

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAE-SAM YUN

Appeal No. 2003-1204
Application No. 09/592,535

HEARD: January 21, 2004

Before KRASS, JERRY SMITH and DIXON, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1, 2, 12-20 and 30-36.

The invention is directed to a portable computer and is best understood from reference to representative independent claim 1, reproduced as follows:

1. A portable computer apparatus, comprising:

a base;

a cover having a front surface and a back surface, said front surface including a display screen conveying varying visual information to a user;

a hinge assembly coupling said cover to said base, forming a first axis of rotation oriented parallel to said base, and forming a second axis of rotation oriented parallel to said cover and substantially perpendicular to the first axis, said cover tilting toward and away from said base around the first axis, said cover swiveling around the second axis in clockwise and counterclockwise directions with respect to said base, the first axis not intersecting with the second axis; and

a support unit supporting said back surface of said cover when said cover is swivelled and tilted to a position having said back surface facing toward said base and having said display screen facing away from said base.

The examiner relies on the following references:

Wu	5,016,849	May 21, 1991
Kawamoto et al. (Kawamoto)	5,034,858	Jul. 23, 1991
Kumar et al. (Kumar)	5,548,478	Aug. 20, 1996

Claims 1, 2, 12-20 and 30-36 stand rejected under 35 U. S.C. §103. As evidence of obviousness, the examiner cites Kawamoto and Wu with regard to claims 1, 2, 13-20 and 30-36, adding Kumar with regard to claim 12 and with regard to a further rejection of claim 30.

Appeal No. 2003-1204
Application No. 09/592,535

Reference is made to the briefs and answer for the respective positions of appellant and the examiner.

OPINION

We REVERSE.

In rejecting claims under 35 U.S.C. §103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teachings, suggestions or implications in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of

Appeal No. 2003-1204
Application No. 09/592,535

complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1051, 189 USPQ 143, 146-147 (CCPA 1976).

With regard to claims 1, 2, 13-20 and 30-36, it is the examiner's position that Kawamoto discloses the claimed subject matter but for the claimed limitation of "the first axis not intersecting with the second axis." There is both a vertical and a horizontal rotation axis in Kawamoto, as seen in Figures 10 and 11, showing the display swiveling in a vertical and then a horizontal directional, respectively. The examiner has never contended that these axes of rotation in Kawamoto do not intersect.

Instead, the examiner turns to Wu for a teaching of a hinge assembly having a first axis of rotation (identifying elements 222 and 242 in Figure 3, and column 1, lines 60-64) which does not intersect with a second axis of rotation (identified as elements 12 and 131 in Figure 3, and column 1, lines 60-64).

The examiner then contends that it would have been obvious to modify the hinge assembly of Kawamoto with Wu's hinge assembly "for the purpose of having the cover being rotating [sic] about two axes perpendicular to each other but not intersecting to each other, so that a space provided between the cover and the base when the computer apparatus is in a closed position could be different with a space provided between the cover and the base when the computer apparatus is in an open position" [answer-pages 4-5].

We find the examiner's position to be erroneous for several reasons.

First, we agree with appellant that, at best, Wu is ambiguous as to whether the two axes of rotation intersect or not. While Wu calls for a "horizontal axle 2" (see column 2, line 10), this axle is nowhere labeled in the drawings of Wu. While Wu's horizontal axis of rotation may be effected by elements 22 and 242, elements 212 and 232 would also seem to be a part of the mechanism which allows the display to rotate in the vertical direction. Thus, it is not clear where, exactly, the horizontal axis of rotation lies on Wu. If it is half-way between elements 212 and 222 in Figure 3, then it is still unclear whether this axis of rotation intersects with the vertical axis of rotation effected by elements 11, 12 and 13.

Appeal No. 2003-1204
Application No. 09/592,535

It is clear that Wu never mentions anything about an intersection or a non-intersection of vertical and horizontal axes of rotation and whether or not these axes intersect is not clear from the drawings of Wu. Accordingly, any conclusion that these axes do not, in fact, intersect, may only be based on speculation. Deficiencies in the factual basis needed to support a rejection under 35 U.S.C. §103 cannot be supplied by resorting to speculation or unsupported generalities. In re Freed, 425 F.2d 785, 787, 165 USPQ 570, 571 (CCPA 1970); In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177-78 (CCPA 1967). Accordingly, we will not sustain the rejection of claims 1, 2, 13-20 and 30-36 under 35 U.S.C. §103. Moreover, we also will not sustain the rejection of claims 12 and 30 under 35 U.S.C. §103 as obvious over Kawamoto, Wu and Kumar because Kumar does not provide for the deficiencies noted supra with regard to the independent claims.

Moreover, even if we agreed with the examiner that Wu disclosed or suggested non-intersecting axes of rotation, the examiner has provided insufficient motivation that would have led the artisan to modify Kawamoto in such a manner as to result in non-intersecting axes of rotation. The examiner's reasoning that it would have been obvious to modify the hinge assembly of Kawamoto with Wu's hinge assembly "for the purpose of having the cover being rotating [sic] about two axes perpendicular to each other but

Appeal No. 2003-1204
Application No. 09/592,535

not intersecting to each other, so that a space provided between the cover and the base when the computer apparatus is in a closed position could be different with a space provided between the cover and the base when the computer apparatus is in an open position” is nothing more than impermissible hindsight since appellant’s specification is the only evidence of record that teaches this. We find nothing in the record, other than appellant’s own teaching, that would have suggested any reason for the artisan to provide a space between the cover and base when the apparatus is in a closed position that is different from the space provided therebetween when the apparatus is in an open position. There is simply no evidence of record, other than appellant’s disclosure, that would have pointed the artisan in any direction that would have resulted in modifying Kawamoto so as to provide the claimed non-intersecting axes of rotation. Thus, even if Wu taught such non-intersecting axes of rotation, and we do not agree that WU does teach this, why would this fact, alone, have led the artisan to modify Kawamoto in any way so as to provide for non-intersecting axes of rotation therein? The examiner does not satisfactorily answer this question. As such, the examiner has failed to provide a prima facie case of obviousness. Accordingly,

Appeal No. 2003-1204
Application No. 09/592,535

again, we will not sustain the rejection of claims 1, 2, 12-20 and 30-36 under 35 U.S.C.
§103.

The examiner's decision is reversed.

REVERSED

ERROL A. KRASS)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
JERRY SMITH)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
JOSEPH L. DIXON)	
Administrative Patent Judge)	

EAK/vsh

Appeal No. 2003-1204
Application No. 09/592,535

ROBERT E. BUSHNELL
1522 K STREET NW
SUITE 300
WASHINGTON , DC
20005-1202