES
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