

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM R. LEGGIO

Appeal No. 1999-0218
Application No. 08/691,889¹

ON BRIEF

Before MARTIN, RUGGIERO, and BLANKENSHIP, Administrative Patent Judges.

MARTIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-19, all of the pending claims, under 35 U.S.C. §§ 102 and 103. We reverse and enter

¹ Application for patent filed August 1, 1996.

a new ground of rejection under 35 U.S.C. § 112, second paragraph, pursuant to 37 CFR § 1.196(b).

A. The invention

The invention is a timepiece which gives a visual or audible indication of the approximate time in conversational terms that are either (a) never correct to the minute or (b) correct to the minute only for multiples of a quarter-hour (Spec. at 2, lines 30-34). For example, the timepiece may give an indication that the time is "close to a quarter past three" followed a short time later by an indication that the time is "exactly a quarter past three" (id. at 6, ll. 17-22). A visual display of the approximate time can be either alphabetic or alphanumeric (id. at 5, ll. 15-22). The face of the timepiece "is devoid of a minute hand or other representation which would indicate more or less the exact minute of the hour" (id. at 4, ll. 8-11). Although the face may include a second hand (id. at 4, ll. 11-16), in a preferred embodiment the face "is devoid of hour, minute or second hands and, additionally, devoid of indicia representing the seconds, minutes or hours" (id. at 4,

11. 16-19). The timepiece may indicate the time continuously or only after actuation of an actuating means (id. at 4, 11. 20-24).

B. The claims

Claims 1, 10, and 19, which are all of the independent claims, read as follows:

1. A timepiece for exactly indicating the approximate time, said timepiece comprising:

(A) a timepiece face without a minute indicator; and

(B) means for indicating the approximate time in conversational terms.

10. A timepiece for exactly indicating the approximate time in words, said timepiece comprising:

(A) a timepiece face without a minute indicator; and

(B) means for indicating the approximate time in words.

19. A timepiece for exactly indicating the approximate time in words, said timepiece comprising:

(A) a timepiece face without a minute indicator; and

(B) means for visually indicating the approximate time in words.

We note these claims do not require that every indicated time be approximate; it is only necessary that at least one time be approximate. Dependent claim 6, for example, specifies that the indicated time is "correct to the minute only on integral multiples of 15 minutes."

C. The prior art and ground of rejection

The only reference relied on in the rejections is the following U.S. patent:

Beguin	3,911,668	Oct. 14, 1975
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The final rejection states (at 1) that claims 1, 2, and 4-7 are rejected under § 102 for anticipation by Beguin and that claims 3 and 8-19 are rejected under § 103 for obviousness over Beguin in view of allegedly known prior art. We therefore assume that the Answer is incorrect to indicate (at 3-4) that § 102 rejection applies to claims 1, 2, 4, and 5 and the § 103 rejection applies to claims 3 and 6-15.

D. New ground of rejection pursuant to 37 CFR § 1.196(b)

Pursuant to 37 CFR § 1.196(b), we are hereby rejecting claims 1-19, i.e., all of the appealed claims, under 35 U.S.C. § 112, second paragraph, on the ground that the terms "exactly" and "approximate" in the preambular phrase "exactly indicating the approximate time" in claims 1, 10, and 19 are contradictory and thus render indefinite those claims and their dependent claims. The following discussion of the § 102 and § 103 rejections presumes that the preambles of claims 1, 10, and 19 do not include the term "exactly."

E. The merits of the § 102 rejection

Beguin discloses a watch which gives the approximate time (col. 1, ll. 21-23) and is also waterproof because it has no stem for winding the watch or setting the time (col. 1, ll. 56-59). The watch has a single hand 7, which in the embodiment depicted in the figures takes three hours to complete one rotation (col. 2, ll. 26-27).² The watch does not have indications representing each minute. Instead, as

² Alternatively, the hand can be made to complete one rotation in one, two, four, six, or twelve hours (Beguin, col. 3, ll. 31-34).

shown in Figure 5, ring 10 of bezel 9 includes indications 21 and 22 which represent intervals of fifteen minutes and five minutes, respectively (col. 2, ll. 30-33). The time is set by rotating the watch case (Fig. 4) relative to ring 10 of the bezel (Fig. 2) (col. 2, ll. 34-39). Beguin states that "[b]etween the five minutes indications 22 the hand 7 can easily be positioned with sufficient accuracy to indicate the minute" (col. 2, ll. 39-41). Disc 11 (Fig. 1) of the bezel carries the hour numbers and is rotatable by the user relative to ring 10, which has three windows 17-19 through which the selected hour numbers can be viewed (col. 2, ll. 48-53). The user can rotate the disc 11 once every three hours to make the correct hour numbers appear in these windows (col. 2, ll. 57-61). Beguin does not disclose means for audibly indicating the time.

Regarding element A of claim 1, i.e., a "timepiece face without a minute indicator," the examiner contends that the "[t]he reference does not have a minute indicator or an hour indicator but rather a minute and hour indicator" (Final Rej. at 2). Appellant counters that hand 7 is a minute indicator because it "can be positioned with sufficient accuracy to

indicate the minute" (Brief at 7), citing Beguin's above-noted explanation of setting the time. Because the term "minute indicator" is not defined in the specification, it must be given its broadest reasonable interpretation when considered in light of appellant's disclosure. See In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997):

[T]he PTO applies to the verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant's specification.

In our view, the term "minute indicator" when broadly construed reads on hand 7 and/or indications 21 and 22, which represent every fifteenth and fifth minute of the hour.³ Thus, we do not agree with the examiner's position that the hand's function as an hour indicator precludes it from being accurately described as a minute indicator. Because element A of claim 1 is not satisfied, the § 102 rejection of that

³ The "minute indicator" term reads on these elements even if the watch has not been accurately set using one of the five-second or fifteen second indications.

claim is reversed, as is the § 102 rejection of its dependent claims 2 and 4-7.

In the interest of completeness, we have also considered whether Beguin satisfies element B of claim 1, i.e., "means for indicating the approximate time in conversational terms." The terms "approximate time" and "conversational terms" are not defined in the specification and therefore must be given their broadest reasonable interpretations. As the claim fails to specify that the time is approximate as to minutes, the term "approximate time," when given its broadest reasonable interpretation consistent with the disclosure, is broad enough to read on a time that is approximate as to minutes or seconds and thus reads on Beguin in two different ways. First, when hand 7 is between pointing directly to one of indicators 21 and 22, it indicates the time exactly in minutes but only approximately as to seconds. Second, when the hand is pointing between the indicators, it indicates the time approximately as to both minutes and seconds. (In both cases, the hand indicates the hour exactly.) Nevertheless, element B is not satisfied, because the time is not indicated, i.e., displayed, in "conversational terms," which when broadly

construed is broad enough to read on any numbers or words which can be used in a conversation to convey the time.

Although none of the claims require that the timepiece indicate the approximate time using the terms "about" or "almost," we will address the examiner's argument that "what the time is called [']about 1 o'clock' almost 1 etc. [sic] cannot be used to define over the art" (Answer at 4). The examiner has cited no authority for failing to give weight to such language in a claim, and we are aware of none.

F. The merits of the § 103 rejection

The claims rejected under § 103 include independent claims 10 and 19, which recite timepieces for "reciting the approximate time in words." These claims and dependent claims 3, 8, 9, and 11-18⁴ are collectively rejected for obviousness over Beguin in view of (1) allegedly known clocks which give an audio indication of the time and (2) allegedly known clocks having a combination of digital and analog displays:

The examiner takes official notice that analog clocks with a digital display [display] both accurate time (digital) and approximate time (analog). It would have

⁴ Claims 3, 8, and 9 depend on claim 1. Claims 11-18 depend on claim 10.

been obvious to one of ordinary skill in the art at the time the invention was made to adapt Beguin to include audio presentation of time data as this is well known in the art and to include a digital display of "accurate" time. To present the time digitally is known in the art and to present this digital time in words rather than numbers would clearly be obvious. It should be note[d] that what the time is called [']about 1 o'clock' almost 1 etc. [sic] cannot be used to define over the art. To allow for a selection of which is desired is clearly obvious. In the instant case, the analog shows the approximate [time] and the digital shows the exact [time]. To change to all digital and display the approximate [time] would be obvious. [Answer at 4.]

This reasoning is unpersuasive for a number of reasons.

Modifying Beguin's watch by adding a visible digital display and/or an audible time indication yields a watch whose face still includes hand 7 and indicators 21 and 22 and thus fails to satisfy elements A of claims 10 and 19, which like element A of claim 1 require a "timepiece face without a minute indicator."

Also, because a digital display presumably would require a stem for setting the time, using a digital display to replace or supplement Beguin's hand 7 and indicators 21 and 22 would destroy one of the essential features of Beguin's watch, which

is to achieving a waterproof construction by avoiding the need for a stem for winding the watch or setting the time. See In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984) (reversing rejection because "if the French apparatus were turned upside down, it would be rendered inoperable for its intended purpose"). Because elements A of claims 10 and 19 are not satisfied, the § 103 rejection is reversed as those claims and claims 11-18, which depend on claim 10. For the same reasons, element A of claim 1, which is identical to elements A of claims 10 and 19, is not satisfied, with the result that the § 103 rejection is also reversed as to claims 3, 8, and 9, which depend on claim 1.

We note in passing that element B of claim 10 ("means for indicating the approximate time in words") would be satisfied by Beguin as modified to provide an audible indication of the time in words. Assuming appellant is correct to argue (Brief at 8) that known audible clocks provide indications which are exact to the minute, this argument overlooks the fact that claim 10 does not require that the time be approximate as to minutes. As a result, element B reads on Beguin as modified to include the admittedly known audible time-indicating means.

Element B of claim 19 ("means for visually indicating the approximate time in words") also would read on Beguin thus modified, because the digital display would use numbers, which are used in conversation to state the time.

Although, as already noted, none of the appealed claims call for the timepiece to use "about" or a similar term to give a time indication that is only approximate to the minute, we will address the examiner's contention that it would have been obvious to use the audible or digital display to indicate the time in such terms. This argument is unconvincing because it is not supported by any evidence or analysis demonstrating that one skilled in the art would have been motivated to produce a timepiece which, for at least some times, uses "about" or a similar term to indicate the time only approximately as to the minute. See Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996):

If the invention is different from what is disclosed in one reference, but the differences are such that combination with another reference would lead to what is claimed, the obviousness question then requires inquiry into whether there is reason, suggestion, or motivation to make that combination.

Such a suggestion may come expressly from the references themselves. See, e.g., In re Sernaker, 702 F.2d 989, 994, 217 USPQ 1, 5 (Fed. Cir. 1983). It may come from knowledge of those skilled in the art that certain references, or disclosures in the references, are known to be of special interest or importance in the particular field. Cf. Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 297 n.24, 227 USPQ 657, 667 n.24 (Fed. Cir. 1985) (stating that the knowledge of one skilled in the art may provide the "teaching, suggestion, or inference" to combine references), cert. denied, 475 U.S. 1017 (1986). It may also come from the nature of a problem to be solved, leading inventors to look to references relating to possible solutions to that problem. See, e.g., Application of Rinehart, 531 F.2d 1048, 1054, 189 USPQ 143, 149 (CCPA 1976) (considering the problem to be solved in a determination of obviousness).

G. Appellant's options regarding the new ground of rejection

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)).

37 CFR

§ 1.196(b) provides, "[a] new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 CFR § 1.197(c) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record

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

REVERSED; 37 CFR § 1.196(b)

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