

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte TOSHIYUKI KITAZAWA and  
TOMOAKI ITABASHI

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Appeal No. 95-3725  
Application 07/944,318<sup>1</sup>

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HEARD: September 15, 1997

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Before JERRY SMITH, FLEMING and CARMICHAEL, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

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<sup>1</sup> Application for patent filed September 14, 1992.

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This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 11-23, which constitute all the claims remaining in the application.

The claimed invention pertains to a camera provided with a built-in strobe. More particularly, the invention is directed to the manner in which a strobe circuit board and a film winding and rewinding motor are fitted within the camera. Specifically, the strobe circuit board is formed into a generally L-shape with a cutout portion, and the motor is positioned within the cutout portion of the strobe circuit board.

Representative claim 11 is reproduced as follows:

11. A camera provided with a built-in strobe, said camera comprising:

a camera body within which elongated space is defined;

a film winding and rewinding motor provided within said camera body, a length dimension of said motor extending in a direction of elongation of said elongated space;

a strobe circuit board provided within said camera body, said strobe circuit board being formed into a generally L-shape with a cutout portion defining said L-shape, said strobe circuit board and said motor being accommodated within said elongated space, such that said motor is positioned to extend into said cutout portion of said strobe circuit board.

The examiner relies on the following references:

Ohmura et al. (Ohmura)	4,896,178	Jan. 23, 1990
Fiorda	4,996,544	Feb. 26, 1991
Yamanaka	5,036,343	July 30, 1991

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Claims 11-23 stand rejected under 35 U.S.C. § 103. As evidence of obviousness the examiner offers Fiorda, Yamanaka and Ohmura taken collectively.

Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs and the answers for the respective details thereof.

#### OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner 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, the 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 answers.

It is our view, after consideration of the record before us, that the collective 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 obviousness of the invention as set forth in claims 11-23. Accordingly, we reverse.

With respect to each of independent claims 11, 13 and 23, the examiner has noted that each element of the claimed

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combination was known to be part of a prior art camera and strobe combination. Since each of the claimed elements was individually known in the prior art combination, the examiner formulated the question as follows:

[W]hether it would have been unobvious to one having ordinary skill in the art to place the motor in an elongated space in the camera and to provide the circuit board in the shape of an L so that it fits around the motor. That is, would it have been unobvious to have made the circuit board so that it fits into the available space. [answer, pages 4-5]

It is noteworthy that the question as rephrased by the examiner is totally different from the question initially posed. The first question comes close to considering the obviousness of the invention based on actual claim recitations whereas the rephrased question relates only to a concept rather than the recitations of the claims. By posing the question as to whether it would generally be obvious to fit components into an available space, the examiner has neatly made it impossible to patent any technique which seeks to attain that goal no matter how claimed. It was error for the examiner to consider the patentability of his own concept of the invention rather than the invention as specifically set forth in the claims.

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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, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 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. 825 (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 Hospital Systems, Inc. v. Montefiore Hospital, 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).

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Obviousness cannot be based only on the broad idea that to make something more compact would be obvious. This position is tantamount to saying that no invention which makes the prior art faster, more efficient or cheaper is patentable because these are obvious desirable results. It is not the result achieved which determines the patentability of an invention. The claimed invention must be considered as a whole to determine if it would have been obvious in view of the teachings of the prior art. Thus, even if it would have been obvious to broadly make a combination of elements more compact, the question for patentability purposes is whether the specific arrangement recited in the claims would have been obvious in view of the applied prior art. The examiner has ignored this question in this case.

The examiner's position is summed up in the supplemental answer as follows:

If the space into which the circuit board must fit is L-shaped it does not require an MIT professor to discover that it would be a good idea to make the circuit board L-shaped.

This would be an interesting observation except where is it written that the space in which the circuit board must fit has to be L-shaped? That is not an appropriate place for the artisan to

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start. The only suggestion for an L-shaped circuit board comes from appellants' own specification which may not be used against appellants in hindsight.

We also agree with appellants that there is absolutely no suggestion on the record before us for combining the teachings of the applied prior art. The examiner never suggests how or why he is modifying any of the references based on suggestions from any of the other references. The three patents cited by the examiner are individually referred to for teaching the same thing which is that circuit components are made to fit into an available space. Why the component fit of one of these patents would be used with any other one of the patents is not clear, and even if used, how the modified component fit would suggest the invention as specifically recited in appellants' claims is still a mystery to us. Thus, the examiner has not only failed to provide a legitimate reason for concluding obviousness, but has also failed to indicate how the relied upon teachings would have been combined to arrive at the claimed invention.

Since each of independent claims 11, 13 and 23 recites a specific relationship between a strobe circuit board and a film motor, and since the examiner has failed to supply any evidence

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which suggests the specific claimed relationship, we do not sustain the rejection of the independent claims. Since the remaining claims depend from claims 11 or 13 and incorporate all the limitations therefrom, we also do not sustain the rejection of the dependent claims.

In conclusion, the decision of the examiner rejecting claims 11-23 is reversed.

REVERSED

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JERRY SMITH	)	
Administrative Patent Judge	)	
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	)	BOARD OF PATENT
MICHAEL R. FLEMING	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES

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