

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(2) is not binding precedent of the Board.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. 46

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MITSURU KONO

Appeal No. 95-3908
Application 07/890,350¹

ON BRIEF

Before HAIRSTON, KRASS, and JERRY SMITH, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of
claims 1, 3, 7, 8 and 17 through 23, all of the claims in the

¹ Application for patent filed May 22, 1992. According to appellant, this application is a continuation of Application 07/496,788, filed March 21, 1990, now abandoned.

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application.

The invention is directed to a portable audio/display device for displaying and reproducing data in the form of alphanumeric information, diagrams, graphics, music and sound which are recorded on a mass storage medium.

Representative independent claim 1 is reproduced as follows:

1. A compact portable audio/display electronic apparatus comprising:

a compact portable casing capable of being held in one hand and operated with the other hand of a user,

a hinged cover secured to one edge of a top surface of said casing and pivoted to cover said casing top surface constituting its closed position and pivoted to an upright angular position relative to said top surface constituting its open position,

a liquid crystal display formed on an inside surface of said hinged cover for viewing by a user when said hinged cover is in its open position,

compact mass storage memory means provided in a cavity in said apparatus comprising a magneto-optic storage medium, said memory characterized by having a data storage capacity that is more than that of conventional memories and capable of handling concurrently recording and access of both display and audio data,

user interface means comprising a keyboard formed in said apparatus top surface and including iconic input keys for inquirable and inquisitorial access to data stored in said compact mass storage means, said user interface means overlying said compact mass storage means in said cavity,

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said keyboard comprising a transparent touch key input matrix on a top surface of said casing overlying a matrix of liquid crystal display elements formed in said casing beneath said top surface comprising said display, the keys of said transparent touch key matrix in alignment with the display elements of said liquid crystal matrix,

circuit control means for operating said mass storage memory means, said user interface means and said display and comprising:

means for recording alphanumeric and graphic display data in said compact mass storage memory,

means to random access said data in response to inquirable and inquisitorial input via said iconic input keys, and

circuit means for synchronizing the reproduction of said data for display and audio output whereby the display and reproduction of said data is arranged in one compact housing for the synchronized reproduction of the display of information concurrently with the audio reproduction of information directly associated with the displayed information based upon user inputted inquirable and inquisitorial entries via said iconic input keys.²

The examiner relies on the following references:

Thom	Des. 277,962	Mar. 12, 1985
Washizuka	4,639,225	Jan. 27, 1987
Dunn	4,667,299	May 19, 1987
Krenz	4,669,053	May 26, 1987

² While neither appellant nor the examiner addresses the limitation of a "storage capacity that is more than that of conventional memories" in the claim, we find the language a bit odd since what is "conventional" now or when the instant application was filed or during the term of any patent which may issue is a continuously changing parameter.

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Hattori

62-279585

Apr. 12, 1987

Claims 1, 3, 7, 8 and 17 through 23 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner cites Dunn and Hattori with regard to claims 1 and 19, adding Washizuka with regard to claims 7, 8, 17 and 20 through 23. With regard to claim 3, the examiner cites Dunn and Hattori together with Krenz. Finally, the examiner cites Krenz in view of Thom and Hattori with regard to claim 18.

Reference is made to the briefs and answers for the respective positions of appellant and the examiner.

OPINION

Turning first to the rejection of claims 1 and 19 under 35 U.S.C. § 103 in view of Dunn and Hattori, we will not sustain this rejection because we agree with appellant that there would have been no reason to combine the teachings of these references.

The examiner contends that Dunn teaches the claimed invention but for the "means for synchronizing the reproduction of said data for display and audio output" so that the information is displayed concurrently with the audio reproduction of information directly associated with the

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displayed information. The examiner then relies on Hattori for synchronizing display information and audio information and concludes that it would have been obvious to have provided Hattori's means for synchronizing the display and audio reproduction to the device of Dunn.

The question which comes to our mind is: Why provide such synchronization in Dunn when Dunn is not interested in any audio information which relates to text or graphical information which might be displayed on Dunn's screen? There is simply no suggestion to the artisan to modify Dunn's system, which displays text or graphics unrelated to any audio information, in a manner so as to synchronize the textual or graphic display therein with the reproduction of related audio information. The examiner appears to have taken references which teach bits and pieces of the claimed subject matter and combined them through a hindsight reconstruction of appellant's invention rather than for any reason that would be fairly suggested by the references themselves or by any common knowledge of artisans.

Claim 1 also recites a "means for recording...in said compact mass storage memory." While the examiner relies on

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Hattori for such a teaching, we agree with appellant that Hattori appears to be directed to prerecorded CDs which are used only for playback and not to a mass storage memory on which data may be recorded. Now, we might agree with the examiner that the limitation is so broadly recited in the claim that "recording" could include the information that was originally prerecorded on the disk. However, previously in the claim, it was recited that the storage capacity of the mass storage memory means is "capable of handling concurrently recording and access of both display and audio data." This would seem to strongly imply that the "recording" of claim 1 does not refer to prerecorded information but, rather, to data which is recorded on the mass storage memory means when using the claimed apparatus.

Thus, we will not sustain the rejection of claims 1 and 19 under 35 U.S.C. § 103. Further, since claims 7, 8, 20 and 21 depend from claim 1 and we find that Washizuka does not provide for the deficiencies noted supra with regard to claim 1, we also will not sustain the rejection of these claims under 35 U.S.C.

§ 103.

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We turn now to the rejection of claims 17, 22 and 23 under 35 U.S.C. § 103 over Dunn, Hattori and Washizuka. Again, because the examiner appears to have constructed the combination of references by fitting together bits and pieces of the claimed subject matter based on hindsight gleaned from the instant claims, we will not sustain this rejection.

As appellant points out, at pages 12-13 of the principal brief, the examiner appears to have ignored the claim limitations relating to the first and second liquid crystal displays and the dual function of the keys, along with their specific cooperation with the other claimed elements. In the response to this argument, at page 12 of the principal answer, the examiner states that Dunn discloses a first liquid crystal display on the inside cover while Hattori teaches a liquid crystal keyboard. However true this might be, the examiner has provided no convincing rationale as to why the artisan would have chosen only the keyboard of Hattori to be combined with only the inside cover display of Dunn. Again, the examiner chooses only so much of one reference required by the instant claims to be combined with only so much of another reference in order to piece together the claimed subject

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matter without a fair suggestion as to why the artisan would have been led to make the combination. This is improper under 35 U.S.C. § 103.

With regard to the "animated" claim limitation, the examiner merely points to the disclosure of "cartoons" at column 2, line 8 of Washizuka and concludes that the claim limitation is taught. However, not only does it appear that there would have been no motivation for the artisan to have provided such "cartoons" in Dunn's device, but the mere disclosure of "cartoons" by Washizuka does not, necessarily, suggest that Washizuka intends for "animated" pictorial representations since animation requires some movement while "cartoons" might include still pictures. Thus, at the very least, speculation is required to find a teaching of the claimed "animated pictorial representations."

Turning to independent claim 18, the examiner now bases the rejection on Krenz, Thom and Hattori, no longer relying on Dunn. We find no reason to modify the Krenz structure in accordance with Thom's teaching of providing a recess in which to place the keyboard. There would have been no reason to

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provide such a recess in Krenz. Moreover, claim 18 requires that the keyboard be "releasably secured" in the recess and there is no teaching of this limitation in either Krenz or Thom.

Claim 18 also requires the keyboard to have a dimensional size "substantially the same as said second portion bottom recess..." While the examiner apparently concludes that this is the case in Thom, appellant concludes otherwise, stating that in Thom, the keyboard can only be fit "partially" under the printer. While the figures in Thom, e.g., Figure 3, would appear to indicate that the keyboard therein is much larger than the space in which it fits, it may also be true that the drawings are not to scale. The important point here is that we just don't know. We must resort to speculation in order to determine if Thom actually teaches that the dimensional size of the key input means is "substantially the same size as said second portion..." and we cannot bottom a finding of obviousness on such speculation.

Finally, we turn to claim 3. However, claim 3 depends from independent claim 1 and we find no indication that the

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additional reference to Krenz provides for the indicated deficiencies of Dunn and Hattori. Accordingly, we will not sustain the rejection of claim 3 under 35 U.S.C. § 103.

We have not sustained any of the rejections under 35 U.S.C. § 103 because, based on the evidence before us, the examiner has failed to establish a prima facie case of obviousness.

The examiner's decision is reversed.

REVERSED

	Kenneth W. Hairston)	
	Administrative Patent Judge)	
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)	
)	
	Errol A. Krass)	BOARD OF
PATENT	Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
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