

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT F. SADLER

Appeal No. 2002-2077
Application 09/273,363

ON BRIEF

Before JERRY SMITH, BARRETT, 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 from the examiner's rejection of claims 1-13, which constitute all the claims in the application.

The disclosed invention pertains to a self-checkout terminal system and to a method for integrating a self-checkout terminal into an already existing network of retail terminals administered by a vendor server computer.

Representative claim 1 is reproduced as follows:

1. A self-checkout terminal system, comprising:

a self-checkout core application module for controlling a self-checkout terminal, the self-checkout core application module controlling peripheral input and output devices at the self-checkout terminal for receiving inputs from, and providing outputs to, a retail customer;

an emulator module connected to the self-checkout core application module for emulating, independent from the self-checkout core application, a native vendor software application in a network of cashier-operated checkout terminals administered by a vendor server computer, the emulator module passing commands and data to, and receiving commands and data from, the vendor server,

the self-checkout core application converting inputs received at the peripheral input devices into inputs expected by the emulated native vendor software application, and converting device update outputs from the emulated native vendor software application into updates to the peripheral output devices.

The examiner relies on the following references:

Takaoka et al. (Takaoka)	4,729,097	Mar. 01, 1988
Humble	5,494,136	Feb. 27, 1996
Kimura et al. (Kimura)	6,108,717	Aug. 22, 2000
		(filed Sep. 04, 1996)

Claims 1-13 stand rejected under 35 U.S.C. § 103(a). As evidence of obviousness the examiner offers Humble in view of Kimura with respect to claims 1-3 and 5-10, and Takaoka is added to this combination with respect to claims 4 and 11-13.

Rather than repeat the arguments of appellant or the examiner, we make reference to the briefs and the answer for the

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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 appellant's arguments set forth in the briefs 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 not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 1-13. Accordingly, we reverse.

Appellant has nominally indicated that the claims do not stand or fall together [brief, pages 5-6], but he has not specifically argued the limitations of each of the claims. The extent of appellant's arguments, with respect to the dependent claims, appears on pages 10-11 of the brief wherein it is stated what is recited in each of the claims and then it is baldly asserted that the prior art does not teach or suggest the

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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." Appellant's arguments fail to satisfy this requirement as a basis to have the claims considered separately for patentability. Since appellant is considered to have made no separate arguments for patentability, all claims will stand or fall together. Note In re King, 801 F.2d 1324, 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 the rejection against claim 1 as representative of all the claims on appeal.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine,

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837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden 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

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arguments. See Id.; 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 those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered and are deemed to be waived by appellant [see 37 CFR § 1.192(a)].

The examiner explains his rejections on pages 3-7 of the answer. With respect to representative, independent claim 1, appellant argues that Humble does not teach or suggest an emulator module connected to the self-checkout core application module for emulating, independent from the self-checkout core application, a native vendor software application as claimed. Specifically, appellant argues that there is no emulator module in Humble because the central processor in Humble knows which mode the checkout terminal is in and controls the terminal accordingly [brief, pages 7-9]. The examiner responds that since Humble teaches integrating two separate systems into one, then the Humble system must inherently use an emulator to perform the function of emulating two different things to operate as one [answer, page 7]. Appellant responds that Humble does not teach

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an emulator module as claimed because the central processor in Humble operates the checkout terminal in manner appropriate for whichever mode is selected [reply brief, pages 2-3].

We will not sustain the examiner's rejection of claims 1-13 for essentially the reasons argued by appellant in the briefs. Specifically, we agree with appellant that there is no teaching of an emulator module in Humble as recited in claim 1. The examiner has provided no support for his position that an emulator module as recited in claim 1 is inherent in the system of Humble. Humble teaches that the central processor can be programmed to switch the checkout terminal 24 between store personnel and customer operation modes [column 4, lines 63-65]. Thus, the central processor in Humble knows when the checkout terminal is in the store personnel mode and when it is in the customer operation mode. As a result, the central processor adjusts its control operations based on the selected mode. As argued by appellant, since the central processor of Humble knows which mode the checkout terminal is in, there is no need to emulate the native vendor software application in a network of cashier-operated checkout terminals as claimed. The claimed emulator module must operate independent of the self-checkout core application and essentially hides the fact that the terminal

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is operating in the self-checkout mode from the central processor. There is no element in Humble which performs like the emulator module of the claimed invention.

Therefore, we do not sustain the examiner's rejection of any of the claims on appeal. Accordingly, the decision of the examiner rejecting claims 1-13 is reversed.

REVERSED

JERRY SMITH)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
LEE E. BARRETT)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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JOSEPH F. RUGGIERO)	
Administrative Patent Judge)	

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Paul W. Martin
NCR Corporation
Intellectual Property Section
Law Department
101 West Schantz Avenue
Dayton, OH 45479-0001