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. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

*Ex parte* MICHAEL OVERY and SEAN PRIOR

Appeal No. 2000-0267
Application No. 08/856,943

ON BRIEF

Before BARRETT, GROSS, and BARRY, *Administrative Patent Judges*.
BARRY, *Administrative Patent Judge*.

## DECISION ON APPEAL

The examiner rejected the appellants' claims 22-34. They appeal therefrom under 35 U.S.C. § 134(a). We affirm-in-part.

## BACKGROUND

The appellants' invention is a holder for a cellular telephone that recharges the telephone's battery. Conventional holders also supply a current to recharge the battery of a stored telephone. Electrical contact between the

holder’s current supply and the telephone’s battery is achieved by placing the telephone in the holder. Heretofore, the weight of the telephone has been sufficient to ensure contact between a spring contact in the bottom of the holder and a fixed contact on the bottom of the telephone. As cellular telephones have become lighter, however, the contact achieved by gravity has become less reliable.

The appellants’ cellular telephone holder features a cradle with a spring contact. A lug protrudes from the rear wall of the cradle and fits in a slot in the telephone. A spring contact in the bottom of the holder biases the telephone in a direction to retain the lug in the slot, thereby holding the telephone in the cradle. The telephone can be removed, however, by pressing down against the bias of the spring contact and disengaging the lug from the slot.

Claim 23, which is representative for present purposes, follows:

> 23. A holder for charging a radio telephone battery disposed within a housing, comprising a cradle member, means for supplying charging current

> for charging the battery, an electrical contact disposed to allow electrical contact between the battery and the means for supplying charging current on positioning the housing in the cradle member, an element disposed on the cradle member for cooperating in abutting relation with a complementary element fixed in relation to the housing, and for releasably locking the housing relative to the cradle member in such a position that electrical contact between the battery and the means for supplying charging current is maintained, wherein the abutting relation is maintained by a spring bias of the holder and the element disposed on the cradle member is sized and shaped such that the housing must be displaced against the spring bias to disengage the housing from the element disposed on the cradle member.

(Appeal Br. at i-ii.)

The prior art applied by the examiner in rejecting the claims follows:

Tomura et al. 5,189,358 Feb. 23, 1993

Mattinger et al. (“Mattinger”), Translation of European Patent No. 0,341,395, Feb. 17, 1993.

Claims 22-34 stand rejected under 35 U.S.C. § 102(b) as anticipated by Tomura et al. The claims also stand rejected under 35 U.S.C. § 103(a) as obvious over Mattinger in view of Tomura et al.

OPINION

After considering the record, we are persuaded that the examiner erred in rejecting claims 22-34 as anticipated and in rejecting claims 22 and 26-34 as obvious. We are also persuaded that he did not err in rejecting claims 23-25 as obvious. Accordingly, we affirm-in-part.

Rather than reiterate the positions of the examiner or appellants *in toto*, we address their points of contention. We begin with a point that concerns all the claims. The appellants argue, “Mattinger et al. (EP 0341395) is directed to an electric hair cutter. This is not analogous art.” (Appeal Br. at 7.) The examiner answers, “cell-phones and heir [sic] cutters are considered as common house hold [sic] devices, they both require charging and support, one skilled in the art could easily apply the support feature of a cell phone to the cutter, or vice versa.” (Examiner’s Answer at 11.) He adds, “[i]n fact, Mattering is submitted by appellant due to a search report for a foreign patent application.” (*Id.*)

"Two criteria have evolved for determining whether prior art is analogous: (1) whether the art is from the same field of endeavor, regardless of the problem addressed, and (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved." *In re Clay*, 966 F.2d 656, 658-59, 23 USPQ2d 1058, 1060 (Fed. Cir. 1992)(citing *In re Deminski*, 796 F.2d 436, 442, 230 USPQ 313, 315 (Fed. Cir. 1986); *In re Wood*, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979)). "[A] reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem . . . . If a reference disclosure has the same purpose as the claimed invention, the reference relates to the same problem, and that fact supports use of that reference in an obviousness rejection." *Id.* at 659, 23 USPQ2d at 1061.

Regarding the second criterion, a problem with which the appellants are involved is that of recharging a battery. Specifically, "[t]he invention relates to a holder that performs the dual functions of storing and **recharging a battery** . . . ." (Spec. at 1 (emphasis added).) A problem that Mattinger solves also relates to recharging a battery. Specifically, "the battery is charged." P. 2. Because the inventions of the appellants and the reference both solve the problem of recharging a battery, Mattinger is analogous art.

Having addressed the point of contention that concerns all the claims, we address the points that concern the following, logical groups of claims:

- claims 22 and 29-31
- claims 23-25
- claims 26-28
- claims 32-34.

We begin with the first group of claims.

## I. Claims 22 and 29-31

The examiner asserts, "Tomura's lug (218) is projecting into the receiving compartment. Also, notice that the spring contact (236) is in the receiving compartment (see Figs. 16-17).
Therefore, Tomura's lug (218) is also projecting toward the spring contact (236)." (Examiner's Answer at 7.) He further asserts, “viewing from the spring (116) toward the loop (111) it appears that Mattering's loop (111) is projecting away from the spring (116). However, if viewing from the loop (111) toward the spring (116), then the loop (111) can be considered as projecting toward the spring ( 116).” (*Id.* at 11.) The appellants argue, "[t]he drawings in Tomura et al. do not disclose or suggest the lug (218) projecting downward towards the spring." (Reply Br. at 1.) They further argue, “[i]n Mattinger et al. the loop (111) projects away from the spring contacts (116, 117).” (Appeal Br. at 9.)

In deciding anticipation, “the first inquiry must be into exactly what the claims define.” *In re Wilder*, 429 F2d 447, 450, 166 USPQ 545, 548 (CCPA 1970). Similarly, in deciding

obviousness, “[a]nalysis begins with a key legal question -- *what* is the invention *claimed*?” *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1567, 1 USPQ2d 1593, 1597 (Fed. Cir. 1987).

Here, claim 22 specifies in pertinent part the following limitations: a "peg section protrudes from a wall of the receiving compartment in an angled direction generally towards the spring contact . . . ." Similarly, claim 29 specifies in pertinent part the following limitations: an "element on the cradle member being angled towards a bottom of a housing receiving area of the cradle member . . . .” Accordingly, claims 22 and 29 require *inter alia* an element of a receiving compartment protruding generally toward a spring contact or toward a bottom of the compartment, respectively.

Starting with the anticipation rejection, “having ascertained exactly what subject matter is being claimed, the next inquiry must be into whether such subject matter is novel.” *Wilder*, 429 F2d at 450, 166 USPQ at 548. “A claim is

anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (citing *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 715, 223 USPQ 1264, 1270 (Fed. Cir. 1984); *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983); *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 771, 218 USPQ 781, 789 (Fed. Cir. 1983)).

Here, although Tomura discloses that "a lug 218 for fitting into a retaining slot of the portable telephone is formed on an upper rear end side 212a of the upper case 212," col. 8, ll. 23-25, the lug protrudes neither toward the reference's "charging terminals 236," *id.* at l. 44, nor toward its "recess 216 for fitting therein of [sic] a swelled bottom of a large-capacity battery pack . . . ." *Id.* at ll. 17-19. To the contrary, Tomura depicts the lug 218 as protruding generally perpendicular to the charging terminals 236 and generally parallel to the recess 216. Figs. 16 and 17.

Because Tomura's lug protrudes generally perpendicular to its charging terminals and generally parallel to its recess, we are not persuaded that the reference discloses the limitations of a "peg section [that] protrudes from a wall of the receiving compartment in an angled direction generally towards the spring contact" or an "element on the cradle member being angled towards a bottom of a housing receiving area of the cradle member . . . ." Therefore, we reverse the anticipation rejection of claim 22, of claim 29, and of claims 30 and 31, which depend from claim 29.

Turning to the obviousness rejection, the next inquiry is whether the subject matter is obvious. "In rejecting claims under 35 U.S.C. Section 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness." *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993)(citing *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992)). "'A *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject

matter to a person of ordinary skill in the art.'" *In re Bell*, 991 F.2d 781, 782, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993)(quoting *In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976)).

Here, the examiner fails to show that Mattering cures the defect of Tomura. Although Mattering discloses "a catch loop 111 of the adapter," p. 13, the catch loop protrudes neither toward the reference's "contact springs 116, 117," *id.*, nor toward its "indentation 102, into which the hair cutting machine 103 can be inserted." *Id.* at 12. To the contrary, Mattering depicts the catch loop 111 as angled away from the contact springs 116, 117 and from the indentation 102. Figs. 15, 17.

Because Tomura's lug protrudes generally perpendicular to its charging terminals and generally parallel to its recess, and Mattering's loop is angled away from its contact springs and indentation, we are not persuaded that the teachings from the applied prior art would have suggested the limitations of

a "peg section [that] protrudes from a wall of the receiving compartment in an angled direction generally towards the spring contact" or an "element on the cradle member being angled towards a bottom of a housing receiving area of the cradle member . . . ." Therefore, we reverse the obviousness rejection of claim 22, of claim 29, and of claims 30 and 31, which depend from claim 29. We proceed to the second group of claims.

## II. Claims 23-25

The examiner asserts, "according to Tomura's Figs. 16-17, the phone can be removed by first removing the speaker end of the phone. As the speaker end of the phone is pulled upward, the phone pivots at lug (218), then the microphone end of the phone is forced downward, in turn pushing, or deflecting the spring (236) down . . . ." (Examiner's Answer at 8.) He further asserts, "as the end part (Mattering and [sic] 118) is moved outward, the spring (116) is deflected to allow the peg section (111) to be disengaged with the slot (108)." (*Id.* at 11.) The appellants argue, "[t]here is no disclosure or suggestion of the telephone being displaced *against* the spring

bias to disengage the telephone." (Reply Br. at 2.) They further assert, "even if the two references could be properly combined, they still do not suggest the combined features of Claim 23." (Appeal Br. at 10.)

Claim 23 specifies in pertinent part the following limitations: "the housing must be displaced against the spring bias to disengage the housing from the element disposed on the cradle member . . . ." Accordingly, the claim require *inter alia* that a housing must displace a spring to disengage it from a cradle.

Starting with the anticipation rejection, Tomura discloses that a battery pack attached to a portable telephone must be displaced against charging springs to engage it with a battery charger. Specifically, "[w]hen the portable telephone 250 is mounted to the charger 210, the charging terminals 236 of the charger 210 are deformed elastically and come into pressure contact with the charging terminals of the battery

pack 252 . . . .” Col. 9, ll. 12-16. The examiner fails to show, however, that disengaging the portable telephone 250 with battery pack 252 from the charger 210 would further deform the charging terminals 236. To the contrary, the rounded edges of the battery pack 252 suggest that pivoting the portable telephone 250 on the lug 218 of the charger 210 to remove the telephone with its battery pack therefrom would not deform the charging terminals 236 any more than they are deformed during charging. Figs. 16 and 17.

Because there is no showing that disengaging Tomura’s portable telephone with battery pack from its charger would further deform the charging terminals, we are not persuaded that the reference discloses the limitations that "the housing must be displaced against the spring bias to disengage the housing from the element disposed on the cradle member . . . .” Therefore, we reverse the anticipation rejection of claim 23 and of claims 24 and 25, which depend from claim 23.

Turning to the obviousness rejection, Mattering discloses that a hair cutting machine with a built-in battery must be

displaced against contact springs to disengage it. Specifically, “[t]o detach the adapter when the hair cutting machine is once more to be operated without the cable, it is first necessary to **displace the hair cutting machine** and then to rotate it, as indicated in Fig. 17 with the arrows 127.” P. 14 (emphasis added). When the hair cutting machine 103 is displaced in the direction shown by the arrow 127, the machine necessarily presses against contact springs 116 and 117, thereby displacing the springs in the same direction.

Because Mattering’s hair cutting machine with a built-in battery must be displaced against its contact springs to disengage it, we are persuaded that the teachings from the applied prior art would have suggested the limitations that "the housing must be displaced against the spring bias to disengage the housing from the element disposed on the cradle member . . . .”

Claims that are not argued separately stand or fall together. *In re Kaslow*, 707 F.2d 1366, 1376, 217 USPQ 1089,

1096 (Fed. Cir. 1983)(citing *In re Burckel*, 592 F.2d 1175, 201 USPQ 67 (CCPA 1979)). When the patentability of dependent claims is not argued separately, moreover, the claims stand or fall with the claims from which they depend. *In re King*, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986)(citing *In re Sernaker*, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983); *Burckel*, 592 F.2d at 1178-79, 201 USPQ at 70.)

Here, because the appellants have not argued separately the patentability of claims 24 and 25, these claims fall with claim 23, from which they depend. Therefore, we affirm the obviousness rejection of claims 23-25. We proceed to the third group of claims.

## III. Claims 26-28

The examiner asserts that he, “reads Tomura's phone (250) as the housing. The battery is a part of the housing. In other words, the phone (250) is a battery housing. The middle or top end of the battery housing is the location of lug (218).” (Examiner’s Answer at 9.) He further asserts, “the

element is identified as Mattinger's loop (111), the middle slot is Mattinger's slot (108). Further, Mattinger is a battery operating device, the device houses the battery. Therefore, the device simply can be considered as the battery housing." (*Id.* at 12.) The appellants argue, "Tomura et al. does not disclose or suggest the lug (218) being located at the area that receives the middle or top *of the battery.*" (Appeal Br. at 5.) They further argue, "[t]here is no disclosure or suggestion in Mattinger et al. of where the battery is located in the hair cutter (103) much less that loop (111) is at an upper area of the receiving area that receives a middle or top end of the battery." (*Id.* at 5-6.)

Claim 26 specifies in pertinent part the following limitations: "the element on the cradle member being spaced from the bottom at an upper area of the housing receiving area that receives a middle or top end of the battery . . . ." Accordingly, the claim requires *inter alia* that an element of a cradle receives a middle or top end of a battery.

Starting with the anticipation rejection, Tomura's lug does not receive the reference's battery pack at all, let alone the middle or top end thereof. To the contrary, the lug fits into Tomura's portable telephone. Specifically, "by fitting the lug 218 into the retaining slot 254 of the portable telephone 250, the portable telephone with the large-capacity battery pack 258 attached thereto is fixed easily to the charger 210 of the portable telephone." Col. 9, ll. 37-42. Furthermore, the reference shows that the lug 218 fits into the bottom of Tomura's portable telephone 250. Figs. 16 and 17.

Because Tomura's lug fits into the bottom of its portable telephone, we are not persuaded that the reference discloses the limitations that "the element on the cradle member being spaced from the bottom at an upper area of the housing receiving area that receives a middle or top end of the battery . . . ." Therefore, we reverse the anticipation rejection of claim 26 and of claims 27 and 28, which depend from claim 26.

Turning to the obviousness rejection, the examiner fails to show that Mattering cures the defect of Tomura. Although Mattering discloses that “[i]nside the hair cutting machine 1', there is a motor (not shown) and a battery for storing the electrical energy necessary for operating the motor,” p. 5, the reference does not show the location of the battery within the hair cutting machine 1'. We will not “resort to speculation,” *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), as to the location of Mattering’s battery *vis-á-vis* its catch loop 111.

Because Tomura’s lug fits into the bottom of its portable telephone, and Mattering does not disclose the location of its battery, we are not persuaded that the teachings from the applied prior art would have suggested the limitations of "the element on the cradle member being spaced from the bottom at an upper area of the housing receiving area that receives a middle or top end of the battery . . . .” Therefore, we reverse the obviousness rejection of claim 26 and of claims 27

and 28, which depend from claim 26. We conclude with the fourth group of claims.

## IV. Claims 32-34

The examiner asserts that Tomura's “phone (250) is a battery housing. The middle or top end of the battery housing is the location of lug (218).” (Examiner’s Answer at 9.) He further asserts, “the element is identified as Mattinger's loop (111), the middle slot is Mattinger's slot (108). Further, Mattinger is a battery operating device, the device houses the battery. Therefore, the device simply can be considered as the battery housing.” (*Id.* at 12.) The appellants argue, “[i]n Tomura the lug (218) engages the housing of the telephone; *not the housing which the battery is disposed within.* In Mattinger et al. there is no indication of where the battery is located in the hair cutter (103), much less that the loop (11) engages the battery housing. In addition, the loop (111) is on the adapter (105); not on the cradle (101).” (Appeal Br. at 13.)

Claim 32 specifies in pertinent part the following limitations: "the housing must be displaced with support from the spring bias to engage the housing with the element disposed on the cradle member." Accordingly, the claim requires *inter alia* that an element of a cradle engages the housing of a battery.

Starting with the anticipation rejection, Tomura's lug does not engage the reference's battery pack. To the contrary, the lug 218 fits into the retaining slot 254 of Tomura's portable telephone 250 as mentioned regarding claims 26-28.

Because Tomura's lug fits into its portable telephone, we are not persuaded that the reference discloses the limitations that "the housing must be displaced with support from the spring bias to engage the housing with the element disposed on the cradle member." Therefore, we reverse the anticipation rejection of claim 32 and of claims 33 and 34, which depend from claim 32.

Turning to the obviousness rejection, the examiner fails to show that Mattering cures the defect of Tomura. Mattering's hair cutting machine 103 does not engage the reference's charger. To the contrary, the hair cutting machine engages Mattering's adapter 105. Specifically, "the hair cutting machine 103 is pressed towards the catch loop 111 and interlocks the adapter with the hair cutting machine." P. 13.

Because Tomura's lug fits into its portable telephone, and Mattering's hair cutting machine interlocks with its adapter, we are not persuaded that the teachings from the applied prior art would have suggested the limitations that "the housing must be displaced with support from the spring bias to engage the housing with the element disposed on the cradle member." Therefore, we reverse the obviousness rejection of claim 32 and of claims 33 and 34, which depend therefrom.

## CONCLUSION

In summary, the rejection of claims 22-34 under 35 U.S.C. § 102(b) and of claims 22 and 26-34 under § 103(a) is reversed. The rejection of claims 23-25 under § 103(a), however, is affirmed. Our affirmance is based only on the arguments made in the briefs. Arguments not made therein are neither before us nor at issue but are considered waived.

No time for taking any action connected with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED-IN-PART

| | | |
|---|---|---|
| LEE E. BARRETT<br>Administrative Patent Judge | ) | |
| ANITA PELLMAN GROSS<br>Administrative Patent Judge | ) | BOARD OF PATENT APPEALS AND INTERFERENCES |
| LANCE LEONARD BARRY<br>Administrative Patent Judge | ) | |

PERMAN & GREEN
425 POST ROAD
FAIRFIELD, CT 06430-6232

**Once signed, forward to Team 3 for mailing.**

APPEAL NO. 2000-0267 - JUDGE BARRY
APPLICATION NO. 08/856,943

APJ BARRY - **2 copies**

APJ GROSS

APJ BARRETT

Prepared By: APJ BARRY

**DRAFT SUBMITTED:** 24 Sep 02

**FINAL TYPED:**

Team 3:

I typed all of this opinion.

Please proofread spelling, cites, and quotes. Mark your proposed changes on the opinion, but **do NOT change matters of form or style. I will include the diskette with the signed copy so that you can make all changes before mailing.**

For any additional reference provided, please prepare PTO 892 and include copy of references

Thanks,
Judge Barry