

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. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT E. LUCEY

Appeal No. 1998-1328
Application No. 08/341,500

ON BRIEF

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

FLEMING, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-15.

The invention relates to the use of a flexible microphone boom which is lightweight and comfortable for a user to wear

for long periods of time. The microphone boom allows for placement of the microphone near the user's mouth and which is rugged enough to avoid fracturing or breaking even after being repeatedly bent over long periods of time. The boom includes an inner conductor having a plurality of support strands, a first insulator disposed about an inner conductor, an outer conductor disposed about the first insulator to shield the inner conductor and an outer jacket disposed about the outer conductor. This arrangement allows for the boom to be positioned to fit a plurality of users. A support wire from a plurality of different strands of wire allows the flexible cable to be repeatedly bent without fracture.¹

Independent claim 1 is as follows:

1. A microphone boom comprising:

an inner conductor including:

a microphone wire strand in electrical communication with a microphone; and

a plurality of wire strands;

a first insulator concentrically disposed about said inner conductor;

¹See page 3 of the specification.

Appeal No. 1998-1328
Application No. 08/341,500

an outer conductor concentrically disposed about said first insulator; and

an outer jacket concentrically disposed about said outer conductor,

wherein said inner conductor imparts to said microphone boom a characteristic of being freely positionable by a user, said microphone boom maintaining a first position until moved to a further position by said user.

The Examiner relies on the following references:

Litauer 1981	4,259,544	Mar. 31,
Sacherman et al. 1994	5,369,857	Dec. 6,

Claims 1-15 are rejected under 35 U.S.C. § 103 as being unpatentable over Sacherman in view of Litauer.

Rather than reiterate all arguments of the Appellant and the Examiner, reference is made to the briefs and the answers for the respective details thereof.²

OPINION

We will not sustain the rejection of claims 1-15 under 35

²See Appellant's brief (hereinafter the brief) filed August 18, 1997 and the Reply Brief filed October 30, 1997. See also the Examiner's answer (hereinafter answer) filed September 5, 1997 and the Supplemental Answer filed November 6, 1997.

Appeal No. 1998-1328
Application No. 08/341,500

U.S.C.

§ 103.

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). Moreover, when interpreting a claim, words of the claim are generally given their ordinary and accustomed meaning unless it appears from the specification or the file history that they were used differently by the inventor. ***Carroll Touch, Inc. v. Electro Mechanical Sys., Inc.***, 15 F.3d 1573, 1577, 27 USPQ2d 1836, 1840. Although an inventor is indeed free to define the specific terms used to describe his or her invention, this must be done with reasonable clarity, deliberateness, and precision. ***In re Paulsen***, 30 F.3d 1475, 1479, 31 USPQ2d 1671,

Appeal No. 1998-1328
Application No. 08/341,500

1674 (Fed. Cir. 1994).

Independent claims 1, 9, 11, and 15 each recite a microphone boom comprising: a conductive core which includes a plurality of strands; a first insulator disposed about the conductive core; an outer conductor disposed about the first insulator; and an outer jacket disposed about the outer conductor.

The Appellant and the Examiner both agree that Sacherman fails to disclose a conductive core with a plurality of strands, a first insulator, and an outer conductor as recited in claims 1, 9, 11, and 15. The Examiner relies on Litauer for a teaching of these limitations.

Appellant argues that a person of ordinary skill in the art would not have been motivated to combine teachings of Sacherman and Litauer. Appellant particularly argues that cables used in the Litauer invention are heavy duty electrical cables requiring reinforcement so that the cables do not collapse under their own weight when strung between utility poles. Appellant also argues that there is no useful benefit for use for longitudinally strengthening as taught by Litauer in the microphone boom disclosed by Sacherman because lack of

Appeal No. 1998-1328
Application No. 08/341,500

longitudinal strength in the boom is not a problem that is discussed or suggested by Sacherman. With respect to sealing the microphone boom from moisture, Appellant argues that moisture is not a concern for an inner conductor of the microphone boom, since electrical components associated with a headset used with a microphone boom will be destroyed by moisture well before degradation of the inner conductor.³

The Examiner has failed to set forth a ***prima facie*** case. It is the burden of the Examiner to establish why one having ordinary skill in the art would have been led to the claimed invention by the express teachings or suggestions found in the prior art, or by implications contained in such teachings or suggestions. ***In re Sernaker***, 702 F.2d 989, 995, 217 USPQ 1, 6 (Fed. Cir. 1983). "Additionally, when determining obviousness, the claimed invention should be considered as a whole; there is no legally recognizable 'heart' of the invention." ***Para-Ordnance Mfg. v. SGS Importers Int'l, Inc.***, 73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995), ***cert. denied***, 117 S. Ct. 80 (1996) ***citing W. L. Gore &***

³See pages 11-13 of the brief.

Appeal No. 1998-1328
Application No. 08/341,500

Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1548, 220 USPQ 303, 309 (Fed. Cir. 1983), **cert. denied**, 469 U.S. 851 (1984).

The Federal Circuit states that "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." **In re Fritch**, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n. 14 (Fed. Cir. 1992), **citing In re Gordon**, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). It is further established that "[s]uch a suggestion may come from the nature of the problem to be solved, leading inventors to look to references relating to possible solutions to that problem." **Pro-Mold & Tool Co. v. Great Lakes Plastics**, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996) **citing In re Rinehart**, 531 F.2d 1048, 1054, 189 USPQ 143, 149 (CCPA 1976) (considering the problem to be solved in a determination of obviousness). The Federal Circuit reasons in **Para-Ordnance Mfg., Inc. v. SGS Importers Int'l Inc.**, 73 F.3d 1085, 1088-89, 37 USPQ2d 1237, 1239-40 (Fed. Cir.

Appeal No. 1998-1328
Application No. 08/341,500

1995), that for the determination of obviousness, the court must answer whether one of ordinary skill in the art who sets out to solve the problem and who had before him in his workshop the prior art, would have reasonably expected to use the solution that is claimed by Appellants. However, "[o]bviousness may not be established using hindsight or in view of the teachings or suggestions of the invention." **Par Ordnance Mfg. v. SGS Importers Int'l**, 73 F.3d at 1087, 37 USPQ2d at 1239, **citing W. L. Gore & Assocs., Inc. v. Garlock, Inc.** 721 F.2d at 1551, 1553, 220 USPQ at 311, 312-13. In addition, our reviewing court requires the PTO to make specific findings on a suggestion to combine prior art references. **In re Dembiczak**, 175 F.3d 994, 1000-01, 50 USPQ2d 1614, 1617-19 (Fed. Cir. 1999).

We agree with Appellant that a person of ordinary skill in the art would not have been motivated to increase the longitudinal strength in Sacherman, particularly as the reference is concerned with decreasing the pressure exerted on

Appeal No. 1998-1328
Application No. 08/341,500

the ears of the headset user.⁴ An increase in longitudinal strength would not advance a solution to this problem. Further, the headsets of Sacherman are for use with telephones and thus would not normally be used in an environment in which moisture would be a problem. We therefore find that no motivation exists to combine Sacherman and Litauer.

For these reasons, the rejection of claims 1-15 under 35 U.S.C. § 103 is reversed.

REVERSED

JAMES D. THOMAS)	
Administrative Patent Judge)	
)	
)	BOARD OF PATENT
MICHAEL R. FLEMING)	
Administrative Patent Judge)	APPEALS AND
)	
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⁴See col. 3 lines 10-31 of Sacherman.