

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Ex parte HAROLD V. PUTMAN and DALE KLINGSHIRN

Appeal No. 2005-2622
Application No. 09/923,089

ON BRIEF

Before HAIRSTON, BARRY, and NAPPI, and, *Administrative Patent Judges*.
BARRY, *Administrative Patent Judge*.

I. BACKGROUND

A patent examiner rejected claims 1-40. The appellants appealed therefrom under 35 U.S.C. § 134(a). We affirmed-in-part. *Ex parte Putman*, No. 2005-2622, at 1 (Bd.Pat.App. & Int. 2005). Pursuant to 37 C.F.R. § 41.52(a)(1), the appellants now ask us to reconsider our affirmance of claims 1-13, 18, 19, 26, 27, 29, 37, and 38.

II. OPINION

"Rather than reiterate the positions of the examiner or the appellants *in toto*, we focus on the point of contention therebetween." *Ex parte Muresan*, No. 2004-1621, 2005 WL 951659, at *1 (Bd.Pat.App & Int. Feb 10, 2005). The examiner asserts that in U.S. Patent No. 6,378,770 ("Clark"), a "control unit will display proper information on the display device after determining source of the input devices that is used by user or

operator." (Examiner's Answer at 8.) The appellants argue that Clark's "ability to perform different functions responsive to inputs from different sources (e.g., user panel keypad 16 or operator panel keypad 27)," (Req. Reh'g at 3), "does not require (nor teach or suggest) Applicants' recited features which include outputting different user interfaces through different display devices on the banking machine, responsive to separate determinations made by a processor in the machine as to the type or capabilities of the particular input device associated with the corresponding display device." (*Id.*)

In addressing the point of contention, the Board conducts a two-step analysis. First, we construe the independent claims at issue to determine their scope. Second, we determine whether the construed claims are anticipated or would have been obvious.

A. CLAIM CONSTRUCTION

"Analysis begins with a key legal question — *what is the invention claimed?*" *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1567, 1 USPQ2d 1593, 1597 (Fed. Cir. 1987). In answering the question, "[c]laims must be read in view of the specification, of which they are a part." *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979, 34 USPQ2d 1321, 1329 (Fed. Cir. 1995).

Here, independent claim 1 recites in pertinent part the following limitations:

at least one software application is operative to determine the first and the second types of the first and the second input devices, wherein the at least one software application is operative to cause a first user interface to be output through the first display device responsive to the determined first type of the first input device, and wherein the at least one software application is operative to cause a second user interface different from the first user interface to be output through the second display device responsive to the determined second type of the second input device.

Independent claims 8, 18, 26, and 37 include similar limitations.

Regarding the specification, the appellants make the following assertion.

As used in the Specification, the recited term "type" corresponds to the physical features and/or capabilities of the input device, and not any form of user or operator designations associated with the persons using the input devices. For example, on page 8, lines 14-22; Page 12, line 12, to Page 13, line 12, the Specification discusses a mouse type input device and a function key type input device as different types of input devices.

(Req. Reh'g at 6-7.) Reading the aforementioned limitations in view of these parts of the specification, the independent claims require determining whether each input device is a mouse or a set of function keys and then responsively displaying a corresponding user interface.

B. ANTICIPATION AND OBVIOUSNESS DETERMINATIONS

Having construed the claim limitations at issue, we now compare the claims to the prior art to determine whether the prior art anticipates or would have suggested those claims. "A claim is anticipated only if each and every element as set forth in the

claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (citing *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 715, 223 USPQ 1264, 1270 (Fed. Cir. 1984); *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983); *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 771, 218 USPQ 781, 789 (Fed. Cir. 1983)). "[A]bsence from the reference of any claimed element negates anticipation." *Kloster Speedsteel AB v. Crucible, Inc.*, 793 F.2d 1565, 1571, 230 USPQ 81, 84 (Fed. Cir. 1986).

Here, Clark discloses an "ATM 10 . . . provided with a user panel 12 including a card reader slot 14 for insertion of a user's identification card, a key pad 16, a cash dispenser slot 18 through which bank notes are delivered to a user, a display screen 20 and a receipt printer slot 22. . . ." Col. 2, ll. 53-58. "The ATM 10 further comprises a controller unit 30 which communicates with components of the user panel 12, [and] with an operator panel 26 mounted inside the ATM. . . ." Col. 3, ll. 8-10. "The operator panel 26 includes a key pad 27, [and] a display screen 28. . . ." *Id.* at ll. 11-12.

"The controller unit 30 includes a processor unit 32, and a memory unit 34 connected . . . to the processor unit 32. The processor unit 32 receives input signals from the card reader 14, the user panel key pad 16 and the operator panel key pad 27, and provides output signals . . . to the displays 20 and 28 of the user and operator

panels 12 and 26. . . ." *Id.* at ll. 13-19. "It should be understood that the processor unit 32 controls . . . the information displayed on the displays 20 and 28. . . ." *Id.* at ll. 21-24. The processor unit 32 outputs different user interfaces to the user's display 20 and the operator's display 28. Items output to the user's display 20 include "[i]nstructions," col. 2, l. 65, a "request[] to enter a personal identification number (PIN)," *id.* at 66-67, "a menu of the various facilities available to the user," col. 3, ll. 3-4, and a "request[] to enter the sum required. . . ." *Id.* at ll. 5-6. Items output to the operator's display 28 include "a menu of the various maintenance procedure options, including a REPLENISH option," col. 5, ll. 61-63 and a "request[] to input data concerning the full cassettes 40 to be inserted in the ATM. . . ." Col. 6, ll. 42-43. Although the processor unit 32 outputs different user interfaces to the user's display 20 and to the operator's display 28 and responds to input signals from the user's card reader 14 and key pad 16 and from the operator's key pad 27, it is uncontested that the reference does not mention determining whether each of the card reader 14, the key pad 16, and the key pad 27, is a mouse or a set of function keys.

Of course, "[a]n anticipatory reference . . . need not duplicate word for word what is in the claims. Anticipation can occur when a claimed limitation is 'inherent' . . . in the relevant reference." *Standard Havens Prods. v. Gencor Indus.*, 953 F.2d 1360, 1369, 21 USPQ2d 1321, 1328 (Fed. Cir. 1991) (citing *Tyler Refrigeration v. Kysor Indus. Corp.*, 777 F.2d 687, 689, 227 USPQ 845, 846-47 (Fed. Cir. 1985)). "To establish inherency,

[however,] the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.'" *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (quoting *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991)) "Inherency . . . may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) (citing *Hansgirk v. Kemmer*, 102 F.2d 212, 214, 40 USPQ 665, 667 (Cust. & Pat.App. 1939)).

Here, we are unpersuaded that Clark necessarily determines whether each of its input devices is a mouse or a set of function keys and would be so recognized by persons of ordinary skill. To the contrary, the reference may operate in the following, different manner as suggested by the appellants.

[T]he processor in Clark could have a hard coded read-only memory that responds to the different inputs from a fixed set of connected input devices. In such a system there would never be any need for Clark's processor to make a determination as to what type or capabilities are associated with the input device of Clark's user panel, or what type or capabilities are associated with the input device of Clark's operator panel.

(Req. Reh'g at 4.) The absence of determining whether each input device is a mouse or a set of function keys and then responsively displaying a corresponding user interface, negates anticipation. Furthermore, the examiner does not allege, let alone show, that the addition of Coutts cures the aforementioned deficiency of Clark. Therefore, we

reverse the rejections of claim 1, 8, 18, 24, 26, and 37 and of claims 2-7, 9-13, 19, 27, 29, and 38, which depend therefrom.¹

III. CONCLUSION

In summary, the rejection of claims 1, 8, 9, 29, and 30 under 35 U.S.C. § 102(e) is reversed. The rejections of claims 2-7, 10-28, and 31-40 under 35 U.S.C. § 103(a) are also reversed. Although the appellants have also requested "withdrawal of the remaining rejections of the pending claims," (Req. Reh'g at 24), the Board has no authority to withdraw the examiner's rejections.

¹We previously reversed the rejections of claims 14-17, 20-25, 28, 30-36, 39, and 40. *Putman*, at 29.

GRANTED

KENNETH W. HAIRSTON
Administrative Patent Judge

LANCE LEONARD BARRY
Administrative Patent Judge

ROBERT E. NAPPI
Administrative Patent Judge

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