

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RANDALL S. ESTEP
and
DENNIS A. ZIMMERMAN

Appeal No. 2000-0965
Application No. 08/927,465

HEARD: NOVEMBER 28, 2001

Before JERRY SMITH, RUGGIERO, and BLANKENSHIP, Administrative Patent Judges.

RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the final rejection of claims 1 and 4-17, which are all of the claims pending in the present application. Claims 2 and 3 have been canceled. An amendment filed June 4, 1999 after final rejection was approved for entry by the Examiner. At page 4 of the Answer, the Examiner has indicated that, on reconsideration of the rejection in view of arguments presented by Appellants in the

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Brief, dependent claims 12-16 contain allowable subject matter subject to being rewritten in independent form to include all the limitations of their parent claims. Accordingly, only the rejection of claims 1, 4-11, and 17 is before us on appeal.

The claimed invention relates to a self-contained hands free electrical signal measurement device in which a system unit having a central processing unit (CPU) and a speech recognition system is carried on or attached to the person of a technician. In operation, the technician connects a test probe to an electrical test point and operates the measurement device by issuing spoken commands. The speech recognition system responds to the spoken commands to direct and navigate through a displayed user interface in order to operate the electrical signal measurement functions.

Claim 1 is illustrative of the invention and reads as follows:

1. A self-contained hands free electrical signal measurement device comprising:

- a system unit which is attachable to or worn on the person of a technician, the system unit including a central processing unit (CPU) and associated circuitry running speech recognition software, a speech recognizer communicating with the CPU to operate electrical signal measurement functions in response to spoken commands, a

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memory communicating with the CPU to store digitized measurements, and a port to allow downloading of digitized measurements stored in the memory for the purpose of further analysis at a remote location;

a test probe connected to said system unit and connectable to an electrical test point for making an electrical signal measurement, the CPU digitizing a measured electrical signal and formatting the digitized signal for display and storing in the memory; and

an integrated visual display and an audio link to the system unit, the audio link generating electrical signals in response to spoken commands by the technician, which spoken commands are recognized by the speech recognition software running on the CPU and associated circuitry to direct and navigate through a displayed user interface in order to operate electrical signal measurement device functions, including storing digitized measurements in memory, and the CPU providing user feedback and messages whereby all measurements may be made in a hands free manner.

The Examiner relies on the following prior art:

Janik	5,581,492	Dec. 03, 1996
Fournier et al. (Fournier)	5,671,158	Sep. 23, 1997
		(filed Sep. 18, 1995)

Claims 1, 4-11, and 17 stand rejected under 35 U.S.C. § 103 as being unpatentable over the combined teachings of Fournier and Janik.

Rather than reiterate the arguments of Appellants and the

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Examiner, reference is made to the Briefs¹ and Answer for the respective details.

¹ The Appeal Brief was filed June 4, 1999 (Paper No. 11). In response to the Examiner's Answer dated August 13, 1999 (Paper No. 14), a Reply Brief was filed October 13, 1999 (Paper No. 15) which was acknowledged and entered by the Examiner as indicated in the communication mailed January 3, 2000 (Paper No. 17).

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OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the Examiner, the arguments in support of the rejection and the evidence of obviousness relied upon by the Examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellants' arguments set forth in the Briefs along with the Examiner's rationale in support of the rejection and arguments in rebuttal set forth in the Examiner's Answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the invention set forth in claims 1, 4-11, and 17. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine,

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F.2d 1071, 1073-74, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In

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so

doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S.

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17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to

modify the prior art or to combine prior art references to arrive

at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole

or knowledge generally available to one having ordinary skill in

the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S.

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(1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.,

776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert.

denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v.

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Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

With respect to the Examiner's obviousness rejection of independent claim 1, Appellants' arguments in the Brief assert a failure of the Examiner to set forth a prima facie case of obviousness since proper motivation for the Examiner's proposed combination of Fournier and Janik has not been established. In addition, Appellants assert that, even if the references were combined, the resultant structure would not meet the specific requirements of claim 1.

After careful review of the applied Fournier and Janik references in light of the arguments of record, we are in agreement with Appellants' arguments as set forth in the Briefs. In our view, the Examiner has combined the general computer wearability teachings of Janik with the measurement

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instrument system of Fournier in some vague manner without specifically describing how the teachings would be combined, nor how any such combination would satisfy the requirements of appealed claim 1. This does not persuade us that one of ordinary skill in the art having the references before her or him, and using her or his own knowledge of the art, would have been put in possession of the claimed subject matter. The 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).

A review of the Examiner's analysis (Answer, page 4) reveals an implied suggestion of the obviousness to the skilled artisan of moving the CPU from the instrument console 14 in Fournier to the person of the technician 21 in view of the advantages associated with the wearability of modular computer components suggested by Janik. We agree with Appellants (Brief, page 11), however, that, even if this modification of Fournier were made, the resultant combination would not satisfy the claimed requirements. Although the

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removal of the CPU from the console to the person of the technician would ostensibly eliminate the requirement for Fournier's wireless communication link between the technician and the console CPU, the resulting system would not be self-contained as claimed since some form of transducer unit would still be required to relay test information from the device under test to the measurement technician.

As to the Examiner's further suggestion (Answer, page 5) that, using the computer wearability teachings of Janik, the skilled artisan would have found it obvious to modify Fournier so that the entire measurement system is worn by the technician, we find no basis on the record to support such a suggestion. We agree with Appellants (Brief, page 10; Reply Brief, page 4) that any attempt to incorporate the entire measurement system of Fournier on to the personage of the technician would result in substantially eliminating the mobility of the technician resulting in a substantial loss of the primary intended function of the system of Fournier. If any proposed modification renders a prior art invention that is being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed

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combination. In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Given the factual situation presented to us, it is our view that any suggestion to make the combination suggested by the Examiner could only come from Appellants' own disclosure and not from any suggestions in the references themselves.

In conclusion, we are left to speculate why one of ordinary skill would have found it obvious to modify the applied prior art to make the combination suggested by the Examiner. The only reason we can discern is improper hindsight reconstruction of Appellants' claimed invention. In order for us to sustain the Examiner's rejection under 35 U.S.C. § 103, we would need to resort to speculation or unfounded assumptions or rationales to supply deficiencies in the factual basis of the rejection before us. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968), reh'g denied, 390 U.S. 1000 (1968).

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Accordingly, since we are of the opinion that the prior art applied by the Examiner does not support the obviousness rejection, we do not sustain the rejection of independent claim 1, nor of claims 4-11 and 17 dependent thereon. Therefore, the decision of the Examiner rejecting claims 1, 4-11, and 17 under 35 U.S.C. § 103 is reversed.

REVERSED

JERRY SMITH)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JOSEPH F. RUGGIERO)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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HOWARD B. BLANKENSHIP)	
Administrative Patent Judge)	

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