

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GEORGE T. BRIECHLE

Appeal No. 1998-0957
Application 08/258,409

ON BRIEF

Before JERRY SMITH, RUGGIERO and LALL, 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 1-45, which constitute all the claims pending in the application.

The disclosed invention pertains to an electronic price display system. More particularly, the system includes

a housing having a power source, a display controller and an RF transceiver therewithin. Of particular note is that the display controller is powered by the power source whereas the RF transceiver is not powered by the power source.

Representative claim 1 is reproduced as follows:

1. An electronic price display system comprising a central computer and an RF transceiver communicatively coupled therewith, and further comprising a multiplicity of electronic price display labels each with a unique address, each electronic price display label comprising:

a housing,

a display within the housing,

a power source within the housing,

a controller within the housing and controlling the display and powered by the power source,

a passive RF transceiver within the housing and not powered by the power source,

an antenna communicatively coupled with the transceiver, the controller further characterized in having a clock speed switchable between a high speed and a low speed, the low speed selected to be sufficient to control the display, the controller comprising an interrupt input causing a switch to the high speed,

the transceiver further characterized in having a register defined to contain the unique address of the label, and in having means responsive to received RF energy at the antenna for receiving an address modulated in the RF energy, for testing for a match between the unique address of the label and the received address, and for generating an interrupt

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output in the event of the match;

the interrupt output of the transceiver operatively coupled with the interrupt input of the controller.

The examiner relies on the following references:

Stevens et al. (Stevens)	4,821,291	Apr. 11, 1989
Anders et al. (Anders)	4,827,395	May 02, 1989
Inagami	5,058,203	Oct. 15, 1991

Claims 22-24 stand rejected under 35 U.S.C. § 112, second paragraph, for failing to particularly point out and distinctly claim the invention. Claims 1-45 stand rejected under 35 U.S.C. § 103. As evidence of obviousness the examiner offers Stevens, Anders and Inagami with respect to claims 1-21 and 25-45 and just Stevens and Anders with respect to claims 22-24.

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 rejections advanced by the examiner, the arguments in support of the rejections and the evidence of obviousness relied upon by the examiner as support for the obviousness

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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 rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that claims 22-24 particularly point out the invention in a manner which complies with 35 U.S.C. § 112. We are also of the view that the collective 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 1-45. Accordingly, we reverse.

We consider first the rejection of claims 22-24 under the second paragraph of 35 U.S.C. § 112. The examiner's rejection states the following:

Regarding claim 22, the function of the reset circuit is unclear. ... Regarding claim 24, the claim is functionally recited, it is not clear what means or elements are being claimed to perform the functions of storing, comparing and generating [answer, page 4].

With respect to claim 22, appellant argues that there is no

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requirement under 35 U.S.C. § 112 that the claim explain how the reset signal is used. He adds that the reset circuit of claim 22 is clear and that claim 22 sets forth the invention in a manner that would be understood by the artisan [brief, pages 5-7]. With respect to claim 24, appellant argues that the claim simply recites functions of the transceiver which are implemented under program control. Appellant asserts that the structure supporting such functional recitations of a programmed device would be clearly understood by the artisan [id., pages 7-8].

The general rule is that a claim must set out and circumscribe a particular area with a reasonable degree of precision and particularity when read in light of the disclosure as it would be by the artisan. In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971). Acceptability of the claim language depends on whether one of ordinary skill in the art would understand what is claimed in light of the specification. Seattle Box Co., v. Industrial Crating & Packing, Inc., 731 F.2d 818, 826, 221 USPQ 568, 574 (Fed. Cir. 1984).

The examiner's rejection of claim 22 is directed to

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the breadth of the claim rather than to its indefiniteness. The breadth of this particular claim is not an appropriate basis for applying a rejection under the second paragraph of 35 U.S.C.

§ 112. With respect to claim 24, we agree with appellant that a general means within the transceiver is understood to perform the functions of that claim. Therefore, we agree with appellant that the artisan having considered the specification of this application would have no difficulty ascertaining the scope of the invention recited in claims 22-24. Therefore, the rejection of claims 22-24 under the second paragraph of 35 U.S.C. § 112 is not sustained.

We now consider the rejection of claims 1-21 and 25-45 under 35 U.S.C. § 103 as unpatentable over the teachings of Stevens, Anders and Inagami. Appellant has indicated that these claims will stand or fall together [brief, page 5]. 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

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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 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). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of

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the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Passaic, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered [see 37 CFR § 1.192(a)].

The examiner cites Stevens as an electronic price display system which only lacks the power saving features of the claims. The examiner cites Anders as teaching that a transceiver need not always be powered by a battery, but can also be powered by an RF signal to reduce the toll on the battery. The examiner asserts that Anders would have suggested the obviousness of any combination of power sources. Inagami is cited to teach the obviousness of switching between a high clock and a low clock frequency to conserve power [answer, pages 5-6].

Appellant points to the limitation of claim 1 that the controller is connected to the power source whereas the passive RF transceiver is not connected to the power source.

Appellant argues that all the circuitry in Anders is powered by the RF energy. Since all the circuitry in Stevens is also powered by a single power source, appellant argues that there is no teaching regarding certain elements powered by the power source and certain other elements not powered by the power source as recited in representative claim 1 [brief, pages 8-10]. The examiner responds that Anders teaches that some of the elements are powered by conventional power cells while other elements are powered by RF energy [answer, pages 8-9].

We have carefully considered the teachings of the applied prior art, and we agree with appellant that Anders does not teach or suggest using different power sources for different elements of that system. The passive transceiver of Anders is shown in Figure 7. The broadband RF energy is converted to DC and is used to charge whatever type of power source is available and that charge is applied to power unit 105. Power unit 105 then powers all elements within the transceiver as argued by appellant.

The clear difference between the claimed invention and the teachings of the applied prior art is the connection of a controller to a power source but not connecting a passive RF

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transceiver to that power source. The examiner has not addressed the obviousness of this difference because the examiner is mistakenly of the view that Anders teaches this feature. Since the examiner has failed to identify and address the obviousness of this specific difference between the claimed invention and the applied prior art, the examiner has failed to establish a prima facie case of obviousness. As noted above, the failure to establish a prima facie case of obviousness requires that this rejection not be sustained.

With respect to the rejection of claims 22-24 based on the teachings of Stevens and Anders, the examiner relies on the teachings in the same manner discussed above. Appellant points out the same deficiencies in the applied prior art as discussed above. Since the examiner has not properly addressed the differences between the claimed invention and the teachings of the applied prior art for the reasons discussed above, we do not sustain this rejection of claims 22-24.

In summary, we have not sustained any of the examiner's rejections of claims 1-45. Therefore, the decision of the examiner rejecting claims 1-45 is reversed.

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REVERSED

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JERRY SMITH)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
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Administrative Patent Judge)	APPEALS AND
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