The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 32

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHRISTER ALMQVIST

Appeal No. 2004-0984
Application No. 09/501,970

HEARD: January 13, 2005

Before HAIRSTON, LEVY, and NAPPI, Administrative Patent Judges.

LEVY, Administrative Patent Judge.

## DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1, 6 and 7[1]. Claim 4 has been canceled (Paper No. 7, filed August 2, 2001). Claims 2, 3 and 5 have been indicated as allowable if rewritten in independent form (Paper No. 25, mailed May 22, 2003.

[1] The examiner (answer, page 2) has withdrawn the rejection of claims 1 and 7. Accordingly, only claim 6 remains before us for decision on appeal.

## BACKGROUND

Appellant's invention relates to an acoustic headset having groups of buttons disposed in depressions in an arched outer side of an auditory cup (specification, page 1, line 1 and page 2, lines 23-27). An understanding of the invention can be derived from a reading of claim 6, which is reproduced as follows:

6. A hearing protection in the form of an acoustic headset comprising:

a first and a second ear cup interconnected by a stirrup or headband, said first and second ear cup each have an inner surface for contacting the ear of a wearer and an outer surface;

one loudspeaker in each one of the ear cups,

one microphone for receiving ambient sound,

one radio unit, and

one electronic control unit actuable by a button set for transmitting sound to the ear cups from the microphone and the radio unit by the intermediary of the loudspeakers, the buttons of the button set being arranged in groups wherein the buttons within each group are functionally connected to one another and each group is located in a separate recess or depression on the outer surface of the first cup.

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

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| Wieder | 4,620,068 | Oct. 28, 1986 |
| Lansang | 5,794,127 | Aug. 11, 1998 |
| Sayler et al. (Sayler) | 5,923,317 | Jul. 13, 1999 |

Claim 6 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Weider in view of Lansang and Sayler.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellant regarding the above-noted rejection, we make reference to the examiner's answer (Paper No. 27, mailed December 2, 2003) for the examiner's complete reasoning in support of the rejection, and to appellant's brief (Paper No. 26, filed August 25, 2003) and reply brief (Paper No. 28, filed December 8, 2003) for appellant's arguments thereagainst. Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered.

## OPINION

In reaching our decision in this appeal, we have carefully considered the subject matter on appeal, the rejection advanced by the examiner, and the evidence of obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, appellant's arguments set forth in the briefs along with the examiner's rationale in support of the rejection and arguments in

rebuttal set forth in the examiner's answer. Upon consideration of the record before us, we affirm.

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 teaching, suggestion or implication 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); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985); 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 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. 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, 1052, 189 USPQ 143, 147 (CCPA 1976).

The examiner's position (Paper No. 25, mailed May 22, 2003, page 3) is that Weider discloses ear cups, headband, loudspeaker, microphone, radio, control unit actuatable by a button set having a microphone ON/OFF switch and a squelch control switch located on the ear cup, but fails to disclose the implementation of an ON/OFF switch and squelch control switch. To overcome this deficiency of Weider, the examiner turns to Lansang for a teaching of on/off switches and channel selector control switches, each having two buttons which are functionally connected. The examiner takes the position that it would have been obvious to implement the use of two button switches of Lansang for the switches of Weider for the purpose of precise controlling of the functions of these switches. The examiner

notes that the combined teachings of Weider and Lansang fail to disclose that buttons within each group are located in a separate recess or depression on the ear cup. To overcome this deficiency of Weider and Lansang, the examiner turns to Sayler for a disclosure of button groupings within a recess (recess 20 having buttons grouping 60). The examiner's reasoning is that the modification would allow comfortable and quick access to each of the buttons in each grouping.

At the outset, we observe that appellant does not dispute the examiner's interpretation of Weider and Lansang. Nor does appellant dispute the combinability of Weider and Lansang. Rather, appellant asserts (brief, page 5) that Sayler is not combinable with Weider and Lansang because Sayler is directed to a hand held control unit and is unrelated to an acoustical headset. It is argued (id.) that the examiner's rejection is nothing more that a hindsight reconstruction of appellant's invention. It is argued that in appellant's invention, the depressions have a plurality of buttons wherein each plurality of buttons in each recess constitutes a button set, and that the buttons are functionally connected to each other; i.e., each set of buttons, such as 18, 18' and 19, 19' are in another recess.

Thus, each recess includes a plurality of buttons, which operate the same function of the radio unit of the acoustical headset. Appellant adds that by providing separate recesses for each function, the user can readily feel, without looking, where his fingers should be to operate the button set.

Before addressing the examiner's rejection based upon prior art, it is an essential prerequisite that the claimed subject matter be fully understood. Analysis of whether a claim is patentable over the prior art under 35 U.S.C. § 103 begins with a determination of the scope of the claim. The properly interpreted claim must then be compared with the prior art. Claim interpretation must begin with the language of the claim itself. See Smithkline Diagnostics, Inc. v. Helena Laboratories Corp., 859 F.2d 878, 882, 8 USPQ2d 1468, 1472 (Fed. Cir. 1988). Accordingly, we will initially direct our attention to appellant’s claim 6 to derive an understanding of the scope and content thereof.

Before turning to the proper construction of the claim, it is important to review some basic principles of claim construction. First, and most important, the language of the claim defines the scope of the protected invention. Yale Lock

Mfg. Co. v. Greenleaf, 117 U.S. 554, 559 (1886) ("The scope of letters patent must be limited to the invention covered by the claim, and while the claim may be illustrated it cannot be enlarged by language used in other parts of the specification."); Autogiro Co. of Am. v. United States, 384 F.2d 391, 396, 155 USPQ 697, 701 (Ct. Cl. 1967) ("Courts can neither broaden nor narrow the claims to give the patentee something different than what he has set forth [in the claim]."). See also Continental Paper Bag Co. v. Eastern Paper Bag Co., 210 U.S. 405, 419 (1908); Cimiotti Unhairing Co. v. American Furuya Ref. Co., 198 U.S. 399, 410 (1905). Accordingly, "resort must be had in the first instance to the words of the claim" and words "will be given their ordinary and accustomed meaning, unless it appears that the inventor used them differently." Envirotech Corp. v. Al George, Inc., 730 F.2d 753, 759, 221 USPQ 473, 477 (Fed. Cir. 1984). Second, it is equally "fundamental that claims are to be construed in the light of the specification and both are to be read with a view to ascertaining the invention." United States v. Adams, 383 U.S. 39, 49, 148 USPQ 479, 482 (1966).

Furthermore, the general claim construction principle that limitations found only in the specification of a patent or patent

application should not be imported or read into a claim must be followed. See In re Priest, 582 F.2d 33, 37, 199 USPQ 11, 15 (CCPA 1978). One must be careful not to confuse impermissible imputing of limitations from the specification into a claim with the proper reference to the specification to determine the meaning of a particular word or phrase recited in a claim. See E.I. Du Pont de Nemours & Co. v. Phillips Petroleum Co., 849 F.2d 1430, 1433, 7 USPQ2d 1129, 1131 (Fed. Cir.), cert. denied, 488 U.S. 986 (1988).

What we are dealing with in this case is the construction of the limitations recited in the appealed claims. As stated by the court in In re Hiniker Co., 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998) "[t]he name of the game is the claim." Claims will be given their broadest reasonable interpretation consistent with the specification, and limitations appearing in the specification are not to be read into the claims. In re Etter, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985).

We find that claim 6 does not require that each recess includes a plurality of buttons which operate the same functions for the radio function of the acoustical headset, as asserted by appellant. As drafted, claim 6 only requires that the buttons

within each group are functionally connected to one another. Of note is that the phrase "functionally connected" does not appear in appellant's specification, as filed. Giving the claim its broadest reasonable interpretation, we find that the phrase "functionally connected" can refer to each of the buttons performing an operation on the portable electronic device.

Turning to the teachings of Weider and Lansang, we find separate pairs of discrete buttons 14, 18 wherein each of the pairs of buttons control the same function (figures 3 and 4 of Lansang). Turning to Sayler, we find that Sayler is directed to a controller for video games or simulations (col. 1, lines 5 and 6). Sayler recognizes a problem with existing button groupings, and proposes a solution, asserting (col. 1, line 65 through col. 2, line 18) that:

> An additional problem in the industry is the configuration of the button groupings on existing controllers especially two-handed controllers. In button groupings of conventional two-handed controllers, the buttons, while generally in close proximity, fail to offer optimal rapid, easy, and comfortable access from one button to another. The button configurations of the prior art typically have divergent pairs, as in the Sega controller, or parallel button lines, as in many generic controllers. Furthermore, the button’s tops tend to protrude from the controller’s top surface with a shape and configuration such that a user’s hand digit will "catch" on the button edge of an adjacent button if the thumb or finger is slid from one button to another. These configurations of the prior art fail to provide for the most desirable, efficient

> and ergonomic access by a user's hand digit, as they each require the lifting of the hand digit to reach other buttons within the grouping. It is therefore desirable, to have a button grouping configuration and design that would allow a user to slide, glide or roll his thumb or finger easily from one button in the grouping to another without having to lift if from the controller, and without it "catching" on another button.

From this disclosure of Sayler, we find a recognition of the problem of button pairs that protrude from the top of the surface of the controller and require lifting of the hand digit to reach other buttons within the grouping. Sayler's solution is to have a button grouping that will allow the user to slide, glide or roll his/her thumb or finger easily from one button of the grouping to another without having to lift it from the controller, and without it catching on another button. Sayler's solution to the problem is providing a button grouping configuration within a recess to allow comfortable and quick access to each of the buttons in the grouping. Sayler adds, (col. 3, lines 26 and 27) that the buttons are arranged in pairs, along radii which converge toward the user's thumb pivot joint. From the disclosure of Sayler of placing the buttons of a group within a recess to provide quick and comfortable access to the buttons, we agree with the examiner that an artisan would have been motivated to place each of the button groups 14, 18 of Lansang within a recess.

In the alternative, to the extent that it could be argued that the teaching of Sayler refers to a single recess with button groups, and that when applied to Lansang would result in one recess for both button groups and not to a recess for each of the separate button groups 14, 18 of Lansang, we note the additional disclosure of Sayler of a separate recess having additional buttons 74, 76 (figure 4). Although Sayler simply refers to buttons 74, 76 as being additional buttons (col. 7, lines 27 and 28), we find that from the disclosure of Sayler showing the buttons unnumbered, and the showing of the buttons in figures 1, 4 and 5, that buttons 74 and 76 are in a recess in the outer surface of the hand held unit. Thus, we find that Sayler discloses two sets of buttons, each within a recess in the outer surface of the handheld unit. From this disclosure of Sayler, we find that an artisan would have been motivated to place each of the button groups 14, 18 of Lansang within a separate recess in the outer surface of the housing.

We are not persuaded by appellant's assertion (brief, page 5) that "[t]he teaching in the Sayler reference which the Examiner relies on have nothing to do with an acoustical headset but rather a handheld control unit which is always visible to the user." Firstly, there is no disclosure in Sayler that a user looks at the hand held device while playing the video game.

Secondly, when handheld game controllers are used while playing a video game, the user looks at the game being played while using the hand-held controller, not at the controller.

In addition, we are not persuaded by appellant's argument (id.) that applying the teachings of a hand held control unit for a video game to an acoustical headset is a hindsight reconstruction of appellant's invention. Firstly, as discussed, supra, Sayler recognizes the problem of ease in moving a user's fingers between the buttons of a handheld controller, and provided the solution of putting button groups in a recess. Secondly, the issue relates not to the structure of an acoustical headset, but rather to a tactile-operated controller that is meant to be operated by the fingers of the user, without looking at the buttons on the controller.

From all of the above, we find that the teachings of Weider, Lansang and Sayler suggest the limitations of claim 6. Accordingly, the rejection of claim 6 under 35 U.S.C. § 103(a) is affirmed.

CONCLUSION

To summarize, the decision of the examiner to reject claim 6 under 35 U.S.C. § 103(a) is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136 (a).

AFFIRMED

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| KENNETH W. HAIRSTON<br>Administrative Patent Judge | ) | |
| STUART S. LEVY<br>Administrative Patent Judge | ) | BOARD OF PATENT APPEALS AND INTERFERENCES |
| ROBERT E. NAPPI<br>Administrative Patent Judge | ) | |

SSL/kis

GREGORY P. LA POINTE
BACHMAN & LA POINTE
900 CHAPEL STREET
NEW HAVEN, CT 06510