

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TOMOSHI HIRAYAMA

Appeal No. 1996-2046
Application 07/978,450¹

ON BRIEF

Before JERRY SMITH, BARRETT, and BARRY, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134
from the examiner's rejection of claims 2-9, 12, 13 and 15,

¹ Application for patent filed November 18, 1992. According to appellant, this application is a continuation of Application 07/642,994, filed January 18, 1991.

which constitute all the claims remaining in the application.

The disclosed invention pertains to an information processing apparatus using a pen and a tablet for the input of data. The apparatus permits sequential pages of a document to be deleted (shredded) or stored (copied) in a reduced number of input actions. A plurality of descriptive images are stored which when viewed successively simulate the process of shredding or copying. When a sequence of pages are to be shredded or copied, the descriptive images are successively displayed to give the appearance of the selected process taking place.

Representative claim 15 is reproduced as follows:

15. An information processing apparatus comprising:

(a) data input means comprising a pen and a tablet for inputting information;

(b) memory means for storing said information input by said data input means;

(c) processing means for processing said information in a form of plural pages;

(d) display means for displaying a plurality of icons and for displaying a page of said information;

Appeal No. 1996-2046
Application 07/978,450

(e) means responsive to said pen for designating a currently displayed page as a first page of a sequence of pages which is an object of a predetermined process;

(f) means responsive to said pen for changing a displayed page so as to select a previous (back) or next (forward) page for display;

(g) means responsive to said pen for designating a currently displayed page as a last page of said sequence;

(h) means responsive to said pen for starting said predetermined process from said first page to said last page in said sequence of pages;

(i) means for storing plural descriptive images designating said predetermined process including an image of a machine for performing the process;

(j) means for controlling said means for storing so as to display said descriptive images successively as a series of moving images to visually represent documents moving in relation to said image of a machine, to graphically simulate performing said predetermined process.

The examiner relies on the following references:

Saki et al. (Saki)	4,965,558	Oct. 23, 1990
Brewer et al. (Brewer)	5,347,628	Sep. 13, 1994
		(filed Jan. 18, 1990)

Tim Field, Using MacWrite™ and MacPaint™, Copyright 1984 by McGraw-Hill, pages 4, 8, 14, 22, 43-47 and 155.

Claims 2-9, 12, 13 and 15 stand rejected under 35

U.S.C. § 103. As evidence of obviousness the examiner offers

Appeal No. 1996-2046
Application 07/978,450

Field in view of Saki and Brewer.

Rather than repeat the arguments of appellant or the examiner, we make reference to the brief and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellant's arguments set forth in the brief along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

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 obviousness of the invention as set forth in claims 2-9, 12, 13 and 15. Accordingly, we

Appeal No. 1996-2046
Application 07/978,450

reverse.

Appellant has nominally indicated that the claims do not stand or fall together [brief, page 4], but he has not specifically argued the limitations of each of the claims. The extent of appellant's arguments appears on pages 7-8 of the brief wherein it is baldly asserted that the prior art does not teach or suggest features of the various dependent claims with no analysis or discussion of obviousness whatsoever. Simply pointing out what a claim requires with no attempt to point out how the claims patentably distinguish over the prior art does not amount to a separate argument for patentability. See In re Nielson, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987). At the time appellant's brief was filed, 37 CFR § 1.192(8)(iv) required that "the argument shall specify the errors in the rejection and, if appropriate, the specific limitations in the rejected claims which are not described in the prior art relied on in the rejection, and shall explain how such limitations render the claimed subject matter unobvious over the prior art." Appellant's arguments fail to

Appeal No. 1996-2046
Application 07/978,450

satisfy this requirement as a basis to have the claims considered separately for patentability. Since appellant is considered to have made no separate arguments for patentability, all claims will stand or fall together. Note In re King, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986); In re Sernaker, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983).

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations 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. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in

Appeal No. 1996-2046
Application 07/978,450

the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

Field teaches the manner in which the applications MacWrite™ and MacPaint™ operate on the Macintosh™ computer system. The examiner finds that Field essentially teaches all of the limitations of independent claim 15 except for the pen and tablet for inputting information and the means for displaying descriptive images successively as a series of moving images.

The examiner cites Saki as teaching that a pen and tablet for inputting information was well known, and the examiner asserts

Appeal No. 1996-2046
Application 07/978,450

that it would have been obvious to substitute Saki's pen and tablet for Field's conventional computer input. Brewer is cited as teaching that animated icons were known in the art. The examiner asserts that it would have been obvious to replace Field's conventional computer display with Brewer's moving images [answer, pages 3-5].

Appellant points out individual deficiencies in the applied references and argues that the claimed invention does not result from the combination of references as asserted by the examiner. Appellant also argues that the examiner has selected bits and pieces from the applied references and assembled these bits and pieces using appellant's own disclosure as a guide [brief, pages 4-7].

After a careful review of the record in this case, we agree with appellant that the collective teachings of Field, Saki and Brewer would not have suggested the invention as recited in independent claim 15. We agree with appellant that this particular combination of prior art references appears to be an improper attempt to reconstruct the invention in hindsight. We cannot agree with the examiner that the artisan

Appeal No. 1996-2046
Application 07/978,450

would have been motivated to modify programs or apparatus designed exclusively for the Macintosh computer system to have a pen and tablet input as used by Saki and animated icons as taught by Brewer. We can see no enhancement to the Macintosh computer system by attempting to incorporate disparate features from Saki or Brewer.

We also agree with appellant that the combination of Field, Saki and Brewer does not meet all the limitations of claim 15 anyway. Claim 15 requires that a sequence of pages be displayed and that a first page and a last page be designated from this sequence of pages [means (e)-(g)]. Neither Field or Saki designates pages in this manner. Claim 15 also requires that a sequence of images be displayed in response to the starting of the predetermined process. As noted by appellant, Brewer simulates animation only with continuous movement of the cursor and does not control the display means to display a sequence of images representing a selected process to be performed on a sequence of pages.

In summary, we agree with appellant that the invention as recited in independent claim 15 is not suggested by the

Appeal No. 1996-2046
Application 07/978,450

collective teachings of Field, Saki and Brewer within the
meaning

of 35 U.S.C. § 103. Therefore, the decision of the examiner
rejecting claims 2-9, 12, 13 and 15 is reversed.

REVERSED

Jerry Smith)	
Administrative Patent Judge)	
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Lee E. Barrett)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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)	
Lance Leonard Barry)	
Administrative Patent Judge)	

Appeal No. 1996-2046
Application 07/978,450

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Appeal No. 1996-2046
Application 07/978,450

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