

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte STEPHEN W. SWAINE  
AND KENNETH A. NICOLL

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Appeal No. 2006-0101  
Application No. 09/710,342

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ON BRIEF

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Before RUGGIERO, LEVY and SAADAT, Administrative Patent Judges.  
SAADAT, 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 1-10, 21, 22 and 24-41. Claims 11-20 and 23 have been canceled.

We reverse and enter a new rejection pursuant to 37 CFR § 41.50(b).

BACKGROUND

Appellants' invention is directed to a user interface in a self-service terminal having indicators associated with predetermined transactions where all the indicators have different shapes. According to Appellants, different

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configuration of the indicators reduces confusion when a user attempts to navigate through the sequence of menu screens before executing a desired transaction. An understanding of the invention can be derived from a reading of exemplary independent claim 1, which is reproduced as follows:

1. A self-service terminal, comprising:

a user interface including a group of indicators, all of different shapes and each indicator being associated with a pre-defined transaction so that a user may execute a desired transaction by selecting a single indicator.

The Examiner relies on the following references:

Tarbox	<u>U.S. Patent</u> 5,705,798	Jan. 6, 1998
Wheeler et al. (Wheeler)	<u>Published UK Patent Application</u> GB 2304449 A	Mar. 19, 1997

Claims 1-10, 21, 22 and 24-41 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tarbox and Wheeler.

Rather than reiterate the opposing arguments, reference is made to the brief and answer for the respective positions of Appellants and the Examiner. Only those arguments actually made by Appellants have been considered in this decision. Arguments which Appellants could have made but chose not to make in the brief have not been considered (37 CFR § 41.37(c)(1)(vii)).

OPINION

In rejecting the claims, the Examiner relies on Tarbox for teaching an ATM machine that includes a user interface with a group of indicators each associated with a pre-defined transaction (answer, page 3). The Examiner further relies on Wheeler for teaching a telephone apparatus and characterizes the telephone push buttons as having unique attributes relating to size, shape and color (Figures 3, 4 and 12) where the buttons are distinguishable to a blind person (answer, page 4). The Examiner concludes that using differently shaped and colored push buttons would have been obvious as the buttons enable a blind person to identify and select a desired button (id.).

Appellants argue that transaction options of Tarbox (505, 507, 509, 511 and 513) are actually visual images on the display and do not have unique size, shape or color attributes (brief, page 11). Appellants further point out that the keypad buttons disclosed by Wheeler only have three shapes which are repeated and may not be substituted for Tarbox's option labels with pre-defined transactions (brief, pages 13-14). Appellants further contend that Wheeler, in fact, uses an audible feedback to indicate the function of the key punched and lacks any indication

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that the shape of the key is used for determining such information (brief, pages 21-23).

The Examiner responds by stating that Tarbox teaches an ATM machine having buttons associated with a pre-defined transaction while Wheeler teaches the recited "each indicator being different in size, shape, color, or texture, or a combination thereof" as the push buttons that are different in size, shape, and/or color (answer, pages 7-8). The Examiner further argues that using buttons having different size, shape, and/or color would have enabled a visually impaired user to easily identify the buttons corresponding to the desired transactions (answer, page 7).

As a general proposition, 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) and In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). A prima facie case of obviousness is established when the teachings of the prior art itself would appear to have suggested the claimed subject matter to one of ordinary skill in the art. See In re Bell, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993); Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051,

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5 USPQ2d 1434, 1438 (Fed. Cir. 1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985). In considering the question of the obviousness of the claimed invention in view of the prior art relied upon, the Examiner is expected to make the factual determination set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (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. See also In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). 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).

Initially, we observe that claim 1 requires that the indicators be all of different shapes and each being associated with a pre-defined transaction. Other claims, such as claim 8, also require that each indicator be different to the other indicators in size, shape, color, or texture, or a combination thereof. Therefore, each button associated with a specific transaction may be identified only by its unique attributes even if a label further describes its function (e.g., claim 40).

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Tarbox describes an ATM machine (Figure 1) having a display 103, selector buttons 105 and the numeric key pad 107 (col. 4, lines 18-26). The display has different text blocks (Figure 5) of which blocks 505, 507, 509, 511 and 513 define function labels associated with each of buttons 105 (col. 6, lines 11-27). As indicated by Appellants (brief, page 11), Tarbox does not include any specific disclosure related to the buttons 105 having different shapes or other attributes. These buttons actually appear identical and only differ in their functions as described by their corresponding labels displayed in display area 103.

Wheeler on the other hand, provides a key pad for a telephone device where the buttons have different shapes to the extent that they differ only from an adjacent button (Figure 12). The uniqueness of the buttons does not appear to be of concern as Wheeler indicates that the lay out of the key pad may be identified by a visually impaired person when the telephone also includes a speech system enabling the user to hear the function of any of the buttons when depressed (page 18, lines 18-29).

Therefore, we agree with Appellants that, even based on Wheeler's concern with enabling the visually impaired user to identify the key pad buttons and contrary to the Examiner's

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assertion (answer, page 7), it is not clear how the identically shaped and sized buttons or the text display of their function labels in Tarbox may be modified with the key pad of Wheeler. The fact that Wheeler's repeating shape of buttons helps with a standard numerical pad in a telephone when it is augmented by a speech system declaring the function of the depressed key, indicates a level of predictability regarding the function of the buttons based on their specific location on the key pad that is not of concern for the ATM buttons of Tarbox. We therefore, find that the Examiner's attempt to modify the selector buttons 105 of Tarbox with the key pad configuration of Wheeler, to arrive at the claimed group of indicators all having different shapes is not based on any teachings within the applied references.

Rejections based on § 103 must also rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967). In concluding that the layout of the

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numeric key pad in Wheeler is even relevant to the ATM buttons of Tarbox where their functions are identified based on the function displays, without providing any reasonable factual evidence, the Examiner actually uses hindsight to justify the combination.

In view of our analysis above, we find that the Examiner has failed to set forth a prima facie case of obviousness because the necessary teachings and suggestions related to the claimed indicators, all of different shapes and each having unique attributes relating to size, shape and color, as recited in independent claims 1 and 8, are not shown. Accordingly, based on the weight of the evidence and the arguments presented by the Examiner and Appellants, we are constrained to reverse the Examiner's decision and not sustain the 35 U.S.C. § 103 rejection of claims 1-10, 21, 22 and 24-41.

#### CONCLUSION

In view of the foregoing the decision of the Examiner rejecting claims 1-10, 21, 22 and 24-41 under 35 U.S.C. § 103 is reversed.

We make the following new ground of rejection for claims 1 and 24 under 35 U.S.C. § 102 as being anticipated by Cragun<sup>1</sup>,

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<sup>1</sup> U.S. Patent No. 5,412,189 (May 2, 1995), a copy of which accompanies this decision.

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pursuant to 37 CFR § 41.50(b). We only consider claims 1 and 24, but encourage the Examiner to consider the other claims for possible rejections over Cragun alone or in combination with other prior art.

With respect to claim 1, Cragun shows an ATM machine (Figure 1) having a user interface in the form of a touch sensitive screen 20 on which regions 31-34 form a group of indicators which provide tactile information corresponding to textual data 25 (col. 2, lines 17-25). All of the indicators 31-33 have different shapes as the Braille markings on each is different and indicates information different from the others such as numbers 1-3 (col. 2, lines 25-28). A user may execute a desired transaction, shown as "Withdrawal," "Deposit" and "Check balance" in Figure 1, by selecting a single indicator from the three indicators 31-33 (col. 3, lines 52-61). Alternatively, as shown in Figure 3, the desired transaction may be obtaining information regarding various services and activities (col. 4, lines 3-5).

Regarding claim 24, in addition to the teachings discussed above, Cragun discloses a dispenser for dispensing money as money tray 90 and a card reader 85 as well as the tactile information

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buttons (Figure 1; col. 2, lines 38-51) which are all three dimensional.

In view of the discussion above, Cragun anticipates claims 1 and 24 as all the claimed elements are disclosed. Accordingly, we find that claims 1 and 24 are unpatentable under 35 U.S.C. § 102.

In addition to reversing the Examiner's decision with respect to the 35 U.S.C. § 103 rejection, this decision contains a new ground of rejection pursuant to 37 CFR § 41.50(b) (2005). 37 CFR § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 CFR § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

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(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

REVERSED  
37 CFR § 41.50(b)

JOSEPH F. RUGGIERO	)	
Administrative Patent Judge	)	
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	)	
	)	BOARD OF PATENT
STUART S. LEVY	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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MAHSHID D. SAADAT	)	
Administrative Patent Judge	)	

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