The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GREGORY B. ARNOLD
and DENNIS S. PROWS

Appeal No. 2005-2576
Application No. 09/384,675

HEARD: JANUARY 25, 2006

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

HAIRSTON, Administrative Patent Judges

DECISION ON APPEAL

This is an appeal from the final rejection of claims 37 through 67, 69, 70 and 72. Claims 73 through 76 have been found to be allowable, and claims 68 and 71 have been objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The disclosed invention relates to a hand-held printer that comprises a printer housing that includes a compartment that slidably receives a portable data entry device.

Claim 37 is illustrative of the claimed invention, and it reads as follows:

37. A hand-held printer, comprising: an elongate printer housing having a portion to receive the palm of the user's hand, the housing having a front portion and a rear portion, a platen roll at the rear portion, the printer housing including a channel and flanges at opposite sides of the housing providing a compartment to embrace a portable date entry device, an electrical connector on the housing for connection to the data entry device, the housing providing space for mounting a roll of a printable web, a print module at the rear portion of the printer housing, the connector being disposed between the front portion and the roll-mounting space, the print module including a thermal print head cooperable with the platen roll for printing on the web and an electric motor for moving the platen roll, a releasable latch to latch the portable data entry device in the compartment of the printer housing, the compartment having an open top between the flanges to provide access to the portable data entry device, the compartment being open at the end of the front portion to enable a portable data entry device to be slidably received through the open end.

The references relied on by the examiner are:

Fukumoto et al. (Fukumoto)	5,047,615	Sept. 10, 1991
Sherman et al. (Sherman)	5,186,558	Feb. 16, 1993
Goodwin et al. (Goodwin)	5,486,259	Jan. 23, 1996
Hanson	5,541,398	July 30, 1996
Austin et al. (Austin)	6,068,420	May 30, 2000 (filed Mar. 11, 1998)
McKinnon et al. (McKinnon)	6,202,642	Mar. 20, 2001 (filed Apr. 23, 1999)

Texas Instruments Abstract NL 174772B dated March 1, 1984.

Claims 37, 51 through 54 and 56 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Fukumoto in view of the admitted prior art and Sherman.

Claims 38 through 42 and 55 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Fukumoto in view of the admitted prior art, Sherman and Hanson.

Claim 43 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Fukumoto in view of the admitted prior art, Sherman and Goodwin.

Claims 44, 45, 66, 67, 69 and 70 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Fukumoto in view of the admitted prior art, Sherman, Goodwin and Austin.

Claims 46, 57 through 60 and 72 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Fukumoto in view of the admitted prior art, Sherman, Goodwin, Austin and McKinnon.

Claims 47 through 49 and 65 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Fukumoto in view of the admitted prior art, Sherman, Austin and McKinnon.

Claim 50 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Fukumoto in view of the admitted prior art, Sherman and the Texas Instruments Abstract.

Claims 61 through 64 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Fukumoto in view of the admitted prior art, Sherman and Austin.

Reference is made to the brief and the answer for the respective positions of the appellants and the examiner.

OPINION

We have carefully considered the entire record before us, and we will reverse the obviousness rejections of claims 37 through 67, 69, 70 and 72.

The admitted prior art used in the rejection is the print module 34 that includes frame 42 with sockets 43 and 44, platen roll 45 on shaft 46, electric motor 47 with gears 48 and 49, springs 50, support 51 and thermal print head 38 (Figures 3 and 7; specification, page 4, line 18 through page 5, line 21).

Fukumoto discloses a hand-held printer 3 that includes a compartment for a portable data entry device 1 (Figures 1 and 2).

The examiner acknowledges (answer, page 4) that “Fukumoto et al fails to specifically teach a platen roll at the rear portion, the print module including thermal print head cooperable with the platen roll for printing on the web and an electric motor for moving the platen roll, wherein the platen roll is pivotally

mounted toward and away from the print head, wherein the housing includes a cover, and wherein the platen roll is pivotally mounted to the cover, wherein the platen roll forms part of the print module." In view of the admitted prior art, the examiner is of the opinion (answer, page 5) that "it would have been obvious to one of ordinary skill in the art at the time of the invention to include, with the system as taught by Fukumoto et al, a platen roll at the rear portion, the print module including thermal print head cooperable with the platen roll for printing on the web and an electric motor for moving the platen roll, wherein the platen roll is pivotally mounted toward and away from the print head, wherein the housing includes a cover, and wherein the platen roll is pivotally mounted to the cover, wherein the platen roll forms part of the print module, in order to provide a compact, conventional, print module that has easily replaceable parts (see page 5, lines 17-21, of the specification) in the event that the print module becomes damaged or worn."

The examiner further acknowledges (answer, page 5) that "Fukumoto et al as modified by the admitted prior art fails to specifically teach the printer housing including a channel and flanges at opposite sides of the housing, an electrical connector

on the housing for connection to the data entry device, the connector being disposed between the front portion and the roll-mounting space, a releasable latch to latch the portable data entry device in the compartment of the printer housing, the compartment having an open top between the flanges, the compartment being open at the end of the front portion to enable a portable data entry device to be slidably received through the open end."

For the latter missing pieces of the claimed puzzle, the examiner turns to the printer housing 16 in Sherman which has a channel 39 for slidably receiving a portable data entry device 40, and electrical terminals that make electrical contact with the portable data entry device (answer, page 6). The compartment is open at the top, and has flanges 45. The examiner has referred to resilient portion 42 as a releasable latch (answer, page 6). The examiner is of the opinion (answer, pages 6 and 7) that it would have been obvious to the skilled artisan to incorporate the noted teachings of Sherman into the Fukumoto device to thereby provide "a more ergonomic system."

Appellants argue inter alia (brief, page 11) that:

> The Examiner has redesigned the Fukumoto et al device based on Appellants' own disclosure. There is no motivation to do the redesign suggested by the Examiner.

We agree with the appellants' argument that the wholesale modification of Fukumoto is based on impermissible hindsight, and that the record completely lacks any teaching that the print module in the admitted prior art "has easily replaceable parts . . . in the event that the print module becomes damaged or worn," or that the Sherman device provides "a more ergonomic system" than the portable printer device already disclosed in Fukumoto. The mere speculation by the examiner as to the benefits as well as the disadvantages of the applied prior art cannot serve as the basis of a finding of obviousness. Only the objective teachings of the prior art or knowledge generally available to one of ordinary skill in the art can be used by the examiner in an obviousness determination. See In re Lee, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

In summary, the obviousness rejection of claims 37, 51 through 54 and 56 is reversed because of the lack of any evidence in the record to support any of the examiner's proposed modifications to Fukumoto.

The obviousness rejections of claims 38 through 50, 55, 57 through 67, 69, 70 and 72 are reversed because the teachings of Hanson, Goodwin, Austin, McKinnon and the Texas Instruments Abstract do not cure the noted shortcomings in the teachings of Fukumoto, Sherman and the admitted prior art.

DECISION

The decision of the examiner rejecting claims 37 through 67, 69, 70 and 72 under 35 U.S.C. § 103(a) is reversed.

REVERSED

KENNETH W. HAIRSTON Administrative Patent Judge	)	
JOSEPH F. RUGGIERO Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
ROBERT E. NAPPI Administrative Patent Judge	)	

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