The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

Paper No. 9

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BRUCE TOGNAZZINI

Appeal No. 1998-2372
Application No. 08/639,815

ON BRIEF

Before THOMAS, FLEMING, and BARRY, Administrative Patent Judges.
BARRY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the rejection of claims 1, 2, 4, 8-11, and 14. We affirm-in-part.

BACKGROUND

The invention at issue in this appeal relates to time keeping. A timepiece needs to be reset when the boundary of a time zone is traversed. This need is particularly troublesome

aboard trains, buses, and airplanes that do not display public clocks.

The appellant discloses techniques for automatically updating a time piece when the boundary of a time zone is crossed. More specifically, stored data defining time zone boundaries are combined with location data from a Global Positioning Satellite receiver to decide when a time zone boundary is crossed. Alternatively, current time data are transmitted to a timepiece from transmitters at locations frequented by travelers, e.g., railroad stations, bus terminals, and airports.

Claim 4, which is representative for our purposes, follows:

> 4. A timepiece which can be remotely updated, comprising:
>
> a. a clock, and
>
> b. a receiver configured to receive externally supplied update information over a communications link for updating said clock in which said update information is provided from a vehicle.

The references relied on in rejecting the claims follow:

Van Orsdel	4,501,502	Feb. 26, 1985
DeLuca et al. (DeLuca)	5,089,814	Feb. 18, 1992.

Claims 1, 2, 4, 8-11, and 14 stand rejected under 35 U.S.C. § 103 as obvious over DeLuca in view of Van Orsdel. Rather than repeat the arguments of the appellant or examiner in toto, we refer the reader to the brief and answer for the respective details thereof.

OPINION

In deciding this appeal, we considered the subject matter on appeal and the rejection advanced by the examiner. Furthermore, we duly considered the arguments and evidence of the appellant and examiner. After considering the totality of the record, we are persuaded that the examiner erred in rejecting claims 1, 2, 8-11, and 14. We are also persuaded, however, that he did not err in rejecting claim 4. Accordingly, we affirm-in-part.

We begin by noting the following principles from In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993).

> In rejecting claims under 35 U.S.C. Section 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).... "A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." In re Bell, 991 F.2d 781, 782, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) (quoting In re Rinehart, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976)).

We next find that the references represent the level of ordinary skill in the art. See In re GPAC Inc., 57 F.3d 1573, 1579, 35 USPQ2d 1116, 1121 (Fed. Cir. 1995)(finding that the Board of Patent Appeals and Interference did not err in concluding that the level of ordinary skill was best determined by the references of record); In re Oelrich, 579 F.2d 86, 91,
198 USPQ 210, 214 (CCPA 1978) ("[T]he PTO usually must evaluate ... the level of ordinary skill solely on the cold words of the literature."). Of course, “‘[e]very patent

application and reference relies to some extent upon knowledge of persons skilled in the art to complement that [which is] disclosed ....'"

In re Bode, 550 F.2d 656, 660, 193 USPQ 12, 16 (CCPA 1977) (quoting In re Wiggins, 488 F.2d 538, 543, 179 USPQ 421, 424 (CCPA 1973)). Those persons "must be presumed to know something" about the art "apart from what the references disclose."

In re Jacoby, 309 F.2d 513, 516, 135 USPQ 317, 319 (CCPA 1962). With the aforementioned principles and finding in mind, we consider the appellant's arguments and the examiner's responses regarding the following claims:

- claims 1, 2, 8-11, and 14
- claim 4.

We first address claims 1, 2, 8-11, and 14.

Claims 1, 2, 8-11, and 14

The appellant argues, "[t]he references do not show a memory storing information about time zone boundaries ...." (Appeal Br. at 5.) The examiner responds, "[t]he Deluca [sic] Reference includes a memory means which contains data to

enable the device to have its time adjusted based on reception of a signal containing location data.... One has but to read the abstract lines 5-8." (Examiner's Answer at 3-4.)

"'[T]he main purpose of the examination, to which every application is subjected, is to try to make sure that what each claim defines is patentable. [T]he name of the game is the claim ....'" In re Hiniker Co., 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998) (quoting Giles S. Rich, The Extent of the Protection and Interpretation of Claims--American Perspectives, 21 Int'l Rev. Indus. Prop. & Copyright L. 497, 499, 501 (1990)). Here, claims 1, 2, and 8-10 specify in pertinent part the following limitations: "a memory medium storing information about time zone boundaries ...." Similarly, claim 11 specifies in pertinent part the following limitations: "providing an element for storing time zone boundary information ...." Also similarly, claim 14 specifies in pertinent part the following limitations: "a computer program stored on said memory medium, said computer program including instructions for comparing information about a current location of a timepiece with

stored information about a time zone boundary ...." Accordingly, claims 1, 2, 8-11, and 14 require storing information about time zone boundaries.

The examiner fails to show a suggestion of the limitations in the prior art. "Obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor." Para-Ordnance Mfg. v. SGS Importers Int'l, 73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995)(citing W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1551, 1553, 220 USPQ 303, 311, 312-13 (Fed. Cir. 1983)). "It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992) (citing In re Gorman, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991)). "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 prior art suggested the desirability of the modification." Id. at 1266,

23 USPQ2d at 1784 (citing In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984)).

Here, the examiner asserts, "[t]he Deluca [sic] Reference includes a memory means which contains data to enable the device to have its time adjusted based on reception of a signal containing location data." (Examiner's Answer at 3.) Although DeLuca teaches storing data to enable a device to have its time adjusted based on reception of a signal containing location data, the former data do not concern time zone boundaries. To the contrary, the former data comprise locations and their respective time zones. More specifically, "[t]able **60** shows a table of location signals and time zones which are stored in memory means **38**.... [A]n indicator indicative of the time zone of the location signal is displayed on display **30**. The indicator is additionally shown in table **60** (FIG. 4)." Col. 3, ll. 12-18. The examiner fails to allege, let alone show, that Van Orsdel cures the deficiency.

Because DeLuca teaches storing only locations and their respective time zones, we are not persuaded that teachings from the prior art would have suggested the limitations of "a memory medium storing information about time zone boundaries"; "providing an element for storing time zone boundary information"; or "a computer program stored on said memory medium, said computer program including instructions for comparing information about a current location of a timepiece with stored information about a time zone boundary ...." The examiner fails to establish a prima facie case of obviousness. Therefore, we reverse the rejection of claims 1, 2, 4, 8-11, and 14 as obvious over DeLuca in view of Van Orsdel. We next address claim 4.

Claim 4

The appellant argues, "[n]one of the references transmit update information from a vehicle to a separate timepiece." (Appeal Br. at 5.) The examiner responds, "the vehicle is shown by 11 in V [sic]." (Examiner's Answer at 4.)

"In the patentability context, claims are to be given their broadest reasonable interpretations. Moreover, limitations are not to be read into the claims from the specification."
In re Van Geuns, 988 F.2d 1181, 1184, 26 USPQ2d 1057, 1059 (Fed. Cir. 1993)(citing In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)). Here, claim 4 specifies in pertinent part the following limitations: "update information is provided from a vehicle." Giving the claim its broadest reasonable interpretation, the limitations recite a vehicle providing update information.

The prior art teaches the limitations. "[A] disclosure that anticipates under Section 102 also renders the claim invalid under Section 103, for 'anticipation is the epitome of obviousness.'" Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983) (quoting In re Fracalossi, 681 F.2d 792, 215 USPQ 569 (CCPA 1982)). Obviousness follows ipso facto, moreover, from an anticipatory reference. RCA Corp. v. Applied Digital Data Sys., Inc.,

730 F.2d 1440, 1446, 221 USPQ 385, 390 (Fed. Cir. 1984). Here, Van Orsdel discloses "a geosynchronous earth satellite **11** ...." Col. 2, l. 23. Because a satellite is a "vehicle intended to orbit the earth, moon, or another celestial body," Webster's Ninth New Collegiate Dictionary 1044 (1990)(copy attached), the reference's geosynchronous earth satellite is a vehicle.

The appellant admits that Van Orsdel further discloses that the geosynchronous earth satellite provides update information. More specifically, he recognizes, "[b]oth the time keeping and synchronization signals may be transmitted ... through a satellite 11 to a remote timepiece 12." (Appeal Br. at 4.) For its part, the reference teaches that the "geosynchronous earth satellite **11** ... transmits a coded time signal back to earth for reception by any suitable receiver which is within the transmission reception zone of the satellite." Col. 2,

ll. 23-26. The coded time signal is used to update the time shown by the hands of a watch. Van Orsdel describes the update as follows.

> The normal timekeeping mode operates through suitable coded signals received at antenna **19**. A receiver 22 of conventional design decodes and amplifies the signal which it receives and converts it into a direct current (DC) pulse.... The DC pulse generated by receiver/amplifier **22** is driven to a timekeeping mode output **25** and through suitable conductive means to a micro-relay switch **26**. Activation of switch **26** feeds the DC pulse to a known set-reset, flip-flop circuit **27** which activates a step motor **28**. Step motor is mechanically connected to a conventional watch gear set **29** which moves the hands of the watch.

Col. 2, ll. 53-67.

The reference further teaches, "[t]he separate synchronization signal is transmitted, for example from satellite **11**, at a relatively long time interval such as once each hour or once each day." Col. 3, ll. 39-41. The synchronization signal is converted into a time update signal. More specifically, "[t]he synchronization signal is received at antenna **19** and directed to receiver/amplifier **22**. The signal is amplified and converted into a DC pulse having

characteristics different from the timekeeping DC pulse. A time correction output **38** is provided and is tailored to the characteristics of this DC signal so that the signal is conveyed from output 38 to the feather switch **35**." Col. 3, l. 65, - col. 4, l. 3.

Because Van Orsdel teaches a vehicle providing update information, we affirm the rejection of claim 4 as obvious over DeLuca in view of Van Orsdel. Our affirmance is based only on the arguments made in the brief. Arguments not made therein are not before us, are not at issue, and are considered waived.

CONCLUSION

In summary, the rejection of claims 1, 2, 8-11, and 14 under 35 U.S.C. § 103 as obvious over DeLuca in view of Van Orsdel is reversed. The rejection of claim 4 under § 103 as obvious over DeLuca in view of Van Orsdel, however, is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED-IN-PART

JAMES D. THOMAS Administrative Patent Judge	)	
MICHAEL R. FLEMING Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
LANCE LEONARD BARRY Administrative Patent Judge	)	

MCDERMOTT, WILL & EMERY
600 13TH STREET, N.W.
WASHINGTON, DC 20005