

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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

Appeal No. 1997-1578
Application No. 08/212,292

ON BRIEF

Before HAIRSTON, FLEMING, and RUGGIERO, Administrative Patent Judges.

RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 12-19, all of the claims pending in the present application. Claims 1-11 have been canceled.

The claimed invention relates to a programmable, scrolling alphanumeric message display in a lapel-pin size housing which includes a clothing attachment to facilitate

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securing to a shirt pocket or coat lapel. Manually activated control buttons are provided for selecting the characters of the message. More particularly, Appellant indicates at page 3 of the specification that the display is driven in a continuous scrolling manner so that the displayed message cycles, returning to the beginning after the last characters have been displayed.

Claim 12 is illustrative of the invention and reads as follows:

12. An electronic lapel button for public displaying of a scrolling digital message comprising a plurality of characters comprising:

a lapel-pin-size housing;

an alphanumeric display on an outwardly facing surface of said housing;

an attachment on an opposite, non-adjacent surface of said housing;

a digital message memory located within said housing for recording the digital message;

a driver for driving said display in continuous scrolling fashion with the digital message so that said digital message cycles, returning to a first character after a last character has been displayed resulting in continuous re-display;

a digital message store circuit within said housing and adapted to operate in response to manually activated controls

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to generate and store the digital message in said message memory;

manually activated controls associated with said housing for selecting said characters of said digital message on a one-by-one basis for storage in said message memory by said message store circuit;

a battery for powering said alphanumeric display, message memory, and message store circuit; and

a cable attaching said battery to said housing for powering said message memory, said message store circuit, said driver, and said display.

The Examiner relies on the following prior art:

Young 1970	3,521,049	Jul. 21,
Sebestyen 24, 1976	3,976,995	Aug.
Piguet 1983	4,385,291	May 24,

A. F. Newell et al. (Newell), "An alphanumeric display as a communication aid for the dumb," Medical and Biological Engineering, pp. 84-88 (January 1975).

Claims 12-19 stand finally rejected under 35 U.S.C. § 103 as being unpatentable over Newell in view of Young, Piguet, and Sebestyen.

Rather than reiterate the arguments of Appellant and the Examiner, reference is made to the Brief and Answer for the respective details.

OPINION

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We have carefully considered the subject matter on appeal, the rejection advanced by the Examiner, the arguments in support of the rejection 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, 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 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 set forth in claims 12-19. 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

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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.
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 Hospital Systems, Inc. v.
Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933
(Fed.

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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 each of the independent claims 12, 13, and 18, the Examiner, as the basis for the obvious rejection, proposes to modify the alphanumeric display disclosure of Newell which describes a precessing or rolling display feature in which displayed characters drop off the display as new characters are added to the display. As recognized by the Examiner, Newell provides no explicit disclosure of a continuous scrolling feature as presently claimed by Appellant in which the precessing display is recirculated by returning to the first character after the last character is displayed so that a message is continuously re-displayed. To address this deficiency, the Examiner turns to Sebestyen which discloses a pager having a precessing display. The Examiner's line of reasoning, which points to lines 8-10 of Sebestyen's

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Abstract which describes the use of a recirculating shift register, is set forth at page 5 of the Answer as follows:

Therefore, one of ordinary skill in the art having Sebestyen would readily find obvious that the message in shift register store of Newell et al could be realized in a recirculation register or counter means.

The Young and Piguet references are added to the combination as teaching the remote battery and coded push-button features, respectively.

In response, Appellant's arguments primarily center on the alleged lack of teaching in any of the references of the claimed recirculating precessing display. After careful review of the applied prior art and, in particular, Sebestyen, the primary reference relied upon for this feature, in light of the arguments of record, we are in agreement with Appellant's position as stated in the Brief. Although the Examiner has relied on an excerpt from the Abstract of Sebestyen which discloses a recirculating shift register which enables the precessing display feature, there is no description in Sebestyen of a continuous scrolling of the displayed message resulting in a continual message re-display as required by the claims on appeal. To the contrary, our interpretation of

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Sebestyen coincides with that of Appellant, i.e. the scrolling of a displayed message in Sebestyen is stopped after a single display. The recirculating shift register 732 in Sebestyen permits a message to be retained in memory for subsequent recall by a user (Sebestyen, column 4, lines 36-50); however, there is no teaching in Sebestyen of any continual re-display of the displayed message absent any manual intervention by the user. It is also apparent from the line of reasoning in the Answer that since the Examiner has, in our view, mistakenly interpreted the disclosure of Sebestyen as disclosing such continual re-display feature, the issue of the obviousness of this feature has not been addressed.

We further agree with Appellant's argument (Brief, page 5) that the Examiner has failed to provide proper motivation for modifying Newell with the teachings of Sebestyen. It is our view that, even assuming arguendo that the precessing display feature in Sebestyen could be construed to teach continuous message re-display, no motivation exists for modifying Newell in the manner suggested by the Examiner. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the

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prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992). None of the problems sought to be overcome by Sebestyen would be expected to exist in Newell. As pointed out by Appellant in the Brief, Newell is directed to interactive, real-time communication in which there would be little need to utilize a stored message repeat feature such as provided for by the pager of Sebestyen. We are left to speculate why the skilled artisan would modify the rolling display feature of Newell with that of Sebestyen. The only reason we can discern is improper hindsight reconstruction of Appellant's claimed invention.

In view of the above discussion, it is our opinion that the Examiner has not established a prima facie case of obviousness and, accordingly, the 35 U.S.C. § 103 rejection of independent claims 12, 13, and 18, as well as claims 14-17 and 19 dependent thereon, cannot be sustained. Therefore, the decision of the Examiner rejecting claims 12-19 is reversed.

REVERSED

KENNETH W. HAIRSTON)

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Administrative Patent Judge)	
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)	BOARD OF PATENT
MICHAEL R. FLEMING)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
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APJ RUGGIERO

APJ HAIRSTON

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DECISION: REVERSED
Send Reference(s): Yes No
or Translation (s)
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Index Sheet-2901 Rejection(s):
Prepared: April 24, 2001

Draft Final

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OB/HD GAU

PALM / ACTS 2 / BOOK
DISK (FOIA) / REPORT