

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte THOMAS GUTHRIE ZIMMERMAN,  
RICHARD CLEMENT ALLEN,  
DAVID JUN LU and FLORIAN VOGT

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Appeal No. 2002-0611  
Application No. 09/234,229

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ON BRIEF

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Before KRASS, JERRY SMITH and DIXON, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 5 and 58. Claims 8, 10-22, 24-41, 43-57, 59 and 60 stand allowed.

The invention is directed to a personal area network (PAN) communication system. In particular, there is more than one PAN receiver antenna on a keyboard of a

computer and at least one of the receiver antennae is elongated, extending from the left side to the right side of the keyboard so that communication can be established between the PAN transmitter and the computer.

Independent claim 58 is reproduced as follows:

58. A personal area network (PAN) communication system, comprising:

a PAN transmitter;

a computer;

more than one PAN receiver antenna on a keyboard associated with the computer, the keyboard defining left and right sides relative to a user of the keyboard, at least one of the receiver antennae being elongated and extending substantially across the keyboard from substantially the left side to substantially the right side such that communication can be established between the PAN transmitter and the computer.

The examiner relies on the following reference:

Gersheneld et al. [Gersheneld]	5,914,701	Jun. 22, 1999 (filed Aug. 06, 1997)
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Claims 5 and 58 stand rejected under 35 U.S.C. §103 as unpatentable over Gersheneld.

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

OPINION

The examiner relies on Figure 8, and column 8, lines 9-33, of Gersheneld for teaching a PAN transmitter and receiver antennae on a keyboard associated with a computer. Appellants do not dispute this much.

The examiner contends that although Gersheneld does not expressly disclose receiver antennae that can be described as “elongated and extending substantially across the keyboard from substantially the left side to substantially the right side” the claimed subject matter would have been obvious in view of Gersheneld because of “the functional equivalence of the array of receiver antennae [of Gersheneld] and the substantially elongated antenna, the only difference in the reference and the prior art is size” [answer-page 3]. Presumably, the examiner intended the last phrase to compare the “instant claimed invention” and the prior art, rather than the “reference” and the prior art. The examiner also explained that “an elongated antenna would be more apt to information input, errant or otherwise, as well as the tradeoff (in additional material) to determine accurate information reception” [answer-page 3].

This reasoning by the examiner appears to us to be a rationale gleaned from impermissible hindsight since only appellants appear to have disclosed an elongated antenna of the type claimed.

When appellants argued that the elongated receiver of claim 58 is more than a mere “size change,” but, rather, “a change in the principal relative relationship between two components that are fundamental to the claim,” [principal brief-page 5], i.e., the elongated component and the keyboard, the examiner changed the focus of the rationale. The examiner now contends that the center receiver 22a of Gersheneld is “elongated,” as that term is relative, and it extends from the left side of the keyboard to the right side since part of the receiver 22a is on each side of the center. The examiner further explains that it would have been “obvious through experimentation that for a keyboard to be mounted to an antenna, there would be tradeoffs in terms of coverage related to the size and the number of receivers used by the inventor” [answer-page 4].

While the examiner’s interpretation of receiver 22a of Gersheneld extending from the left to the right side of the keyboard because it passes through the center is certainly creative, it is our view that this interpretation is not reasonable. Claim 58 calls for at least one of the receiver antennae to extend “substantially across the keyboard from substantially the left side to substantially the right side . . .” While a portion of the receiver 22a may be said to be on the left side of the keyboard and a portion may be said to be on the right side of the keyboard, the receiver 22a cannot be said to extend “substantially across the keyboard,” as claimed. Clearly, the claim language is meant to

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describe a receiver antenna which extends along substantially the entire keyboard, as depicted by element 18D in Figure 1 of the application.

Gersheneld, in fact, gives no indication, in the short description of Figure 8, at column 8, lines 9-23, of the structure of receiver 22a. While the shape of receiver 22a appears to be rectangular and in the center of the keyboard edge in Figure 8, it may be elongated and extending across the entire keyboard. The point is, simply, that we do not know from the disclosure of Gersheneld. Therefore, to find that receiver 22a is, structurally, as claimed by appellants is to resort to speculation. Deficiencies in the factual basis cannot be supplied by resorting to speculation or unsupported generalizations. In re Freed, 425 F.2d 785, 787, 165 USPQ 570, 571 (CCPA 1970); In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967).

Moreover, the examiner's rationale of claimed subject matter being "obvious through experimentation" is in conflict with the case law that indicates that the fact finder may not employ an "obvious to try" test for obviousness, within the meaning of 35 U.S.C. § 103. In re Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1599 (Fed. Cir. 1988). Also see In re Geiger, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987); In re Goodwin, 576 F.2d 375, 377, 198 USPQ 1, 3 (CCPA 1978). Whether a particular combination might be "obvious to try" is not a legitimate test of patentability.

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Accordingly, since the examiner has not established a prima facie case of obviousness, we will not sustain the rejection of claims 5 and 58 under 35 U.S.C. § 103

The examiner's decision is reversed.

REVERSED

ERROL A. KRASS	)	
Administrative Patent Judge	)	
	)	
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	)	
	)	BOARD OF PATENT
JERRY SMITH	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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JOSEPH L. DIXON	)	
Administrative Patent Judge	)	

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