

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MITCHELL A. MARKOW, DANIEL V. FORLENZA,
KEVIN R. FROST and GREGORY B. MEMO

Appeal No. 2002-1987
Application No. 08/880,032¹

ON BRIEF

Before FLEMING, DIXON, and SAADAT, Administrative Patent Judges.
SAADAT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the Examiner's final rejection of claims 34-42. Claims 1-33 have been cancelled and claims 43-46 are not before us as their rejection was withdrawn by the Examiner.²

We reverse.

¹ Application for patent filed June 20, 1997.

² The only rejection of claims 43-46 under 35 U.S.C. § 112, second paragraph, as indicated in the final Office action (Paper no. 16, mailed November 8, 2000), was withdrawn in the answer (page 7).

BACKGROUND

Appellants' invention relates to a ported speaker enclosure of a portable computer formed between the upper surface and the lower surface of the speaker enclosure.

Representative independent claim 36 is reproduced as follows:

36. A modular ported speaker enclosure for a portable computer system, the modular ported speaker enclosure comprising:

a speaker enclosure top independent of a plurality of portable computer surfaces of the portable computer system;

a speaker enclosure base independent of the plurality of portable computer surfaces and having a plurality of ports formed therein the speaker enclosure base; and

a plurality of loudspeakers housed between the speaker enclosure top and the speaker enclosure base.

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

Hickman	5,610,992	Mar. 11, 1997
Freadman	5,818,942	Oct. 6, 1998 (filed Nov. 2, 1994)

Claims 34-39, 41 and 42 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Freadman.

Claim 40 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Freadman and Hickman.

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We make reference to the answer (Paper No. 22, mailed July 31, 2001) for the Examiner's reasoning and to the brief (Paper No. 21, filed May 14, 2001) for Appellants' arguments thereagainst.

OPINION

With respect to the rejection of claims 34-39, 41 and 42, Appellants argue that Freadman does not teach or suggest a speaker enclosure in a portable computer and instead, is directed to speakers enclosed in a monitor or a keyboard of a conventional computer (brief, page 6). The Examiner responds by pointing out that, under the broadest reasonable interpretation, the computer of Freadman represents a portable computer since nothing in the reference precludes the system from being moved from one location to another (answer, pages 3 & 4).

We agree with Appellants that the computer of Freadman is not portable as it includes separate monitor and keyboard. Although its components can be moved from one location to another, it is not a portable computer within the ordinary meaning of the term "portable computer."³ A portable computer, therefore, must be self-contained with respect to functionality

³ According to IBM Dictionary of Computing, McGraw-Hill, Inc., 1994, p. 517, "portable computer" is defined as "A microcomputer that can be hand carried for use in more than one location," a copy of which accompanies this decision.

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and power supply and be capable of functioning and maintaining its computing capabilities while being transportable, such as a laptop computer.

Appellants further argue that the description of the computer monitor or keyboard embodiments of Freadman offer no teaching to suggest that the speaker enclosure is independent of the surfaces of the conventional computer monitor or the keyboard (brief, pages 6-8). The Examiner relies on Figure 2 of Freadman to show that the speaker enclosure, while being formed in the keyboard shell, is independent of the keyboard surfaces as it can be mounted on other parts such as the monitor (answer, page 4).

We agree with Appellants since the claimed top and base independent of a plurality of surfaces of the portable computer are not explicitly shown or disclosed in Freadman. The Examiner merely refers to Figure 2 to show independent top and base of the modular speaker enclosure whereas the dashed lines depicted as extending along the edges merely indicate the boundaries of each compartment without establishing whether surfaces independent of the computer surfaces define the top and the base of the enclosures. A rejection for anticipation under section 102 requires that the four corners of a single prior art document describe every element of the claimed invention, either expressly

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or inherently, such that a person of ordinary skill in the art could practice the invention without undue experimentation. See Atlas Powder Co. v. Ireco Inc., 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999); In re Paulsen, 30 F.3d 1475, 1478-79, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994). In this case, as there is no indication in Freadman that the surfaces depicted in the speaker unit of Figure 2 are independent of the surfaces of the computer, the examiner's conclusion is based merely on speculation and therefore, fails to support a prima facie case of anticipation. Accordingly, the rejection of claims 34-39, 41 and 42 under 35 U.S.C. § 102 over Freadman cannot be sustained.⁴

Regarding the 35 U.S.C. § 103 rejection of claim 40, we note the Examiner's failure to point to any teachings or suggestions in Hickman that would have overcome the deficiencies of Freadman discussed above. Hickman, at best, shows a ported speaker enclosure placed in the lower shell of a portable computer but does not teach that the top and base surfaces of the enclosure are independent of the computer surfaces (Figure 4 and col. 3, line 49 et seq.). Based on our determination that Freadman does

⁴ Our decision not to sustain the rejection of claims 34-39, 41 and 42 under 35 U.S.C. § 102 over Freadman should not be taken as an indication of the patentability of these claims that would prevent the Examiner from potentially introducing new grounds of rejection under 35 U.S.C. § 103 over the combination of Freadman with other reference(s) to show the missing elements.

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not teach the invention of base claim 38 and the failure of Hickman to provide the missing teaching or suggestion, the 35 U.S.C. § 103 rejection of the dependent claim 40 over Freadman and Hickman cannot be sustained.

CONCLUSION

In view of the foregoing, the decision of the Examiner rejecting claims 34-39, 41 and 42 under 35 U.S.C. § 102 and rejecting claim 40 under 35 U.S.C. § 103 is reversed.

REVERSED

MICHAEL R. FLEMING)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JOSEPH L. DIXON)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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MAHSHID D. SAADAT)	
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