

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte ANTHONY F. AKINS

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Appeal No. 1997-3719  
Application No. 08/559,156

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ON BRIEF<sup>1</sup>

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Before McQUADE, NASE, and GONZALES, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the refusal of the examiner to allow claims 1, 3 and 8 to 12, as amended subsequent to the final rejection. These claims constitute all of the claims pending in this application.

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<sup>1</sup> On January 18, 2000, the appellant waived the oral hearing (see Paper No. 16) scheduled for February 23, 2000.

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We REVERSE.

BACKGROUND

The appellant's invention is a combination cover/carrying case for a laptop or notebook computer (brief, p. 2). An understanding of the invention can be derived from a reading of exemplary claim 1 (the sole independent claim under appeal), a copy of which is set forth in the appendix to the appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Gasparaitus et al. 1991 (Gasparaitus)	5,025,921	June 25,
Seni <sup>2</sup> 1984	2,533,896  (France)	April 6,
Silicon Sports, Inc. "Portable Computer Wetsuit Carrying Case," 1994 (Silicon Sports)		

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<sup>2</sup> In determining the teachings of Seni, we will rely on the translation provided by the PTO. A copy of the translation is attached for the appellant's convenience.

Claims 1, 3 and 8 to 12 stand rejected under 35 U.S.C. § 103 as being unpatentable over Silicon Sports in view of Seni and Gasparaitus.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the answer (Paper No. 13, mailed April 25, 1997) for the examiner's complete reasoning in support of the rejection, and to the brief (Paper No. 12, filed February 25, 1997) for the appellant's arguments thereagainst.

#### OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will

not sustain the examiner's rejection of claims 1, 3 and 8 to 12 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of

the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

The teachings of the applied prior art are set forth on page 4 of the answer. The examiner ascertained (answer, p. 4) that Silicon Sports lacks "a front wall on the upper cover section, a keyboard base cover and a flap adapted to cover a computer component as recited in claim 1." The examiner then determined (answer, pp. 4-5) that these differences would have been obvious at the time the invention was made to a person having ordinary skill in the art.

The appellant argues that the applied prior art does not suggest the claimed subject matter. We agree.

All the claims under appeal require the front wall of the keyboard base cover section and the front wall of the screen cover section to be "thin enough to allow the base keyboard section and the screen section [of the computer] to be pivoted

closed and latched." All the claims under appeal also require the keyboard base cover section to have a plurality of cut-outs

and a flap over at least some of the cut-outs. However, these limitations are not suggested by the applied prior art since these limitations are not even taught by any of the applied prior art. To supply these omissions in the teachings of the applied prior art, the examiner made determinations (answer, pp. 4-5) that these differences would have been obvious to an artisan. However, these determinations have not been

supported by any **evidence**<sup>3</sup> that would have led an artisan to arrive at the claimed invention.

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<sup>3</sup> Evidence of a suggestion, teaching, or motivation to modify a reference may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, see Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), Para-Ordinance Mfg. v. SGS Imports Intern., Inc., 73 F.3d 1085, 1088, 37 USPQ2d 1237, 1240 (Fed. Cir. 1995), although "the suggestion more often comes from the teachings of the pertinent references," In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular. See, e.g., C.R. Bard, Inc. v. M3 Sys., Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998). A broad conclusory statement regarding the obviousness of modifying a reference, standing alone, is not "evidence." E.g., McElmurry v. Arkansas Power & Light Co., 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993) ("Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact."); In re Sichert, 566 F.2d 1154, 1164, 196 USPQ 209, 217 (CCPA 1977) ("The examiner's conclusory statement that the specification does not teach the best mode of using the invention is unaccompanied by evidence or reasoning and is entirely inadequate to support the rejection."). See also In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

In our view, the only suggestion for modifying Silicon Sports in the manner proposed by the examiner to meet the above-noted limitations stems from hindsight knowledge derived from the appellant's own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). It follows that we cannot sustain the examiner's rejection of independent claim 1 and claims 3 and 8 to 12 dependent thereon.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 3 and 8 to 12 under 35 U.S.C. § 103 is reversed.

REVERSED

JOHN P. McQUADE )  
Administrative Patent Judge )  
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) BOARD OF PATENT  
JEFFREY V. NASE ) APPEALS

Administrative Patent Judge )           AND  
  )   INTERFERENCES  
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JOHN F. GONZALES                    )  
Administrative Patent Judge        )

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