

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES D. MACDONALD JR. and YAWEI MA

Appeal No. 1999-2381
Application No. 08/586,434

ON BRIEF

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

URYNOWICZ, Administrative Patent Judge.

Decision on Appeal

This appeal is from the final rejection of claims 1-17, 20-40, 43 and 45-48¹. Claims 18, 19, 41, 42 and 44 stand

¹ The brief indicates at page 6, lines 6-9, that claim 21 stands rejected for double patenting and this is in fact the case. Accordingly, the statement at page 19, item 11, of the answer indicating that claim 21 is objected to and would be

Appeal No. 1999-2381
Application No. 08/586,434

objected to as being dependent upon a rejected base claim, but allowable if rewritten in independent form including all of the limitations of the base claim.

The invention pertains to portable phone apparatus. Claims 1 and 36, the only independent claims, are illustrative and read as follows:

1. A portable phone, comprising:

(a) a main housing having a top portion, a bottom portion, a front portion, and a rear portion;

(b) circuitry located within said main housing for operating said portable phone in a designated communication mode;

(c) a support bracket assembly slidably and detachably coupled over and to said top portion of said main housing;

(d) a flip cover rotatably secured to said support bracket assembly about a first axis; and

(e) an antenna coupled to said circuitry for transmitting and receiving signals in said designated communication mode, said antenna being integrated with said flip cover.

36. A support bracket assembly for indirectly and detachably coupling a flip cover and a main housing of a portable phone, comprising:

allowable if rewritten in independent form is incorrect because claim 21 stands rejected under on the grounds of obviousness-type double patenting.

Appeal No. 1999-2381
Application No. 08/586,434

(a) a support bracket having a first end with a slotted portion sized to slidably couple over and to a top portion of said main housing;

(b) a latching mechanism for detachably coupling said support bracket and said main housing top portion; and

(c) a hinge mechanism rotatably coupling said flip cover and a second end of said support bracket about a first axis.

The references relied upon by the examiner are:

Huang	4,973,972	Nov. 27, 1990
McGirr et al. (McGirr)	5,231,407	Jul. 27, 1993
Takagi et al. (Takagi)	5,303,291	Apr. 12, 1994
Pye et al. (Pye)	5,337,061	Aug. 09, 1994
Tsao	5,513,383	Apr. 30, 1996
Dent	5,535,432	Jul. 09, 1996
Wilcox et al. (Wilcox)	5,628,089	May 13, 1997

Claims 1-15, 20-28, 36-39, 43 and 45 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 6, 8-17, 20-24, 28, 29 and 31-34 of U.S. Patent Application No. 08/586,433 ('433 application) in view of Takagi since the claims, if allowed, would improperly extend the "right to exclude" if the '433 application issued.

Claims 36 and 46-48 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Takagi in view of Wilcox.

Appeal No. 1999-2381
Application No. 08/586,434

Claims 1-5, 8, 9, 14, 15, 23-26 and 29-35 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dent in view of Takagi, Wilcox and Pye.

Claim 6 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Dent in view of Takagi, Wilcox, Pye and Huang.

Claim 7 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Dent in view of Takagi, Pye, Wilcox and McGirr.

Claims 10-13, 16, 17, 20 and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dent in view of Takagi, Pye, Wilcox and Tsao².

Claims 27 and 28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dent in view of Takagi, Pye, Wilcox, McGirr and Huang.

Claims 37-40, 43 and 45 stand rejected under 35 U.S.C.

² We have assumed that claim 17 was inadvertently omitted in the statement of the rejection in both the final rejection (Paper No. 15) and the answer. The paragraph bridging pages 17 and 18 of the final rejection indicates claim 17 is obvious over Dent, Takagi, Pye, Wilcox and Tsao. The brief acknowledges at page 2, line 13, that claim 17 stands finally rejected. Lastly, at page 16, lines 4-8, the answer argues that claim 17 is obvious over Dent, Takagi, Pye, Wilcox and Tsao.

Appeal No. 1999-2381
Application No. 08/586,434

§ 103(a) as being unpatentable over Takagi in view of Wilcox and Tsao.

The respective positions of the examiner and the appellants with regard to the propriety of these rejections are set forth in the examiner's answer (Paper No. 18) and the appellants' brief and reply brief (Paper Nos. 17 and 19, respectively).

Grouping of Claims

At page 7 of the brief, appellants provide the following grouping of claims,

(1) dependent claims 2-5, 8, 9, 12, 14, 15, 17 and 23-35 will rise and fall with independent claim 1,

(2) dependent claims 38, 40 and 46-48 will rise and fall with independent claim 36,

(3) dependent claims 11, 13 and 22 will rise and fall with dependent claim 10, and

(4) dependent claims 39 and 45 will rise and fall with dependent claim 37.

The Rejection under Obviousness-type Double Patenting

Claims 1-15, 20-28, 36-39, 43 and 45

We will not sustain this rejection.

At page 8 of the brief, appellants argue that the

Appeal No. 1999-2381
Application No. 08/586,434

mounting mechanism in Takagi (support bracket 34, 36 of Figure 10) is integrally and rotatably secured to the phone body 4 and that this contrasts with the flip cover of the present invention being rotatably secured to the support bracket assembly as recited in sole independent claims 1 and 36.

This distinction is not addressed by the examiner and we agree with the position taken by appellants. In Takagi, the flip cover 14 is fixed to mounting portions 34, 36, which portions the examiner relies on as the support bracket of claims 1 and 36. Being fixed in position with respect to each other, the flip cover 14 and support bracket 34, 36 of Takagi are not rotatably secured to each other. Whereas the combined teachings of claim 11 of the '433 application and Takagi, and the combined teachings of claim 15 of the '433 application and Takagi do not satisfy all the elements of the sole independent claims 1 and 36, respectively, and the examiner has not established that the missing feature of the teachings relied on would have involved obvious modification thereof, a prima facie case of obviousness-type double patenting has not been made by the examiner³.

³ Claims 11 and 15 of the '433 application, which claims correspond to claims 1 and 36 in issue, teach a flip cover rotatably secured to the top portion of the main housing of

Appeal No. 1999-2381
Application No. 08/586,434

Appellants' argument in the first full paragraph at page 9 of the brief that the issue of double patenting is moot because the '433 application and their application on appeal are commonly owned, and were filed on the same day such that the patents would expire on the same date, is not persuasive because the term of any patent granted on their application on appeal could be extended under 35 U.S.C. § 154(b)(1)(C)(iii). We note that appellants have not filed a terminal disclaimer in this case.

Whereas we will not sustain the rejection of sole independent claims 1 and 36 on the grounds of obviousness-type double patenting, we will not sustain the rejection of dependent claims 2-15, 20-28, 37-39, 43 and 45 for the same reason. The Rejection under 35 U.S.C. § 103

Independent Claim 36

After consideration of the positions and arguments presented by both the examiner and the appellants, we have concluded that this rejection should not be sustained.

As noted above with respect to the rejection of claim 36 on obviousness-type double patenting, the teachings relied on

the portable phone. As such, claims 11 and 15 suffer from the same deficiency as Takagi.

Appeal No. 1999-2381
Application No. 08/586,434

by the examiner in claim 15 of the '433 application and Takagi do not include a mechanism rotatably coupling a flip cover and an end of a support bracket as defined in the claim. Here, neither Takagi nor Wilcox teach such a mechanism. These references teach rotatably coupling a flip cover to the end of the main body of a portable phone.

The Rejection under 35 U.S.C. § 103

Independent Claim 1

We will not sustain the rejection of claim 1. None of the prior art applied against claim 1 teaches a flip cover rotatably secured to a support bracket. As noted in the above discussion of the rejection of claim 36 over Takagi and Wilcox, neither reference teaches a mechanism rotatably coupling a flip cover and an end of a support bracket and the examiner does not rely on Dent or Pye for such a teaching.

The Rejections under 35 U.S.C. § 103

Dependent Claims 2-17, 20, 22-35, 37-40, 43 and 46-48

Whereas we will not sustain the rejections of sole independent claims 1 and 36 as obvious over the prior art, we

will not sustain the obviousness rejections of the above

Appeal No. 1999-2381
Application No. 08/586,434

dependent claims for the same reasons.

REVERSED

STANLEY M. URYNOWICZ, JR.)	
Administrative Patent Judge)	
)	
)	
)	
)	
)	
ERROL A. KRASS)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
)	
JOSEPH F. RUGGIERO)	
Administrative Patent Judge)	

Appeal No. 1999-2381
Application No. 08/586,434

US/RWK

PATENT SPECIALIST
ERICSSON INC
1 TRIANGLE DRIVE
P.O. BOX 13969
RESEARCH TRIANGLE PARK, NC 27709