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Table with 5 columns: APPLICATION NO., FILING DATE, FIRST NAMED INVENTOR, ATTORNEY DOCKET NO., CONFIRMATION NO.
13/413,606 03/06/2012 Scott Wilson 002009 P0065 1534

77093 7590 12/02/2016
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EXAMINER

BUI, LUAN KIM

ART UNIT PAPER NUMBER

3728

NOTIFICATION DATE DELIVERY MODE

12/02/2016

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte SCOTT WILSON, DUSTIN BROWN, JON
GODSTON, WILLIAM WELCH, and JOHN HONG

Appeal 2014-009108
Application 13/413,606
Technology Center 3700

Before ANNETTE R. REIMERS, JILL D. HILL, and GORDON D.
KINDER, *Administrative Patent Judges*.

KINDER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

Appellants¹ appeal under 35 U.S.C. § 134 from a rejection of claims
1–17. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

¹ Appellants state that the real party in interest is UNCOMMON LLC.
Appeal Br. 1.

CLAIMED SUBJECT MATTER

The claims are directed to a one-piece protective carrying case. Claims 1, 9, and 17 are independent. Claim 1, reproduced below, illustrates the claimed subject matter:

1. A protective case for a portable electronic device, the case comprising:
 - a body section formed of a first material and having a back surface and upturned sides extending from the back surface;
 - a distinct rim separately formed of a second material and defining an open area; and
 - a bond formed between the first material of the body section and the second material of the rim;wherein the body section forms a cavity defined by the back surface and upturned sides, and at least a portion of the distinct rim forms an overhang to the cavity to facilitate securing of an electronic device within the case.

REFERENCES

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Artzt	US 4,238,033	Dec. 9, 1980
Richardson	US 7,933,122 B2	Apr. 26, 2011
Lin	US 2008/0308437 A1	Dec. 18, 2008
Emsky	US 2009/0230161 A1	Sept. 17, 2009
Bau	US 2010/0096284 A1	Apr. 22, 2010
Johnson	US 2011/0259771 A1	Oct. 27, 2011

REJECTIONS

The Examiner made the following rejections:

1. Claims 1, 2, and 4 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Artzt.

2. Claim 1–4 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Emsky or Johnson or Lin in view of Artzt.

3. Claim 5–17 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Emsky or Johnson or Lin in view of Artzt and further in view of Bau or Richardson.²

OPINION

First Rejection.

A. Inherency. Appellants argue the anticipation rejection of claims 1, 2, and 4 together. We select claim 1 as representative and claims 2 and 4 stand or fall with claim 1. 37 C.F.R. § 41.37(c)(1)(iv).

Appellants argue first that the Examiner has misapplied the inherency doctrine in rejecting claim 1 as anticipated by Artzt. Appeal Br. 9–12. The Examiner found that the case disclosed by Artzt “is inherently capable for [sic] a portable electronic device.” Non-Final Act. 3. We do not take this as invoking the inherency doctrine under which the implicit and inherent disclosures of a prior art reference may be relied upon in the rejection of claims under 35 U.S.C. §§ 102 or 103. Instead, we take this as a statement of how the case disclosed by Artzt may be used to hold anything that fits inside, including a portable electronic device.

Appellants argue that the Examiner has injected an undisclosed, but inherent element into the prior art to form the basis of a rejection, and specifically that the Examiner has added a portable electronic device to the

² The Non-Final Action mailed September 10, 2013, also rejected claims 1 – 16 under 35 U.S.C. §112, second paragraph. That rejection is withdrawn. Ans. 3.

disclosure of Artzt. Appeal Br. 10. The Examiner replies that the recitation in claim 1 of a portable electronic device is a statement of intended use and that any prior art device that is capable of the claimed intended use anticipates such a claim limitation. Ans. 3. We are not persuaded by Appellants that the Examiner erred because, although the Examiner used the word “inherently,” it was not done to interpolate a missing, but inferable, disclosure. Instead the plain meaning of the rejection was that the Artzt case was capable of receiving and containing an electronic device.

B. Sides. In the Non-Final Action rejecting claim 1 as anticipated, the Examiner finds that Artzt discloses a “case comprising a body section (11) formed of a first material and having a back surface (14) and upturned sides (13) extending from the back surface.” Non-Final Act. 3. Appellants’ Reply Brief argues that Artzt does not disclose plural sides because the case of Artzt is cylindrical and has only one side. Reply Br. 2–3. This argument was not raised in Appellants’ Appeal Brief, is not responsive to an argument raised in the Examiner’s Answer, and no good cause is shown why we should consider it when first raised in the Reply Brief. 37 C.F.R. § 41.41 (b)(2). Deciding such an issue precludes meaningful judicial review, and we decline to consider it now. Accordingly, we are not persuaded the Examiner erred in Rejection I.

Second Rejection.

Appellants argue together the rejection of claims 1–4 as obvious. We select claim 1 as representative and claims 2–4 stand or fall with claim 1. 37 C.F.R. § 41.37(c)(1)(iv).

Appellants argue that the rejection of claim 1 as obvious over Emsky or Johnson or Lin in view of Artzt should be reversed. Appeal Br. 12–18. Appellants allege various shortcomings of the individual primary references, arguments we need not address because these arguments do not address the combination relied on by the Examiner. Appeal Br. 12–16. *See In re Merck & Co. Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986).

Appellants argue that none of the three primary references discusses bonding two materials to make a finished product and that Artzt cannot be used to make up this deficiency because Artzt is non-analogous art. Appeal Br. 16–17. The Examiner finds Artzt discloses “a case (10) comprising a body section (11) formed of a first material and having a back surface (14) and upturned sides (13) extending from the back surface, a distinct rim (16) separately formed of a second material and defining an open area, and a bond (column 4, lines 19–26) formed between the body section of the first material and the rim of the second material.” Non-Final Act. 5.

Specifically, Artzt discloses

The container **11** has an opening **15** at the top thereof, and a generally circular rim **16** extends around each such opening **15**. The rim **16** is also preferably formed of a plastic resin and may be molded integrally with cylindrical sidewall **13** or formed separately from the latter and then permanently joined to the upper edge portion of the side wall **13** as by heat and pressure or a suitably permanent adhesive.

Artzt 4:19–26.

The Examiner further responds that “Artzt teaches the [sic, a] case for holding contents which is in the field of Appellant’s endeavor and is considered as analogous art.” Ans. 7.

Prior art is analogous and can be applied in an obviousness combination if it either (1) “is from the same field of endeavor, regardless of the problem addressed” or (2) “is reasonably pertinent to the particular problem with which the inventor is involved.” *In re Clay*, 966 F.2d 656, 658–59 (Fed. Cir. 1992). To determine if art is analogous, we look to “the purposes of both the invention and the prior art.” *Id.* at 659. If a reference disclosure and the claimed invention have a same purpose, the reference relates to the same problem, which supports an obviousness rejection. *Id.*

Unwired Planet, LLC v. Google, Inc., 2016 WL 6694955, Case Nos. 2015-1810, 2015-1811 (Fed. Cir. Nov. 15, 2016), slip op. 4.

We agree with the Examiner that the field of endeavor is the design of “case[s] for holding contents,” that both Artzt and Appellants are engaged in this field, and that Artzt is analogous art. (Ans. 6–7) We reach this conclusion because both address the problem of making a case for holding an article, and because the manufacturing process described by Artzt (“permanently joined to the upper edge portion of the side wall **13** as by heat and pressure or a suitably permanent adhesive” (Artzt 4:24–26)) is reasonably pertinent to the particular problem confronted by the Appellants. Appellants’ BACKGROUND OF THE INVENTION describes the field of endeavor as producing “thermoformed items having details disposed on one or both sides of the item, using plastic or other suitable material.” Specification ¶ 3. Lin specifically mentions making a computer case by

molding plastic. Lin ¶ 9.³ The Appellants' Specification and Lin thus support the Examiner's finding, with which we agree, that the applicable field of endeavor is the broad field of making a case for holding an article. Accordingly, we find Artzt to be analogous, and therefore relevant to the obviousness of claim 1.

Appellants do not challenge that Artzt, if properly combinable with any of the three primary references, fills the gap, teaching a distinct rim that may be molded integrally with a body section of formed separately and bonded to the body section. Appeal Br. 12–18, Reply 3–5; *see also* Non-Final Act. 4–5. Accordingly, we have not been shown error in Rejection 2.

Third Rejection.

Appellants first incorporate the arguments made in connection with the Second Rejection, above. Appeal Br. 18. As indicated, we were not persuaded by these arguments and find no Examiner error in Rejection 2.

Appellants argue that the added references (Bau and Richardson) do not teach a distinct rim, a bond formed between the rim and the body sections, or a bond created to mask imperfections at the edge of the body sections. *Id.* The Examiner answers that these two references are relied on only for teaching an image transferred onto at least the portion of the protective case. Ans. 7. Appellants provide no argument in support of their assertion that neither Bau nor Richardson discloses “a bond created to mask imperfections at the edge of the body sections.” Appeal Br. 18. 37 C.F.R. §

³ Richardson, although not cited against these claims, describes a case for an electronic device that may be molded (5:67–6:5) from plural materials (3:58–61).

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41.37(c)(1)(vii) requires more substantive arguments in an appeal brief than a mere recitation of the claim elements and a naked assertion that the corresponding elements were not found in the prior art. *See In re Lovin*, 652 F.3d 1349, 1357 (Fed. Cir. 2011). Accordingly we are not persuaded the Examiner erred in Rejection 3.

DECISION

For the above reasons, the Examiner's rejection of claims 1–17 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