

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHIAKI TAKIZAWA, KAZUO USUI, TAKASHI HAKODA,
and CHI HARU NISHIZAWA

Appeal No. 2002-1140
Application No. 08/947,470

ON BRIEF

Before KRASS, BARRY, and BLANKENSHIP, Administrative Patent Judges.

BLANKENSHIP, 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 5 and 15-20, which are all the claims remaining in the application.

We reverse.

BACKGROUND

The invention is directed to an injection molding machine and an input touch panel fitted over a display screen, with the touch panel extending to an area outside of the screen. Separate switch panels over the display area and outside of the display area thus become unnecessary. Claim 5 is reproduced below.

5. An apparatus comprising:

a molding machine; and

an input device for inputting data into said molding machine, said input device including:

an electronic display screen defined within a first area;

a support plate arranged adjacent to said electronic display screen;

indicia, indicating functions of a plurality of input keys, printed on said support plate; and

a touch input panel having a sensing region responsive to a touch of a human finger, said sensing region being defined within a second area, said second area overlaying said first area and being larger than said first area, and a portion of said second area which does not overlay said first area being defined as a panel extension portion and overlaying said indicia printed on said support plate.

The examiner relies on the following evidence:

Furukawa et al. (Furukawa)	4,745,241	May 17, 1988
Deeran et al. (Deeran)	5,594,471	Jan. 14, 1997 (filed Oct. 31, 1994)
Bonsall	5,631,805	May 20, 1997 (filed Sep. 27, 1995)

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Appellants' Admitted Prior Art ("the APA"), consisting of the "Description of the Related Art" at pages 1-3 of the specification.

Claims 5 and 15-20 stand rejected under 35 U.S.C. § 103 as being unpatentable over the APA, Deeran, Furukawa, and Bonsall.

We refer to the Final Rejection (Paper No. 14) and the Examiner's Answer (Paper No. 17) for a statement of the examiner's position and to the Brief (Paper No. 16) for appellants' position with respect to the claims which stand rejected.

OPINION

Appellants assert three "independent grounds" for reversing the rejection before us, which we will address in turn.

First, appellants argue the examiner has not shown motivation from the prior art for combining the teachings of the APA and Deeran. According to appellants, the examiners finding for motivation set forth in the Final Rejection -- to eliminate the cost associated with producing a separate switch panel -- comes from appellants' disclosure, rather than from the APA or Deeran. (Brief at 7-8.)

We note, however, that the APA (specification at 2, lines 15-19) relates that the greater cost inherent in providing a separate switch panel was known. In any event, the examiner points to column 2, lines 45-52 of Deeran for a teaching with respect to the relatively inexpensive production and maintenance of a single-piece touchscreen. (Answer at 5.) We concur that Deeran would have suggested the improvement over

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the APA, as set forth in the rejection, in having a single-piece input device with a touch sensitive area over both a display screen and a border touch zone outside of the display screen. We thus find appellants' argument unpersuasive.

Appellants' second argument is based on the view that there was no motivation to combine the teachings of Deeran and Furukawa. As support, appellants postulate that Deeran's shell or case 20 provides necessary support for the touchscreen, and adding a support plate as disclosed by Furukawa would be unnecessary or duplicative. Appellants point to column 1, lines 48 through 52 of Deeran, wherein the reference states that the case may be reinforced to an extent sufficient to withstand a high level of impact. (Brief at 9-10.)

Deeran's teaching that the case could be reinforced might fairly be viewed as providing motivation for adding a support plate, as taught by Furukawa. Further, the examiner notes (Answer at 8) that Deeran does not provide details as to the interior of case 20. There must be something inherently supporting at least the border touch zone outside of the display screen, and most likely a plate. Furukawa thus could also be viewed not as supporting a combination of teachings, but as providing evidence of inherent support for the touchscreen disclosed by Deeran -- i.e., showing an inherent feature of Deeran. The inherent teaching of a prior art reference arises both in the context of anticipation and obviousness. In re Napier, 55 F.3d 610, 613, 34 USPQ2d 1782, 1784 (Fed. Cir. 1995) (citing In re Grasselli, 713 F.2d 731, 739, 218 USPQ 769, 775 (Fed. Cir. 1983)). When a reference is silent about an asserted inherent

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characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Continental Can Co. v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991).

In any event, for the foregoing reasons, we are unpersuaded by appellants' argument that providing a support plate to the apparatus of Deeran would be unnecessary or duplicative of the function of case 20, and therefore find the asserted "lack of motivation" for the combination to be untenable.

Appellants' third and final argument begins with the assertion that both Deeran and Bonsall "teach away" from a permanent printing of indicia for a touch input panel. (Brief at 10-12.)

Deeran discloses a template overlay 15 (Fig. 1), placed over the border touch zone 18, which includes markings 17. Col. 3, ll. 35-40. Bonsall discloses a custom graphics sheet 36 (Fig. 1) between the display 54 and the touch screen 50. Col. 2, ll. 56-59; col. 3, ll. 46-55.

"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." Para-Ordnance Mfg. v. SGS Importers Int'l, 73 F.3d 1085, 1090, 37 USPQ2d 1237, 1241 (Fed. Cir. 1995) (quoting In re Gurley, 27 F.3d 551, 553, 31 USPQ2d 1130, 1131 (Fed. Cir. 1994)).

While we agree that Deeran and Bonsall tout the advantages of indicia that are relatively easy to remove, as pointed out by appellants at pages 11 and 12 of the Brief, we find no warning in the references, directed to the artisan, that teaches against indicia on a support plate, rather than on, for example, a custom graphics sheet. Nor have appellants pointed out any such discouragement in the disclosures. We thus are not persuaded that the references “teach away” from the instant invention.

However, we agree with appellants to the extent that the evidence relied upon by the instant rejection is not sufficient to support a prima facie case for obviousness. Although the APA and the references do not teach away from the instant invention, we find no disclosure or suggestion for indicia, indicating functions of a plurality of input keys, printed on the support plate, as required by instant claim 5 (the sole independent claim on appeal).

The examiner advances various rationales in attempting to make up for the admitted deficiency in the applied prior art; e.g., Final Rejection at 5-6 and Answer at 6-7, 9-10. A rejection based on assertions, absent evidence in support of the proposed combination, could not stand upon further appeal. See In re Zurko, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001) (in a determination of unpatentability “the Board must point to some concrete evidence in the record in support of...[the]...findings”). For example, while one might, in hindsight, glean from appellants’ disclosure that indicia printed on a plate and on a removable template are considered to

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be equivalents (Answer at 10), the rejection has no teaching from the prior art to show that the artisan considered the structures to be equivalents.

We therefore cannot sustain the rejection of claims 5 and 15-20 under 35 U.S.C. § 103 as being unpatentable over the APA, Deeran, Furukawa, and Bonsall.

CONCLUSION

The rejection of claims 5 and 15-20 under 35 U.S.C. § 103 is reversed.

REVERSED

ERROL A. KRASS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
LANCE LEONARD BARRY)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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HOWARD B. BLANKENSHIP)	
Administrative Patent Judge)	

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BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH , VA 22040-0747