

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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 BRIAN P. COOPER and DUSTY L. LUTZ

Appeal No. 2003-0355
Application No. 09/217,725¹

ON BRIEF

Before BARRETT, FLEMING, and SAADAT, Administrative Patent Judges.

SAADAT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the Examiner's final rejection of claims 1-17, which constitute all of the claims pending in this application.

We reverse.

¹ Application for patent filed December 21, 1998.

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BACKGROUND

Appellants' invention relates to generating item menu lists for use during operation of a self-service checkout terminal which allow a customer to quickly and efficiently find an item name in an item list of a selection menu.

Representative independent claim 1 is reproduced as follows:

1. A method of displaying an item name having a first word and a second word on an item list of an item selection menu of a retail terminal, comprising the steps of:

displaying a first version of said item name on said item list of said item selection menu such that said first word is followed by said second word; and

displaying a second version of said item name on said item list of said item selection menu such that said second word is followed by said first word.

The prior art references of record relied upon by the Examiner in rejecting the appealed claims are:

Humble	4,964,053	Oct. 16, 1990
Walter	5,987,428	Nov. 16, 1999 (filed Jun. 25, 1996)

Claims 1-17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Walter in view of Humble.

We make reference to the answer (Paper No. 11, mailed August 20, 2002) for the Examiner's reasoning, and to the brief (Paper No. 10, filed June 7, 2002) and the reply brief (Paper No. 12, filed October 28, 2002) for Appellants' arguments thereagainst.

OPINION

The Examiner relies on Walter for disclosing an apparatus for self check-out which displays an item name having a first word, a second word and a third word on an item list of the item selection menu (answer, page 3). Indicating that Walter does not specifically teach displaying a multitude of different arrangements of the words, the Examiner further relies on Humble and concludes that modifying Walter by producing many hierarchies of groups and classes would have been obvious because such arrangements would facilitate customer selection (id.). The Examiner further asserts that although Walter does not disclose the different arrangements of the words that describe the item, the difference is merely related to nonfunctional descriptive material which is not functionally involved in the recited steps (id.).

Appellants argue that Humble provides no teaching or suggestion to include multiple descriptions or versions of each item name in its alphabetically arranged or hierarchically organized list (brief, page 15). Appellants further assert that it is the item list of Humble, in fact, includes only one entry, description or version of each listed item, that can be arranged in the form of many hierarchical groups (reply brief, page 3).

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Additionally, Appellants argue that the recited first and second versions of the item name are indeed functionally involved in the recited steps such that the customer's search for an item name is facilitated (brief, page 17).

In response to Appellants' arguments, the Examiner asserts that Humble provides the motivation by indicating that many hierarchies of groups and classes, such as alphabetical listings, will facilitate customer selection (answer, page 8). Additionally, the Examiner further points out that the claimed displaying of item names appears to be only nonfunctional descriptive material without exhibiting any functional interrelationship with the computing process (answer, page 9).

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). To reach a conclusion of obviousness under § 103, the examiner must produce a factual basis supported by teaching in a prior art reference or shown to be common knowledge of unquestionable demonstration. Such evidence is required in order to establish a prima facie case. In re Piasecki, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984). The Examiner must not only identify the

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elements in the prior art, but also show "some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead the individual to combine the relevant teachings of the references." In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

Upon a review of the applied prior art, we find ourselves in agreement with Appellants' arguments that because many hierarchies of groups and classes of the item names can be provided, one skilled in the art would not necessarily be motivated to include multiple descriptions/versions of each item name (brief, page 16). Claim 1 requires that different versions of the same item name, which are additional multiple entries, be provided under the same hierarchical arrangement. In contrast, Humble provides only one version of an item name in each of the different categories that guide the customer through a hierarchical arrangement of classes of items until the actual item name is encountered (col. 5, lines 37-68 and col. 6, lines 18-26), instead of providing different multiple entries for each item under each category.

We also disagree with the Examiner (answer, page 9) that the claimed displaying of item names in different combinations is nothing more than nonfunctional descriptive material which would

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not affect the recited displaying steps. If the printed matter encompasses a new and unobvious functional relationship between the printed matter and the substrate, the limitation must be given patentable weight. See In re Lowry, 32 F.3d 1579, 1582, 32 USPQ2d 1031, 1034 (Fed. Cir. 1994) (citing In re Gulack, 703 F.2d 1381, 1384, 217 USPQ 401, 403). In fact, displaying different versions of the item name having different word arrangements is specific information that has technological value and constitutes a new and non-obvious functional relationship between each version and the way an item name is displayed and searched during the selection process.

Therefore, assuming, arguendo, that it would have been obvious to combine Walter and Humble, as held by the Examiner, there would not have been any teaching or suggestion that different versions of the item names are displayed under any of the many hierarchies of groups and classes, as recited in independent claims 1, 7 and 12.² Additionally, as discussed

² We note the Examiner's reliance on the Manual of Patent Examining Procedure in an attempt to allege that including multiple listings of items in different word arrangements is generally well known (answer, page 8). This argument, which is presented for the first time in the response to arguments section of the answer, and apparently presented as an attempt to introduce new evidence in support of the previously made arguments does, in fact, constitute a new ground of rejection prohibited by 37 C.F.R. § 1.193(a)(2). If this evidence is deemed material to the patentability of the claims, reopening of the prosecution would have been the appropriate option that could have properly placed the issue before this panel in case of a subsequent appeal.

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above, the Examiner's proposed combination of the references cannot be based on the assertion that displaying the recited first and second versions of an item name is not functionally involved in displaying the item selection menu. Accordingly, since the Examiner has failed to establish a prima facie case of obviousness, the 35 U.S.C. § 103 rejection of claims 1-17 cannot be sustained.

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CONCLUSION

In view of the foregoing, the decision of the Examiner to reject claims 1-17 under 35 U.S.C. § 103 is reversed.

REVERSED

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LEE E. BARRETT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
MICHAEL R. FLEMING)	
Administrative Patent Judge)	APPEALS AND
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MAHSHID D. SAADAT)	
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