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. 34

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte JOHN STEVEN OUTSLAY and WAYNE F. LARSON

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Appeal No. 2004-2043
Application 09/312,919

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ON BRIEF

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Before THOMAS, BLANKENSHIP, and MACDONALD, **Administrative Patent Judges**.

MACDONALD, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1, 3-8, and 10-13

Invention

Appellants' invention relates to a key for an electronic lock, the key being a general-purpose personal digital assistant (PDA) with a physical interface to the lock. The PDA displaying

a soft key operable by a user and providing unlocking signals to the electronic lock.

Appellants' specification at page 2, line 10, through page 3, line 9.

Claim 1 is representative of the claimed invention and is reproduced as follows:

1. In a key for an electronic lock, the lock having a physical interface with which the key is designed to mechanically interact, an improvement wherein the key is a general purpose personal digital assistant device that has been modified to provide a physical interface for interacting with the physical interface of the lock and has a display capable of displaying at least characters and of displaying a soft key operable by a user, said device being adapted to provide unlocking signals to the lock, wherein the functionality of an electronic key is provided with that of a personal digital assistant.

References

The references relied on by the Examiner are as follows:

Karasawa et al. (Karasawa)	4,786,900	Nov. 22, 1988
Bosley	5,014,049	May 7, 1991
Hitchcock	5,050,207	Sept. 17, 1991

The references cited by the Board are as follows:

Yokozawa	4,534,012	Aug. 6, 1985
Bard et al.	5,793,032	Aug. 11, 1998

Rejections At Issue

Claims 1, 3-8, and 10-13 stand rejected under 35 U.S.C. § 103 as being obvious over the combination of Karasawa and Bosley and Hitchcock.

Throughout our opinion, we make references to the Appellants' briefs, and to the Examiner's Answer for the respective details thereof.[1]

OPINION

With full consideration being given to the subject matter on appeal, the Examiner's rejections and the arguments of the Appellants and the Examiner, for the reasons stated **infra**, we reverse the Examiner's rejection of claims 1, 3-8, and 10-13 under 35 U.S.C. § 103.

Appellants have indicated that for purposes of this appeal the claims stand or fall separately. See page 3 of the brief. However, Appellants have failed to meet the requirements of 37 CFR § 1.192 (c)(7) (July 1, 2002) as amended at 62 Fed. Reg. 53169 (October 10, 1997), which was controlling at the time of Appellants filing of the brief. 37 CFR § 1.192 (c)(7) states:

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[1] Appellants filed an appeal brief on February 21, 2003. Appellants filed a reply brief on June 23, 2003. The Examiner mailed out an Examiner's Answer on April 23, 2003.

> *Grouping of claims.* For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together and, in the argument under paragraph (c)(8) of this section, appellant explains why the claims of the group 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**. (Emphasis added)

Therefore, based on the applicability of Appellants' arguments to the rejected claims, we will consider Appellants' claims, as standing or falling together and we will treat claim 1 as the representative claim of this group. If the brief fails to meet either requirement, the Board is free to select a single claim from each group and to decide the appeal of that rejection based solely on the selected representative claim. **In re McDaniel**, 293 F.3d 1379, 1383, 63 USPQ2d 1462, 1465 (Fed. Cir. 2002). **See also In re Watts**, 354 F.3d 1362, 1367, 69 USPQ2d 1453, 1457 (Fed. Cir. 2004).

I. Whether the Rejection of Claims 1, 3-8, and 10-13 Under 35 U.S.C. § 103 is proper?

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 invention as set forth in claims 1, 3-8, and 10-13. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a **prima facie** case of obviousness. **In re Oetiker**, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). **See also In re Piasecki**, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The Examiner can satisfy this burden by showing that some objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art suggests the claimed subject matter. **In re Fine**, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the Appellants. **Oetiker**, 977 F.2d at 1445, 24 USPQ2d at 1444. **See also Piasecki**, 745 F.2d at 1472, 223 USPQ at 788.

An obviousness analysis commences with a review and consideration of all the pertinent evidence and arguments. "In reviewing the [E]xaminer's decision on appeal, the Board must necessarily weigh all of the evidence and argument." **Oetiker**, 977 F.2d at 1445, 24 USPQ2d at 1444. "[T]he Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion." **In re Lee**, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

A) With respect to independent claim 1, Appellants argue at page 5 of the brief, "Karasawa teaches away from using a display capable of 'displaying a soft key'" because Karasawa teaches "(1) the apparatus is embodied in a wristwatch or compact electronic calculator and (2) the display section is separate from the key-operation section." We find Appellants' argument to be unpersuasive. We find that Karasawa's preferred embodiment does not constitute a teaching away. Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or non-preferred embodiments. **In re Susi**, 440 F.2d 442, 446, 169 USPQ 423, 426 (CCPA 1971).

Appellants further argue at page 5 of the brief, “because the display in the disclosed embodiments is small, it would not be possible to implement the keyboard functionality on the display.” We find Appellants’ argument to be unpersuasive. Appellants have provided no evidence to support their argument that small size equates to inoperability. We find that at most the small size might equate to inconvenience and thus may be an indication of inferiority. The fact that a combination of references is inferior does not teach away from making the combination. “A known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use.” **In re Gurley**, 27 F.3d 551, 554, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994).

Appellants also argue at pages 5-7 of the brief, “Hitchcock offers no rationale for the inclusion of a touch screen” and “the Examiner’s . . . rejection constitutes improper hindsight.” We find Appellants’ argument to be unpersuasive. Express suggestion to substitute one equivalent technique for another need not be present to render such substitution obvious. **In re Fout**, 675 F.2d 297, 301, 213 USPQ 532, 536 (CCPA 1982); **In Siebentritt**, 372 F.2d 566, 568, 152 USPQ 618, 619 (CCPA 1967). Here, we find it abundantly clear that the combined teachings of Karasawa and

Bosley and Hitchcock would have suggested the interchangeability of a touch screen and a display with attached keyboard. As noted by the Examiner at page 8 of the answer, Hitchcock teaches that the prior art uses a separate display and keyboard while Hitchcock substitutes a touch screen for the same functionality.

At pages 3-6 of the reply brief, Appellants reiterated the above arguments and additionally argue at page 6 that, "wristwatches having a touchscreen input have only recently been introduced." Appellants cite to a 2003 publication and 2002 press release (Exhibit A) as evidence supporting this conclusion. We find Appellants' argument to be unpersuasive. We have reviewed the cited references and we find that they in fact show the introduction of "the world's first Palm Powered watch" (press release at lines 8-9) rather than the first touch screen watch. We also direct Appellants' attention to exemplary U.S. Patent 5,793,032 at column 5, lines 55-67, which teaches the use of a touch screen wristwatch as early as February 1, 1995. We also note at this point that although Appellants' application claims priority back to July 30, 1993, claims including the soft key feature are only entitled to the June 28, 1999 filing date as none of the prior applications in Appellants' continuity claim included this touch screen feature.

B) With respect to independent claim 1, Appellants argue at pages 7-8 of the brief and pages 7-9 of the reply brief that the combination of references fail to teach a “general purpose personal digital assistant device.” Particularly, Appellants argue that “general purpose” and “personal digital assistant” both require the device be general purpose, i.e. programmable, and while the references teach multi-functional data processing, none of the references are programmable. The Examiner responds that Appellants defined “general purpose” at page 19 of the substitute specification to be “not dedicated to access control tasks exclusively” and programmability is not required. We find Appellants argument persuasive.

To determine whether claim 1 is obvious over the references, we must first determine the scope of the claim. Appellant argues that “general purpose” should be defined as programmable. Our reviewing court states in **In re Zletz**, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) that “claims must be interpreted as broadly as their terms reasonably allow.” Our reviewing court further states, “[t]he terms used in the claims bear a ‘heavy presumption’ that they mean what they say and have the ordinary meaning that would be attributed to those words by

persons skilled in the relevant art." **Texas Digital Sys. Inc v. Telegenix Inc.**, 308 F.3d 1193, 1202, 64 USPQ2d 1812, 1817 (Fed. Cir. 2002), **cert. denied**, 538 U.S. 1058 (2003).

Upon our review of Appellants' specification, we fail to find any definition of the term "general purpose" that is contradictory to the ordinary meaning. Therefore, we find the ordinary meaning of the term "general purpose" is best found in the dictionary. We note that the definition most suitable for "general purpose" is capable of "performing any computational task", i.e. programmable.[2] We also find that Appellants' statement that "general purpose" refers to "not dedicated . . . exclusively" is not contradictory to "programmability."

We appreciate the Examiner's position that "general purpose" is only a multi-functional device and programmability is not required. However, we find that the claim language does require the device to be programmable. An example of a general-purpose personal digital assistant device that is "programmable" can be found in U.S. Patent 4,534,012 to Yokozawa. At column 12, lines 41-51 of Yokozawa teach that his device (see figure 10) is both

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[2] ***Microsoft Press Computer Dictionary, 1991, page 160. See the definition of "general-purpose computer."***

multi-function and programmable.

C) With respect to independent claim 1, Appellants argues "commercial success, failure of others, and long-felt need" at pages 9-10 of the reply brief. We find Appellants argument unpersuasive. Appellants have failed to show any connection between their submitted evidence (Exhibits C, D, E) and the features found in the claim. We refer the Appellants to MPEP § 716.03-716.04 for a discussion of the requirements and case law with regards to commercial success, failure of others, and long-felt need.

Therefore, for the reasons discussed at B) above, we will not sustain the Examiner's rejection under 35 U.S.C. § 103.

Other Issues

The Board of Patent Appeals and Interferences is a review body, rather than a place of initial examination. Therefore, we have not reviewed claims 1, 3-8, and 10-13 to determine whether these claims are patentable over the Yokozawa patent. We leave it to the Examiner to determine the appropriateness of any other rejections based on the references.

We also note that the amendment filed March 23, 2001 (Paper

No. 10) has not been properly entered. At the top of page 2 of this amendment there is an instruction as to the placement of pages 2-15 of the amendment. This instruction line has been overlooked and pages 2-15 of the amendment have been treated as part of the insert found on page 1 of this amendment.

Conclusion

In view of the foregoing discussion, we have not sustained the rejection under 35 U.S.C. § 103 of claims 1, 3-8, and 10-13.

REVERSED

JAMES D. THOMAS Administrative Patent Judge	)	
HOWARD B. BLANKENSHIP Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
ALLEN R. MACDONALD Administrative Patent Judge	)	

ARD:pgc

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