

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 11

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GEORGE ERIC PHILLIPS

Appeal No. 2001-1427
Application No. 09/107,795

ON BRIEF

Before HAIRSTON, KRASS and RUGGIERO, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-15, all of the pending claims.

The invention is directed to an adaptor that can be removably secured to a peripheral device card such as a radiotelephone card.

Representative independent claim 1 and representative dependent claim 4 are reproduced as follows:

1. An electronic device, comprising:
 - a housing;
 - a peripheral device slot within said housing, said peripheral device slot comprising a peripheral device interface;
 - a peripheral device card removably secured within said peripheral device slot such that a first end of said peripheral device card is electrically connected to said peripheral device interface;
 - a power connector interface, wherein said power connector interface is configured to provide electrical power from said electronic device independent of said peripheral device interface, and
 - an adapter removably secured to a second end of said peripheral device card and to said power connector interface such that said adapter is electrically connected to said power connector interface and such that said peripheral device card receives electrical power from said electronic device independent of said peripheral device interface.
4. An electronic device according to claim 1 further comprising an antenna pivotally mounted to said adapter.

The examiner relies on the following references:

Virtuoso et al. (Virtuoso)	5, 594,952	Jan. 14, 1997
Stein	5,628,055	May 06, 1997

Claims 1, 2, 4-8 and 10-14 stand rejected under 35 U.S.C. § 103 as unpatentable over Stein, while claims 3, 9 and 15 stand rejected under 35 U.S.C. § 103 as unpatentable over Stein in view of Virtuoso.

Reference is made to the brief and answer for the respective positions of appellant and the examiner.

OPINION

At the outset, we note that while claims 1-15 stand rejected, as indicated by the examiner in the final rejection as well as the answer, and as acknowledged by appellant at pages 1 and 3 of the brief, appellant apparently argues only the rejection of dependent claims 4, 10 and 13. Note the statement of issues at the top of page 3 of the brief. Accordingly, in view of no arguments presented by appellant with regard to claims 1-3, 5-7, 8, 9, 11, 12, 14 and 15, the rejection of these claims under 35 U.S.C. § 103 is summarily sustained.

Our focus is on claims 4, 10 and 13 and the rejection thereof under 35 U.S.C. § 103 over Stein.

Claims 4, 10 and 13 add only the limitation that there is an antenna pivotally mounted to said adaptor. Clearly, there can be no dispute about Stein showing this specific limitation since column 7, lines 34-36, clearly states that “The particular modular antenna structure 138 of FIG. 8 includes an antenna bar 140, which is pivotally mounted through pivot antenna mount 141...” Accordingly, appellant relies on limitations appearing in independent claims 1, 8 and 12 for the patentability argument, yet, surprisingly enough, appellant does not argue the independent claims separately.

In any event, applying Stein to independent claim 1, Stein clearly discloses an electronic device, viz., a personal computer, with a housing and a peripheral device slot 201 within the housing. The slot has a peripheral device interface (slot connector 204). Stein also teaches a peripheral device card (modular unit 131) removably secured within the slot such that a first end of the “card” is connected to the interface (connector 133 on the modular unit connects to slot connector 204). With regard to a “power connector interface,” Stein discloses an internal power supply 290 (Figure 12) which provides power from the electronic device independent of the peripheral device interface. An adaptor removably secured to a second end of the card is clearly seen in Figure 10 of Stein. That adaptor comprises elements 142 and 154 to which the antenna is connected. The adaptor is connected, albeit via the modular unit, or “card” 131, to the peripheral device interface 204.

While not shown as being connected to a power connector interface 290 in Figure 10, because power is supplied by external supply 250, the examiner seems to imply that, viewing the embodiments of Figure 10 and Figure 12 as a whole, wherein each figure discloses either an internal power supply or an external power supply, but not both, it would have been equally obvious to have both an external power supply with an antenna (as in Figure 10) and an internal power supply (as in Figure 12). In our view, the examiner’s rationale is clearly based on impermissible hindsight.

Each of claims 4, 10 and 13, by dint of their dependence on independent claims 1, 8 and 12, respectively, requires the adaptor to be electrically connected to the power connector interface such that the peripheral device card receives electrical power from the electronic device “independent of said peripheral device interface” or “independent of said PCMCIA interface.”

In Stein, if the peripheral device interface is connector 205 in Figure 10, either device card 131 is connected to this peripheral interface and is supplied power from an external source 250 (in Figure 10) or the card is connected to the peripheral interface via an internal power supply 290 (Figure 12). While Figure 10 may show an embodiment wherein power is supplied independent of the peripheral interface 205, there is no power connector interface to provide electrical power from the electrical device independent of the peripheral device interface because AC/DC adaptor 250 is not being supplied “from the electrical device.” Where Figure 12 shows an embodiment where power is supplied “from the electrical device” (viz., from supply 290), this power is supplied to the peripheral device interface 205 so that power is not supplied independent of the interface. One figure discloses certain claimed elements and another figure discloses other claimed elements but there is no suggestion within Stein for combining Figures 10 and 12 in any manner so as to result in the instant

Appeal No. 2001-1427
Application No. 09/107,795

claimed subject matter and the examiner's explanation as to why it would have been obvious to do so is not convincing of obviousness with the meaning of 35 U.S.C. § 103.

In order to meet the instant claimed limitations, one would need to modify Stein by combining Figures 10 and 12 such as to include both power supplies and to make supply 250 internal to the device while, at the same time, retaining the connection of power supply 250 to connection 154. There is simply no reason, other than hindsight gleaned from appellant's own disclosure, for making such a modification.

Accordingly, we will not sustain the rejection of claims 4, 10 and 13 under 35 U.S.C. § 103.

While it may seem incongruous to do so, although we have reversed the rejection of claims 4, 10 and 13 under 35 U.S.C. § 103, based on limitations appearing in their independent claims, we have sustained the rejection of claims 1-3, 5-9, 11, 12, 14 and 15 under 35 U.S.C. § 103 because, for whatever reason, known only to appellant, appellant has made a conscious effort to specifically not argue these claims, going so far as to stating the issue on appeal as being solely whether claims 4, 10 and 13 were properly rejected under 35 U.S.C. § 103 (brief-page 3). Arguments not made are waived. In re Kroeke, 803 F.2d 705, 709, 231 USPQ 640, 642-43 (Fed. Cir. 1986).

Accordingly, the examiner's decision is affirmed-in-part.

Appeal No. 2001-1427
Application No. 09/107,795

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

KENNETH W. HAIRSTON)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
ERROL A. KRASS)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JOSEPH F. RUGGIERO)	
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Appeal No. 2001-1427
Application No. 09/107,795

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