

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT F. MEYERSON and YUNG-FU CHANG

Appeal No. 1997-2790
Application No. 08/486,830¹

ON BRIEF

Before HAIRSTON, BARRETT, and DIXON, **Administrative Patent Judges**.
DIXON, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 25-41, which are all of the claims pending in this application.

We AFFIRM-IN-PART.

¹ Application for patent filed June 7, 1995. According to appellants, this application is a continuation of Application No. 08/268,806, filed June 30, 1994, now U.S. Patent 5,594,470, issued January 14, 1997, which is a continuation of Application No. 07/956,112, filed October 2, 1992, now abandoned.

BACKGROUND

The appellants' invention relates to a highly integrated portable electronic work-slate unit. The workslate having a handle disposed on the bottom thereof containing both power cells and modular processing circuitry. An understanding of the invention can be derived from a reading of exemplary claim 25, which is reproduced below.

25. An electronic workslate unit comprising:
- a) a shell including a generally planar upper surface and a generally planar lower surface spaced apart from the upper surface defining an interior region, the shell further includes a handle extending from the lower surface, the handle includes a grip portion spaced from and disposed below a plane defined by the lower surface and configured to enable gripping and support of the workslate unit with one hand during use;
 - b) electronic circuitry supported within the interior region; and
 - c) an interactive display screen supported by the shell, the screen forming a portion of the shell upper surface and electrically coupled to the electronic circuitry, at least a portion of the display screen being touch sensitive for data entry.

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

Bradbury et al. (Bradbury)	Des. 297,939	Oct. 04, 1988
de la Huerga et al. (de la Huerga)	Des. 309,295	Jul. 17, 1990
Hacker et al. (Hacker)	5,123,064	Jun. 16, 1992
Powell et al. (Powell) ²	5,350,909	Sep. 27, 1994

² We note that Powell has a filing date after the effective filing date of the present application and is not available under 35 U.S.C. § 102(e), yet appellants have not argued this point.

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Koenck et al. (Koenck)	5,410,141	(Filed Oct. 14, 1992) Apr. 25, 1995 (Filed Jan. 7, 1992)
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Claims 25-41 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hacker in view of Koenck, Powell, Bradbury, and de la Huerga.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the examiner's answer (Paper No. 14, mailed Feb. 20, 1997) for the examiner's reasoning in support of the rejection, and to the appellants' brief (Paper No. 12, filed Nov. 22, 1996) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

CLAIMS 25, 26, 31, 36, 37- 39 and 41

As pointed out by our reviewing court, we must first determine the scope of the claim. "[T]he name of the game is the claim." **In re Hiniker Co.**, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). We find that the examiner has provided teachings and a convincing line of reasoning why one skilled in the art would have desired to have a shell which further "includes a handle extending from the lower surface, the handle includes a grip portion spaced from and disposed below a plane defined by the lower surface and configured to enable gripping and support of the workslate unit with one hand during use" as set forth in the language of claim 25.

"To reject claims in an application under § 103, an examiner must show an un rebutted prima facie case of obviousness. **See In re Deuel**, 51 F.3d 1552, 1557, 34 USPQ2d 1210, 1214 (Fed. Cir. 1995). In the absence of a proper prima facie case of obviousness, an applicant who complies with the other statutory requirements is entitled to a patent. **See In re Oetiker**, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). On appeal to the Board, an applicant can overcome a rejection by showing insufficient evidence of prima facie obviousness or by rebutting the prima facie case with evidence of secondary indicia of nonobviousness." **In re Rouffet**, 149 F.3d 1350, 1355, 47 USPQ2d 1453 (CAFC 1998). Here, we find that appellants have not overcome the **prima facie** case of obviousness by showing insufficient evidence by the examiner of nonobviousness or by rebutting the **prima facie** case with evidence of secondary indicia of

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nonobviousness. Therefore, we will sustain the rejection of independent claim 25.

Furthermore, independent claims 39 and 41 contain similar claim limitations and appellants have not rebutted the rejections of these claims. Similarly, appellants have not shown insufficient evidence by the examiner of nonobviousness or rebutted the *prima facie* case with evidence of secondary indicia of nonobviousness with respect to dependent claims 26, 31, 36, 37, and 38.

Appellants argue that the references alone or in combination do not teach or suggest the claimed invention. (See brief at pages 3-5.) We disagree with appellants. Appellants further argue that Hacker teaches away from the use of a handle. (See brief at page 4.) We disagree with appellants. Appellants argue that the examiner has used hindsight reconstruction and used appellants' specification as a template. (See brief at pages 4-5.) We disagree with appellants. Rather, we find that the language of claim 25 is broad in the recitation of the limitation as to the structural orientation of the handle, and the prior art combination teaches and would have fairly suggested the combination of elements as set forth in the language of claims 25, 39 and 41.

We find that the examiner has set forth a brief explanation of the references and the motivation for the combination. (See answer at page 5.) The examiner has further elaborated upon the rejection in the response to appellants' arguments. (See answer at pages 5-7.) We agree with the examiner concerning the above-mentioned claims. The

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express language of claim 25 merely requires that “the shell further includes a handle extending from the lower surface, the handle includes a grip portion spaced from and disposed below a plane defined by the lower surface and configured to enable gripping and support of the workslate unit with one hand during use.” Clearly, Hacker discloses (see Hacker at figure 1) the basic data entry and display device with electronics, and Koenck discloses (see Koenck at figures 11 and 12) the combination of a display and digitizer and that the handle “includes a grip portion spaced from and disposed below a plane defined by the lower surface and configured to enable gripping and support of the workslate unit with one hand during use” as set forth in the language of claim 25. (See answer at pages 5-6.) The claim language is silent as to the physical orientation of the handle beyond that it is “spaced from and disposed below a plane.” Clearly, Koenck teaches the claimed orientation. Therefore, we will sustain the rejection of claim 25. Similarly, we will sustain the rejection of claims 39 and 41 on the same basis.

With respect to claim 26, appellants argue that the prior art does not teach that the handle is substantially parallel to the lower surface and relies on the argument with respect to claim 25. We disagree with appellants. Bradbury clearly shows the orientation of a handle on an input device which is substantially parallel to the lower surface as the examiner states. (See answer at page 6.) We agree with the examiner.

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Appellants have not provided a separate convincing argument as to the patentability of claim 26. Therefore, we will sustain the rejection of claim 26.

With respect to claim 31, appellants merely repeat the language of the claim and rely on the argument provided against claim 25. This argument is not persuasive. Clearly, de la Huerga teaches and would have suggested the use of handles/supports with distal ends connected to the lower surface. (See answer at page 5.) We agree with the examiner.

With respect to claims 36 and 37, appellants argue that the prior art does not teach or suggest that the display screen is at least 70% of the visible surface (see brief at page 8) and the screen is at least 3 inches by 5 inches. The examiner maintains that the “visible surface area of the interactive display screen is considered as a matter of design choice since it does not solve any stated problem or have any unexpected results.” (See answer at page 7.) We agree with the examiner.

With respect to claim 38, appellants rely upon the argument with respect to claim 25 and merely repeats the language of the claim. This argument is not persuasive as discussed above with respect to Koenck.

CLAIMS 27- 30, 32- 36 and 40

With respect to claims 27 and 40, appellants argue the interchangeability of a plurality of electronic modules in the handle. (See brief at pages 6, 7, 10 and 11.) The examiner relies upon Powell to teach this interchangeability function. (See answer at page 5.) Even though Powell is not available as prior art, we find that it does not teach nor would have suggested the interchangeability of electronic modules in the handle. (See answer at page 5.) Powell merely teaches the use of the handle as the location for some processing circuitry. (See Powell at figure 3.) The examiner maintains that Koenck teaches the placement of the battery in the handle. (See answer at page 6). Koenck in figure 14 and at column 16 does teach that an option is to place the batteries/power supply in the handle, but is silent as to the interchangeability of both an electronic module and a power supply. Furthermore, the examiner has not provided a convincing line of reasoning why it would have been obvious to one of ordinary skill in the art at the time of the invention to place interchangeable modules in the handle of the workslate. Therefore, we will not sustain the rejection of claim 27 or claim 40, nor will we sustain the rejection of claims 28-30 and 32-36 which depend from claim 27.

CONCLUSION

The decision of the examiner to reject claims 25, 26, 31, 36, 37- 39 and 41 under 35 U.S.C. § 103 is affirmed, and the decision of the examiner to reject claims 27- 30, 32-

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36 and 40 is reversed. To summarize, the decision of the examiner to reject claims 25-41 under 35 U.S.C. § 103 is affirmed-in-part.

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

KENNETH W. HAIRSTON)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
LEE E. BARRETT)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JOSEPH L. DIXON)	
Administrative Patent Judge)	

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APJ DIXON

APJ HAIRSTON

APJ BARRETT

DECISION: **REVERSED**

Prepared By: **Reginald Kimbrough**

DRAFT TYPED: 07 May 01

FINAL TYPED: