

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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

Appeal No. 2000-1555
Application No. 08/922,929

ON BRIEF

Before THOMAS, KRASS and SAADAT, Administrative Patent Judges.
SAADAT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the Examiner's final rejection of claims 1, 3-7, 9-25 and 27, which are all of the claims pending in this application.

We reverse and enter a new ground of rejection under 37 CFR § 1.196(b).

BACKGROUND

Appellant's invention is directed to a radio handset which is mountable in a curved configuration to a wearable element and has a flexible portion and a rigid portion (specification, pages 1 & 2). The flexible portion is biased into a straighter configuration but must be forced into the curved configuration when the handset is mounted to the wearable element (specification, page 6). The handset is held in place by releasable couplings that engage both ends of the handset (specification, page 7).

Representative independent claims 1 and 25 are reproduced as follows:

1. A radio handset assembly comprising:
a wearable element; and
a radio handset demountable from the wearable element and comprising a flexible portion which is deformable between a curved configuration and a straighter configuration for extending between the ear and mouth of a user, said radio handset being biased to the straighter configuration.
25. A radio handset comprising a flexible portion which is deformable between a curved configuration and a straighter configuration for extending between the ear and mouth of a user, said radio handset being biased to the straighter configuration.

Appeal No. 2000-1555
Application No. 08/922,929

The Examiner relies on the following references in rejecting the claims:

Olsen	4,847,818	Jul. 11, 1989
Seager	5,274,613	Dec. 28, 1993
Blonder et al. (Blonder)	5,381,387	Jan. 10, 1995

Claims 1, 3, 4, 7, 9, 10, 12-24 and 27 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Blonder.

Claim 25 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Olsen in view of Blonder.

Claims 5 and 6 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Blonder in view of Seager.

Claim 11 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Blonder in view of Olsen.

Rather than reiterate the conflicting viewpoints of the Examiner and Appellant regarding the above-noted rejections, we make reference to the answer (Paper No. 10, mailed December 16, 1999) for the Examiner's reasoning, the appeal brief (Paper No. 9, filed September 13, 1999) and the reply brief (Paper No. 11, filed February 1, 2000) for Appellant's arguments thereagainst.

OPINION

With respect to the 35 U.S.C. § 102 rejection of claim 1, Appellant argues that the term "stiff," as used by Blonder, means that strap 10 and top layer 12 could take any position and retain

Appeal No. 2000-1555
Application No. 08/922,929

the most recent assumed position (brief, page 6). Appellant contests the Examiner's conclusion that including a "spring material" causes layer 12 to be also biased to a particular position (brief, pages 6 & 7).

In response to Appellant's arguments, the Examiner asserts that Blonder's strap stays in an upright position while it has to be bent before being attached around the wrist (answer, page 11). The Examiner also points out that an external force is needed to bend and deform the strap from its upright position in order to attach it around the wrist (id.).

Before addressing the Examiner's rejection based on prior art, as pointed out by our reviewing court, we must first determine the scope of the claim. "[T]he name of the game is the claim." In re Hiniker Co., 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). Claims will be given their broadest reasonable interpretation consistent with the specification, and limitation appearing in the specification are not to be read into the claims. In re Etter, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985).

A review of claim 1 reveals that the claimed radio handset assembly requires a wearable element and a radio handset. The handset is further required to be demountable from the wearable

Appeal No. 2000-1555
Application No. 08/922,929

element and to include a flexible portion and a straighter portion. The flexible portion is further recited to be deformable between a curved configuration (when mounted on the wearable element) and a straighter configuration (when in use). Additionally, the claim requires that the handset be biased to the straighter configuration. We find that Appellant's specification defines the claimed bias as automatically adopting the straighter configuration when the handset is released from its curved position on the wearable element (specification, page 6). Therefore, deforming the handset into its curved configuration requires an external force and means for holding the handset in place while the straighter configuration is automatically assumed when the handset is released.

A rejection for anticipation under section 102 requires that each and every limitation of the claimed invention be disclosed in a single prior art reference. In re Paulsen, 30 F.3d 1475, 1478-79, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994). See also Atlas Powder Co. v. Ireco Inc., 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999).

We observe that Blonder, in figures 1-3, discloses a portable wrist radiotelephone including telephone case 4 which is attached to multilayer strap 10 (col. 2, lines 35-38).

Appeal No. 2000-1555
Application No. 08/922,929

Detachable top layer 12 separates from strap 10 at one end and pivots at its other end which is attached to bottom layer 14 by hinge 18 (col. 2, lines 56-67). We further find that Blonder refers to the function of top layer 12 as being "released and rotated at hinge 18" (col. 3, lines 28-30, 62-65 and col. 4, lines 37-44) which shows that top layer 12 does not require to be straightened after release and adopts a straighter configuration as soon as it is released from its first end 13. In particular, Blonder specifies in col. 4, lines 37-40 that:

The strap 10 is made of materials that are relatively stiff so that when the top layer 12 of the strap 10 is released and rotated, the top layer 12 will remain in an "upright" position. [Emphasis added.]

Therefore, top layer 12 is biased to a straighter configuration compared to the curvature of the strap 10. However, neither top layer 12 nor any part of the handset is demountable from the wearable element or strap 10. In fact, all the elements remain attached to strap 10 forming the wrist radiotelephone device.

Accordingly, we find that the radiotelephone device of Blonder does not include a wearable element and a demountable handset; rather it includes the wrist strap and the handset in one integral structure that is wearable as one unit. Although we disagree with Appellant that Blonder's top layer 12 is not biased

Appeal No. 2000-1555
Application No. 08/922,929

to a straighter configuration, we find that the reference teachings lack the limitation of "a radio handset demountable from the wearable element," as recited in claim 1. As discussed above, the radio handset of Blonder includes telephone case 4, part of strap 10 and top layer 12 which are not demountable and remain attached to each other during operation by a user.

In view of the analysis above, we find that the Examiner has failed to meet the burden of providing a prima facie case of anticipation. Accordingly, the rejection of claims 1, 3, 4, 7, 9, 10,¹ 12-24 and 27 under 35 U.S.C. § 102 over Blonder cannot be sustained.

We note that the Examiner relies on Seager and Olsen in combination with Blonder to reject claims 5, 6 and 11 under 35 U.S.C. § 103(a). Seager teaches a demountable radio handset which is reconfigured to a straighter position by unfolding stiff elongated members at pivotal connection points. Olsen, on the other hand, teaches a radiotelephone in the form of a wrist watch that may be worn around the wrist or used as a radio handset when the strap ends are not connected. Although Olsen describes the strap material as being flexible enough to go around the wrist,

¹ Claim 10 depends upon the canceled claim 2, which should be corrected before allowance.

Appeal No. 2000-1555
Application No. 08/922,929

but stiff enough to hold the microphone and the speaker in proper position (col. 3, line 66 through col. 4, line 2), nothing in the reference indicates that the strap is biased to the straighter configuration. Assuming, arguendo, that it would have been obvious to combine the radiotelephone device of Blonder with the teachings of Olsen or Seager as held by the Examiner, Seager and Olsen do not overcome the deficiencies in the rejection of base claim 1 discussed above. Accordingly, we do not sustain the 35 U.S.C. § 103 rejections of claims 5 and 6 over Blonder and Seager and of claim 11 over Blonder and Olsen.

Turning to the rejection of claim 25, Appellant relies on the arguments made with respect to claim 1 above and adds that, similar to Blonder, Olsen fails to teach or suggest that the strap is biased to a straighter configuration (brief, pages 9 & 10). In response, the Examiner refers to the discussion of the teachings of Blonder with respect to top layer 12, as applied to claim 1 (answer, page 12).

As discussed above, the top layer in Blonder is biased to the straighter configuration to position the speaker in the palm of the user's hand while the remaining part of the handset is worn around the wrist as the user operates the phone. On the other hand, a review of Olsen determines that the strap is both

Appeal No. 2000-1555
Application No. 08/922,929

stiff and flexible enough that may go around the wrist when not in use and hold the speaker and the microphone in their proper position during operation as a telephone. In evaluating the combination of the prior art, we are guided by the court's decision in Para-Ordnance Mfg. Inc. v. SGS Importers Int'l Inc., 73 F.3d 1085, 1088-89, 37 USPQ2d 1237, 1239-40 (Fed. Cir. 1995), that for the determination of obviousness, the court must answer whether one of ordinary skill in the art who sets out to solve the problem and who had before him in his workshop the prior art, would have been reasonably expected to use the solution that is claimed by the Appellants. Based on the court's guidance, we disagree with the Examiner (answer, page 8) that one of ordinary skill in the art would have followed the teachings of Blonder and biased the wristband of Olsen to a straighter configuration "to prevent slippage." In fact, Blonder has nothing to do with preventing slippage. Blonder merely provides speaker openings at the side surfaces of the end portion of top layer 12 such that the user will be able to hear the incoming sounds even if the user's arm drops and the end portion slips down the user's face and blocks the speaker openings on the flat surface of the end portion. Olsen does not face similar problems since the user

holds the wrist watch in its open position instead of wearing the handset with the speaker extended out.

Based on our analysis of the prior art, we remain unpersuaded by the Examiner's arguments that the biased top layer of Blonder can be combined with Olsen. In that regard, while a part of strap in the radio handset of Blonder is biased to a straighter configuration, there is no teaching or suggestion for modifying the entire strap in the phone device of Olsen to arrive at the radio handset of claim 25. Accordingly, we do not sustain the 35 U.S.C. § 103 rejection of claim 25 over Olsen and Blonder.

CONCLUSION

In view of the foregoing, the decision of the Examiner rejecting claims 1, 3, 4, 7, 9, 10, 12-24 and 27 under 35 U.S.C. § 102 and rejecting claims 5, 6, 11 and 25 under 35 U.S.C. § 103 is reversed.

We make the following new ground of rejection for claim 25 under 35 U.S.C. § 102 as anticipated by Blonder pursuant to 37 CFR § 1.196(b).

Claim 25 is rejected under 35 U.S.C. § 102(b) as anticipated by Blonder. Initially, we note that claim 25, unlike claim 1, merely recites a radio handset including a flexible portion which is "deformable between a curved configuration and a straighter

Appeal No. 2000-1555
Application No. 08/922,929

configuration for extending between the ear and mouth of a user.” The claim further requires that the handset be “biased to the straighter configuration.” Blonder teaches a radio handset (wrist radiotelephone 2) comprising a flexible portion (top layer 12) as recited in Appellant’s claim 25. Blonder specifically teaches that the flexible portion is deformable between a curved configuration (closed position in figures 1 and 2) and a straighter configuration (open position in figure 3) for extending between the ear and mouth of a user (col. 1, lines 35-38, “... the user’s palm containing the speaker is proximate to the user’s ear and the microphone is proximate to the user’s mouth.”). Blonder further teaches that the handset is biased to the straighter configuration (see the discussion of Blonder above with respect to claim 1). Based on the teachings related to top layer 12 assuming an “upright” position after it is released and rotated, Blonder teaches the limitation of “biased to the straighter configuration.”

As discussed above, Blonder teaches all the limitations of independent claim 25. Accordingly, claim 25 is rejected under 35 U.S.C. § 102 as anticipated by Blonder.

Appeal No. 2000-1555
Application No. 08/922,929

In addition to reversing the Examiner's decision rejecting the claims, this decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b). 37 CFR § 1.196(b) provides that "[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 grounds 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. . . .

Appeal No. 2000-1555
Application No. 08/922,929

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)

JAMES D. THOMAS)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
ERROL A. KRASS)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
MAHSHID D. SAADAT)	
Administrative Patent Judge)	

MDS/ki

Appeal No. 2000-1555
Application No. 08/922,929

Perman & Green
425 Post Road
Fairfield, CT 06430