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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* JIANCHAO WU and JENNY HUANG-YU LAI

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Appeal 2010-006055  
Application 11/614,960  
Technology Center 2600

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Before JOSEPH L. DIXON, ST. JOHN COURTENAY III, and  
CARLA M. KRIVAK, *Administrative Patent Judges*.

DIXON, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 from a rejection of claims 1-19, 22-24, and 27-30. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

The claims are directed to computer-driven systems for users to enter text into a computer using a reduced-set keyboard. Claim 1, reproduced below, is representative of the claimed subject matter:

1. A computer implemented text entry method comprising operations of:

receiving entry of user input via multi-key keyboard, said user input including key selections specifying intended text;

storing said user input in a buffer;

operating in a first mode, including interpreting the user input stored in the buffer according to a first vocabulary yielding any entries of the first vocabulary possibly specified by the user input, and displaying said interpretations;

receiving a first prescribed stimuli including predetermined application context or user instructions to switch to a second mode; and

responsive to receiving said first prescribed stimuli, operating in the second mode including re-interpreting the user input stored in the buffer according to a second vocabulary yielding entries of the second vocabulary possibly specified by the user input, and displaying said interpretations excluding the interpretations from the first mode.

## REFERENCES

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Kunihiro	US Patent 5,915,228	Jun. 22, 1999
Krasnov	US Pat. App. Pub. No.: 2003/0101044 A1	May 29, 2003
Meurs	US Pat. App. Pub. No.: 2005/0027534 A1	Feb. 03, 2005
James	US Pat. App. Pub. No.: 2005/0198023 A1	Sep. 08, 2005

## REJECTIONS

Claims 27-30 stand rejected under 35 U.S.C. § 112, first paragraph for failing to comply with the enablement requirement.

Claims 1-15, 17, 19, 23, 24, and 27-30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over James in view of Kunihiro.

Claim 16 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over James, in view of Kunihiro and Krasnov.

Claims 18 and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over James, in view of Kunihiro and Meurs.

## ANALYSIS

### 35 U.S.C. §112, first paragraph

The Examiner maintains that:

because the specification, while being enabling for the structural elements known and described in the specification, does not reasonably provide enablement for structural and functional elements that have yet to be identified/known (*which are "encompassed by the present claims", Specification, Paragraph 1109*). The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make/use the invention commensurate in scope with these claims. As the specification does not and cannot describe functional elements that have yet to be

invented, the full scope of the claimed elements of claims 27-30 is not enabled because one of ordinary skill in the art, at the time of invention, could not know how to utilize something which does not yet exist.

(Ans. 3-4). Appellants contend that paragraph [1109], as originally filed, is entitled to claim scope expansion under the judicially created doctrine of equivalents. (App. Br. 16-19; Reply Br. 4-6).

Regarding the argued doctrine of equivalents, we note that prosecution history estoppel narrows the range of equivalents by preventing recapture of subject matter surrendered during prosecution. *Southwall Techs., Inc. v. Cardinal IG Co.*, 54 F.3d 1570, 1578 (Fed. Cir. 1995). Prosecution history estoppel comes into play only after no literal infringement is found by a federal district court. *Southwall*, 54 F.3d at 1578. Because the issue of patent infringement falls properly within the subject matter jurisdiction of the federal court system, the doctrine of equivalents is immaterial during prosecution before the USPTO for purposes of this appeal.

Rather, the test for compliance with the enablement requirement in the first paragraph of 35 U.S.C. § 112 is whether the disclosure, as filed, is sufficiently complete to enable one of ordinary skill in the art to make and use the claimed invention without undue experimentation. *In re Wands*, 858 F.2d 731, 737 (Fed. Cir. 1988). “Enablement is not precluded by the necessity for some experimentation .... However, experimentation needed to practice the invention must not be undue experimentation. The key word is ‘undue,’ not ‘experimentation.’” *Id.* at 736-737.

When rejecting a claim under the enablement requirement of section 112, the PTO bears an initial burden of setting forth a reasonable explanation

as to why it believes that the scope of protection provided by that claim is not adequately enabled by the description of the invention provided in the specification of the application; this includes, of course, providing sufficient reasons for doubting any assertions in the specification as to the scope of enablement. If the PTO meets this burden, the burden then shifts to the applicant to provide suitable proofs indicating that the specification is indeed enabling. *In re Wright*, 999 F.2d 1557, 1561-62 (Fed. Cir. 1993) (citing *In re Marzocchi*, 439 F.2d 220, 223-24 (CCPA 1971)).

Here, from our review of the Examiner's stated grounds of rejection, we conclude the Examiner has not proffered a sufficient showing of lack of enablement of the claimed invention, at the time of filing. Therefore, we cannot sustain the enablement rejection of claims 27-30.

Additionally, we note that claims 27 and 28 do not recite "means" as maintained by the Examiner in the grounds of rejection. Furthermore, the Examiner has made no rejection or findings regarding the scope of the disclosure with respect to the programmed processor and corresponding algorithm. Therefore, we make no findings regarding the correspondence or lack thereof of the "means" to the disclosed structure, acts, or materials.

### 35 U.S.C. §103

The main contention raised by Appellants in the Appeal Brief and Reply Brief is that independent claim 1 recites:

responsive to receiving said first prescribed stimuli, operating in the second mode including re-interpreting the user input stored in the buffer according to a second vocabulary yielding entries of the second vocabulary possibly specified by the user input, and displaying said interpretations excluding the interpretations from the first mode.

(Reply Br. 6). Appellants maintain that "[h]owever, a careful inspection of Figure 7 [of the Kunihiro reference] simply reveals exactly that, and nothing more - - a solitary example consisting of single character and capitalization." Appellants' further contend the Examiner's discussion of the Kunihiro reference with regards to "re-analysis" and "re-evaluating" does not originate anywhere in the Kunihiro reference and the Examiner relies on speculation. Additionally, Appellants contend that the Kunihiro reference fails to qualify as an enabling reference. (App. Br. 23-24; Reply Br. 6-7). Appellants further contend that:

Admittedly, Kunihiro's specification is assumed to be "enabling" as to its own claims, under 35 USC 282. However, this is irrelevant to Appellant's arguments. The relevant inquiry is not whether the prior art patent was invalid for lack of enablement, as] but whether the prior art patent enabled persons of ordinary skill in the art to produce Applicant's claimed invention.

(Reply Br. 9; *see also* App. Br. 24-25).

Responsive to Appellants' contention that "[t]he relevant inquiry is not whether the prior art patent was invalid for lack of enablement, but whether the prior art patent enabled persons of ordinary skill in the art to produce Applicant's claimed invention" (*id.*), our reviewing court guides that "a non-enabling reference may qualify as prior art for the purpose of determining obviousness under 35 U.S.C. 103." *Symbol Techs. Inc. v. Opticon Inc.*, 935 F.2d 1569, 1578 (Fed. Cir. 1991).

Moreover, Appellants admit that the Kunihiro reference is enabled as to its own claims, we note that the Kunihiro reference in dependent claim 9 recites "[t]he terminal apparatus according to claim 7, wherein said changing

mode operation corresponds to changing languages of said information displayed on said display means." We therefore find that dependent claim 9 corresponds to the solitary example that the Examiner relies upon to teach and fairly suggest the process of "re- interpreting."

Since Appellants admit that this changing mode of operation is enabled for the Kunihiro reference, we find Appellants' detailed arguments in the Appeal Brief and Reply Brief to be unavailing and unpersuasive of error. We find that if the solitary example is admitted as enabled, those skilled in the art would have readily appreciated how to implement the change of mode in combination with the teachings of the James reference.

Assuming *arguendo* that Appellants did not admit that the Kunihiro reference is enabling as to switching modes to a second language, we still reach the same conclusion. We find that since James clearly evidences an evaluation process for two languages in the bilingual mode, then those skilled in the art would have appreciated that the same evaluation process is performed twice and the results are displayed to the user at the same time. We find that it would have been readily apparent to those skilled in the art that a sequential process would similarly have been obvious to skilled artisans to save on simultaneous processing. We find that those skilled in the art would appreciate that two separate single language interpretations may be done separately as suggested by the Kunihiro reference in response to a mode change stimuli. Therefore, Appellants' argument is not persuasive of error in the Examiner's reasoned conclusion of obviousness.

With respect to dependent claims 2-19, 22-24, and 27-30 Appellants' rely upon the arguments advanced with respect to independent claim 1. Since we found Appellants' argument to be unpersuasive of error in the

Examiner's conclusion of obviousness, we similarly find Appellants' argument unavailing. *See* 37 C.F.R. § 41.37(c)(1)(iv).

With respect to dependent claim 4, Appellants' contend that the Examiner's rejection "does not make any sense" and "[h]ow can an alphabet be the same, but also be different?" (App. Br. 27). We disagree with Appellants' contentions and find that the James reference clearly evidences that the same keystrokes are interpreted differently for different languages so as to evidence the use of different mapping between the keys and the symbols that form entries in the vocabularies. Therefore, Appellants' argument does not show error in the Examiner's conclusion of obviousness.

With respect to dependent claims 6 and 7, Appellants' argue that the James reference does not teach different modalities. The Examiner further details the rejection in the responsive arguments (App. Br. 28-31), but Appellants' do not address the Examiner's responses in the Reply Brief. Therefore, we find Appellants' arguments unpersuasive of error in the Examiner's conclusion of obviousness. Appellants do not set forth separate arguments for patentability of claims 8 and 10 and they fall with claims 6 and 7. *See* 37 C.F.R. § 41.37(c)(1)(iv).

With respect to claims 11, 12, 14, and 15, Appellants rely on the arguments advanced with respect to independent claim 1, which we found unpersuasive. Appellants present arguments regarding the James reference (App. Br. 32-33), but the Examiner relied upon the Kunihiro reference for the mode switching and actuation thereof. Therefore, Appellants' argument does not show error in the Examiner's conclusion of obviousness.

With respect to claims 16, 18, and 22, Appellants' rely on the arguments advanced with respect to independent claim 1, which we found unpersuasive. (App. Br. 33-34).

With respect to dependent claim 18, Appellants contend that the James reference does mention ideographic sequences but the disclosure is limited. Appellants also contend there is nothing in James that fairly suggests or teaches the use of alphabetic language and logographic languages concurrently. (Reply Br. 10-11). We agree with Appellants, but the express language of dependent claim 18 as it depends from independent claim 1 does not require two languages concurrently. The James reference at a minimum suggests that a logographic language may be used in place of the alphabetic language for the single language embodiment. Additionally, the van Meurs reference is relied upon by the Examiner to show the use of the more (?) than two databases/vocabularies. Appellants present arguments to the James reference and the van Meurs reference (Reply Br. 10-11), but Appellants do not address the teachings and suggestions of the Kunihiro reference in the combination. Therefore, Appellants' argument does not show error in the Examiner's reasoned conclusion of obviousness.

With regards to Appellants' arguments concerning whether the Examiner has resolved the level of ordinary skill (Reply Br. 12), we find the ordinary skilled artisan would be one skilled to appreciate and implement the teachings of the James reference and the Kunihiro reference as the Examiner concludes. (Ans. 36). As guided by our reviewing court, we also consider the cited prior art as representative of the level of ordinary skill in the art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (“[T]he

absence of specific findings on the level of skill in the art does not give rise to reversible error ‘where the prior art itself reflects an appropriate level and a need for testimony is not shown’”) (quoting *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985).

#### CONCLUSIONS OF LAW

The Examiner erred in rejecting claims 27-30 under 35 U.S.C. §112, first paragraph. The Examiner did not err in rejecting claims 1-19, 22-24, and 27-30 under 35 U.S.C. §103.

#### DECISION

For the above reasons, we reverse the Examiner’s rejection of claims 27-30 under § 112, first paragraph, for failing to comply with the enablement requirement. However, we affirm the Examiner’s obviousness rejection of claims 1-19, 22-24, and 27-30.

Because we have affirmed at least one ground of rejection with respect to each claim on appeal, the Examiner’s decision is affirmed. See 37 C.F.R. § 41.50(a)(1).

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

AFFIRMED

Vsh