

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte HIDEKI HAYAKAWA

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Appeal No. 1999-0469  
Application 08/734,175

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ON BRIEF

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Before JERRY SMITH, BARRETT and RUGGIERO, 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 1-10, which constitute all the claims in the application. An amendment after final rejection was filed on December 5, 1997, but was denied entry by the examiner.

The disclosed invention pertains to a pager for receiving and displaying messages. An important feature of

the invention is that the display is a dot matrix display, and the message is scrolled by shifting the display by a predetermined number of dots rather than character by character.

Representative claim 1 is reproduced as follows:

1. Pager for receiving a transmitted pager signal, including identification code data and message data, and for displaying said received message data, comprising:

a receiving portion for receiving said transmitted pager signal;

a demodulator for demodulating said received pager signal;

a detector for detecting identification code data and detecting and receiving said message data when said identification code data agrees with an identification code assigned to said pager;

an alert portion for alerting a user of said pager when said detected identification code data agrees with an identification code assigned to said pager;

a dot matrix display, having dot matrix of  $a \times b$ , for displaying said message data, said  $a$  and  $b$  being natural numbers;

a detection portion for detecting a total length of said message data to be displayed on said dot matrix display and whether or not said total length is larger than said  $a$ ; and

a display control portion for displaying a portion of said message data on said dot matrix display, said display control portion scrolling a predetermined number of dots of

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said to be displayed message data provided to said dot matrix display at the same time every successive predetermined interval in the direction defined by said a when said total length is larger than said a so that said message data appears to be shifted by a given shift amount on said dot matrix display said every successive predetermined interval.

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The examiner relies on the following references:

Sebestyen	3,976,995	Aug. 24, 1976
Iwasaki	4,358,761	Nov. 09, 1982
Tsunoda	4,646,081	Feb. 24, 1987
Katsura et al. (Katsura)	4,947,342	Aug. 07, 1990
DeLuca et al. (DeLuca)	4,952,927	Aug. 28, 1990
Grosjean et al. (Grosjean)	5,146,612	Sep. 08, 1992

The admitted prior art.

The following rejections are on appeal before us:

1. Claims 1-10 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification so as to reasonably convey to the artisan that appellant had possession of the claimed invention.

2. Claims 1 and 7-10 stand rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of the admitted prior art in view of Iwasaki.

3. Claims 1 and 7-10 stand rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of DeLuca, Sebestyen or Tsunoda in view of Iwasaki and the admitted prior art.

4. Claims 2, 3 and 5 stand rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of DeLuca,

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Sebestyen or Tsunoda in view of Iwasaki and the admitted prior art and further in view of Katsura.

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5. Claims 4 and 6 stand rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of DeLuca, Sebestyen or Tsunoda in view of Iwasaki, the admitted prior art, Katsura and Grosjean.

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 rejections advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the obviousness rejections. 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 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 specification as filed provides a written description of the invention which is now claimed. We are also of the view that the evidence relied upon and the level of skill in the particular art would have suggested to one of

ordinary skill in the art the obviousness of the invention as set forth in claims 1 and 7-10. We reach the opposite conclusion with respect to claims 2-6. Accordingly, we affirm-in-part.

We consider first the rejection of claims 1-10 under the first paragraph of 35 U.S.C. § 112. The examiner's rejection is based on the written description requirement of section 112. Specifically, the examiner points to the recitation in the claims of the display control portion scrolling a predetermined number of dots of said to be displayed message data provided to said dot matrix display at the same time every successive predetermined interval. The examiner argues that there is no support in the specification for this "at the same time" recitation [answer, page 4].

Appellant indicates how the display control portion of independent claims 1 and 9 should be interpreted, and appellant argues that there is adequate support in the specification for this interpretation [brief, pages 11-14]. The examiner maintains his position that the specification does not support the language of the claimed invention.

The language of the display control portion in claims

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1 and 9 is ambiguous at best. The phrase "at the same time" could be construed to modify the scrolling step or could be construed to modify the "provided to the dot matrix display" recitation. For purposes of the rejection before us, we are of the view that the claim construction does not matter. The specification as filed supports the interpretation that a predetermined number of dots are scrolled at the same time as evidenced by Figures 5A-5E. The specification as filed also supports the interpretation that a portion of data is provided to the dot matrix display at the same time for reasons argued by appellant.

Since we find that the original specification provides evidence to support the fact that appellant was in possession of the claimed invention at the time this application was filed, we do not sustain the examiner's rejection of the claims under 35 U.S.C. § 112.

We now consider the various rejections of the claims under 35 U.S.C. § 103. 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.

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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 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

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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 Piasecki, 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 appellants have been considered in this decision.

Arguments which appellants could have made but chose not to make in the brief have not been considered [see 37 CFR § 1.192(a)].

We consider first the rejection of claims 1 and 7-10 based on the admitted prior art and Iwasaki. The examiner finds that the admitted prior art teaches scrolling a pager display on a character by character basis but not on a dot by dot basis as claimed. The examiner cites Iwasaki as teaching the scrolling of a dot matrix display on a column by column basis. The examiner finds that it would have been obvious to the artisan to modify the admitted prior art to scroll on a column by column basis rather than on a character by character basis in order to make the scrolling display easier to read [answer, page 5].

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Appellant argues that Iwasaki transfers data to the display one row at a time whereas the claimed invention displays all the dots of a displayed area at the same time. Appellant argues that the way in which a received message is displayed in Iwasaki is completely different from the way a message is displayed in their invention [brief, pages 15-17]. Appellant also argues that there is no motivation for combining Iwasaki's column by column display with the character by character display of the admitted prior art.

The examiner responds that Iwasaki teaches that a row of bits is provided to the display at the same time, but Iwasaki also suggests that a column of bits could be provided to the display at the same time. The examiner also notes that the motivation to modify the admitted prior art comes directly from Iwasaki which teaches that column by column scrolling is easier to read than character by character scrolling [answer, pages 12-13].

We agree with the position argued by the examiner. As noted above, the language of independent claims 1 and 9 is ambiguous. If the claims are construed to require only that scrolling of a predetermined number of dots occurs at the same

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time, then Iwasaki clearly teaches that a predetermined number of dots (1) are scrolled at the same time [see Figures 7A-7E]. If the claims are construed to require that a plurality of display message data be provided to the display at the same time, then Iwasaki teaches that a full row of data or a full column of data is provided to the display at the same time. Thus, in our view, either of these claim interpretations is taught by Iwasaki.

We also agree with the examiner that the motivation to modify the admitted prior art comes directly from Iwasaki. Iwasaki discloses character by character scrolling in the prior art and points out that such scrolling is difficult to read [column 1, lines 23-31]. Iwasaki discloses that column by column scrolling is easier to read [id., lines 41-43]. Thus, the artisan would have been motivated to modify the character by character scrolling of the admitted prior art to column by column scrolling to make the displayed message easier to read as taught by Iwasaki.

In summary, we find that the examiner has presented a prima facie case of the obviousness of claims 1 and 7-10 based on the admitted prior art and Iwasaki. We have considered

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each of appellant's arguments, but we find none of these arguments to be persuasive of error in the rejection.

Therefore, we sustain this rejection of claims 1 and 7-10.

We now consider the rejection of claims 1 and 7-10 based on DeLuca, Sebestyen or Tsunoda in view of Iwasaki and the admitted prior art. Each of DeLuca, Sebestyen and Tsunoda are cited as teaching the scrolling of a display although none of these references scroll the display on a predetermined number of dots basis as claimed. The examiner cites Iwasaki as teaching scrolling on a dot by dot basis as discussed above. The examiner finds that it would have been obvious to the artisan to modify any of DeLuca, Sebestyen or Tsunoda to scroll on a dot by dot basis to make the display easier to read as taught by Iwasaki [answer, pages 7-9].

Appellant argues that DeLuca uses a liquid crystal display having elements rather than dots. Thus, appellant argues that there can be no scrolling by dots in DeLuca. Appellant also argues that the dot matrix displays of Sebestyen are not shifted as claimed, and appellant argues that there would be no motivation to combine the teachings of Sebestyen and Iwasaki. Appellant notes that Tsunoda uses a

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liquid crystal display and suffers the same deficiencies as DeLuca [brief, pages 19-21].

The examiner has not rebutted or even responded to any of appellant's arguments regarding the deficiencies of DeLuca, Sebestyen or Tsunoda. We agree with appellant that there appears to be questionable motivation for combining the teachings of Iwasaki and the admitted prior art with the displays of DeLuca, Sebestyen or Tsunoda. Since appellant has presented reasonable arguments against the rejection of claims 1 and 7-10 based on the teachings of DeLuca, Sebestyen or Tsunoda which have gone unrebutted by the examiner, we will not sustain this rejection of claims 1 and 7-10 as formulated by the examiner.

We now consider the rejection of claims 2-6 based on DeLuca, Sebestyen or Tsunoda in view of Iwasaki and the admitted prior art and further in view of Katsura or Grosjean. Each of these claims depends from claim 1. As discussed above, we have not sustained the rejection of claim 1 based on DeLuca, Sebestyen or Tsunoda in view of Iwasaki and the admitted prior art. Therefore, this combination of references is not sufficient to support the rejection of any claims which

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depend from claim 1. Since neither Katsura nor Grosjean overcomes the deficiencies of the basic combination of references discussed above, we also do not sustain the examiner's rejection of claims 2-6. We also note for the record that we agree with appellant that there is no valid basis for combining the teachings of Katsura which relate to cathode ray tubes with the teachings of DeLuca, Sebestyen or Tsunoda.

In summary, the rejection of claims 1-10 under the first paragraph of 35 U.S.C. § 112 is not sustained. The rejection of claims 1 and 7-10 under 35 U.S.C. § 103 based on the teachings of the admitted prior art and Iwasaki is sustained. The rejection of claims 1-10 under 35 U.S.C. § 103 based on the teachings of DeLuca, Sebestyen or Tsunoda is not sustained. Therefore, the decision of the examiner rejecting claims 1-10 is affirmed-in-part.

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

AFFIRMED-IN-PART

	)	
JERRY SMITH	)	
Administrative Patent Judge	)	
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	)	BOARD OF PATENT
LEE E. BARRETT	)	)
Administrative Patent Judge	)	APPEALS AND
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