

The opinion in support of the decision being entered today was not written for publication is not binding precedent of the board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte MASAYOSHI OKAMOTO

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Appeal No. 1998-0918  
Application 08/314,451

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ON BRIEF

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

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 4-12, which constitute all the claims remaining in the application.

The disclosed invention pertains to a telephone note taking device which is specifically adapted to automatically take notes from a user before the user places an outgoing telephone call through the device.

Representative claim 7 is reproduced as follows:

7. A telephone note-taking device, adapted to take notes from a user before the user places an outgoing telephone call through the telephone note-taking device, comprising:

selecting means, responsive to user selection, for enabling the user to select a telephone using mode through which, when selected, the telephone note-taking device is instructed to accept notes to be entered by the user and subsequently, upon a further command from the user, initiate an outgoing telephone call to a called party;

party designating/inputting means, responsive to said selecting means, for enabling the user to designate the called party to which the telephone call is to be directed, wherein the party designating/inputting means begins operation when the user selects the telephone using mode via the selecting means;

transmitting means, operative in conjunction with said selecting means and responsive to the further command from the user, for initiating the outgoing telephone call between the user and the called party, said further command being separate from and subsequent to the user selection of the telephone using mode;

note inputting means for accepting the notes entered by the user before the outgoing telephone call is initiated, said note inputting means automatically commencing operation, so as to accept the notes, sequentially after the party designating/inputting means starts operation but before the user, through the selecting means, commands the device means to initiate the telephone call;

storing means, connected to said note inputting means, for storing said notes entered via the note inputting means;  
and

note displaying means, connected to the note inputting means, for displaying the notes to the user as the notes are

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entered thereby.

The examiner relies on the following references:

Norwood	5,063,600	Nov. 05, 1991
Putnam et al. (Putnam)	5,065,309	Nov. 12, 1991

Claims 4-12 stand rejected under 35 U.S.C. § 103. As evidence of obviousness the examiner offers Putnam in view of Norwood.

Rather than repeat the arguments of appellant or the examiner, we make reference to the briefs 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 appellant's arguments set forth in the briefs along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record

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before us, that the examiner has failed to establish a prima facie case for the obviousness of the invention as set forth in claims 4-12. 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. 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

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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). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Passaic, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered [see 37 CFR § 1.192(a)].

With respect to each of the claims on appeal, the examiner points out how Putnam is relied on in meeting the claimed invention. The examiner acknowledges that Putnam does not teach the inputting of notes before a call is made [answer, page 5]. Norwood is cited as teaching an information

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management system which provides for the entry of notes before a call is made. The examiner asserts that it would have been obvious to the artisan to include Norwood's information management system with the telephone note taking system of Putnam to allow the editing of notes without requiring that a telephone number be called [id.].

Appellant argues that the collective teachings of Putnam and Norwood "neither teach nor suggest note inputting means for accepting notes entered by the user before an outgoing telephone call is initiated, and automatically commencing operation, so as to accept the notes, sequentially after a party designating/inputting means starts operation but before the user, through a selecting means, commands the device to initiate the telephone call" [brief, page 9].

Although the examiner acknowledges that the operation of each of Putnam and Norwood requires that the user make a manual selection to effect the note taking function, the examiner finds these manual selections to be within the claimed automatic operation [answer, pages 7-8 and 10].

We agree with the position argued by appellant for

essentially the reasons set forth in the briefs. The relationship of automatically commencing operation of the note taking function before a call is made is simply not suggested by either of the references applied by the examiner. The confirm window of Putnam disappears if no input is made by the user so that note taking does not occur automatically. The examiner admits that Norwood requires a manual input by the user, and such a manual input does not fall within the meaning of automatic operation as argued by the examiner.

Thus, the examiner's findings on the differences between the claimed invention and the prior art teachings are incorrect. The examiner, therefore, has failed to establish a prima facie case of obviousness. The question of whether the actual differences between the claimed invention and the teachings of the applied prior art would have been obvious within the meaning of 35 U.S.C. § 103 has not been established on this record. In other words, this record does not reflect the examiner's position on the obviousness of modifying the systems of Putnam and Norwood to carry out the automatic operation as claimed. Failure to properly address the differences between the claimed invention and the applied

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prior art results in a failure to establish a prima facie case  
of obviousness.

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Since all the appealed claims recite the above discussed features, we do not sustain the examiner's rejection of any of the appealed claims on this record. Therefore, the decision of the examiner rejecting claims 4-12 is reversed.

REVERSED

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KENNETH W. HAIRSTON	)	)
Administrative Patent Judge	)	
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	)	BOARD OF PATENT
JERRY SMITH	)	
Administrative Patent Judge	)	APPEALS AND
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PARSHOTAM S. LALL	)	
Administrative Patent Judge	)	

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