

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte YASUHIRO KOMATSU, SHUNJI MURAOKA
SHUJI OSAWA and HIDEKI NISHIYAMA

Appeal No. 1999-1319
Application No. 08/495,390

HEARD: May 10, 2001

Before KRASS, BARRETT and BLANKENSHIP, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-4, all of the pending claims.

The invention is directed to input devices; more particularly to sensitive coordinate input devices. A sensitive member, made of a dielectric, extends across

electrodes spaced relative to each other. The surface of the sensitive member is touched by a finger and movement of the finger over the surface of the dielectric sensitive member causes the capacitance of the device to change.

Representative independent claim 1 is reproduced as follows:

1. A sensitive coordinate input device comprising:
 - at least two electrodes spaced relative to each other at an interval;
 - and
 - a sensitive member made of a dielectric, said sensitive member extending across said at least two electrodes, with a surface of said sensitive member adapted to be touched with a finger.

The examiner relies on the following reference:

Tanahashi et al. (Tanahashi)	5,589,857	Dec. 31, 1996 (filed Nov. 29, 1994)
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Claims 1-4 stand rejected under 35 U.S.C. § 102(e) as anticipated by Tanahashi.

Two other rejections under 35 U. S. C. § 102 have been withdrawn by the examiner and are not before us.

Reference is made to the briefs and answers for the respective positions of appellants and the examiner.

OPINION

With regard to the independent claims, the examiner points out that Tanahashi discloses a coordinate input device with at least two electrodes (claim 1) and as much

as four electrodes (claim 3). See electrodes 1a, 1b, 2a and 2b of Tanahashi. The electrodes are spaced relative to each other, as claimed. Tanahashi further discloses that the input surface is adapted to be pushed, or pressed, which action causes resistive surfaces of first and second input detecting members to contact each other. The examiner contends that the pushing, or pressing, is performed by a pen, finger, or the like, and appellants do not dispute this. The input surface 13 of Tanahashi, i.e., the “sensitive” member, extends across the electrodes as required by independent claims 1 and 3.

The only dispute between appellants and the examiner concerns whether or not the input surface 13 of Tanahashi comprises a “dielectric,” as claimed.

The examiner cites a dictionary definition of “dielectric” as “a nonconductor of electricity.” Appellants’ position, as set forth at page 2 of the reply brief, is that Tanahashi “does not specifically define member 13 as a dielectric and the examiner suggests that member 13 is a nonconductor and therefore a dielectric. But every nonconductor is not necessarily a dielectric.”

There is no dispute between appellants and the examiner that member 13 of Tanahashi is a nonconductor.¹ There is also no dispute with the dictionary definition, offered by the examiner, of “dielectric” as “a nonconductor of electricity.” Accordingly, it

¹We make no representation that Tanahashi’s member 13 is, in fact, a nonconductor; only that the examiner alleges that this is so and that appellants do not dispute it.

appears that the examiner has established a prima facie case of anticipation.

The burden is now shifted to appellants to overcome that prima facie case by convincing argument that the examiner has not shown that each claimed element is disclosed in a single prior art reference. Yet, appellants do not dispute that member 13 of Tanahashi is a nonconductor nor do they dispute that a dielectric is a nonconductor. They argue only that “every nonconductor is not *necessarily* a dielectric” (emphasis ours). Yet, appellants do not offer their own definition distinguishing “dielectric” from “nonconductor.” At least implicitly, appellants appear to concede that at least some nonconductors are dielectrics but point to nothing which indicates that Tanahashi’s member 13 is not a dielectric even though they do not dispute that member 13 is a nonconductor. Independent claims 1 and 3 recite no properties that would distinguish a “dielectric” from the “nonconducting” member 13 of Tanahashi.

Moreover, we note, with interest, that in the discussion of the prior art, at the top of page 2 of the instant specification, appellants themselves admit that such dielectrics are used in the prior art as the film which is pressed by the finger for converting variations of capacitance into a coordinate signal (also see prior art Figure 4). Accordingly, we do not find persuasive appellants’ argument that the subject matter of instant claims 1 and 3 distinguishes over Tanahashi by the recitation of “a sensitive member made of a dielectric.”

In the summary of the arguments, set forth at page 7 of the principal brief, appellants list various advantages of the present invention over the art of record. These include: 1. Allows operation with as small a force as possible; 2. Does not require its sensitive members to be contacted; 3. Permits for the use of less expensive components and 4. Permits for the use of fewer components. Whether or not any of these cited “advantages” make for a patentably distinct invention, none of these “advantages” are set forth in the instant claims.

For the reasons supra, we will sustain the rejection of claims 1 and 3 under 35 U.S.C. § 102(e).

Although not set forth as a very strenuous argument, appellants do state, at page 7 of the principal brief, that claims 2 and 4 further define the sensitive member as made from ceramic plate material and that “[n]one of the references teach this limitation either.” The examiner’s response to this argument is to state that since input member 13 of Tanahashi “is a nonconductor plate and is made of a dielectric and ceramic, paper, synthetic resin and the like are classified as dielectric, the input member 13, thus, is made of a ceramic plate” (principal answer-page 4).

The examiner’s position regarding claims 2 and 4 is clearly erroneous. If the reference does not disclose or suggest the particular material claimed, viz., ceramic,

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the claim cannot be said to be anticipated under 35 U.S.C. § 102. Therefore, we will not sustain the rejection of claims 2 and 4 under 35 U.S.C. § 102(e).

The examiner's decision rejecting claims 1-4 under 35 U.S.C. § 102(e) is affirmed as to claims 1 and 3 but reversed as to claims 2 and 4.

The examiner's decision is affirmed-in-part.

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

ERROL A. KRASS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
LEE E. BARRETT)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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HOWARD B. BLANKENSHIP)	
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