

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. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KIMBERLY A. SHEPHERD

Appeal No. 2001-2612
Application No. 09/479,741

ON BRIEF

Before ABRAMS, FRANKFORT, and McQUADE, Administrative Patent Judges.
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-20 and 22, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellant's invention relates to a an educational system (claims 1-12) and to an educational method (claims 13-20 and 22). An understanding of the invention can be derived from a reading of exemplary claim 1, which reads as follows:

1. An educational system for teaching individuals their emotions, comprising:

(a) at least one set of plural faces;

(b) said set of plural faces being correlated with a respective one and only one of a multiplicity of different emotions experienced by individuals from time to time; and

(c) for said one and only one emotion correlated with said one set of plural faces, a plurality of states of said respective one and only one emotion are defined in the form of different facial expressions on said plural faces of said one and only one set thereof which distinguish different levels of intensities of the respective states from one another.

The single prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Frank et al. (Frank)

5,405,266

Apr. 11, 1995

Claims 1-20 and 22 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the rejection.

Claims 1-6 and 8 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Frank.

Claims 7, 9, 10-12, 13-20 and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Frank.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the Answer (Paper No. 9) and the final rejection (Paper No. 5) for the examiner's complete reasoning in support of the rejections, and to the Brief (Paper No. 8) and Reply Brief (Paper No. 10) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The Rejection Under Section 112, Second Paragraph

The examiner is "unsure" as to what is meant by the phrase "distinguish different levels of intensities of the respective states from one another," and on that basis rejects independent claims 1, 3 and 13 as being indefinite. The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. See, for example, In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). In making this determination, the definiteness of the language employed in the claims must be analyzed, not in a

vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. Id.

The first 7 pages of the appellant's specification inform the reader that insofar as the invention is concerned each of the emotions experienced by individuals from time to time manifests itself in different facial expressions indicating the intensity of an emotion, such as subdued, normal and exaggerated. It is our view that one of ordinary skill in the art would have understood, especially from the explanations on pages 3 and 7 of the specification, that the phrase in issue indicates that each set of plural faces defines the three such levels of intensity of a single emotion. Therefore, from our perspective, the examiner's position that the meaning of the disputed phrase is unclear is not well taken

The rejection of claims 1-20 and 22 under Section 112 is not sustained.

The Rejection Under Section 102

Claims 1-6 and 8 stand rejected as being anticipated¹ by Frank. It is our view that Frank fails to disclose or teach the requirement in independent claims 1 and 3 that

¹Anticipation is established only when a single prior art reference discloses, either expressly or under the principles of inherency, each and every element of the claimed invention. See, for example, In re Paulsen, 30 F.3d 1475, 1480-1481, 31 USPQ2d 1671, 1675 (Fed. Cir. 1994) and In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990).

the faces show, for each “one and only one emotion,” “different facial expressions . . . which distinguish different levels of intensities” of the respective states of the emotion, and therefore the rejection cannot be sustained.

With particular reference to page 4 of the Answer and page 6 of Paper No. 5 (the final rejection), the examiner has taken the position that the faces shown in Frank’s Figures 3A-3H can be grouped into particular emotions. As an example, the examiner expresses the view that three levels of intensity of the emotion “happy” are shown in Figures 3A (labeled “happy” in column 5), Figure 3B (labeled “content”), and Figure 3H (labeled “falsely happy”). Thus, as we understand the rejection, Figures 3A, 3B, and 3H constitute the “one and only one emotion” recited in claims 1 and 3, and the expressions pictured in these three Figures correspond to the “facial expressions . . . which distinguish different levels of intensity” of the emotion of happiness, considering Figure 3B to be a first level of happiness, Figure 3H a second level, and Figure 3A a third level. We do not agree with this interpretation of the teachings of the reference.

Frank characterizes each of the eight face elements shown in Figures 3A-3H as being different “emotions” (column 5, lines 37-49, emphasis added). Thus, in accordance with the Frank invention, “content” (Figure 3B), “falsely happy” (Figure 3H), and “happy” (Figure 3A) are not different intensities of the same emotion, but are entirely different emotions. This being the case, while we would admit that anticipation merely requires that the subject matter of the claims “read on” elements in the

reference,² it is our view that such clearly is not the case here, for since the eight figures are described as separate emotions in the reference, the selection of three of them to arbitrarily be labeled as representations of different intensities of a single emotion flies in the face of the Frank invention, and therefore would not be considered in this vein by one of ordinary skill in the art. Interestingly, the examiner seems to support our conclusion by virtue of the statement on page 6 of Paper No. 5 that “[t]hough Frank teaches different emotions for each figure . . .,” although the discussion continues by nevertheless concluding that the Figures are different states of a “respective one and only emotion.”

The rejection of independent claims 1 and 3 and, it follows, of dependent claims 2, 4-6 and 8, as being anticipated by Frank is not sustained.

The Rejection Under Section 103

Claims 7, 9-20 and 22 stand rejected as being obvious³ in view of Frank.

²Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), *cert. denied*, 465 U.S. 1026 (1984)

³The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a *prima facie* case of obviousness, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir.), *cert. denied*, 488 U.S. 825 (1988).

Claims 7 and 9-12 depend from independent claim 3 and include limitations regarding changing the relative sizes of the faces and the facial features thereon to reflect the expressions of different intensities of the emotions represented thereby. The examiner acknowledges that Frank does not disclose these size differences but concludes this would have been “a mere design choice” which is recognized as being within the level of ordinary skill in the art (Paper No. 5, page 4).

With regard to these claims, we first conclude that considering Frank in the light of Section 103 does not cause it to alleviate the deficiency noted above in the rejection of independent claim 3 under Section 102, namely, Frank does not disclose or teach multiple representations of the levels of intensity of one and only one emotion. Thus, the rejection of claims 7 and 9-12, which necessarily include the limitations of claim 3, cannot be sustained on this basis. Moreover, the rejection of claims 7 and 9-12 further is deficient in that the examiner has provided no evidence that one of ordinary skill in the art would have found it obvious to change the relative sizes of facial expressions on the various manifestations of the levels of intensity of the single emotions, or the relative sizes of the faces themselves, which are recited in these claims.

In view of the foregoing, the teachings of Frank fail to establish a prima facie case of obviousness with regard to the subject matter recited in claims 7 and 9-12, and we will not sustain this rejection.

Independent claim 13 is directed to a method for teaching individuals their emotions, which includes in its first step providing a multiplicity of different sets of plural faces having the same limitations contained in claims 1 and 3, and recites the further steps of selecting at least a pair of faces from different ones of the sets, displaying the faces the pair on each of a succession of substrates, and changing the faces so as to switch emphasis between the faces.

The only comment made by the examiner in the statement of the rejection of claim 13 is that it would have been obvious to provide a succession of substrates because this is “a mere duplication of the essential working parts of a device [which] involves only routine skill in the art” (Paper No. 5, page 4). The examiner has not pointed out where in Frank the method recited in claim 13 is taught and, left to our own devices, we have not found the reference to render them obvious. Thus, the evidence adduced by the examiner fails to establish a prima facie case of obviousness with regard to the method recited in independent claim 13, and therefore the Section 103 rejection of claims 13-20 and 22 cannot be sustained. Moreover, claims 18-20 and 22 contain limitations directed to the relative sizes of the facial expressions and, as we explained above with regard to claims 7 and 9-12, the lack of such a teaching in Frank provides an additional reason for not sustaining the rejection of claims 18-20 and 22.

CONCLUSION

The rejection of claims 1-20 and 22 under 35 U.S.C. § 112, second paragraph, is not sustained.

The rejection of claims 1-6 and 8⁴ under 35 U.S.C. § 102(b) as being anticipated by Frank is not sustained.

The rejection of claims 7, 9, 10-12, 13-20 and 22 under 35 U.S.C. § 103(a) as being unpatentable over Frank is not sustained.

The decision of the examiner is reversed.

⁴ We note an inconsistency in the rejections, in that claim 8 was included in the Section 102 rejection as being anticipated by Frank even though it depends from claim 7, which stands rejected as being unpatentable over Frank. Since we have concluded not to sustain either of the rejections owing to the failure of Frank to disclose or teach the subject matter recited in claim 3, from which claims 7 and 8 both depend, the conclusion is inescapable that claim 8 is neither anticipated nor rendered unpatentable by Frank.

REVERSED

NEAL E. ABRAMS
Administrative Patent Judge

CHARLES E. FRANKFORT
Administrative Patent Judge

JOHN P. McQUADE
Administrative Patent Judge

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RETURN TO LESLEY

APPEAL NO. 2001-2612 - JUDGE ABRAMS
APPLICATION NO. 09/479,741

APJ ABRAMS

APJ McQUADE

APJ FRANKFORT

DECISION: **REVERSED**

Prepared By: LESLEY BROOKS

GAU:3700

OB/HD

DRAFT TYPED: 07 Aug 03

FINAL TYPED: