

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(2) is not binding precedent of the Board.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. 28

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT F. MYERSON,
YUNG-FU CHANG, GARY KOCHIS,
and DONALD M. EMBREE

Appeal No. 1997-2705
Application 08/341,429

ON BRIEF

Before THOMAS, KRASS, and RUGGIERO, Administrative Patent
Judges.

RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of
claims 1, 3-4, 6-9, 16-17, 19-21, and 23-24, all of the claims
pending in the present application. Claims 22 and 25-28 were
canceled earlier in the prosecution. An amendment after final

Appeal No. 1997-2705
Application No. 08/341,429

rejection filed August 7, 1996, which canceled claims 2, 5, 10-15, and 18, was entered by the Examiner on August 16, 1996.

The claimed invention relates to a hand-held, portable computer that includes a display screen housing for supporting an interactive display screen. More particularly, Appellants indicate at pages 4 and 5 of the specification that a computer housing and handle assembly is rotatably connected to the display screen housing for rotation about an axis substantially perpendicular to the display screen surface. Appellants assert that the relative rotational movement between the display screen housing and computer housing permits the computer to be held in one hand of a user while the other hand is used for data and command input.

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

1. A hand-held computer for supplying data to and receiving data from a user, the computer comprising:

a) a display screen housing for supporting an interactive display screen having a generally planar visible display surface;

b) a computer housing and handle assembly rotatably connected to the display screen housing for rotation with respect to the interactive display about an axis substantially perpendicular to the display surface, the computer housing and handle assembly defining an

Appeal No. 1997-2705
Application No. 08/341,429

internal space for housing computer components for providing displays on the screen and receiving and processing user provided information input via the screen; and

c) the computer housing and handle assembly including a handle subassembly for use by a user in supporting the computer, a relative rotational movement between the display screen housing and the computer housing and handle assembly permitting a user to relatively position the handle and the screen to an ergonomically acceptable position for support of the computer with one hand and data input with a user's other hand.

The Examiner relies on the following prior art:

| | | |
|------------------------|-----------|---------------|
| Sato | 4,237,540 | Dec. 02, 1980 |
| Learn | 4,458,238 | Jul. 03, 1984 |
| Gombrich | 4,916,441 | Apr. 10, 1990 |
| Hanson et al. (Hanson) | 5,349,497 | Sep. 20, 1994 |

(filed Oct. 5, 1992)

Claims 1, 3-4, 6-9, 16-17, 19-21, and 23-24 stand finally rejected under 35 U.S.C. § 103 as being unpatentable over Hanson in view of Sato, Learn, and Gombrich.¹

¹ In response to Appellants' arguments in the Brief, the Examiner withdrew a 35 U.S.C. § 112, first paragraph, rejection as indicated at page 2 of the Answer.

Appeal No. 1997-2705
Application No. 08/341,429

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Brief and Answer for the respective details.

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 Brief along with the Examiner's rationale in support of the rejections 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 obviousness of the invention set forth in claims 1, 3-4, 6-9, 16-17, 19-21, and 23-24. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to

Appeal No. 1997-2705
Application No. 08/341,429

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.,

Appeal No. 1997-2705
Application No. 08/341,429

776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. 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 each of the independent claims 1, 8, 19, and 23, the Examiner, as the basis for the obvious rejection, proposes to modify the hand-held computer structure disclosed by Hanson by adding a teaching of a rotatable handle as taught by Sato. The Examiner's line of reasoning is expressed at page 5 of the Answer as follows:

Since Hanson pivot their device for ergonomic reason [sic, reasons], it would have been obvious in view of Sato to add rotation to the display/computer in Hanson et al to enhance ergonomic considerations.

Appeal No. 1997-2705
Application No. 08/341,429

The Learn and Gombrich references are added to the combination to address the display screen features of the appealed claims.

In response, Appellants' arguments primarily center on the alleged lack of teaching in any of the applied references of the claimed rotational relationship between the computer housing and handle assembly and the display screen surface. After careful review of the applied prior art, in light of the arguments of record, we are in agreement with Appellants' position as stated in the Brief. We note that the relevant portion of independent claim 1 recites:²

a computer housing and handle assembly rotatably connected to the display screen housing for rotation with respect to the interactive display about an axis substantially perpendicular to the display surface,...

We find no disclosure in any of the applied prior art that would meet the specifics of this claim language. The Examiner, although primarily relying on Sato as providing a teaching of a rotatable handle and display screen structure, suggests in the "Response to argument" portion at page 5 of

² Similar recitations appear in each of the other appealed independent claims 8, 19, and 23.

Appeal No. 1997-2705
Application No. 08/341,429

the Answer that Hanson also suggests a handle rotatable with respect to a computer housing. In particular, the Examiner points to Figure 12 of Hanson which illustrates the handle 30 rotated to a position which is perpendicular to the computer housing 10. We find, however, that the Examiner's reliance on this particular illustration of Hanson is misplaced. While it is true that Hanson's handle can be pivoted or rotated to any number of positions, it is quite apparent that any such rotation is about an axis parallel to the display screen surface and not about an axis perpendicular thereto as claimed.

Similarly, our review of Sato reveals the same deficiency as that discussed with respect to Hanson. While the computer housing 1 of Sato clearly rotates with respect to the display portion 9, this rotation is about a parallel axis to the display surface, not a perpendicular axis as claimed. It is also apparent from the line of reasoning in the Answer that since the Examiner has, in our view, mistakenly interpreted the disclosures of Hanson and Sato as disclosing handle rotation about an axis perpendicular to a display surface, the

Appeal No. 1997-2705
Application No. 08/341,429

issue of the obviousness of this feature has not been addressed.

We have also reviewed the disclosures of Learn and Gombrich which, as indicated earlier, were applied to the proposed combination of Hanson and Sato to address the display screen structure feature of the appealed claims. We find nothing in the disclosures of Learn and Gombrich related to rotatable handle-housing combinations which would cure the innate deficiencies of Hanson and Sato.

In view of the above discussion, it is our view, that, since all of the limitations of the appealed claims are not taught or suggested by the prior art, the Examiner has not established a prima facie case of obviousness. We further agree with Appellants (Brief, page 14) that even assuming arguendo that proper motivation existed for the combination suggested by the Examiner, the resulting structure would not meet the requirements of the claims on appeal. Accordingly, the 35 U.S.C. § 103 rejection of independent claims 1, 8, 19, and 23, as well as claims 3-4, 6-7, 9, 16-17, 20-21, and 24 dependent thereon,

Appeal No. 1997-2705
Application No. 08/341,429

cannot be sustained. Therefore, the decision of the Examiner
rejecting claims 1, 3-4, 6-9, 16-17, 19-21, and 23-24 is
reversed.

REVERSED

| | | | |
|--------|-----------------------------|---|---------------|
| | James D. Thomas |) | |
| | Administrative Patent Judge |) | |
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| | Errol A. Krass |) | BOARD OF |
| PATENT | Administrative Patent Judge |) | APPEALS AND |
| | |) | INTERFERENCES |
| | |) | |
| | Joseph F. Ruggiero |) | |
| | Administrative Patent Judge |) | |

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Appeal No. 1997-2705
Application No. 08/341,429

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