UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte JUAN M. PEREZ, JEFFREY A. LAMBERT and DONALD J. HALL

Appeal No. 2005-0340
Application No. 10/098,105

ON BRIEF

Before COHEN, FRANKFORT, and MCQUADE, Administrative Patent Judges.
FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 16 through 47, all of the claims remaining in this application. Claims 1 through 15 have been canceled.

As noted on page 1 of the specification, appellants' invention relates generally to electronic apparatus and, more particularly, to methods for operatively mounting circuit boards on support structures such as computer chassis walls. On page 3 of the

specification, it is indicated that a key aspect of the present invention is that the circuit board will be operatively secured to the computer chassis wall "without the use of screws or any sort of support tray secured to the circuit board." Independent claims 16, 23, 32 and 41 are representative of the subject matter on appeal and a copy of those claims may be found in the Appendix to appellants' brief.

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

Ho	5,593,219	Jan. 14, 1997
Sands et al. (Sands)	5,691,504	Nov. 25, 1997
Crowley	5,963,432	Oct. 5, 1999

Claims 16 through 18, 21, 23, 25, 26 and 28 stand rejected under 35 U.S.C. § 102(b) as anticipated by or in the alternative, under 35 U.S.C. § 103(a) as being unpatentable over Sands.

Claims 22, 30 and 31 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sands.

Claims 16 through 18, 21 through 23, 25, 26, 28, 30 through 34, 37 through 41, 43 and 45 through 47 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sands in view of Ho.

Claims 16 through 31 and 41 through 47 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Crowley in view of Sands.

Claims 16 through 47 also stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Crowley in view of Sands and Ho.

Rather than attempt to reiterate the examiner's full commentary with regard to the above-noted rejections and the conflicting viewpoints advanced by the examiner and appellants regarding those rejections, we make reference to the examiner's answer (mailed November 6, 2003) for the reasoning in support of the rejections, and to appellants' brief (filed September 8, 2003) and reply brief (filed January 12, 2004) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art references, and to the

respective positions articulated by appellants and the examiner. As a consequence of our review, we have made the determinations which follow.

With regard to the examiner's rejection of claims 16 through 18, 21, 23, 25, 26 and 28 under 35 U.S.C. § 102(b) as being anticipated by Sands, we have reviewed the applied Sands patent and, like appellants, find no teaching or disclosure therein of a "screwless method of locking a circuit board on a support structure" as set forth in claim 16 on appeal including the step of "releasably preventing an unlocking movement of the circuit board relative to the support structure via a latchable panel." In our opinion, the examiner's attempt to read the "latchable panel" of appellants' claim 16 on the access panel (119) of Sands is unreasonable and ignores the fact that claim 16 as a whole is directed to "[a] screwless method of locking a circuit board on a support structure." As noted in column 6, lines 44-54 of Sands, the access panel (119) seen in Figure 1 and which prevents the circuit board (130) from shifting inadvertently and perhaps disengaging from the circuit board mounts (112), is fastened in place "with a couple of screws or bolts in the conventional manner." Thus, it is clear that the method of locking a circuit board on a support structure taught in Sands is not a "screwless method" like that in appellants' claim 16.

Moreover, consistent with appellants' many indications in the specification that the invention provides for the "screwless" installation and removal of a circuit board on and from a support structure in an electronic device such as a computer, we are of the view that one of ordinary skill in the art at the time of appellants' invention would not have equated the screw/bolt secured panel (119) of Sands with the "latchable panel" set forth in claim 16 on appeal. In that regard, we share appellants' position that by equating "latchable" with a bolt or screw, the examiner has provided a definition or interpretation which is inconsistent with the ordinary meaning understood by those of ordinary skill in the art and which has neither a basis in common usage by an artisan nor a basis in the present application.

Thus, for the above reasons, we will not sustain the examiner's rejection of independent claim 16, or claims 17, 18 and 21 which depend therefrom, under 35 U.S.C. § 102(b) as being anticipated by Sands.

Concerning independent claim 23 and claims 25, 26 and 28 which depend therefrom, we note that claim 23 sets forth a method of forming a "tool-free mounting structure for a circuit board" and includes the step of "providing a latchable wall section of the support structure adjacent an edge of the circuit board in a blocking position relative to at least one direction of the multi-directional motion." Similar to our position

regarding claim 16 above, while Sands teaches a method of forming a mounting structure including the steps of forming projections (112) on one of the circuit board and a support structure, and creating openings (134) on the remaining one of the circuit board and support structure, wherein the projections are interlockable with the openings via a multidirectional motion of the circuit board, it is our view that one of ordinary skill in the art would not perceive the method disclosed in Sands as providing a "tool-free mounting structure" since securement of the access panel (119) that locks the circuit board into its retained position requires the use of either screws or bolts (col. 6, lines 44-47) which an artisan would readily understand requires tools to properly secure in place. Moreover, regarding the "latchable wall section," we again conclude that it is inconsistent with appellants' specification and unreasonable for the examiner to equate the screw/bolt secured panel (119) of Sands with the "latchable wall section" set forth in claim 23 on appeal.

For those reasons, we will not sustain the examiner's rejection of independent claim 23, or claims 25, 26 and 28 which depend therefrom, under 35 U.S.C. § 102(b) as being anticipated by Sands.

With respect to the rejection of claims 16 through 18, 21, 23, 25, 26 and 28 under 35 U.S.C. § 103(a) as being unpatentable over Sands, the examiner's position is that it

would have been obvious to one of ordinary skill in the art at the time appellants' invention was made that the panel (119) of Sands "may be secured [sic, by] any known attachment means for fastening including latching means provided to equivalently attach the panel to a support structure in a convenient, reliable, tool-free manner which allows the panel to be easily attached, detached and reattached" (answer, page 5). Like appellants, it is our opinion that the examiner's position is based entirely on speculation and conjecture, since the examiner has not pointed to or relied upon any evidence to support the above-noted contention. Thus, the examiner has not made out a prima facie case of obviousness.

We additionally note the examiner's mention of several patents on page 17 of the answer, but observe that none of the 20 or so listed patents have been set forth in the statement of the § 103 rejection presently before us. Accordingly, those references form no part of the issues presented for review by this panel of the Board. As pointed out by the Court in In re Hoch, 428 F.2d 1341, 1342, 166 USPQ 406, 407 (CCPA 1970), where a reference is relied upon to support a rejection, whether or not in a minor capacity, there would appear to be no excuse for not positively including the reference in the statement of the rejection.

For the above reasons, the examiner's rejection of claims 16 through 18, 21, 23, 25, 26 and 28 under 35 U.S.C. § 103(a) as being unpatentable over Sands will not be sustained.

The next rejection for our review is that of claims 22, 30 and 31 under 35 U.S.C. § 103(a) as being unpatentable over Sands. As noted by appellants in the brief (page 10), because these are dependent claims they include the recitations and limitations of independent claims 16 and 23 from which they ultimately depend. Given our disposition above of the examiner's rejections of independent claims 16 and 23 based on Sands, it follows that the examiner's rejection of dependent claims 22, 30 and 31 under 35 U.S.C. § 103(a) based on Sands will likewise not be sustained.[1]

Regarding the examiner's rejection of claims 16 through 18, 21 through 23, 25, 26, 28, 30 through 34, 37 through 41, 43 and 45 through 47 under 35 U.S.C. § 103(a) as being unpatentable over Sands in view of Ho, it appears to be the examiner's position that since Ho discloses the concept of latchable cover panels (2, 4, 6) associated with a rectangular base frame (1) of a computer housing, it would have been obvious to one of ordinary skill in the art at the time of appellants' invention that the

[1]We additionally note that in treating claims 22, 30 and 31 on pages 6 and 7 of the answer, the examiner has again provided no evidence to support the various assertions of obviousness and has therefore again failed to set forth a *prima facie* case.

access and retaining panel (119) of Sands "may be secured as shown by Ho." While in retrospect, it would appear that one skilled in the art could have used a latchable panel in place of the access and retaining panel (119) of Sands that is screwed or bolted in place to prevent inadvertent shifting of the circuit board (130), we observe that, like appellants, we find no fair teaching, suggestion or motivation in the references relied upon by the examiner for making such a modification. In that regard, we note that the mere fact that the prior art could be modified in the manner urged by the examiner would not have made such modification obvious unless the prior art suggested the desirability of the modification. See In re Gordon, 773 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984) and In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). In our opinion, the patents to Sands and Ho provide no suggestion regarding the desirability of such a modification.

From our perspective, the examiner has relied upon impermissible hindsight and used appellants' claimed invention as an instruction manual or "template" in an attempt to piece together disparate teachings of the prior art so that the claimed invention is rendered obvious. This approach to a determination of obviousness is improper and cannot be sanctioned by this Board. See In re Gorman, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991) and Interconnect Planning Corp. v. Feil,

774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985).

Since the teachings and suggestions found in Sands and Ho would not have made the subject matter as a whole of independent claims 16, 23, 32 and 41 on appeal obvious to one of ordinary skill in the art at the time of appellants' invention, we must refuse to sustain the examiner's rejection of those claims, and of dependent claims 17, 18, 21, 22, 25, 26, 28, 30, 31, 33, 34, 37 through 40, 43 and 45 through 47 under 35 U.S.C. § 103(a).

Concerning the examiner's rejection of claims 16 through 31 and 41 through 47 under 35 U.S.C. § 103(a) as being unpatentable over Crowley in view of Sands, we note that Crowley discloses a standoff for mounting two or more printed circuit boards to a chassis in which one keyhole cut printed circuit board may be slidably mounted on the keyhole mount portion (30, 230) of the standoff and a second printed circuit board may be mounted to the top portion of the standoff spaced away from the first printed circuit board. However, there is no disclosure or showing in Crowley of exactly what constitutes the support structure or chassis of the electronic instruments mentioned therein. The examiner has found that Crowley lacks only a latchable panel for releasably preventing unlocking movement of the circuit board relative to the support structure and concluded that it would have been obvious to one of ordinary skill in the

art to modify the configuration of Crowley to provide the retaining wall as taught by Sands.

For the reasons already set forth above in our discussions regarding the Sands patent, even if the modification urged by the examiner to the unknown support structure of Crowley were possible, the result would not be the "screwless method" of claim 16, or the tool-free mounting methods of independent claims 23, 32 and 41. In particular, we again find that consistent with appellants' specification one of ordinary skill in the art at the time of appellants' invention would not have equated the screw/bolt secured panel (119) of Sands with the latchable panel, latchable wall section or tool-free releasable wall/wall section set forth in the claims on appeal. In that regard, we again share appellants' position that by equating "latchable" with a bolt or screw, the examiner has provided a definition that is inconsistent with the ordinary meaning understood by those of ordinary skill in the art and which has neither a basis in common usage by an artisan nor a basis in the present application.

In light of the foregoing, we will not sustain the examiner's rejection of claims 16 through 31 and 41 through 47 under 35 U.S.C. § 103(a) as being unpatentable over Crowley in view of Sands.

The last of the examiner's rejections for our review is that of claims 16 through 47 under 35 U.S.C. § 103(a) as being unpatentable over Crowley in view of Sands and Ho. In setting forth this rejection, the examiner has merely indicated that "[r]egarding these claims, please refer to the rejection above" (answer, page 13). Although it is unclear which "rejection above" the examiner would have us refer to, we note that given our discussions *supra* regarding the examiner's use of Sands and Ho, it follows that the examiner's attempt here to rely on Sands and Ho to teach or suggest modifying a support structure in Crowley is equally unavailing. Again, we find that the examiner has relied upon impermissible hindsight in attempting to provide a latchable panel in place of the retaining panel (119) of Sands (now used in Crowley) that is screwed or bolted in place to prevent inadvertent shifting of the circuit board therein. Nothing in the prior art relied upon teaches or suggests replacement of such a screw/bolt retained blocking panel with a latchable panel or wall section, nor discloses any particular form of latchable panel or wall section that would be suitable to the task. Thus, the examiner's rejection of claims 16 through 47 under 35 U.S.C. § 103(a) as being unpatentable over Crowley in view of Sands and Ho will not be sustained.

In summary, we have refused to sustain any of the examiner's rejections before us on appeal, and thus the decision of the examiner to reject claims 16 through 47 of the present application is reversed.

REVERSED

IRWIN CHARLES COHEN Administrative Patent Judge	)	
CHARLES E. FRANKFORT Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
JOHN P. MCQUADE Administrative Patent Judge	)	

CEF/lbg

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