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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/974,555	10/26/2004	Edward K.Y. Jung	0404-003-009B-000000	2879
71484	7590	01/30/2013	EXAMINER	
IV - SUITER SWANTZ PC L.L.O 14301 FNB PARKWAY , SUITE 220 OMAHA, NE 68154			ROSWELL, MICHAEL	
			ART UNIT	PAPER NUMBER
			2141	
			NOTIFICATION DATE	DELIVERY MODE
			01/30/2013	ELECTRONIC

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* EDWARD K.Y. JUNG, ROYCE A. LEVIEN,  
MARK A. MALAMUD, and JOHN D. RINALDO JR.

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Appeal 2010-005687  
Application 10/974,555  
Technology Center 2100

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Before ST. JOHN COURTENAY III, ELENI MANTIS MERCADER, and  
ANDREW J. DILLON, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

## STATEMENT OF THE CASE

The Patent Examiner finally rejected claims 1-7, 9-41, and 43-52. Appellants appeal therefrom under 35 U.S.C. § 134(a). We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

## INVENTION

This invention relates to user assistance for a device. (Spec. 1). Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A method comprising:

- (a) receiving a selection corresponding to a hardware aspect of an electronic device through a first physical user-interface associated with the hardware aspect of the electronic device;
- (b) receiving a selection corresponding to an assistance request related to the hardware aspect of the electronic device through a second physical user-interface of the electronic device; and
- (c) providing an assistance correlating to the assistance request related to the hardware aspect of the electronic device through a third physical user-interface of the electronic device.

## REJECTIONS

- R1. Claims 1-7, 9, 12-15, 19-21, 23-41, 43, and 45-52 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Palmer (U.S. Patent No. 5,825,355) and Makino (U.S. Patent No. 5,388,251).
- R2. Claims 10, 11, 22 and 44 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Palmer, Makino, and Makinen (U.S. Patent No. 6,920,612 B2, filed Nov. 29, 2001).

- R3. Claims 16-18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Palmer, Makino, and McKiel Jr. (U.S. Patent No. 5,287,102) . (McKiel )

### ANALYSIS

We disagree with Appellants' contentions regarding the Examiner's obviousness rejections of the claims. We adopt as our own: (1) the findings and reasons set forth by the Examiner in the action from which this appeal is taken, and (2), the reasons set forth by the Examiner in the Answer in response to arguments made in Appellants' Appeal Brief. (Ans. 10-20). We highlight and address specific findings and arguments below.

#### R1. REJECTION OF CLAIMS 1-7, 9, 12-15, 19-21, 23-41, 43, AND 45-52

##### A.

**Issue:** Under § 103, did the Examiner err in combining the cited references relied upon in the rejection R1 of claims 1-7, 9, 12-15, 19-21, 23-41, 43, and 45-52?

Appellants contend, *inter alia*, that the "Examiner[s]" assertions regarding a teaching to modify/combine to meet the recitations of independent claim 1 are based on 'mere conclusory statements without evidentiary support.'" (App. Br. 42 (lower case)).

Appellants' contentions are not persuasive. We conclude that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the help interface of Palmer to include the hardware help of Makino. (Ans. 4). In particular, we agree with the Examiner that "[o]ne would have been motivated to make such a combination for the

advantage of simply and quickly displaying a help message for any function of an electronic device. [See] Makino, col. 2, lines 1-6." (Ans. 4). Thus, we find the Examiner's articulated reasoning possesses some rational underpinning to support the legal conclusion of obviousness.<sup>1</sup>

Appellants do not offer any substantive arguments and supporting evidence rebutting the Examiner's articulate reasoning. (App. Br. 42-43; 46-48). Instead, Appellants merely reproduce the record, recite the claim language, and make conclusory statements. (*Id.*). Moreover, we find the combination of Palmer's help interface with the hardware help aspects of Makino is a combination of known elements with each performing their same known function that yields no more than predictable results.<sup>2</sup>

For these reasons, we are not persuaded of Examiner error.

B.

**Issue:** Under § 103, did the Examiner err in finding that the cited references, either alone or in combination, would have taught or suggested "providing an assistance correlating to the assistance request related to the

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<sup>1</sup> The Examiner's articulated reasoning in the rejection must possess a rational underpinning to support the legal conclusion of obviousness. *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). The Supreme Court stated that "rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) (quoting *Kahn*, 441 F.3d at 988).

<sup>2</sup> "[W]hen a patent 'simply arranges old elements with each performing the same function it had been known to perform' and yields no more than one would expect from such an arrangement, the combination is obvious." *KSR*, 550 U.S. at 417 (quoting *Sakraida v. AG Pro, Inc.*, 425 U.S. 273, 282 (1976)).

*hardware aspect* of the electronic device . . . ," (emphasis added) within the meaning of claim 1 and the commensurate language of claims 35, 47, 48, 49, and 50?

Appellants contend that “[n]owhere in the examiner-identified portions of Makino is there a recitation of this clause. Rather, the examiner-identified portions of Makino recite “[w]hen the help key 13 is depressed in this state (Step 103) . . . .” See *Makino*, Col. 5, lines 38-39.” (App. Br. 39).

Appellants' contention is not persuasive. The Examiner does not rely only on the Appellants' quoted sentence of Makino. (Ans. 12). The Examiner relies on the *combination* Palmer and Makino to teach or suggest the limitation at issue. (Ans. 11-12; 3-4). Specifically, the Examiner relies on Makino to teach or suggest the "hardware aspect" limitation. (Makino col. 5, ll. 48-53; Ans. 4, 12). We agree with the Examiner that Makino's "function keys" would have taught or suggested the claimed "hardware aspect" because Makino's function keys are hardware. (*Id.*). Moreover, Makino's teaching of displaying state explanation messages (assistance) related to the function key (hardware aspect) would have taught or suggested the limitation at issue. (Makino col. 5, ll. 48-50; Ans. 4, 12). For these reasons, we are not persuaded of Examiner error.

C.

**Issue:** Under § 103, did the Examiner err in finding that the cited references, either alone or in combination, would have taught or suggested the limitations of claim 1 and the commensurate language of claims 35, 47, 48, 49, and 50?

Appellants content, *inter alia*, that: (1) “the Examiner-identified portions of Palmer do not recite the text of Appellant's Independent Claim 1” (App. Br. 34) and (2) that “the Examiner-identified portions of Makino do not recite the text of Appellant's Independent Claim 1.” (App. Br. 38). However, an *ipsissimis verbis* test is not required. *Cf. In re Bond*, 910 F.2d 831, 832-33 (Fed. Cir. 1990) (citing *Akzo N.V. v. U.S. Int'l Trade Comm'n*, 808 F.2d 1471, 1479 n. 11 (Fed. Cir. 1986)). “An anticipatory reference . . . need not duplicate word for word what is in the claims.” *Standard Havens Prods. v. Gencor Indus., Inc.*, 953 F.2d 1360, 1369 (Fed. Cir. 1991).

Moreover, Appellants merely recite the language of the claim, reproduce the Examiner's rejection and selected portions of references, and assert that the limitations are allowable over the individual references and combination of references. (App. Br. 30-40). We find Appellants have failed to present substantive arguments that rebut the specific underlying factual findings made by the Examiner in support of the ultimate legal conclusion of obviousness. (*See* Ans. 3-4, 10-12, *et seq.*). A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim. *See* 37 C.F.R. § 41.37(c)(1)(vii). We decline to examine the claims *sua sponte*, looking for distinctions over the prior art. *Cf. In re Baxter Travenol Labs.*, 952 F.2d 388, 391 (Fed. Cir. 1991) (“It is not the function of this court to examine the claims in greater detail than argued by an appellant, looking for [patentable] distinctions over the prior art.”). *See also Ex parte Belinne*, No. 2009-004693, 2009 WL 2477843 at \*3-4 (BPAI Aug. 10, 2009) (informative).

Moreover, Attorney arguments and conclusory statements that are unsupported by factual evidence are entitled to little probative value. *In re*

*Geisler*, 116 F.3d 1465, 1470 (Fed. Cir. 1997); *see also In re De Blauwe*, 736 F.2d 699, 705 (Fed. Cir. 1984). “Argument in the brief does not take the place of evidence in the record.” *In re Schulze*, 346 F.2d 600, 602 (CCPA 1965) (citing *In re Cole*, 326 F.2d 769, 773 (CCPA 1964)). For these reasons, we are not persuaded of Examiner error.

Accordingly, we sustain the Examiner's rejection of claim 1, and of claims 35, 47, 48, 49, and 50, which recite commensurate limitations.

D.

**Issue:** Under § 103, did the Examiner err in finding that the cited references, either alone or in combination, would have taught or suggested the limitations of claims 2-7, 9, 12-15, 19-21, 23-34, 36-41, 43, 45, 46, 51, and 52?

Appellants, *inter alia*, recite case law, recite the language of the claims, reproduce the Examiner's rejection and pertinent portions of references, and then assert that the limitations are allowable over the individual references and combination of references. (App. Br. 23-157). On this record, we find Appellants have failed to present *substantive* arguments and supporting *evidence* persuasive of Examiner error regarding rejection R1. (See App. Br. 1-158). *See In re Lovin*, 652 F.3d 1349, 1357 (Fed. Cir. 2011) (“we hold that the Board reasonably interpreted Rule 41.37 to require more substantive arguments in an appeal brief than a mere recitation of the claim elements and a naked assertion that the corresponding elements were not found in the prior art.”); *see also Hyatt*, 551 F.3d at 1314 (Arguments not made are considered waived).

Although Appellants present nominal separate arguments responding to the Examiner's rejection R1 (App. Br. 23-157), we affirm the Examiner's rejection R1 for the reasons set forth by the Examiner in the Answer and for the reasons discussed above regarding commensurate limitations and issues. Appellants' Reply Brief does not rebut the Examiner's underlying factual findings and conclusions of law, because the Reply Brief fails to present persuasive *substantive* arguments and supporting evidence. (See Reply Br. 3-8; See *In re Geisler*, 116 F.3d at 1470). For these reasons, we are not persuaded of Examiner error.

Accordingly, we sustain the Examiner's § 103 rejection R1 of claims 2-7, 9, 12-15, 19-21, 23-34, 36-41, 43, 45, 46, 51, and 52.

#### R2 – REJECTION OF CLAIMS 10-11, 22, AND 44

**Issue:** Under § 103, did the Examiner err in combining the cited references relied upon in the rejection R2 of claims 10-11, 22, and 44?

Appellants contend, *inter alia*, that claims 10-11, 22, and 44 are patentable by virtue of their dependency from their parent claims. (App. Br. 49, 84). However, we find no defects for the reasons discussed above.

Appellants contend that "Makinen does not show the text of at least Clause [g] of Dependent Claim 10." (App. Br. 58). However, an *ipsissimis verbis* test is not required. *Cf. In re Bond*, 910 F.2d at 832-33. For these reasons, we are not persuaded of Examiner error.

Therefore, we sustain the Examiner's rejection R2 of claims 10-11, 22, and 44.

R3. REJECTION OF CLAIMS 16-18

**Issue:** Under § 103, did the Examiner err in combining the cited references relied upon in the rejection R3 of claims 16-18?

Appellants contend that claims 16-18 are patentable by virtue of their dependency from parent claim 1. (App. Br. 49). However, we find no defects for the reasons discussed above.

Appellants contend that McKiel does not show the text of at least clause [j] of dependent claims 17 and 18. (App. Br. 63, 65). However, an *ipsissimis verbis* test is not required. *Cf. In re Bond*, 910 F.2d at 832-33. Appellants do not rebut the Examiner's findings and conclusions of law (Ans. 9) with persuasive substantive arguments. (App. Br. 61-65). For these reasons, we are not persuaded of Examiner error.

Therefore, we sustain the Examiner's rejection R3 of claims 16-18.

DECISION

We affirm the Examiner's rejections of claims 1-7, 9-41, and 43-52 under § 103.

No time for taking any action connected with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

Vsh