

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not written for publication and is not binding
precedent of the Board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. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KOFI SCHULTERBRANDT,
RAFAEL ALEJANDRO SAMUELS
and WILLIAM M. PERKINS

Appeal No. 2004-1641
Application 09/764,388

ON BRIEF

Before FLEMING, JEFFREY T. SMITH, and PAWLIKOWSKI, Administrative
Patent Judges.

PAWLIKOWSKI, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1, 3, 5-8 and 20-25. A copy of each of these claims is set forth in the attached Appendix.

Appellants group the claims as set forth on page 3 of the brief. To the extent that any one claim is separately argued with regard to patentability, we will consider such claim in this appeal.

Claims 1, 3, 7, 8, and 24 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kiyohara in view of Garland.

Claims 5, 6, 20-23, and 25 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kiyohara in view of Garland and further in view of Simpson.

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We note that at the top of page 2 of the brief, appellants discuss a 35 U.S.C. § 112 rejection. However, on page 3 of the brief, the listed issues do not include a 35 U.S.C. § 112 rejection. The final rejection included a 35 U.S.C. § 112 rejection that appears to have been overcome by the after final amendment filed on August 11, 2003. The advisory action indicates that the amendment has been entered. Hence, the examiner's answer correctly does not include, in the Grounds of Rejection section, a 35 U.S.C. § 112 rejection. Therefore, no 35 U.S.C. § 112 rejection is before us in this appeal.

The examiner relies upon the following references as evidence of unpatentability:

Kiyohara	5,327,503	July 5, 1994
Garland et al. (Garland)	5,544,045	Aug. 6, 1996
Simpson, "Mastering WordPerfect 5.1 & 5.2 for Windows," pp. 30-33 (1993).		

We have carefully reviewed appellants' brief and the examiner's answer. This review has led us to the following determinations.

OPINION

I. The 35 U.S.C. § 103 rejections of claims 1, 3, 7, 8 and 24 as being unpatentable over Kiyohara in view of Garland

In this rejection, we consider claims 1 and 8.

We refer to the examiner's rejection as set forth on pages 3-4 of the answer, and agree with the prima facie case presented therein.

Beginning on page 4 of the brief, appellants essentially argue that the reasons provided by the examiner to combine Kiyohara in view of Garland do not appear to be taken from the applied art. Appellants argue that Kiyohara does not disclose

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any motivation for combining the features of Garland with Kiyohara. Appellants argue that Kiyohara's pointing device is taught in only two places in the patent (in column 5 and in column 9), and neither place mentions sufficiently the pointing device. Appellants conclude that one of ordinary skill in the art would not have found it obvious to have combined Garland with Kiyohara because Kiyohara at best "vaguely discloses" what his pointing device is and how it works in conjunction with the remainder of his invention. Brief, page 5. Appellants also argue that it would therefore not have been obvious to have substituted a mouse for Kiyohara's pointing device. Brief, page 5.

Beginning on page 5 of the answer, the examiner rebuts and states that Kiyohara discloses a pointing device in column 5 at lines 36-40. The examiner acknowledges that this pointing device is not a mouse, but the examiner correctly points out that it functions like a mouse by moving a cursor on a display screen to indicate a selected position on the display screen. The examiner then states that Garland teaches that a pointing device (the disclosed electronic pen, e.g.) and a mouse can be interchangeable or they can be used together, and refers to column 1, lines 66-67.

In view of the above, a person of ordinary skill in the art would have reasonably expected that the devices regularly used for pointing would have been suitable for use in the invention of Kiyohara. In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

While appellants argue that Kiyohara's disclosure is not specific enough regarding the pointing device used, we are not convinced that one of ordinary skill in the art would not have readily appreciated that Kiyohara's disclosed stylus is of the kind described in Garland (e.g., an electronic pen).

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Furthermore, the examiner is correct that Garland teaches that input device 3 may be a keyboard, mouse, electronic pen, etc., or a combination thereof. See column 1, lines 66 and 67 of Garland. On page 5 of the brief, appellants state "[a]lthough a mouse, a digitizer and a keyboard can be used to input data to a computer, an inventor developing an idea does not necessarily think of each as interchangeable just because they can all be used to input data." We disagree with this statement, in view of the teaching of Garland, that, in fact, indicates that "input device 3 may be a keyboard, mouse, electronic pen, etc., or a combination thereof." We also note that in order for a prima facie case of obviousness of the claimed invention to be established, the prior art as applied must be such that it would have provided one of ordinary skill in the art with both a suggestion to carry out appellants' claimed invention and a reasonable expectation of success in so doing. See In re Dow Chem. Co., 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988). "Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure." Id. Garland provides the teaching that a mouse and an electronic pen, e.g., are interchangeable. Hence, both a suggestion to carry out appellants' claimed invention and a reasonable expectation of success in so doing is found in the prior art of Garland. Appellants' arguments do not convince us that substitution of the mouse in Garland for the stylus of Kiyohara amounts to an unreasonable expectation of success. The teaching in Garland provides sufficient motivation to modify Kiyohara as suggested by the examiner.

In view of the above, we therefore affirm the 35 U.S.C. § 103 rejection of claims 1, 3, 7, 8, and 24 as being unpatentable over Kiyohara in view of Garland.

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II. The 35 U.S.C. § 103 rejection of claims 5, 6, 20-23 and 25 as being obvious over Kiyohara in view of Garland and further in view of Simpson

We refer to the examiner's rejection as set forth on page 4 of the answer, and agree with the prima facie case presented therein.

Appellants' position regarding this rejection is set forth on pages 5-6 of the brief. Appellants refer to the same arguments presented with regard to the previously discussed rejection. Hence, for the same reasons, discussed, supra, we are not convinced by such arguments, and affirm this rejection also.

We note that appellants discuss the examiner's comments regarding that Kiyohara teaches a scanner for scanning an image. However, we find this discussion is not pertinent to the rejection at hand, as this teaching, as pointed by the examiner on page 6 of the answer, is simply a teaching of an extra limitation.

In view of the above, we, therefore, also affirm the 35 U.S.C. §103 rejection of claims 5, 6, 2-23 and 25 as being obvious over Kiyohara in view of Garland and further in view of Simpson.

III. Conclusion

Each of the rejections 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)(1)(iv)(effective Sept. 13, 2003; 69 Fed. Reg. 49960 (Aug. 12, 2004); 1286 Off. Gaz. Pat., Office 21 (Sept. 7, 2004)).

AFFIRMED

Michael R. Fleming)	
Administrative Patent Judge)	
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Jeffrey T. Smith)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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)	
Beverly A. Pawlikowski)	
Administrative Patent Judge)	

BAP/cam

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APPENDIX

1. A device for choosing a point on an object comprising:
transparent display means; and

choosing means, wherein said choosing means further
comprises a first cursor movably displayed on said transparent
display means and a mouse which controls the position of said
first cursor,

wherein said object is viewed through said transparent
display means, wherein a user visually locates and associates
said first cursor with said point on said object to be chosen,
wherein said choosing device is used to choose said location of
said point, and wherein a location of said point is communicated
between said device and a computer.

3. The device of claim 1, wherein said transparent display means
is a liquid crystal display.

5. The device of claim 3, wherein said liquid crystal display,
displays a second cursor in said location when said point is
chosen.

6. The device of claim 5, wherein said device further comprises:
a holder;

wherein said object is placed between said transparent
display means and said holder.

7. The device of claim 1, further comprising: a light source;
wherein light from said light source is reflected off of said
object to an eye of a user.

8. The method of choosing a point on an object using the device
of claim 1.

20. The device of claim 5, further comprising: character input
means.

21. The device of claim 20, wherein said second cursor is
displayed on said transparent display means and a position of
said second cursor is further adjusted using keys of said
character input means.

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22. The device of claim 21, wherein characters or images are imputed by said character input means and made to display on said transparent display means at the location of said second cursor.

23. The device of claim 6, wherein said holder has a stand-up picture frame arrangement.

24. The device of claim 3, wherein said liquid crystal display is larger than said object.

25. The device of claim 20, further comprising: printing means, wherein said object is transferred to said printing means to be printed on.