THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOSEPH S. SPORN

Appeal No. 2000-0807
Application No. 08/971,647

ON BRIEF

Before HAIRSTON, BARRETT, and GROSS, Administrative Patent Judges.

GROSS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 12 and 15, which are all of the claims pending in this application.

Appellant's invention relates to a wrist-borne radiotelephone set having a microphone on the wristband or strap and an earphone mounted in a finger thimble that is insertable into the user's ear. Claim 1 is illustrative of the claimed invention, and it reads as follows:

1. A wrist-borne radiotelephone set comprising:

A. a case coupled to a strap adapted to engage the wrist on a hand of a user whereby the strip then overlies an inner side of the wrist and the case an outer side thereof;

B. a miniature microwave transceiver housed in the case having an audio input and an audio output to provide two-way mobile telephone communications;

C. a microphone mounted on the strap and connected to said audio input whereby when the hand is raised to a position at which the microphone on the strap engaging the wrist is then adjacent the mouth of the user, voice messages from the user may then be transmitted; and

D. an earphone mounted within a finger thimble and connected by a cable that is retractable within the case to said audio-output, the microphone reproducing telephone voice messages received by the transceiver; said cable when retracted in the case then retaining said thimble against a side of the case whereby to operate the radiotelephone, the thimble is pulled away from the side of the case and fitted onto a finger of the hand, the hand then being raised to a position at which the thimble carrying the earphone can be inserted by the finger in an ear of the user, at which position the microphone is adjacent the mouth whereby the user can speak into the microphone and listen through the earphone, said finger thimble having the earphone mounted therein being dimensioned to be insertable into the ear to effectively shield the ear from extraneous sounds whereby what the ear hears is only sound from the earphone, said finger of the hand being an index finger, and said finger thimble being dimensioned to conform to the index finger so that it is insertable into the ear of the user.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Blonder	5,239,521	Aug. 24, 1993
Saksa	5,659,611	Aug. 19, 1997

Claims 1 through 12 and 15 stand rejected under 35 U.S.C. § 103 as being unpatentable over Saksa in view of Blonder.

Reference is made to the Examiner's Answer (Paper No. 19, mailed November 10, 1999) for the examiner's complete reasoning in support of the rejection, and to appellant's Brief (Paper No. 18, filed August 30, 1999) and Reply Brief (Paper No. 20, filed November 23, 1999) for appellant's arguments thereagainst.

OPINION

We have carefully considered the claims, the applied prior art references, and the respective positions articulated by appellant and the examiner. As a consequence of our review, we will reverse the obviousness rejection of claims 1 through 12 and 15.

Independent claim 1 recites, in pertinent part, "a microphone mounted on the strap" and "an earphone mounted within a finger thimble." More specifically, the finger thimble is

> dimensioned to be insertable into the ear to effectively shield the ear from extraneous sounds, . . . said finger of the hand being an index finger, and said finger thimble being dimensioned to conform to the index finger so that it is insertable into the ear of the user.

Thus, claim 1 requires a microphone on the wristband or strap and an earphone mounted within a thimble which is dimensioned to fit into the user's ear.

The examiner rejects claim 1 over Saksa and Blonder. The examiner asserts (Answer, page 3) that "Saksa teaches all features claimed except for the location of the microphone," and

that "[i]t would have been obvious . . . to adapt Saksa to include positioning the microphone on the band as is conventionally done and is shown by Blonder." Appellant argues (Brief, pages 4 and 6) that Saksa's earphone fails to meet all of the claimed features regarding the earphone, as Saksa's earphone is mounted on a thumb thimble which "cannot be inserted in the ear canal but can only be brought next to the ear." The examiner responds (Answer, page 4) that "one could and would choose the appropriate finger and this as claimed does not add patentability to the claim."

Assuming, ***arguendo***, that Saksa and Blonder can be combined in the manner proposed by the examiner, and that Blonder provides sufficient motivation for relocating the microphone of Saksa to a wristband, we find that the combination fails to meet each and every limitation of claim 1. In particular, our review of Saksa reveals that any finger may be used for the earphone thimble (see column 3, lines 29-30), but the thimble is to be used adjacent the user's ear, not in the user's ear (see column 3, line 1). Nowhere does Saksa suggest sizing the thimble to fit the particular finger to be used nor to fit within the user's ear. Saksa specifies that the thimble is to remain next to the ear, not within the ear. Accordingly, Saksa fails to teach or suggest the "finger thimble having the earphone mounted therein being

dimensioned to be insertable into the ear to effectively shield the ear from extraneous sounds . . ., and said finger thimble being dimensioned to conform to the index finger so that it is insertable into the ear of the user."

Blonder discloses that both the microphone and also the earphone are to be located on the strap or wristband. Therefore, Blonder does not cure the deficiencies of Saksa. Consequently, we cannot sustain the obviousness rejection of claim 1 and its dependents, claims 2 through 12 and 15.

CONCLUSION

The decision of the examiner rejecting claims 1 through 12 and 15 under 35 U.S.C. § 103 is reversed.

REVERSED

KENNETH W. HAIRSTON Administrative Patent Judge	)	
LEE E. BARRETT Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
ANITA PELLMAN GROSS Administrative Patent Judge	)	

APG:clm

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