

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 12

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

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Ex parte F. J. STEVE DOLAN

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Appeal No. 2002-0954  
Application No. 09/543,632

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ON BRIEF

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Before McQUADE, NASE and BAHR, Administrative Patent Judges.  
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 3, 4, 6, 7, 15, 17, 18, 20 and 21, which are all of the claims pending in this application.

We REVERSE.

### BACKGROUND

The appellant's invention relates to a teaching aid that may be used to enhance understanding of vocabulary words. The two independent claims on appeal read as follows:

1. A vocabulary teaching aid system, comprising:
  - a programmable apparatus;
  - a video monitor operably coupled to said programmable apparatus;
  - an user-interactive peripheral operably coupled to said programmable apparatus; and
  - a program wherein said program directs the operations of said programmable apparatus to:
    - provide an interactive screen presentation on said video monitor;
    - provide for selection of a vocabulary word from said interactive screen presentation through use of said interactive peripheral; and
    - present an example of usage of the selected vocabulary word on said video monitor wherein said example of usage is a complete sentence utilizing said vocabulary word and wherein said program directs the operations of said programmable apparatus to present a synonym of said selected vocabulary word on said video monitor in the complete sentence.
15. A method for expanding knowledge of vocabulary, comprising the steps of:
  - providing an interactive screen presentation on a video monitor;

allowing selection of a desired vocabulary word from said interactive screen presentation by means of an interactive peripheral;

providing an example of usage of the selected vocabulary word on the video monitor wherein said example of usage is a complete sentence utilizing said vocabulary word; and

providing a synonym of said selected vocabulary word in said complete sentence.

The following rejection is before us for review.

Claims 1, 3, 4, 6, 7, 15, 17, 18, 20 and 21 stand rejected under 35 U.S.C.

§ 103(a) as being unpatentable over Sorensen<sup>1</sup>.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the answer (Paper No. 11) for the examiner's complete reasoning in support of the rejection and to the 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 Sorensen patent, and to the respective positions articulated by the appellant and the examiner. Based on our review, for the reasons which follow, we cannot sustain the examiner's rejection.

Independent claim 1 calls for, inter alia, a program which directs a programmable apparatus to present on a video monitor both a complete sentence utilizing a selected

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<sup>1</sup> U.S. Patent No. 5,827,071, issued October 27, 1998 to Sorensen et al.

vocabulary word and a synonym of the selected vocabulary word in the complete sentence. Independent claim 15 likewise recites steps of providing on the video monitor a complete sentence utilizing a selected vocabulary word and a synonym of the selected vocabulary word in the complete sentence.<sup>2</sup>

Sorensen discloses a computer program product and method for teaching vocabulary wherein users may directly input the words of their choice into a user word list along with associated information such as definitions, usage sentences, synonyms, antonyms, etc. (column 7, lines 41-45). Sorensen also discloses presentation of various learning frame settings which may include “the word only, the word with definitions, the word with synonyms<sup>[3]</sup>, example sentences, etc.” (column 10, lines 28-30). Note Figures 8B and Appendix pages A3, wherein the vocabulary word itself is enclosed in brackets in the example sentences, and A6, which illustrates a presentation

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<sup>2</sup> We note what appears to be an inconsistency between the subject matter of the claims as now presented and appellant’s underlying disclosure. In particular, while appellant’s specification (page 5 and Figure 3) discloses presentation of a selected vocabulary word in a complete sentence “with the meaning/definition of the word as used in the sentence indicated within brackets, parentheses or otherwise punctuated” per operations block 46, the specification discloses only the presentation of a “listing of synonyms” (page 6) per decision block 60 when requested by the user. Appellant’s specification does not disclose the presentation of the use of the “synonyms” in a sentence per decision block 60, as called for in the claims as now presented. While we recognize that the “meaning/definition” inserted in the complete sentence after the selected vocabulary word per operations block 46 might be considered to be a listing of synonyms for the vocabulary word, appellant’s specification appears to distinguish “synonyms” from “meaning/definition.” Upon return of this application to the Technology Center, the primary examiner may wish to take appropriate action to clarify whether the term “synonyms” as used in appellant’s application differs from “meaning/definition” and to consider whether the claimed subject matter finds written description support in the application as originally filed, as required under the first paragraph of 35 U.S.C. § 112.

<sup>3</sup> With further regard to our observations in footnote 2, Sorensen’s separate references to “the word with definitions” and “the word with synonyms” suggests that the terms “definitions” and “synonyms” are viewed differently within the field of teaching vocabulary.

of a listing of synonyms and antonyms for the selected vocabulary word in addition to a presentation of the use of the selected vocabulary word in sentences. As conceded by the examiner (answer, page 3), however, Sorensen does not disclose presentation of the use of synonyms of the selected vocabulary word in a sentence, much less the same sentence in which the vocabulary word is used. While it might appear to involve only a very simple modification of Sorensen's device and method to present the usage of one or more of the listed synonyms of the selected vocabulary word in the same sentence(s) in which the selected vocabulary word is presented, we find no suggestion in Sorensen to do so. The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification. See In re Mills, 916 F.2d 680, 682, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. See In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000). From our perspective, the only suggestion for modifying Sorensen in the manner proposed by the examiner is found in the luxury of hindsight accorded one who first viewed the appellant's disclosure. This, of course, is not a proper basis for a rejection. See In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992).

For the foregoing reasons, we conclude that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness of the subject

matter of claims 1 and 15. It thus follows that the examiner's rejection of claims 1 and 15, as well as claims 3, 4, 6, 7, 17, 18, 20 and 21 which depend therefrom, is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 3, 4, 6, 7, 15, 17, 18, 20 and 21 under 35 U.S.C. § 103 is reversed.

REVERSED

JOHN P. McQUADE  
Administrative Patent Judge

JEFFREY V. NASE  
Administrative Patent Judge

JENNIFER D. BAHR  
Administrative Patent Judge

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