

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 WILLIAM P. DAVIS

Appeal 2006-2253
Application 10/464,595
Technology Center 3600

Decided: March 28, 2007

Before MURRIEL E. CRAWFORD, JENNIFER D. BAHR, and STUART S. LEVY, Administrative *Patent Judges*.

MURRIEL E. CRAWFORD, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This appeal involves claims 1 to 21, the only claims pending in this application. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b) (2002).

The claims are directed to a data protection device. Claim 1 is illustrative:

1. A data protection device comprising:

a fire-resistant enclosure comprising an inner wall and an outer wall and having a thermally resistant material between the inner and outer walls, the inner wall defining an interior volume for housing an electronic data storage device therein, and having a closeable opening, said enclosure capable of protecting contents from environmental hazard;

at least one electrical connector within said enclosure for providing power inside said enclosure; and

at least one data link within said enclosure for providing data communication between inside said enclosure and outside said enclosure when said opening is open or closed;

said at least one electrical connector and said at least one data link extending outside said enclosure for connection with at least one power source and at least one data source;

wherein said at least one electrical connector and said at least one data link extend between said inner and outer walls in such manner to substantially prevent an environmental hazard from affecting contents of said enclosure.

The Examiner relies on the following prior art references to show unpatentability:

Robbins	US 5,295,447	Mar. 22, 1994
Dhont	US 5,397,237	Mar. 14, 1995

Appellant's Prior Art Admission ("AAPA") on page 5 of Specification

REJECTIONS

The rejections as presented by the Examiner are as follows:

Claims 1 to 9, 11 to 13 and 15 to 20 are rejected under 35 U.S.C § 103(a) as unpatentable over Dhont in view of Robbins.

Claims 10, 14 and 21 are rejected under 35 U.S.C. § 103 as being unpatentable over Dhont and Robbins and further in view of AAPA.

The Examiner contends that a person of ordinary skill in the art at the time of the invention would have been motivated to modify the Dhont device so as to be comprised of a thermally resistant material, as taught by Robbins, in order to provide the device in Dhont with fire-resistant properties that would safeguard any items located within the enclosure in the event of a fire.

The Appellant contends that the Examiner has failed to cite a credible or legitimate suggestion to modify the Dhont device so as to be comprised of a thermally resistant material as taught by Robbins.

ISSUE

The sole issue in this case is whether the Appellant has shown that the Examiner erred in holding that a person of ordinary skill in the art at the time of the invention would have been motivated to modify the Dhont device so as to be comprised of a thermally resistant material, as taught by Robbins.

FINDINGS OF FACT

Dhont describes an apparatus for simulating respiratory conditions. The apparatus includes a control device 3 which is housed in a carrying case (col. 2, ll. 26 to 28). Dhont does not disclose the material of the carrying case. Dhont is silent about the environment in which the control device 3 is utilized.

Robbins discloses a fire resistant safe comprised of internal and exterior walls that encapsulate a space filled with insulation 34 (col. 5, ll. 9 to 12). The insulation is a mixture of water, Portland cement, cellulose fibers and a foaming agent (col. 5, ll. 15 to 20). The insulation 34 absorbs heat energy by changing the water in the mix from liquid state to a vapor state at 100 degrees centigrade (col. 5, ll. 16 to 20).

PRINCIPLES OF LAW

When it is necessary to select elements of various teachings in order to form the claimed invention, we ascertain whether there is any suggestion or motivation in the prior art to make the selection made by the Appellants. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or

incentive supporting the combination. The extent to which such suggestion must be explicit in, or may be fairly inferred from, the references, is decided on the facts of each case, in light of the prior art and its relationship to the appellants' invention. As in all determinations under 35 U.S.C. § 103, the decision maker must bring judgment to bear. It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the Appellants' structure as a template and selecting elements from references to fill the gaps. The references themselves must provide some teaching whereby the Appellants' combination would have been obvious. *In re Gorman*, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991) (citations omitted). That is, something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. See *In re Beattie*, 974 F.2d 1309, 1312, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992); *Lindemann Maschinenfabrik GmbH v. American Hoist and Derrick Co.*, 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984). In determining obviousness/nonobviousness, an invention must be considered "as a whole," 35 U.S.C. § 103, and claims must be considered in their entirety. *Medtronic, Inc. v. Cardiac Pacemakers, Inc.*, 721 F.2d 1563, 1567, 220 USPQ 97, 101 (Fed. Cir. 1983).

ANALYSIS

Dhont does not include any suggestion to make the carrying case fire resistant. Robbins does not disclose that the materials utilized to form the fire resistant safe can be used to form a carrying case. In fact, as the insulation in Robbins is comprised at least in part of concrete, it would appear that a person of ordinary skill in the art would not be motivated to include the insulation in the carrying case because such inclusion would increase the weight and thus reduce the portability of the case. We must conclude that the only suggestion for combining such disparate structures in the manner proposed by the Examiner stems from an impermissible hindsight reconstruction of the Appellant's invention wherein the claims have been used as a template to selectively piece together isolated disclosures in the prior art.

CONCLUSION

In view of the foregoing, we will not sustain either of the Examiner's rejections of the appealed claims because both rejections rely on the combination of Dhont/Robbins and we find no motivation or suggestion to make the combination.

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ORDER

The Examiner's decision is reversed.

REVERSED

vsh:

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