

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES E. WICKS
and EDUARDO SCIAMMARELLA

Appeal No. 2000-1711
Application 08/808,870¹

ON BRIEF

Before BARRETT, DIXON, and LEVY, Administrative Patent Judges.
BARRETT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the final rejection of claims 1-29.

We affirm-in-part.

¹ Application for patent filed February 28, 1997, entitled "Pager with Rotating Knob and Character Display for Inputting Messages."

BACKGROUND

The invention relates to a device and method for inputting a message to a wireless pager that will be transmitted by the pager over a paging system to a designated recipient.

Claim 1 is reproduced below.

1. A pager for entering and transmitting a message comprising:

a display;

at least one character displayed on said display;

a character display control by which the said at least one character displayed is changed;

a selection control which, when actuated, selects a character from among the at least one character displayed;

an electronic controller for storing selected characters and a sequence in which said selected characters are selected, wherein said message comprises selected characters, and said sequence of selected characters is associated by said controller with a recipient identifier, said controller converts said recipient identifier and said sequence of selected characters into an electronic signal; and

a transmitter which receives said electronic signal from said controller and transmits said signal to a paging system.

The examiner relies on the following references:

Zabarsky et al. (Zabarsky)	4,644,351	February 17, 1987
Indekeu et al. (Indekeu)	5,694,120	December 2, 1997
		(filed February 26, 1996)
Metroka et al. (Metroka)	5,754,645	May 19, 1998
		(filed September 30, 1994)

Appeal No. 2000-1711
Application 08/808,870

Claims 1-29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Metroka, Indekeu, and Zabarsky.

We refer to the final rejection (Paper No. 6) and the examiner's answer (Paper No. 13) (pages referred to as "EA__") for a statement of the examiner's rejection, and to the appeal brief (Paper No. 11) (pages referred to as "Br__") and reply brief (Paper No. 14) (pages referred to as "RBr__") for a statement of appellants' arguments thereagainst.

OPINION

Grouping of claims

The claims are grouped as follows (Br5): (1) claims 1, 3-12, 15-25, 28, and 29, stand or fall together with representative claim 1; (2) claim 2 stands or falls alone; and (3) claims 13, 14, 26, and 27 stand or fall together with representative claim 13.

Claims 1, 3-12, 15-25, 28, and 29

Metroka discloses a data entry device for a keyless electronic device, such as a cellular telephone in the preferred embodiment of figure 1. Metroka discloses that the input device may be used by other electronic devices too small to use a normal keypad, including pagers (col. 8, lines 32-37). The device has a display 106 having an alphanumeric section 202 for displaying the alphanumeric characters entered by a user and a menu section 204

Appeal No. 2000-1711
Application 08/808,870

to display various menus and alphanumeric characters for the user interface. Data is entered by rotating the end cap 104 until the desired menu selection or alphanumeric character appears in the menu section 204; then the cap is pushed in the direction 114 to select the menu item or alphanumeric character; and the menu item or character appears in the alphanumeric section 202. Example 2 (cols. 5-6) is an example of entering a telephone number.

Metroka teaches that the data entry device is an improvement in terms of size, weight, and cost over keypads (col. 2, lines 3-9; col. 8, lines 55-59). Thus, Metroka is an excellent teaching of a data entry device almost identical to appellants' device.

The examiner first finds that Metroka does not teach a pager for entering and transmitting data (EA4). The examiner finds that Indekeu teaches "a method for selecting information services from a menu in [a] selective call transceiver which comprises a selective call receiver for entering and transmitting a message (200, figure 1; col. 1, lines 38-39 & col. 2, lines 57-59) for the purpose of being capable of sending multiple types of information" (EA4). The examiner concludes that it would have been obvious to include a pager in Metroka as taught by Indekeu "for the purpose of being capable of sending multiple types of information" (EA4).

Appellants note that Indekeu teaches a paging system in which a subscriber to an information service selects from a menu

Appeal No. 2000-1711
Application 08/808,870

of available types of information and signals the system for that information to be sent (Br6). It is argued that Indekeu does not teach or suggest entering or addressing messages to particular recipients (Br6). It is argued that there is no reason why one of ordinary skill in the art would combine the complex character entry and retrieval system of Metroka with Indekeu because Indekeu only requires that a user select from a limited menu of available information services (Br7-8).

We do not find where the examiner addresses these arguments.

It is not clear why the examiner applies Indekeu. Although Indekeu is in a pager environment, the user merely makes a menu selection and does not enter and transmit messages comprising a sequence of characters. Thus, we agree with appellants that there seems to be no motivation for one of ordinary skill to provide the complex data entry device of Metroka. To the extent that a pager environment is required, Metroka expressly teaches that the input device can be used for a pager (col. 8, line 35), which implies a pager having a need to enter and transmit data. Indekeu is not seen to contribute to the rejection.

The examiner next finds (EA4) that Metroka does not disclose the following limitations of claim 1:

an electronic controller for storing selected characters and a sequence in which said selected characters are selected, wherein said message comprises selected characters, and said sequence of selected characters is associated by said controller with a recipient identifier,

Appeal No. 2000-1711
Application 08/808,870

said controller converts said recipient identifier and said sequence of selected characters into an electronic signal; and

a transmitter which receives said electronic signal from said controller and transmits said signal to a paging system.

We note that Metroka actually discloses an electronic controller as recited in the first phrase, but not that the sequence of characters is a message. The examiner refers to Zabarsky for the teachings of a message associated with a recipient identifier, which is converted into an electronic signal and transmitted to a paging system (EA4). The examiner concludes that it would have been obvious to include the teachings of Zabarsky in the combination of Metroka and Indekeu "for the purpose of enabling the delivery of a message to a particular page unit wherever in the system it may be located" (EA5).

Appellants argue that the examiner has failed to provide any reasons to support the conclusion that the combination would have been obvious (Br8).

The examiner responds that Metroka, Indekeu, and Zabarsky are all transceivers and "[t]herefore, it would not be such a complex matter to combine Metroka and Indekeu's devices in order to provide multiple features in a small device to users" (EA9).

Appellants argue that this argument fails to satisfy the burden of showing motivation (RBr4). It is argued that "[t]he

'complexity' of the proposed combination has no bearing on whether or not motivation for the combination is evident" (RBr4).

We agree that the examiner has not provided sound reasoning for the combination. However, we find express motivation for the combination as discussed in response to the next argument.

Appellants argue (Br7) that Zabarsky states an express preference for an alphanumeric keyboard 903 as a means of entering data at column 12, lines 26-28: "Pager 106 further preferably [sic] has a built-in RF modem and full alphanumeric keypad which is used as a message encoder." Thus, it is argued, one of ordinary skill in the art would have been lead away from the combination of Zabarsky and Metroka (Br8).

We conclude that the collective teachings of Metroka and Zabarsky would have suggested the claimed subject matter to one of ordinary skill in the art, without the need for Indekeu. Zabarsky discloses a two-way pager with an input device (keypad 903 in figures 9 & 10) for composing a message of a sequence of characters. Messages are stored after the page user generates and enters them (col. 12, lines 41-43; col. 13, lines 63-66). An address of the pager or destination of the message ("recipient identifier") is entered after which the message is transmitted (col. 13, line 68 to col. 14, line 3). The difference between Zabarsky and the claimed subject matter is that Zabarsky uses a keypad for data entry rather than the

Appeal No. 2000-1711
Application 08/808,870

claimed character selection control. However, Metroka teaches the data entry device can be used in a pager (col. 8, line 36) and that it is an improvement in terms of size, weight, and cost over keypads (col. 2, lines 3-9; col. 8, lines 55-59). One of ordinary skill in the data entry art would have been motivated to substitute the data entry device of Metroka for the keypad of the pager in Zabarsky because Metroka expressly describes the advantages of such a data entry device over a keypad and expressly suggests it can be used in a pager. The fact that Zabarsky states that the page "preferably" has a full alphanumeric keyboard does not "teach away" from using the data entry device in Metroka. "A reference may be said to teach away when a person of ordinary skill, upon [examining] the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant." In re Gurley, 27 F.3d 551, 553, 31 USPQ2d 1130, 1131 (Fed. Cir. 1994). The term "preferably" only expresses a preference; it does not state that other types of character input devices will not work and, so, does not teach away. For these reasons, we sustain the rejection of claims 1, 3-12, 15-25, 28, and 29 over Metroka and Zabarsky.

Claim 2

Appeal No. 2000-1711
Application 08/808,870

Claim 2 recites that a plurality of characters is displayed in alphanumeric order with one of the characters being indicated as the character that will be selected when the selection control is actuated. This refers to showing, for example, three characters with the one to be selected highlighted as shown in appellants' figure 4.

The examiner finds (EA5; EA9) this feature taught in Zabarsky at column 13, lines 30-42, and column 15, lines 10-20. The examiner also finds that Metroka teaches displaying a plurality of characters (EA9-10).

Appellants argue that Metroka does not suggest displaying several characters in alphanumeric order to give context to the selection of additional characters, that Zabarsky only teaches displaying characters which have already been selected, and Indekeu fails to teach any character entry whatsoever (Br9). It is argued that Zabarsky teaches only entry of alphanumeric data which, when entered, is echoed on the display (RBr6).

We agree with appellants that none of the references teach or suggest a plurality of characters displayed on the display for selection. Metroka teaches only a single character at a time. Zabarsky teaches only displaying characters that have been selected. The examiner has failed to establish a prima facie case of obviousness. The rejection of claim 2 is reversed.

Appeal No. 2000-1711
Application 08/808,870

Claims 13, 14, 26, and 27

Claim 13 requires a speaker and an encoder which encodes the message in a series of sounds which are emitted by the speaker. This permits a one-way pager to send messages via a conventional telephone as described in connection with figure 3 at page 11, line 21 to page 12, line 15 of the specification.

The examiner finds that Metroka has a speaker 110 and an encoder/decoder 330 which encodes the message in a series of sounds which are emitted by the speaker (EA7-8).

Appellants argue that the speaker in Metroka is only used in the course of a telephone call in the conventional manner and does not teach that the speaker emits a series of sounds which represent a message input to the device using a character display and selection controls (Br10-11).

The examiner responds that the "limitation has no patentable weight, and on [sic, one] skilled in the art could have used Metroka's speaker to emit a series of sounds which represent a message input to the device using a character display" (EA10).

Appellants question the examiner's ability to disregard claim limitations for no apparent reason and without any explanation (RBr7). It is argued that it is irrelevant that the prior art could have used the speaker in Metroka in the manner claimed (RBr8).

Appeal No. 2000-1711
Application 08/808,870

We agree with appellants that Metroka does not teach or suggest the limitations of claim 13. Limitations in the claim cannot be ignored. Since Metroka does not send messages input by a character display and selection control, it does not teach encoding a message as a series of sounds. We also agree that "could have" is not the test for obviousness. See In re Mills, 916 F.2d 680, 682, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990) ("While Mathis' apparatus may be capable of being modified to run the way Mills' apparatus is claimed, there must be a suggestion or motivation in the reference to do so."). The examiner has failed to establish a prima facie case of obviousness. The rejection of claims 13, 14, 26, and 27 is reversed.

CONCLUSION

The rejection of claims 1, 3-12, 15-25, 28, and 29 is sustained. The rejection of claims 2, 13, 14, 26, and 27 is reversed.

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

AFFIRMED-IN-PART

Appeal No. 2000-1711
Application 08/808,870

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