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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MARKO E. LEINONEN and PERTTI TOIVO KANGAS

Appeal 2010-006638
Application 10/982,469
Technology Center 2600

Before MAHSHID D. SAADAT, BRYAN F. MOORE, and
LYNNE E. PETTIGREW, *Administrative Patent Judges.*

PETTIGREW, *Administrative Patent Judge.*

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134(a) from a final rejection of claims 1, 5-7, 9-11, 24-27, and 35.¹ We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

¹ Claims 2-4, 8, 12-23, 28-34, and 36 have been cancelled.

STATEMENT OF THE CASE

Introduction

Appellants' invention relates to a portable hand-held electronic device and a cover for such a device having a movable section with an antenna.

Claims 1 and 24 are illustrative of the invention:

1. A portable hand-held electronic device comprising:

a first section having electronic circuitry with a ground plane and a first antenna adapted to communicate with a mobile telephone system; and

a second section movably connected to the first section, the second section comprising a second antenna, wherein the second antenna is operably coupled to the electronic circuitry in the first section, and wherein the second antenna is movable with the second section away from the ground plane as the second section is moved relative to the first section.

24. A protective cover for a portable hand-held electronic device comprising:

a first cover section which is sized and shaped to cover at least a portion of the portable hand-held electronic device;

a movable section adapted to move relative to the first cover section at a movable junction;

an antenna connected to the movable section to move with the movable section; and

a connection extending from the antenna through the movable junction for connection to electronic circuitry in the portable hand-held electronic device, wherein the antenna is adapted to be moved away from the first cover section when the movable section is moved away from the first cover section to thereby move the antenna away from a ground plane of the portable hand-held electronic device located inside the first cover section.

Rejections on Appeal

The Examiner rejected claims 1, 5-7, 24, 26, 27, and 35 under 35 U.S.C. § 102(e) as being anticipated by Ito (US 2005/0143151 A1, pub. June 30, 2005, filed Sept. 2, 2004).

The Examiner rejected claims 9-11 and 25 under 35 U.S.C. § 103(a) as unpatentable over Ito and Tseng (US 2002/0027768 A1, pub. Mar. 7, 2002).

Appellants' Contentions

Appellants contend that the Examiner erred in finding that Appellants' declaration under 37 C.F.R. § 1.131 is insufficient to remove Ito as available prior art. App. Br. 5-11. Specifically, Appellants contend that the Examiner erred in finding that the declaration does not establish due diligence by Appellants during the entire period from prior to the September 2, 2004, effective date of Ito until the filing of Appellants' application on November 5, 2004. *Id.*

With respect to the Examiner's rejection under 35 U.S.C. § 102(e), Appellants contend that the Examiner erred in finding that Ito discloses the following claim limitations:

(a) "a cover with a substantially stationary cover section at least partially enclosing the first section of the portable hand-held electronic

device and a second movable cover section,” as recited in claim 5 (App. Br. 12);

(b) “wherein the second movable cover section is adapted to cover over a display of the first section of the portable hand-held device,” as recited in claim 6 (App. Br. 12-13);

(c) “wherein the second movable cover section comprises a flap,” as recited in claim 7 (App. Br. 13); and

(d) “a first cover section which is sized and shaped to cover at least a portion of the portable hand-held electronic device,” as recited in claim 24 (App. Br. 13-14).

With respect to the Examiner’s rejection under 35 U.S.C. § 103(a), Appellants challenge the Examiner’s rationale for combining elements of Ito and Tseng in the manner claimed, alleging that the combination is based on hindsight reasoning. App. Br. 16, 17.

Issues on Appeal

1. Did the Examiner err in finding that Appellants’ declaration under 37 C.F.R. § 1.131 is insufficient to remove Ito as available prior art?
2. Did the Examiner err in finding that Ito discloses the recited limitations in claims 5-7 and 24?
3. Did the Examiner provide a sufficient rationale for combining the references in the rejection under 35 U.S.C. § 103(a)?

ANALYSIS

We have reviewed the Examiner's rejections in light of Appellants' arguments that the Examiner has erred. We are not persuaded by Appellants' arguments, and we concur with the conclusions reached by the Examiner.

Declaration under 37 C.F.R. § 1.131

Under 37 C.F.R. § 1.131, an applicant may submit a declaration to establish invention prior to the effective date of a reference applied in a rejection and thus remove the reference as available prior art. One way in which a declaration may establish prior invention is by a "showing of facts" that is sufficient "in character and weight" to show "conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date . . . to the filing of the application." 37 C.F.R. § 1.131(b). In the declaration, the applicant "must 'account for the entire period during which diligence is required.'" *Creative Compounds, LLC v. Starmark Labs.*, 651 F.3d 1303, 1312-13 (Fed. Cir. 2011) (quoting *Gould v. Schawlow*, 363 F.2d 908, 919 (CCPA 1966)).

Here, the effective date of Ito is September 2, 2004, and Appellants' filing date is November 5, 2004. Thus, in order to antedate Ito, Appellants must establish conception prior to September 2, 2004, and due diligence during the critical period from just before September 2, 2004, until November 5, 2004.

Based on Appellants' declaration, the Examiner finds that Appellants' conception occurred as early as July 10, 2004. Ans. 7. The Examiner also finds that the declaration shows due diligence by Appellants' attorney in preparing and filing the application between October 7, 2004, the date the

invention disclosure was sent to the attorney for drafting the application, and November 5, 2004, the date the application was filed. Ans. 8. The Examiner, however, finds that Appellants' declaration is not sufficient to establish due diligence during the first part of the critical period—from just before September 2, 2004, the effective date of Ito, until October 7, 2004, when Appellants' attorney received instructions to prepare and file an application. Ans. 8-10. Appellants allege error in this finding. App. Br. 10-11; Reply Br. 1-2.

We agree with the Examiner that Appellants' declaration does not provide sufficient evidence of due diligence by Appellants between September 2, 2004, and October 7, 2004. Regarding that time period, the declaration (p. 2) states only the following:

a. a description of the invention was submitted for review by the applicants' employer Nokia Corporation before September 2, 2004 for a determination of whether or not a patent application should be prepared and filed;

b. after a determination was made that a patent application should be prepared and filed, on October 7, 2004 the invention disclosure form was sent by email to applicants' attorney for drafting of the patent application[.]

Appellants argue that they have established due diligence because the time period between September 2, 2004, and October 7, 2004, is less than time periods in other cases in which due diligence was found. App. Br. 11. The number of days, however, is not the determinative factor. Instead, the critical question is whether Appellants have shown sufficient activity during the period or provided reasons for inactivity. *See Hull v. Davenport*, 90 F.2d 103, 105 (CCPA 1937) (“Evidence of diligence during the critical period may be shown either by affirmative acts or acceptable excuses or reasons for

failure of action.”); *see also* *Rebstock v. Flouret*, 191 USPQ 342, 345 (BPAI 1975) (citing *Hull*). As the Examiner correctly finds, Appellants’ declaration fails to explain why their employer required several weeks to decide whether to file a patent application. Ans. 9. For example, the declaration provides no information regarding the employer’s procedures for determining whether to file a patent application or any details as to who reviewed Appellants’ invention disclosure and when. Without more than a bare assertion that the employer was considering whether to file an application, Appellants have not persuaded us that the Examiner erred in finding that Appellants’ declaration does not provide sufficient evidence of diligence from just before September 2, 2004, until October 7, 2004. Accordingly, we conclude that Appellants’ declaration is insufficient to antedate Ito, and therefore Ito is available as prior art against Appellants’ claimed invention.

35 U.S.C. § 102(e) Rejection – Claims 1, 5-7, 24, 26, 27, and 35

With respect to independent claims 1 and 35, Appellants’ only argument is that they have overcome the rejection under 35 U.S.C. § 102(e) by submission of a declaration under 37 C.F.R. § 1.131. App. Br. 11-12. Because we conclude that Appellants’ declaration is insufficient to remove Ito as available prior art, we sustain the Examiner’s rejection of claims 1 and 35 under 35 U.S.C. § 102(e) over Ito.

With respect to Appellants’ arguments that Ito fails to teach certain limitations in the remaining claims rejected under 35 U.S.C. § 102(e), we are not persuaded that the Examiner erred. Based on the broadest reasonable interpretation, the Examiner properly reads the housing of Ito’s device as the cover for the hand-held electronic device. Ans. 10. (We note that Figures

1B and 1C, cited by the Examiner in the rejection, are simplified diagrams that do not show many features of Ito's device, such as a display. *See* Ito, ¶ [0022].) The Examiner identifies two sections of Ito's housing (i.e., cover)—a first cover section that is substantially stationary and at least partially encloses the first section (e.g., the display) of the device, and a second cover section that moves relative to the first cover section, as recited in claim 5. Ans. 4, 10. The second cover section identified by the Examiner also covers over the first section (e.g., the display) of the device, as recited in claim 6, when the device is in the closed position (*see* Fig. 1C of Ito). Ans. 4, 10-11. Further, the second cover section can properly be described as a flap, as recited in claim 7. Ans. 4, 11. We agree with these findings by the Examiner and therefore sustain the Examiner's rejection of claim 5-7 under 35 U.S.C. § 102(e) over Ito.

With respect to claim 24, Appellants argue that the housing in Ito is part of the portable hand-held electronic device and therefore cannot be a protective cover. App. Br. 13. Under a broadest reasonable interpretation, however, the Examiner properly considers Ito's housing to be a cover. Ans. 10. Therefore, the Examiner properly relies on a section of Ito's housing as a first cover section that is sized and shaped to cover at least a portion of the portable hand-held electronic device, as recited in claim 24. Ans. 4, 11. Thus, we sustain the Examiner's rejection of claim 24 under 35 U.S.C. § 102(e) as well as the rejection of dependent claims 26 and 27, for which Appellants have not made separate, detailed arguments.

35 U.S.C. § 103(a) Rejection – Claims 9-11 and 25

Claim 9 recites “wherein the second section comprises a non-metallic frame,” and claim 25 recites “wherein the first cover section and the movable section are comprises [sic] of fabric or leather.” We disagree with Appellants’ conclusion that combining the non-metallic cover of Tseng’s handheld device with Ito’s device to achieve the claimed invention is based on pure hindsight. App. Br. 16, 17. As stated by the Examiner, the purpose of using Tseng in the § 103(a) rejection is to show that non-metallic materials such as leather, molded plastic, or a polymer were used to either provide a cover for a hand-held device or to embed an extra layer of protection in the housing. Ans. 11. We concur with the Examiner’s conclusion that it would have been obvious at the time of Appellants’ invention to combine the teachings of Tseng with Ito’s device in order to provide anti-shock protection. Ans. 12. We therefore sustain the Examiner’s rejection of claims 9 and 25 under 35 U.S.C. § 103(a) over Ito and Tseng. We also sustain the Examiner’s rejection of claims 10 and 11, which depend from claim 9 and for which Appellants have not made separate, detailed arguments.

CONCLUSION

The Examiner did not err in rejecting claims 1, 5-7, 24, 26, 27, and 35 under 35 U.S.C. § 102(e).

The Examiner did not err in rejecting claims 9-11 and 25 under 35 U.S.C. § 103(a).

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DECISION

The Examiner's decision rejecting claims 1, 5-7, 9-11, 24-27, and 35 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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