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BAKER & HOSTETLER LLP WASHINGTON SQUARE, SUITE 1100 1050 CONNECTICUT AVE. N.W. WASHINGTON, DC 20036-5304			PERREAULT, ANDREW D	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ANTHONY REALE

Appeal 2013-002801
Application 11/393,760
Technology Center 3700

Before PHILLIP J. KAUFFMAN, EDWARD A. BROWN, and
MICHAEL C. ASTORINO, *Administrative Patent Judges*.

BROWN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134(a) from the Examiner's decision rejecting claims 1, 3, 4, 6, 9-11, 13, 14, 16, 19, and 20. Reply Br. 2. Claims 2 and 12 were cancelled, and claims 5, 7, 8, 15, 17, 18, and 21 were withdrawn.¹ *Id.* We have jurisdiction over this appeal under 35 U.S.C. § 6(b).

We reverse and enter a NEW GROUND OF REJECTION pursuant to our authority under 37 C.F.R. § 41.50(b).

CLAIMED SUBJECT MATTER

Claims 1 and 11 are the independent claims on appeal. Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. An apparatus for protecting an electronic device, the apparatus comprising:
 - a skeletal frame to at least partially surround the device, with the skeletal frame having projecting external frame members;
 - a resilient body member configured to receive the skeletal frame and at least partially surround the skeletal frame; and
 - wherein the electronic device has a display region and the apparatus provides visibility of the display region.

¹ Appellant requests rejoinder of claims 8 and 18 and contends that both claims were improperly withdrawn by the Examiner subsequent to a restriction requirement. Reply Br. 22. The propriety of a restriction requirement is a petitionable matter reviewable by petition to the Technology Center Director. *See* 37 C.F.R. § 1.144; MPEP §§ 818.03(c), 1002.02(c)(2), and 1201. Petitionable issues are not subject to review by the Board. *See In re Berger*, 279 F.3d 975, 984-85 (Fed. Cir. 2002). Accordingly, we provide no opinion concerning the propriety of the restriction requirement.

REJECTIONS

Appellant requests review of the following rejections:

1. Claims 1, 6, 9, 11, 16, and 19 under 35 U.S.C. § 102(b) as anticipated by Lord (US 7,359,184 B2; iss. Apr. 15, 2008);² and
2. Claims 3, 4, 10, 13, 14, and 20 under 35 U.S.C. § 103(a) as unpatentable over Lord and Richardson (US 7,158,376 B2; iss. Jan. 2, 2007).

ANALYSIS

Rejection of claims 1, 6, 9, 11, 16, and 19 – Lord

Claims 1, 6, and 9

Independent claim 1 is directed to “[a]n apparatus for protecting an electronic device” and recites the limitation “wherein the electronic device has a display region and the apparatus provides visibility of the display region.” The Examiner made two separate findings and interpretations as to how Lord discloses the above limitation. First, in the Final Rejection, the Examiner found that Lord discloses an apparatus (protection device 10 in combination with saddle bag 50) for protecting an electronic device (notebook computer¹²); that the electronic device has a display region in the form of “any surface on the electronic device that is visible in fig. 1”; and that the protection device 10 provides visibility of this display region. Final

² The Examiner rejected claims 1, 6, 9, 11, 16, and 19 under 35 U.S.C. § 102(b); however, Lord has an issue date of April 15, 2008, which is after the March 31, 2006 filing date of the instant application. Relying on the October 31, 2003 filing date of Lord, the proper basis for rejection is under 35 U.S.C. § 102(e). As neither the Examiner nor Appellant has addressed this issue, we consider it harmless error for purposes of this appeal.

Rej. 3, 6. Second, in the Answer, the Examiner found that Lord discloses an apparatus (protection device 10 in combination with saddle bag 50) for protecting an electronic device (security device 40); that the electronic device must have a display region because it includes a proximity sensor that may be armed/disarmed by the entering of a passcode; that a display is absolutely necessarily present in the electronic device to facilitate entering a passcode; and that Figure 1 of Lord shows that the protection device 10 provides visibility of this display of the electronic device. Ans. 5, 6, 8.

Appellant contends that Lord fails to disclose the above limitation of claim 1, regardless of whether the electronic device disclosed by Lord is assumed to be the notebook computer 12 or security device 40. Reply Br. 11-15. Assuming that the claimed electronic device is the notebook computer 12, Appellant contends that, in the field of notebook computers, the term “display” is known to be a computer monitor or similar device. *Id.* at 13. Appellant contends that lateral surface portions 16 of the notebook computer 12 cannot be “display regions” within the meaning of claim 1, because such a finding contradicts the ordinary and understood meaning of the term “display.” *Id.* Thus, Appellant contends that the only “display region” of the notebook computer 12 is its monitor, and Figures 11-13 of Lord show that the notebook computer 12 is in a closed position with its monitor hidden from view while in the protection device 10. *Id.* at 12.

Assuming that the claimed electronic device is the security device 40, Appellant contends that Lord does not disclose that the security device 40 is a display. *Id.* at 14. Appellant contends that Lord only teaches that the security device 40 may include a proximity sensor, and that a proximity sensor is not a display. *Id.*

We agree with Appellant that the Examiner did not make a finding supported by a preponderance of the evidence that Lord discloses that “the electronic device has a display region and the apparatus provides visibility of the display region,” as recited in claim 1. Regarding the Examiner’s first finding discussed *supra*, claim 1 does not recite any specific structure that defines the phrase “display region.” The Patent and Trademark Office determines the scope of the claims “not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction ‘in light of the specification as it would be interpreted by one of ordinary skill in the art.’” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316-17 (Fed. Cir. 2005). We note that the Specification only appears to refer to a tablet PC “having a large touch screen display” as an example of an electronic device having a display region. Spec. 4, para. [0033]. An ordinary meaning of “display” is structure that “presents information in visual form.” MERRIAM-WEBSTER’S COLLEGIATE DICTIONARY 361 (11th ed. 2003). Applying this ordinary meaning when interpreting claim 1, “the electronic device has a display region” should be interpreted to mean that an area of the electronic device has structure that presents information in visual form.

Lord discloses that the protection device 10 has a plurality of openings 14 permitting visual access to lateral portions 16 of a notebook computer 12 received within the protection device. *See* Lord, col. 2, ll. 46-49. The Examiner did not find that the visible lateral portions 16 of the notebook computer present information in visual form. *See* Final Rej. 3, 6. Applying the ordinary meaning of “display region,” we agree with Appellant that the Examiner’s interpretation of this term in claim 1 is unreasonably broad. *See* Reply Br. 13. Thus, the Examiner did not make a finding

supported by a preponderance of the evidence that “any surface on the electronic device that is visible in fig. 1” of Lord is a display region, and that the apparatus of Lord provides visibility of a display region.

Regarding the Examiner’s second finding discussed *supra*, Lord discloses that the protection device 10 may include a security device 40; that the security device 40 may include a proximity sensor; and that the proximity sensor may be armed/disarmed by an IR programming device, by the entering of a passcode, or other suitable activation device. *See* Lord, col. 3, ll. 7-13. Lord fails to disclose that the security device 40 generally, or the proximity sensor specifically, has a display region, as claimed. *Id.* Lord fails to disclose that the entering of a passcode necessarily requires any part of the security device 40 to have a display region, and the Examiner has not provided any other evidence to support this finding. *See id.* Thus, the Examiner’s second finding that Lord discloses an electronic device having a display region is also not supported by a preponderance of the evidence. Therefore, we do not sustain the rejection of claim 1, and its dependent claims 6 and 9.

Claims 11, 16, and 19

Claim 11 is directed to an apparatus for protecting an electronic device similar to the apparatus recited in claim 1. The Examiner’s findings and conclusions (Final Rej. 3, 6; Ans. 5, 6, 8) and Appellant’s arguments (Reply Br. 11-15) regarding Lord in relation to claim 11 are the same as those discussed *supra* for claim 1. Thus, we do not sustain the rejection of claim 11, and its dependent claims 16 and 19.

Rejection of claims 3, 4, 10, 13, 14, and 20 – Lord and Richardson

Claims 3, 4, 10, 13, 14, and 20 depend from either claim 1 or claim 11. The Examiner's findings and conclusions (Final Rej. 4-6; Ans. 6, 7) and Appellant's arguments (Reply Br. 18-21) regarding Lord in relation to these dependent claims are the same as those discussed *supra* for claims 1 and 11. The Examiner's application of Richardson does not cure the deficiencies of Lord discussed *supra*. See Final Rej. 4-6; Ans. 6, 7. Thus, we do not sustain the rejection of claims 3, 4, 10, 13, 14, and 20.

New ground of rejection of claims 1 and 11 under 35 U.S.C. § 102(e) as anticipated by Lord, and further evidenced by Ouchi (US 5,796,577; iss. Aug. 18, 1998) or Hollon (US 5,768,164; iss. Jun. 16, 1998).³

Claim 1

Lord discloses an apparatus comprising: a skeletal frame (protection device 10), with the skeletal frame having projecting external frame members (body extensions 20); and a resilient body member (saddle bag 50) configured to receive the skeletal frame and at least partially surround the skeletal frame. See Lord, col. 2, ll. 41-52, col. 3, ll. 26-29, and figs. 1, 14, 15. Appellant did not challenge the Examiner's finding that an electronic

³ The Patent Trial and Appeal Board is a review body, rather than a place of initial examination. We have entered a new ground of rejection of independent claims 1 and 11. However, we have not reviewed claims 3, 4, 6, 9, 10, 13, 14, 16, 19, and 20 to the extent necessary to determine whether these claims are unpatentable over Lord and/or Richardson, or any other prior art. In the event of further prosecution, we leave it to the Examiner to determine the patentability of these dependent claims in light of our findings and conclusions herein. Our decision not to enter a new ground of rejection for all appealed claims should not be considered as an indication regarding the appropriateness of allowance of the non-rejected claims.

device having a display region is not positively recited in claim 1 (i.e., that an electronic device having a display region is not an element of the claimed apparatus). Final Rej. 6. We construe claim 1 as only requiring that the skeletal frame be *capable of* at least partially surrounding an electronic device, and *capable of* providing visibility of a display region of the electronic device partially surrounded by the skeletal frame.

We note that Lord discloses that the protection device is preferably comprised of a translucent material permitting a visual inspection of substantially all of a notebook computer when the computer is received within the protection device. *See* Lord, col. 2, ll. 5-8. Ouchi provides evidence that, before the time of Appellant's invention, a notebook computer having a display device formed on an outer surface of the notebook was known. *See* Ouchi, Abstract; fig. 3 (showing second display device 70). Hollon provides additional evidence that, before the time of Appellant's invention, a portable computer including a display on the outer cover of the notebook that is visible to the user when the portable computer is closed also was known. *See* Hollon, Abstract; fig. 2 (showing spontaneous use display 39); col. 2, ll. 51-53). In light of this evidence, we find that the apparatus of Lord is capable of providing visibility of a display region of an electronic device as recited in claim 1 when, for example, a computer, such as one disclosed by Ouchi or Hollon, is received within the protection device of Lord's apparatus. Thus, Lord supports a *prima facie* case of anticipation of claim 1. Where the Patent and Trademark Office has reason to believe that a claimed functional limitation is an inherent characteristic of the prior art, the burden is shifted to Appellant to show that the prior art does not possess that characteristic. *See In re Best*, 562 F.2d 1252, 1254-55 (CCPA 1977)

(quoting *In re Swinehart*, 439 F.2d 210, 212-13 (CCPA 1971)); *see also In re Spada*, 911 F.2d 705, 708 (Fed. Cir. 1990) ("[W]hen the PTO shows sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not."). Therefore, we enter a new ground of rejection of claim 1 under 35 U.S.C. § 102(e), and in responding to the rejection, Appellant will have the burden to show that Lord's apparatus is not capable of providing visibility of a display region of the electronic device partially surrounded by the skeletal frame.

Claim 11

Lord discloses an apparatus comprising: attaching means (protection device 10) for attaching to and at least partially surrounding an electronic device, and having projecting external frame members (body extensions 20); and a resilient body member (saddle bag 50) configured to receive the skeletal frame and at least partially surround the skeletal frame. *See* Lord, col. 2, ll. 41-52, col. 3, ll. 26-29; figs. 1, 14, 15. For reasons similar to those described *supra* regarding the new ground of rejection of claim 1, we also enter a new ground of rejection of claim 11 under 35 U.S.C. § 102(e).

DECISION

The Examiner's decision rejecting claims 1, 3, 4, 6, 9-11, 13, 14, 16, 19, and 20 is REVERSED.

This decision also contains a NEW GROUND OF REJECTION of claims 1 and 11 pursuant to 37 C.F.R. § 41.50(b), which provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review." 37 C.F.R. § 41.50(b) also provides that Appellant,

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WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options *with respect to the new ground of rejection* to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

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

REVERSED; 37 C.F.R. § 41.50(b)

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Notice of References Cited	Application/Control No. 11/393,760	Appeal No. 2013-002801	
	Examiner Perreault, Andrew	Art Unit 3788	Page 1 of 1

U.S. PATENT DOCUMENTS

*	Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
*	A US-5,796,577	08-1998	Ouchi	361/38.1
*	B US-5,768,164	06-1998	Hollon	364/710.14
C				
D				
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