

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES A. CAMPO, DONALD M. EMBREE,
DONALD I. SLOAN, ROGER H. RAMSEY,
ROBERT G. MARTINEZ, DENNIS M. FLUTO

Appeal No. 95-3998
Application 07/914,904¹

ON BRIEF

Before KRASS, JERRY SMITH and FLEMING, **Administrative Patent Judges**.

FLEMING, **Administrative Patent Judge**.

DECISION ON APPEAL

¹Application for patent filed July 16, 1992.

Appeal No. 95-3998
Application 07/914,904

This is a decision on appeal from the final rejection of claims 1 through 20, all of the claims present in the application.

The invention relates to a portable, wireless, optical scanner configured to be held in the palm of one hand with the thumb or fingers of that hand operating the keys of a keyboard on the front face of the scanner housing.

The independent claim 1 is reproduced as follows:

1. A portable bar code scanner apparatus comprising:

a housing configured to be held in the palm of one hand with a front face of the housing facing upwardly from the palm and with an upper end of the housing facing outwardly;

a keyboard and a display mounted on the front face of the housing, the keyboard being oriented with its upper end nearest the upper end of the housing and having a full numeric set of keys that are individually engageable by the thumb or fingers of the hand holding the housing; and

means disposed within the housing for scanning a bar code positioned adjacent to the upper end of the housing.

The Examiner relies on the following references:

Tierney et al. (Tierney) 23, 1988	4,766,299	Aug.
Wakatsuki et al. (Wakatsuki) 11, 1991	5,023,438	Jun.
Metlitsky et al. (Metlitsky)	5,191,197	Mar.

Appeal No. 95-3998
Application 07/914,904

02, 1993		
Main et al. (Main)	5,216,233	Jun.
01, 1993		
Kumar	5,294,782	Mar. 15,
1994		

Claims 1 through 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Metlitsky, Tierney and Wakatsuki in view of Main or Kumar².

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the briefs³ and answers⁴ for the

²On page 3 of the answer, the Examiner listed Huber, U.S. Pat. No. 4,420,682 and Chadima, U.S. Pat. No. 4,570,057. However, the Examiner rejected the claims in the Final Action based upon Metlitsky, Tierney and Wakatsuki in view of Main or Kumar. The Examiner states on page 3 of the answer that no new art has been applied and on page 5 of the answer that the answer does not contain any new ground of rejection. Thus, the record shows that claims 1 through 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Metlitsky, Tierney and Wakatsuki in view of Main or Kumar as stated in the Final rejection. Therefore, Huber and Chadima are not relied upon by the Examiner for the rejection of the claims.

³Appellants filed an appeal brief on January 12, 1995. We will refer to this appeal brief as simply the brief. Appellants filed a reply appeal brief on June 6, 1995. We will refer to this reply appeal brief as the reply brief. The Examiner responded to the reply brief with a supplemental Examiner's answer on August 1, 1996, thereby entering the reply brief into the record.

⁴The Examiner responded to the brief with an Examiner's answer, mailed April 6, 1995. We will refer to the Examiner's
(continued...)

Appeal No. 95-3998
Application 07/914,904

respective details thereof.

OPINION

We will not sustain the rejection of claims 1 through 20 under 35 U.S.C. § 103.

The Examiner has failed to set forth a **prima facie** case. It is the burden of the Examiner to establish why one having ordinary skill in the art would have been led to the claimed invention by the express teachings or suggestions found in the prior art, or by implications contained in such teachings or suggestions. **In re Sernaker**, 702 F.2d 989, 995, 217 USPQ 1, 6 (Fed. Cir. 1983). "Additionally, when determining obviousness, the claimed invention should be considered as a whole; there is no legally recognizable 'heart' of the invention." **Para-Ordnance Mfg. v. SGS Importers Int'l, Inc.**, 73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995), **cert. denied**, 117 S.Ct. 80 (1996) **citing W. L. Gore & Assocs.**,

⁴(...continued)
answer as simply the answer. The Examiner responded to the reply brief with a supplemental Examiner's answer mailed August 1, 1996.

Appeal No. 95-3998
Application 07/914,904

Inc. v. Garlock, Inc., 721 F.2d 1540, 1548, 220 USPQ 303, 309
(Fed. Cir. 1983), **cert. denied**, 469 U.S. 851 (1984).

On page 13 of the brief, Appellants argue that independent claim 1 defines a portable bar code scanner having a keyboard oriented so as to allow the keys to be individually engagable by the thumb or fingers of the hand holding the housing. Appellants further argue that such a scanner apparatus is not shown or suggested by any of the references applied by the Examiner. On page 14 of the brief Appellants argue that the only other independent claim, claim 13, on appeal defines a portable bar code scanner having all of the features set forth in independent claim 1 and that for reasons set forth with respect to claim 1, the rejection of independent claim 13 should be reversed as well.

We note that Appellants' claim 1 recites in part the following:

a housing configured to be held in the palm of one hand ...

a keyboard ... having a full numeric set of keys

Appeal No. 95-3998
Application 07/914,904

that are individually engageable by the thumb or fingers of the hand holding the housing.

We note that Appellants' claim 13 recites in part the following:

the housing being sized and configured to be holdable in the palm of a hand such that the thumb or fingers of the hand holding the scanner can selectively engage individual keys on the keyboard while the hand is holding the housing.

Upon a careful review of references relied upon by the Examiner, we fail to find that the references teach or suggest the above limitations as recited in Appellants' claims. We appreciate that Main does teach in column 4, lines 42-46, that the actuating button 42 shown in Figure 2 is located so as to allow the thumb of the hand holding the housing 30B to actuate button 42. However, Main teaches in column 4, lines 49-58, that the keys 12 are actuated by the free hand of the user and not the fingers or thumb of the hand holding the housing.

The Examiner argues on pages 4 and 5 of the answer that engaging the keys or the keyboard using the thumb or fingers of the same hand that holds the housing is known in such things as television remotes. However, the Examiner has not provided any

Appeal No. 95-3998
Application 07/914,904

evidence in the record of showing these television remotes or that these remotes were known at the time of Appellants' filing. We are not inclined to dispense with proof by evidence when the proposition at issue is not supported by a teaching in a prior art reference or shown to be common knowledge of unquestionable demonstration. Our reviewing court requires this evidence in order to establish a **prima facie** case. *In re Knapp-Monarch Co.*, 296 F.2d 230, 232, 132 USPQ 6, 8 (CCPA 1961); *In re Cofer*, 354 F.2d 664, 668, 148 USPQ 268, 271-72 (CCPA 1966).

Furthermore, the Examiner has not provided any evidence that the prior art would have suggested modifying the Main housing to allow the user to engage the keys 12 using the thumb or fingers of the same hand that holds the housing. The Federal Circuit states that "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Fritch*, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992), *citing In re Gordon*, 733 F.2d 900, 902, 221

Appeal No. 95-3998
Application 07/914,904

USPQ 1125, 1127 (Fed. Cir. 1984). "Obviousness may not be established using hindsight or in

view of the teachings or suggestions of the inventor." **Par Ordnance Mfg.**, 73 F.3d at 1087, 37 USPQ2d at 1239, **citing W. L. Gore**, 721 F.2d at 1551, 1553, 220 USPQ at 311, 312-13.

We have not sustained the rejection of claims 1 through 20 under 35 U.S.C. § 103. Accordingly, the Examiner's decision is reversed.

REVERSED

ERROL A. KRASS)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
JERRY SMITH)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
)	
)	
MICHAEL R. FLEMING)	

Appeal No. 95-3998
Application 07/914,904

Administrative Patent Judge)

Appeal No. 95-3998
Application 07/914,904

James R. Brueggemann
Pretty, Schroeder,
Brueggemann & Clark
444 S. Flower Street
Suite 2000
Los Angeles, CA 90071