

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 ELIZABETH B. DIAZ, KUN-CHI HSIEH, and BO SIU-FAI

Appeal No. 2006-1554
Application No. 10/369,819
Technology Center 3600

ON BRIEF

Before LEVY, HORNER and FETTING, *Administrative Patent Judges*.
HORNER, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the examiner's final rejection of claims 1-6, all of the claims pending in the application. Claim 7 has been canceled.

We reverse and enter a new ground of rejection pursuant to 37 C.F.R. § 41.50(b).

BACKGROUND

The appellants' invention relates to method for replacing a side panel member of a casing of a computer. Claim 1, reproduced below, is representative of the subject matter on appeal. A copy of all of the claims on appeal can be found in the appendix to the appellants' brief.

1. A method of replacing a side panel member of a casing of a computer comprising:
 positioning the computer with a normally hidden bottom surface portion thereof exposed; and
 pushing a push button on the normally hidden bottom surface portion.

The examiner relies upon the following as evidence of unpatentability:

Miyai <i>et al.</i> (Miyai)	5,139,319	Aug. 18, 1992
Hrehor, Jr. <i>et al.</i> (Hrehor)	6,054,662	Apr. 25, 2000

The following rejections are before us for review.

1. Claims 1-3 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Hrehor.
2. Claims 4-6 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hrehor in view of Miyai.

Rather than reiterate in detail the conflicting viewpoints advanced by the examiner and the appellants regarding this appeal, we make reference to the examiner's answer (mailed November 28, 2005) for the examiner's complete reasoning in support of the rejections and to the appellants' brief (filed November 8, 2005) and reply brief (filed March 29, 2005) for the appellants' arguments.

OPINION

In reaching our decision in this appeal, we have carefully considered the appellants' specification and claims, the applied prior art, and the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations that follow.

Rejection under 35 U.S.C. § 102(e)

In the rejection of independent claim 1, the examiner determined that Hrehor teaches a removable side panel member (207) of a casing of a computer (201) that includes a push button (211) located on a bottom surface portion of the computer, wherein, pushing the push button releases a side panel member from engagement with the computer casing. Answer, p. 2 (citing Hrehor, col. 4, lines 39-44). As to the claimed method steps, the examiner determined,

[A] general application of the prior art's structure would inherently encompass the steps as set forth, i.e., *positioning the computer with a normally hidden bottom surface portion thereof exposed* [moving the computer from a location where a bottom surface portion is concealed by an adjacent wall or panel member or article {box or piece of equipment, for example} so that the bottom surface portion is now exposed to a user]; and *pushing a push button on the normally hidden bottom surface portion* [pushing the button, now exposed, to release the side panel member from the casing].
(Answer, p. 3 (emphasis in original.))

The examiner further explained,

It is viewed that the functional and abstract limitation "normally hidden" may be reasonably interpreted and broadly applied depending upon the environment in which the computer is situated or placed i.e., as presently recited, the computer may be a functioning or non-

functioning computer [used for parts e.g.,] that is stored in the corner of a room [surface portions being concealed], the computer being removed and *positioned* so as to gain access into the casing when a part is needed [surface portions exposed – button used to unlatch a panel], the computer being returned to the corner when not needed [restoration of the normally hidden surface portions]. (Answer, pp. 4-5 (emphasis in original.))

The appellants contend that Hrehor discloses that the push button (211) is to be “accessible from the front of computer system 201.” Brief, p. 12 (citing Hrehor, col. 4, lines 30-44). The appellants argue that Hrehor does not disclose that the push button (211) is located on a “normally hidden bottom surface portion” as recited in claim 1. Brief, p. 13. With regard to the examiner’s position on inherency, the appellants argue that use as a parts computer is not the normal use for a computer device. Rather, the appellants contend that the normal use for a computer device is as a functioning computer, and, in this normal use, the front panel of the computer must be accessible since it contains drive access slots, etc. Brief, p. 15. As such, the appellants challenge the examiner’s finding that a general application of the structure of Hrehor would inherently encompass the step of positioning the computer with a normally hidden bottom surface portion thereof exposed, because the push button (211) of Hrehor is already exposed when the computer is in its normal operating position. Brief, p. 15.

We agree with the appellants’ positions. First, we agree that Hrehor does not disclose the step of pushing a push button on the normally hidden bottom surface portion, because the push button (211) of Hrehor is clearly disclosed as located on the front bezel panel (209) so that it is accessible from the front of the computer system (201). Hrehor, col. 4, lines 28-31.

We disagree with the examiner that in normal use the front panel (209) would be in a hidden position. We interpret “normally hidden” as used by the appellants in the claims “not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction ‘in light of the specification as it would be interpreted by one of ordinary skill in the art.’” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316, 75 USPQ2d 1321, 1329 (Fed. Cir. 2005) (quoting *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364, 70 USPQ2d 1827, 1830 (Fed. Cir. 2004)). We must be careful not to read a particular embodiment appearing in the written description into the claim if the claim language is broader than the embodiment. See *Superguide Corp. v. DirectTV Enterprises, Inc.*, 358 F.2d 870, 875, 69 USPQ2d 1865, 1868 (Fed. Cir. 2004) (“Though understanding the claim language may be aided by explanations contained in the written description, it is important not to import into a claim limitations that are not part of the claim. For example, a particular embodiment appearing in the written description may not be read into a claim when the claim language is broader than the embodiment.”) The challenge is to interpret claims in view of the specification without unnecessarily importing limitations from the specification into the claims. See *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.2d 1364, 1369, 67 USPQ2d 1947, 1950 (Fed. Cir. 2003).

The specification throughout refers to the “normal operating position” of the computer (as shown, for example, in Figure 1) and describes that “an outer casing 270 is provided which may be mounted on housing 12 through locking engagement of casing portions with the housing and other casing portions to form an enclosure with no visible means of unlocking the casing when the computer is [in] its normal operating position.” Specification, page 39, lines 19-23. The

specification further describes that “the bottom surface 948 is exposed to an operator as by placing the computer on its side.” Specification, page 39, lines 1-2. As such, we find that it would be clear to one of ordinary skill in the art, in view of the description in the specification, that “normally hidden” as used in the claims means not visible when the computer is in its normal operating position. Because Hrehor discloses that its push button (211) is clearly visible when the computer is in its normal operating position (as shown in Figure 2), Hrehor does not disclose the step of pushing a push button on the normally hidden bottom surface portion, as recited in claim 1.

Second, we agree with the appellants that Hrehor does not inherently disclose the step of positioning the computer with a normally hidden bottom surface portion thereof exposed. Because Hrehor discloses a push button (211) visible to the user when the computer system (201) is in its normal operating position, there is no need when using the system of Hrehor to position the computer with a normally hidden bottom surface exposed (e.g., on its side) to remove a panel member. Further, we agree with the appellants that the use of the computer system (201) of Hrehor as a non-functioning “parts computer” is not the normal use of the computer. As such, we do not sustain the rejection of claim 1 under 35 U.S.C. § 102(e). Because the rejections of dependent claims 2 and 3 rely upon the underlying rejection of independent claim 1, we also decline to sustain the examiner’s rejection of these claims.

Rejection under 35 U.S.C. § 103(a)

With regard to the rejection of claims 4-6 under 35 U.S.C. § 103(a), the examiner relied on the combination of Hrehor and Miyai. Claims 4-6 depend from claim 1. We find that the combination of the teachings of Hrehor and Miyai does

not render obvious the method of claim 1. In particular, the teachings of Miyai do not cure the deficiencies of Hrehor, *viz*, locating a push button on a normally hidden bottom surface portion such that to replace a side panel member, the user positions the computer to expose the normally hidden bottom surface portion and pushes a push button on the normally hidden bottom surface portion. We find that Miyai discloses a portable cassette player (shown in Figure 12) that includes a pair of push buttons (69) on its front panel (53) and on its back panel (54). Miyai, col. 7, lines 52-53 and 60-62. To remove each facing member (51) from the cabinet (52), the push buttons (69) are depressed to release a hook (65) from a claw (70). Miyai, col. 8, lines 11-13. We find no teaching or suggestion in Miyai to locate a push button on the normally hidden bottom surface portion of the cassette player. As such, we hold that a person of ordinary skill in the art, possessed with the understandings and knowledge reflected in the prior art, and motivated by the general problem facing the inventor, *viz*, of finding a method for replacing panels on a computer that does not lend itself to inadvertent or mischievous removal, would not have been led to the method of claim 1. Because claims 4-6 depend from claim 1, we hold that these claims are also not obvious in view of Hrehor in view of Miyai. Accordingly, we do not sustain the rejection of claims 4-6 under 35 U.S.C. § 103.

NEW GROUND OF REJECTION

Under our authority provided in 37 C.F.R. § 41.50(b), we enter a new ground of rejection of claim 1 under 35 U.S.C. § 103(a) as being unpatentable over

Hrehor in view of U.S. Patent No. 4,527,906 to Jezbera and/or HP Jornada 420 Palm-size PC User's Guide, Ed. 1, 1999 ("User's Guide").¹

Hrehor discloses a method of replacing a side panel member (207) of a casing of a computer (201) including the step of pushing a push button (211). Hrehor, col. 4, lines 39-44. Hrehor does not disclose that the push button is on a normally hidden bottom surface portion, nor does Hrehor disclose the step of positioning the computer with a normally hidden bottom surface portion thereof exposed, because the push button of Hrehor is disposed on the front bezel panel (209) of the computer housing (205). Hrehor, col. 4, lines 28-31. We find, however, that it would have been obvious to one having ordinary skill in the art at the time the invention was made to have located the push button on the normally hidden bottom surface portion of the computer, instead of on the front bezel panel, in order to protect the button from inadvertent actuation. We find this to be obvious because it was well known in the prior art at the time of the invention to place other buttons, such as reset switches, on the bottom surface portion of computer devices so that they would not be inadvertently actuated. We provide two prior art references that demonstrate that placement of reset switches on the bottom surface portion of a computer device was well known.

Jezbera discloses a digital menstrual cycle indicator that includes a hidden switch (14) on the bottom surface portion of the device (Figure 3). Jezbera teaches that to reset the device, a push button (14), located beneath a battery case cover (42) on the rear of a housing (15), is depressed twice. Jezbera, col. 3, lines 30-33. Although the battery case cover (42) is described as being on the rear of the

¹ A copy of the HP Jornada User's Guide is attached to this decision.

housing (15), it is clear from Figure 3 that the push button (14) is located on the bottom surface portion of the housing (15). Jezbera further teaches that the push button (14) is hidden inside the indicator housing (15) so that it will not be accidentally depressed, with concomitant erroneous resetting of the display (12). Jezbera, col. 3, lines 35-37; see also col. 2, lines 42-45.

The HP Jornada User's Guide similarly shows a personal computer device having a reset button (17) located on the normally hidden bottom surface portion of the device. HP Jornada User's Guide, p. 10. The User's Guide teaches that to reset the device, the user must use a stylus to press the reset button (17) on the back of the device. HP Jornada User's Guide, pp. 99-101. By locating the reset button on the normally hidden bottom surface portion and by further requiring the use of a stylus to depress the button, the HP Jornada was designed to avoid inadvertent actuation of the reset button.

These two prior art references demonstrate that it was well known at the time of the invention to place push buttons on the normally hidden bottom surface portion of a computer device to avoid inadvertent actuation of the button. We find no difference in this case because the claimed method is for replacing a side panel of a casing rather than for triggering a reset switch.

The person of ordinary skill in the art is a hypothetical person who is presumed to know the relevant prior art. *Custom Accessories, Inc. v. Jeffrey-Allan Indus., Inc.*, 807 F.2d 955, 962, 1 USPQ2d 1196, 1201 (Fed. Cir. 1986). In determining this skill level, the court may consider various factors including "type of problems encountered in the art; prior art solutions to those problems; rapidity with which innovations are made; sophistication of the technology; and educational level of active workers in the field." *Id.* In a given case, every

factor may not be present, and one or more factors may predominate. *Id.* at 962-63, 1 USPQ2d at 1201.

In re GPAC, 57 F.3d 1573, 1579, 35 USPQ2d 1116, 1121 (Fed. Cir. 1995). In this case, we find that a person of ordinary skill in the art would have been familiar with the practice of locating push buttons on the normally hidden bottom surface of a computer device to avoid inadvertent actuation of a button. We also find that a person of ordinary skill in the art would have been familiar with the use of a push button to remove the side panel of a computer casing, as taught by Hrehor.

We further find that there was a sufficient “teaching, suggestion, or motivation” to modify or combine the prior art teachings that would have led to the invention. See *Dystar Textilfarben GmbH v. C.H. Patrick Co.*, 464 F.3d 1356, 1367, 80 USPQ2d 1641, 1650 (Fed. Cir. 2006) (“Our suggestion test . . . requires . . . consideration of common knowledge and common sense.”) (citations omitted).

[T]he “motivation-suggestion-teaching” test asks not merely what the references disclose, but whether a person of ordinary skill in the art, possessed with the understandings and knowledge reflected in the prior art, and motivated by the general problem facing the inventor, would have been led to make the combination recited in the claims. From this it may be determined whether the overall disclosures, teachings, and suggestions of the prior art, and the level of skill in the art – i.e., the understandings and knowledge of persons having ordinary skill in the art at the time of the invention-support the legal conclusion of obviousness.

In re Kahn, 441 F.3d 977, 988, 78 USPQ2d 1329, 1337 (Fed. Cir. 2006) (internal citations omitted).

“In considering motivation in the obviousness analysis, the problem examined is not the specific problem solved by the invention but the general problem that confronted the inventor before the invention was made. *Kahn*, 441 F.3d at 988, 78 USPQ2d at 1336 (citations omitted). In this case, the general problem to be solved was to develop a computer with removable panels that may be removed and replaced easily without lending themselves to inadvertent or mischievous removal.

To establish a prima facie case of obviousness, the references being combined do not need to explicitly suggest combining their teachings. See e.g., *Kahn*, 441 F.3d at 987-88, 78 USPQ2d at 1337-38 (“the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references”); and *In re Nilssen*, 851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988) (“for the purpose of combining references, those references need not explicitly suggest combining teachings.”).

An explicit teaching that identifies and selects elements from different sources and states that they should be combined in the same way as in the invention at issue, is rarely found in the prior art. As precedent illustrates, many factors are relevant to the motivation-to-combine aspect of the obviousness inquiry, such as the field of the specific invention, the subject matter of the references, the extent to which they are in the same or related fields of technology, the nature of the advance made by the applicant, and the maturity and congestion of the field.

...

Precedent has also recognized that “[t]he suggestion or motivation to combine references does not have to be stated expressly; rather it may be shown by reference to the prior art itself, to the nature of the problem solved by

the claimed invention, or to the knowledge of one of ordinary skill in the art.”

In re Johnston, 435 F.3d 1381, 1385, 77 USPQ2d 1788, 1790-91 (Fed. Cir. 2006) (citing *Medical Instrumentation and Diagnostics Corp. v. Elekta AB*, 344 F.3d 1205, 1221-22 (Fed. Cir. 2003)). “The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.” *Kahn*, 441 F.3d at 987-88, 78 USPQ2d at 1336 (quoting *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000)).

We find that a person of ordinary skill in the art, possessed with the understandings and knowledge reflected in the prior art, and motivated by the general problem facing the inventor, would have been led to make the combination recited in the claims. In particular, a person having ordinary skill in the art, possessed with the knowledge of using a push button to release and replace a side panel member of a casing of a computer, and possessed with the knowledge of locating push buttons on the normally hidden bottom surface portion of a computer to prevent inadvertent actuation, would have been led to locate the push button of Hrehor on the normally hidden bottom surface portion to solve the problem facing the inventor of developing a computer with removable panels that may be removed and replaced easily without lending themselves to inadvertent or mischievous removal. This configuration would naturally require one to position the computer with the normally hidden bottom surface portion exposed so as to push the pushbutton to remove and replace the side panel. As such, we reject claim 1 as obvious under 35 U.S.C. § 103(a) based on the prior art teaching of Hrehor and the common knowledge in the art of locating push buttons on the bottom surface

portion of a computer device, as taught in Jezbera and the HP Jornada User's Guide.

Observations and Remarks

Because we are primarily a board of review, we have applied the prior art references only to claim 1. We leave it to the examiner to determine whether these references, alone or in combination with other pertinent references of which the examiner is aware, should be applied to any or all of the remaining claims on appeal.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-6 is reversed. Under the provisions of 37 C.F.R. § 41.50(b), we enter a new ground of rejection of claim 1 under 35 U.S.C. § 103(a) as being unpatentable over Hrehor in view of common knowledge, as taught by Jezbera and/or HP Jornada User's Manual.

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b) (effective September 13, 2004). 37 C.F.R. § 41.50(b) provides, "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review." 37 C.F.R. § 41.50(b) also provides that the appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner....

(2) *Request rehearing*. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. The request for rehearing must address any new ground of rejection and state with particularity the points believed to have been misapprehended or overlooked in entering the new ground of rejection and also state all other grounds upon which rehearing is sought.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

REVERSED; 37 CFR 41.50(b)

STUART S. LEVY
Administrative Patent Judge

LINDA E. HORNER
Administrative Patent Judge

ANTON W. FETTING
Administrative Patent Judge

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