

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte FRANS A. GERRITSEN and MANFRED HORNDL

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Appeal No. 97-1273  
Application 08/269,818<sup>1</sup>

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ON BRIEF

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

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

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<sup>1</sup> Application for patent filed June 30, 1994.

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This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 2-5 and 8-16, which constitute all the claims remaining in the application.

The disclosed invention pertains to a remote control device for providing control and data signals to a multi-media data processing device. More specifically, the remote controller has a voice transducer physically integrated therewith and sends command signals to the multi-media device for selecting, annotating and processing images displayed by the multi-media device.

Representative claim 15 is reproduced as follows:

15. A hand-sized and manually activatable remote control unit for selecting and annotating images in a multimedia data processing device having a memory storage for storing images and digitized voice annotations, a display for displaying the images, and an information processor comprising;

discrete manipulatory controls for selecting and accessing stored images on the display;

a voice transducer physically integrated to the unit for producing voice signals for annotating the stored images; and

a short range interface connected to the controls and the voice transducer for converting outputs from the

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controls to discrete manipulatory control signals, for combining the discrete manipulatory control signals with voice input signals to form command signals and for transferring the command signals to the multimedia data processing device for selecting, annotating and processing transiently displayed images in said memory storage.

The examiner relies on the following reference:

Glick et al. (Glick)                      5,283,819                      Feb. 1, 1994

Claims 2-5 and 8-16 stand rejected under 35 U.S.C. § 103. As evidence of obviousness the examiner offers Glick taken alone.                      Rather than repeat the arguments of appellants 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 appellants' 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.

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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 2-5 and 8-16. Accordingly, we reverse.

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 the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S.

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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).

With respect to independent claim 15, the examiner basically asserts that Glick teaches all the features of the claimed remote control unit except for physically integrating the voice transducer in the remote control unit [answer, pages 3-4]. The examiner observes that it would have been obvious to physically integrate the voice transducer in the remote control unit to allow the user to have one hand free while the other hand was holding the remote or to eliminate a separate unit for the voice transducer [id., page 4].

Appellants argue that the examiner's position represents a classic case of hindsight reconstruction of the claimed invention. Appellants note that the advantages they obtained by placing the voice transducer in a remote control

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unit of a device for annotating images would have no comparable purpose in Glick's invention [brief, page 4]. We agree with appellants.

Glick's system is directed to the integration of a personal computer, an audio/video entertainment circuit and a telecommunications circuit into a single chassis. The only remote control in Glick is a remote control [52] for the audio/video circuit. No description of this remote control is provided in Glick. The assumption would have to be that the remote control controls the audio and video operations of the audio/video circuit in the manner conventionally done by infrared remote controllers. Glick discloses nothing about his system that would have suggested any advantages to placing a voice transducer in the remote control unit. In fact, a voice transducer in Glick's remote control unit would serve no suggested benefit in Glick so that any motivation to integrate a voice transducer into the remote control unit of Glick comes entirely from appellants' own disclosure. The examiner's proposed rationale for modifying Glick fails because there is nothing within the four corners of Glick which suggests the types of "problems" solved by the modification.

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Independent claims 14 and 16 also recite that the remote controller has a voice transducer for receiving voice input signals and a transmitting means for selecting and annotating the displayed images. For reasons discussed above with respect to claim 15, these features are neither taught nor suggested by the system of Glick.

In summary, the examiner's rejection of claims 2-5 and 8-16 under 35 U.S.C. § 103 based on Glick alone fails to provide the requisite evidence of obviousness necessary to support such a rejection. Therefore, the decision of the examiner rejecting claims 2-5 and 8-16 is reversed.

REVERSED

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Errol A. Krass	)	
Administrative Patent Judge	)	
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	)	BOARD OF PATENT
Jerry Smith	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
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John C. Martin	)	
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JS/dm

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