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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JEFFREY D. CARNEVALI

Appeal 2014-009509
Application 11/711,418
Technology Center 3600

Before JOHN C. KERINS, WILLIAM A. CAPP, and
ARTHUR M. PESLAK, *Administrative Patent Judges*.

PESLAK, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Jeffrey D. Carnevali (“Appellant”) appeals under 35 U.S.C. § 134(a) from the Examiner’s non-final decision rejecting claims 1–21. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM-IN-PART.

THE CLAIMED SUBJECT MATTER

Claim 1, reproduced below, is illustrative of the claimed subject matter.

1. A flexible portable device mount apparatus, the apparatus comprising:

a frame structured for being coupled to an external mounting device, the frame comprising: a mounting surface and a plurality of first and second passages provided adjacent to each of opposing side edges thereof;

a plurality of substantially resiliently flexible clamps each comprising a leg portion, a finger portion extended from the leg portion, and a substantially resiliently flexible urging portion coupled between the leg portion and the finger portion; and

coupling means operating between different ones of the first and second passages of the frame and the leg portion of each of different ones of the clamps for coupling the leg portion relative to the mounting surface.

REJECTIONS

- 1) Claims 1–8 are rejected under 35 U.S.C. § 103(a) as unpatentable over Carnevali '458 (US 7,551,458 B2, iss. June 23, 2009) and Carnevali '583 (US 2007/0022583 A1, iss. Feb. 1, 2007).
- 2) Claims 9–14 are rejected under 35 U.S.C. § 103(a) as unpatentable over Carnevali '583.
- 3) Claims 15–21 are rejected under 35 U.S.C. § 103(a) as unpatentable over Carnevali '583 and Carnevali '458.

DISCUSSION

Rejection 1

Appellant argues Claims 1–8 as a group. Appeal Br. 8–10. Pursuant to 37 C.F.R. § 41.37(c)(iv), we select claim 1 to decide this rejection. Claims 2–8 stand or fall with claim 1.

The Examiner finds that Carnevali ‘458 discloses the limitations of claim 1 except the “plurality of substantially resiliently flexible clamps” with the “substantially resiliently flexible urging portion.” Non-final Act. 3. The Examiner finds that Carnevali ‘583 discloses “a resiliently flexible jaw structure, which can also be read as a clamp” that has “leg portion (124), finger portion (213) and an urging portion (235).” *Id.* The Examiner concludes it would have been obvious to “combine the teaching of Carnevali ‘458 with Carnevali ‘583 for the purpose of automatically securing items of various sizes. Springs and/or urging members allow for continual adjustability, versus incremental adjustability Carnevali ‘458.” *Id.*

Appellant contends that Carnevali ‘458 teaches away from having a “resiliently flexible urging portion” because it discloses posts 44 fixed in a permanent position with sufficient clearance between the posts for easy insertion and removal of an apparatus. Appeal Br. 9 citing Carnevali ‘458, col. 6, ll. 40-48, Fig. 1. Appellant admits that Carnevali ‘458 does “not overtly argue against urging of flexible clamps” but “clearly **inherently teaches away** from the ‘resiliently flexible urging portion’ between upright post 52 and foot structure 38 at least because ‘resiliently urging’ upright post 52 relative to foot structure 48 would **necessarily** reduce or eliminate ‘clearance’ between posts 44 whereby such ‘sufficient clearance’ for such

‘easy insertion and removal’ would be **destroyed**.” Reply Br. 3. For the following reasons, we sustain the rejection.

When a prior art reference discloses a different solution to a similar problem, it does not teach away from the claimed subject matter unless the prior art reference also criticizes, discredits or otherwise discourages the solution claimed. *See Crocs, Inc. v. U.S. International Trade Commission*, 598 F.3d 1294, 1308 (Fed. Cir. 2010)(Prior art taught away by specifically discouraging use of foam straps.); *In re Fulton*, 391 F. 3d 1195, 1201 (Fed. Cir. 2004). Appellant does not direct us to any specific portion of Carnevali ‘458 where the use of resilient flexible urging members is discouraged. In fact, Appellant admits there is no overt disclosure discouraging use of a resilient flexible urging member. Appellant’s teaching away argument is thus, not persuasive.

Appellant fails to persuasively apprise us of error in the Examiner’s factual findings or rationale, quoted above, for the combination of Carnevali ‘458 and Carnevali ‘583, which we determine to be reasonable and supported by the disclosure in the cited references. *See KSR Intern. Co. v Teleflex Inc.*, 550 US 398, 416 (2007) (“[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.”). We thus, sustain the rejection of claims 1–8 under 35 U.S.C. § 103(a).

Rejection 2

The Examiner finds that Figure 5 of Carnevali ‘583 discloses the limitations of claim 9 except for the recited “plurality of means for resiliently clamping an external object . . .” Final Act. 5. The Examiner specifically finds that Figure 5 discloses “a **mounting surface (the planar**

top portions of elements 17 and 19).” *Id.* The Examiner finds that Figure 10 of Carnevali ‘583 discloses “a **plurality of means (213 and 214)** for resiliently clamping an external object . . . each of the **plurality of clamping (213 and 214)** means comprising an operational clamping surface inclined toward the mounting surface and a means for **resiliently urging (235) the inclined operational clamping . . . surface** toward the mounting surface; and **coupling means 325.**” *Id.* at 6. The Examiner concludes it would have been obvious “to combine the teaching of Figure 1/embodiment 1 with the resilient urging clamps in Figure 10/embodiment 10 for the purpose of accommodating electronic devices with slightly different widths.” *Id.*

Appellants contend that the Examiner’s finding that Carnevali ‘583 discloses a frame (10) is erroneous because item 10 is the entire assembly in Carnevali’s ‘583’s Figure 1 and the Examiner’s argument regarding the “frame” element is unclear. *Id.* at 12. The Examiner responds that a definition of “frame” as “something composed of parts fitted together and united” was provided. Ans. 3; Non-final Act. 5. For the following reasons, we do not sustain the rejection.

Carnevali ‘583 discloses “a releaseably-clamped universal cradle apparatus 10 that is structured for securely receiving different larger or irregularly shaped devices.” Carnevali ‘583, ¶28, *see also* Fig. 1. Apparatus 10 includes “a pair of opposing jaw structures 13, 14 that are structured to cooperate for securely releaseably cradling different larger or irregularly shaped devices.” *Id.* Apparatus 10 also includes “an elongated male drive shaft 17 and a mating elongated female drive frame 19.” *Id.*

Claim 9 recites, *inter alia*, “a substantially rigid frame . . . having a mounting surface formed thereon between first and second opposing side edges.” Appeal Br. 27 (Claims App.). Element 10 of Carnevali ‘583 includes jaw structures 13 and 14 which extend vertically upward from the planar top portion of elements 17 and 19. Element 10 also extends vertically downward toward the bottom surface of element 19. The planar top portion of elements 17 and 19 is internal to element 10. Thus, the Examiner’s finding that the planar top portion of elements 17 and 19 is “a mounting surface formed” on the frame is not supported by a preponderance of the evidence. As the rejection of claim 9 is based on an erroneous factual finding, the conclusion of obviousness cannot stand. *See In re Warner*, 379 F.2d 1011, 1017 (CCPA 1967). We do not sustain the rejection of claim 9 and claims 10–14 which are dependent on claim 9.

Rejection 3

The Examiner finds that Carnevali ‘583 discloses the limitations of claim 15 except for “a plurality of first and second substantially parallel slots . . . and coupling means operating between different ones of the first and second slots of the frame.” Non-final Act. 7–8. The Examiner finds that Carnevali ‘458 discloses parallel slots 60 and concludes it would have been obvious “to combine the teaching of Carnevali (‘583) with Carnevali (‘458) of having multiply [sic] means of securing an electronic device.” *Id.* at 8.

Appellants contend that the Examiner’s finding that Carnevali ‘583 discloses a frame (10) is erroneous because item 10 is the entire assembly in Carnevali’s ‘583’s Figure 1 and the Examiner’s argument regarding the “frame” element is unclear. Appeal Br. 16–17. Appellants next contend that Carnevali ‘583 does not disclose the recited coupling means between the

frame and the clamps because the embodiments in Figure 1 and Figures 7–10 of Carnevali ‘583 disclose clamps that are integral with the frame and there is no coupling means between them. *Id.* at 19–21. The Examiner responds that Figure 10 of Carnevali ‘583 “teaches a coupling means 325.” Ans. 4. For the following reasons, we do not sustain the rejection.

Claim 15 recites, *inter alia*, “the frame comprising . . . a plurality of first and second substantially parallel slots” and “coupling means operating between different ones of the first and second slots of the frame and the leg portion of each of different ones of the clamps for coupling the leg portion relative to the mounting surface.” Appeal Br. 28 (Claims App.). Although the Examiner finds that Carnevali ‘458 discloses parallel slots 60, the Examiner does not explain where the parallel slots would be placed in the frame of Carnevali ‘583 when Carnevali ‘583 is combined with Carnevali ‘483. In Figure 10 of Carnevali ‘583, the Examiner points to a single coupling means 325 that couples the leg portions of two resiliently flexible clamps to the mounting surface. The Examiner does not explain how coupling means 325 would operate, in the proposed combination, between different ones of the first and second slots of the frame and the leg portion of each of different ones of the clamps as recited in claim 15. For the foregoing reasons, the rejection of claim 15 is not supported by rational underpinnings. We, thus, do not sustain the rejection of claim 15 and dependent claims 16–21.

DECISION

The Examiner’s decision rejecting claims 1–8 is affirmed.

The Examiner’s decision rejecting claims 9–21 is reversed.

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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).

AFFIRMED-IN-PART