

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID L. FRAGER, RICHARD J. LAWSON, and
JOSEPH W. BELL JR.

Appeal No. 1998-0925
Application No. 08/588,836

ON BRIEF

Before KRASS, FLEMING, and HECKER, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1 through 4 and 6 through 21, all of the claims pending in the application.

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The invention is directed to a multimedia computer keyboard wherein the keyboard has at least one speaker integrated into and mounted within the keyboard.

Representative independent claim 1 is reproduced as follows:

1. An alphanumeric computer keyboard physically separate from and externally coupled to a desktop computer, comprising:

at least one speaker integrated into and mounted within said computer keyboard;

a keyboard cable extending between said keyboard and said computer having one conductor within said cable electrically connected to said speaker; and

an electrical coupling for passing current of varying frequency from said computer to said cable corresponding to sound waves reproduced by said speaker during use.

The examiner relies on the following references:

Aoki et al. (Aoki) JP HEI 1[1989]-119821¹ May 11, 1989

¹Our understanding of this reference is based on an English translation thereof prepared for the United States Patent and Trademark Office, a copy of which is attached hereto.

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IBM Technical Disclosure Bulletin [IBM]; Vol. 36, No. 04;
Apr. 1993; pp 353-4.

The examiner also relies on admitted prior art of appellants at page 9, lines 19-25 of the specification [APA1] and at page 2, line 26 through page 3, line 8 of the specification [APA2], as well as on remarks made by appellants in Paper No. 6, Feb. 24, 1995 [APA3].

Claims 1 through 4 and 6 through 21 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner cites IBM with regard to claims 1 through 4, 6 and 11 through 15, adding APA1 with regard to claims 7 and 8. With regard to claims 9 and 10, the examiner cites IBM in view of APA2 and APA3. IBM in view of Aoki is cited with regard to claims 16 through 19, with APA1 added to this combination with regard to claims 20 and 21.

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

OPINION

We turn first to the rejection of claims 1 through 4, 6 and 11 through 15 under 35 U.S.C. § 103 as unpatentable over

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IBM. The examiner applies IBM against the instant claims by contending that the reference discloses the claimed subject matter but for the claimed electrical coupling passing current of varying frequency from the computer to the cable corresponding to the sound waves reproduced by the speaker during use. The examiner contends that the subject matter as a whole would have been obvious, within the meaning of 35 U.S.C. § 103, because it would have been readily apparent to artisans "that the stereo signals produced by the computer system are transmitted in the form of currents and carried by the lines within the cable 5 to the computer keyboard unit (1) and speaker units (2,3) in order for the speaker units to reproduce the corresponding sound waves" [Answer-page 7].

Appellants' only response is to contend that each of the independent claims requires at least one speaker "integrated into and mounted within" the computer keyboard whereas IBM discloses speakers removably connected to the outside of the keyboard. The examiner counters with the argument that once the speakers of IBM are connected, the keyboard unit and the speakers become one with the speakers, "integrated" and "mounted within" the computer keyboard.

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We agree with the examiner insofar as connection of the speakers in IBM causing the speakers and the computer keyboard to become "integrated." However, we do not see how such connection causes the speaker(s) to become "mounted within" the computer keyboard. The speakers may be considered to be mounted "on" the computer keyboard in IBM but they cannot reasonably be considered to be mounted "within" the computer keyboard.

Accordingly, we will not sustain the rejection of claims 1 through 4, 6 and 11 through 15 under 35 U.S.C. § 103 based on IBM. Since neither APA1 or APA2 or APA3 provides for the deficiency of IBM, we also will not sustain the examiner's rejection of claims 7 through 10 under 35 U.S.C. § 103.

Turning now to the rejection of claims 16 through 19 under 35 U.S.C. § 103 based on IBM and Aoki, we will sustain this rejection since Aoki, in Figure 3, clearly provides the teaching which would have led the artisan to provide for a speaker integrated into and mounted within the computer keyboard. Appellants, for their part, provide no argument against this rejection and provide no comments whatsoever with regard to the Aoki reference, preferring, instead, to rely on

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their argument relating to claim 1 and the IBM reference as to the lack of a teaching of speakers being integrated with and mounted within the computer keyboard.

Accordingly, we will sustain the rejection of claims 16 through 21 since the rejections of these claims rely, in pertinent part, on Aoki in combination with IBM and appellants fail to argue the merits of Aoki or of claims 17 through 21, individually.

We make the following new ground of rejection in accordance with 37 CFR1.196(b):

Claims 1 and 11 are rejected under 35 U.S.C. § 103 as unpatentable over IBM and Aoki.

Aoki clearly suggests at least one speaker "integrated into and mounted within" the computer keyboard, as claimed. As to whether or not Aoki discloses or suggests the claimed "electrical coupling for passing current of varying frequency..." to whatever extent Aoki might be unclear on this, IBM's disclosure of "a cable 5, which includes lines transmitting stereo audio signals to unit 1" would have made it clear to artisans that the cable connecting the computer system and the keyboard would be used for passing current of

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varying frequency corresponding to sound waves reproduced by the speaker during use.

With regard to the specifics of claim 11 wherein left and right channel speakers are employed, the artisan viewing the stereo system of IBM together with Aoki's teaching of providing a speaker integrated with and mounted within the keyboard would have been led to the claimed combination.

While we do not herein enter a new ground of rejection under 35 U.S.C. § 103 with regard to dependent claims 2 through 10 and 12 through 15, we do not mean to imply that we view these claims as patentable over the prior art. Rather, we leave any such rejection(s) of these claims to the good auspices of the examiner after the examiner has had an opportunity to thoroughly review the Aoki teachings in combination with other prior art previously applied by the examiner in view of our new application of Aoki against independent claims 1 and 11.

We have sustained the rejections of claims 16 through 21 under 35 U.S.C. § 103. We have not sustained the rejections of claims 1 through 4 and 6 through 15 under 35 U.S.C. § 103. We have also entered a new ground of rejection against claims

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1 and 11 under 35 U.S.C. § 103 in accordance with 37
CFR1.196(b).

The examiner's decision is affirmed-in-part.

In addition to affirming the examiner's rejection of one or more claims, this decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63,122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides, "A new ground of rejection shall not be considered final for purposes of judicial review."

Regarding any affirmed rejection, 37 CFR § 1.197(b) provides:

(b) Appellant may file a single request for rehearing within two months from the date of the original decision

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise

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one of the following two options with respect to the new ground 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. . . .

Should the appellant elect to prosecute further before the Primary Examiner pursuant to 37 CFR § 1.196(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the appellant elects prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final

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action on the affirmed rejection, including any timely request
for reconsideration thereof.

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

ERROL A. KRASS)
Administrative Patent Judge)
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MICHAEL R. FLEMING) BOARD OF PATENT

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