

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEVEN CLARK EMMERT and THOMAS ANTHONY PETRELLA

Appeal No. 2001-1644
Application No. 08/951,149

ON BRIEF

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

BLANKENSHIP, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-18, which are all the claims in the application.

We reverse.

BACKGROUND

The invention is directed to a radiotelephone handset having a light guide or indicator which is viewable from multiple orientations. Claim 1 is reproduced below.

1. A communication device having housing elements which are movable between a closed position and an opened position, said communication device comprising:

a first housing portion having a hinge element and a front portion spaced from the hinge element; and

a light guide positioned on the hinge element to be viewable from the front portion when said housing elements are moved between said closed position and said opened position.

The examiner relies on the following reference:

Motorola Product Brochure TR-304 EN (Roadmap), Roadmap: The ETACS StarTAC Wearable Phone, pp. 1-16, May 1996.

Claims 1-18 stand rejected under 35 U.S.C. § 103 as being unpatentable over Roadmap.

We refer to the Final Rejection (Paper No. 9) and the Examiner's Answer (Paper No. 16) for a statement of the examiner's position and to the Brief (Paper No. 15) for appellants' position with respect to the claims which stand rejected.

OPINION

The examiner finds that Roadmap discloses all the claimed invention but for “an indicating light being positioned in the opening of [the] knuckle and a display in the second housing.” (Answer at 3.) The examiner concludes that it would have been obvious to locate an indicating light in the claimed location “since it has been held that rearranging essential [sic; nonessential?] parts of an invention involves only routine skill in the art,” citing “*In re Japikse*, 86 USPQ 70.” (Id. at 4.)

In appellants’ view, In re Japikse does not apply. Appellants assert that the indicator light taught by Roadmap can only be viewed by orienting the device so that the back of the device is in view. By centering the indicator in the hinge, operation of the handset would be modified because the handset would not have to be turned to be oriented so that the back of the device is in view. (Brief at 5.) The examiner counters (Answer at 4) that the rearrangement of the indicator device does not modify operation of the communication device because the device would receive or send a call regardless of the location of the indicator.

We cannot discern the precise location of the status indicator light in the Roadmap reference. The reference at page 4, however, states that the indicator light is an LED “on the back of the phone [and] indicates whether the phone is on, in a service area, roaming, or receiving a call.”

In place of a teaching from the prior art to modify the Roadmap phone, the instant rejection relies on a per se rule of obviousness. Our reviewing court looks with

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disfavor on per se rules of obviousness. See, e.g., In re Ochiai, 71 F.3d 1565, 1572, 37 USPQ2d 1127, 1133 (Fed. Cir. 1995) (“[R]eliance on per se rules of obviousness is legally incorrect and must cease.”).

Moreover, we agree with appellants that the record establishes (as explained in the specification) that repositioning of the indicator provides a useful result different from prior art positioning -- i.e., the chosen positioning facilitates viewing of the indicator from different orientations with respect to the handset -- and thus represents more than mere arbitrary rearrangement of parts.

Instant claim 1 requires a light guide positioned on the hinge element of a first housing portion. Claim 11 requires a first housing with a first spaced knuckle and a light guide positioned in an opening of the first spaced knuckle. Claim 15 requires a first housing with a first spaced knuckle and a light guide positioned in the opening of the first spaced knuckle. Since the rejection fails to show disclosure or suggestion of a communication device having a light guide in any of the above-noted positions, we do not sustain the rejection of claims 1-18 under 35 U.S.C. § 103 as being unpatentable over Roadmap.

As an aside, we note that claim 15 recites that the light guide is “viewable from said front side of the communication device,” which is consistent with the specification (e.g., at 2, ll. 17-20). However, claim 1 has been amended during prosecution, and claim 11 has been added, such that the claims recite that the light guide is “viewable from the front portion” (i.e., viewable from front portion 110 of housing 108; see spec. at

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2, ll. 21-24; Fig. 1). While the significance of “viewable from the front portion” is not entirely clear to us, we interpret the recitations with respect to “viewable” as merely further limiting the recitations of structure clearly set forth in the claims -- a light guide positioned on a hinge element or in the opening of a knuckle in the housing. Defining the position of an indicator by reference to where it may be “viewable,” without more, would not distinguish over the Roadmap phone. An indicator on the back of the handset could be viewed from the front of the handset by indirect means, such as by an image reflected from a mirror.

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CONCLUSION

The rejection of claims 1-18 under 35 U.S.C. § 103 is reversed.

REVERSED

ERROL A. KRASS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
MICHAEL R. FLEMING)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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HOWARD B. BLANKENSHIP)	
Administrative Patent Judge)	

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