

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board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

Appeal No. 2000-1592
Application 08/661,220

ON BRIEF

Before THOMAS, FLEMING, and DIXON, Administrative Patent Judges.
THOMAS, Administrative Patent Judge.

DECISION ON APPEAL

Appellant has appealed to the Board from the examiner's final rejection of claims 1 and 3-27. Representative claim 1 is reproduced below:

1. A telephone and its holder, whereby the telephone has a lower end and the holder contains a space, into which the telephone can be placed with the lower end against a bottom of the space, characterized in that the bottom having three support points placed mutually in a triangular pattern and the lower end

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of the telephone having three correspondingly placed counterparts, which are fixed to the support points so that lateral movement or overturning of the telephone is prevented when the telephone is placed against the bottom, wherein the support points are projections or cavities and correspondingly the counterparts are mating cavities or projections.

The following references are relied on by the examiner:

Hellier et al. (Hellier)	Des. 361,069	Aug. 8, 1995 (filing date June 21, 1994)
Léman et al. (Léman)	5,229,701	July 20, 1993
Hashimoto et al. (Hashimoto) (Japanese)	1 236753 ¹	Sep. 21, 1989

All claims on appeal, claims 1 and 3-27, stand rejected under 35 U.S.C. § 103. In an initial rejection, the examiner considers that claims 1, 3-9, 16-20, 22, 23, 25, and 27 would have been obvious in view of Léman alone, with the addition of Hashimoto as to claims 10 and 13, and with the separate addition of Hellier to Léman as to claims 11, 12, 14, 15, 21, 24, and 26.

Rather than repeat the positions of the appellant and the examiner, reference is made to the briefs, the final rejection and the answer for the respective details thereof.

¹ Our understanding of this reference is based upon a translation provided by the Scientific and Technical Information Center of the Patent and Trademark Office. A copy of the translation is enclosed with this decision.

OPINION

From our consideration of the teachings and suggestions of the applied prior art, taken in light of the claimed invention, further in view of the positions set forth by the examiner and appellant, we sustain the rejection of argued independent claims 1, 6, 7, and 18 and dependent claims 16, 21 and 24. and reverse the rejection of independent claims 9 and 25, as well as dependent claims 5, 8, 10, 13, 26, and 27. Because no arguments have been presented in the brief and reply brief as to claims 3, 4, 9, 11, 12, 14, 15, 17, 19, 20, 22 and 23, they also fall with our consideration of their respective parent claims.

In relying upon the final rejection for the examiner's statement of the rejection, the examiner considers that the recitation in each of the independent claims on appeal of three support points in a triangular position is met by the two guide fins 5 and the two charging contacts 3 in Figures 1 and 2 of Léman. The examiner considers it would have been obvious to have removed one of these support points in Léman since it was known in the art that redundant components (from 4 to 3) in Léman would still support and charge a mobile phone or equipment.

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Additionally, the examiner takes the view at pages 4 and 5 of the answer that it would have been a mere design choice to have reduced from 4 to 3 the number of support points in Léman, the examiner urging that the omission of an element would have been obvious if the function of the element is not desired.

We do not consider any of these arguments persuasive because no evidence of obviousness has been provided and, in our judgment, we are unpersuaded of the examiner's view as a mere matter of design choice to omit one of the four labeled elements since we remain unconvinced that the function of one of them would not have been necessary. We are therefore in agreement generally with appellant's arguments set forth initially at pages 4 and 5 of the principal brief on appeal and repeated in latter portions of this brief, as well as the paragraph bridging pages 1 and 2 of the reply brief. As stated at the top of page 5 of the principal brief on appeal, "it clearly would not be obvious to eliminate one of these four points [3,3 and 5,5 in Léman] because this would interfere with their separate and distinct functions."

Notwithstanding these considerations, we sustain the rejection of independent claims 1, 6, 7, and 18 on appeal for reasons independent of the positions of the examiner and do so as

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a matter of claim interpretation. None of these claims require only three support points. Clearly, the four support points 5,5 and 3,3 in Figures 1 and 2 of Léman include the recited 3 support points recited in each of these independent claims on appeal. Furthermore, the additional limitation with respect to them recited in each of these independent claims on appeal, that of they being placed in a triangular pattern, is still met by the teachings and showings in Figures 1 and 2 of Léman as to the relative location, generally speaking, of guide fins 5,5 with respect to the general location of the charging contacts 3,3. The fact that the reference teaches more than what is claimed does not obviate its applicability to that which is positively claimed. The claims do not exclude the additional teaching of an additional point, that is, the fourth point among corresponding structures 5,5 and 3,3 in Léman.

As to argued dependent 5 at page 5 of the principal brief on appeal, we are persuaded by appellant's reasoning here. The ribs 5 in the battery charger base 1 of Léman and their corresponding grooves 6 in the telephone 2 cannot also be construed by the examiner as the additionally recited feature of the vertical rib or groove in dependent claim 5 on appeal. As noted by appellant

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at the bottom of page 5 of the principal brief on appeal the "ribs (5) and grooves (6) cannot be interpreted as both claimed features."

We reverse the rejection of dependent claim 8 and corresponding limitations recited in independent claim 9 because, as argued by appellant at pages 7 and 8 of the principal brief on appeal, the feature of the battery itself having at least one of the counterpart cavities in dependent claim 8 and a corresponding feature recited in independent claim 9 cannot be met by this reference since it simply does not disclose anything at all about the physical location in Figures 1 and 2 or its written description of the battery itself.

We sustain the rejection of dependent claim 16 notwithstanding appellant's arguments at pages 9 and 10 of the principal brief on appeal. The essential additional feature in dependent claim 16 added over those in its parent independent 1 on appeal is the means for holding different sizes of phones. The claim goes on to recite that the holding means of claim 16 comprises the same three support points recited in the parent claim 1. Since we have already determined that the three support points of independent claim 1, as interpreted earlier in this opinion, are

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met by the teachings and showings in Léman, we sustain the rejection of dependent claim 16. Figure 2 of Léman shows two different sized (that is two different thicknesses) of two phones labeled 2 and 7. Appellant's argument at pages 9 and 10 of the brief on appeal is misplaced to the extent it is argued that the lateral distance between the sidewall portions 4 may not be varied. This is not the manner in which the "family of phones" of Léman may be accommodated in a single base element or battery charger 1. It is the depth shown in Figure 2 accorded to the different thicknesses of phone elements 2 and 7 that may be accommodated and not any change in the width dimension between the wall portions 4.

We also reverse the rejection of dependent claims 10 and 13 because we are unpersuaded by the examiner's reasoning at page 4 of the final rejection that it would have been obvious for the artisan to have utilized the teachings of Hashimoto incorporated into the system of Léman. Each of dependent claims 10 and 13 require electrical contacts which are separate from the three support points recited in their respective parent independent claims. The examiner's proposal to utilize the charging elements contacts 11 and 12 of the base 8 in Figure 1 of Hashimoto, along

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with the tube-shaped protrusion 16 therein to provide the separate contacts of the dependent claims 10 and 13 on appeal apparently make no sense to us from an artisan's perspective. As noted at the top of page 9 of the principal brief on appeal Léman already has contact points 3, which the examiner is utilizing in part as a basis for the claimed 3 contact points. The artisan would not have been persuaded by Hashimoto to have added additional electrical contacts for charging purposes to Léman based upon Hashimoto's teachings. As noted by appellant, the examiner's reasoning appears to be based on pure prohibited hindsight.

On the other hand, we note in passing that components 11, 12 and 16 in the Figures 1 and 2 embodiments of Hashimoto appear to plainly teach only three support elements in a shaped triangular configuration to the extent required by the independent claims on appeal.

Finally, we reverse the rejection of independent claim 25 and its respective dependent claims 26 and 27. This rejection, as set forth by the examiner is logically flawed because independent claim 25 in part requires an open-front wall, which feature is plainly not met by Léman alone. Therefore, the

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examiner's rejection of claims 25 and 27 is logically flawed because claim 25 cannot be met by Léman and its dependent claim 27, dependent through intermediate dependent claim 26, cannot be met as well. Additionally, the inclusion of claim 26 in the third stated rejection of the claims on appeal under 35 U.S.C. 103, that involving Léman in view of Hellier, also cannot be sustained because we have not sustained the rejection of its parent independent claim 25.

On the other hand, we do sustain the rejection of dependent claims 11, 12, 14, 15, 21, and 24 in light of the collective teachings and showings of Léman in view of Hellier as argued by the examiner's on pages 4 and 5 of the final rejection. Figures 1 and 5 of Hellier do provide persuasive teachings of the claimed concave shape as argued by the examiner and the overall ornamental design of Hellier would have been a persuasive teaching in our view for the artisan to have modified the front portion of Léman's battery charger 1 to achieve a more ornamental design for this battery charger in light Hellier's showings in Figures 1 and 5. Additionally, it is apparent to us that with such a combination, it would have been easier for the user of the phones 2, 7 in Léman to have placed or removed them from the base 1 utilizing the base design of Hellier.

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We are therefore unpersuaded by appellant's arguments as to the rejection of dependent claims 21 and 24 as argued at page 11 of the principal brief on appeal. We do not agree with appellant's assertion that the removal of one of the two walls 4 would have been necessary in Léman due to the teachings of Hellier. On the contrary, only the front wall 9 would have been necessary to have been shaped according to the showings in Figures 1 and 5 of Hellier. Advantageously, since Léman is designed to accommodate phones of different depth, as represented by phones 2 and 7 in Figure 2 of this reference, the artisan would have found it obvious as well to have incorporated the design teachings of Hellier into the front portion of Léman's base 1.

Because of the earlier noted logical flaws of the rejection of independent claim 25 and because of our decision to sustain the rejection of claims 11, 12, 14, 15, 21, and 24, which contain similar features of an open front wall, we institute a new rejection under 37 CFR § 1.196(b) of independent claim 25 and its dependent claims 26 and 27 consistent with the examiner's reasoning initially advanced for obviousness of claims 11, 12,

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14, 15, 21 and 24 of Léman in view of Hellier. As to dependent claims 26 and 27, the use of the word "proximate" with respect to the front and rear walls in a relative term which is subject to many interpretations and, in our view, clearly met by the combined teachings and showings of Léman in view of Hellier as argued earlier.

Finally, because we sustain the rejection of the earlier noted claims on appeal in accordance with the line of reasoning not advanced by the examiner before in the answer, we will also denominate this affirmance a new ground of rejection.

We have sustained the rejection of claims 1, 3, 4, 6, 7, 11, 12, and 14-24. The affirmance of these claims has been denominated as a new ground of rejection within 37 CFR § 1.196(b). We have reversed the rejection of claims 5, 8, 9, 10, 13, and 25-27. We have also instituted a separate, new rejection of claims 25-27 under this rule as well. Accordingly, the decision of the examiner is affirmed-in-part.

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This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b). 37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 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. . . .

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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

37 CFR § 1.196(b)

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Administrative Patent Judge)	
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