

**THIS OPINION WAS NOT WRITTEN FOR PUBLICATION**

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte SERGEY G. PODWALNY, MICHAEL D. DEROCHER,  
SCOTT N. HICKMAN and JAN HIPPEN

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Appeal No. 95-3338  
Application 07/994,035<sup>1</sup>

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ON BRIEF

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Before HAIRSTON, KRASS and JERRY SMITH, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

**DECISION ON APPEAL**

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<sup>1</sup> Application for patent filed December 21, 1992.

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This is a decision on appeal from the final rejection of claims 1 through 3, 8, 9, 11 through 13, 15 through 18 and 20. Claims 4 through 7 have been withdrawn as being directed to a nonelected invention. Claims 10, 14 and 19 have been cancelled.

The invention is directed to facilitating user interaction with portable computers and, more particularly, to a cover for the housing of such computers wherein the cover has a window therein permitting a portion of the computer screen to be viewed without first opening the cover. It is said that the invention has particular utility with scheduling and E-mail software so that when an alarm is sounded indicating an appointment or that E-mail has been received, the user can view a message through the window and possibly interact through the window, e.g., through the use of a stylus, without the need to open the cover on the portable computer housing.

Representative independent claim 1 is reproduced as follows:

1. A computer comprising:  
a housing;  
an input/output screen mounted in the housing; and  
a cover movable between first and second positions and secured in each position to the housing, in the first position the cover being arranged to overlie and protect the input/output

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screen, in the second position the cover exposing the input/output screen for use, the cover defining a window permitting a portion of the input/output screen to be viewed even when the cover is in the first position.

The examiner relies on the following references:

York	4,918,632	Apr. 17, 1990
Derocher	Des. 321,865	Nov. 26, 1991
Blonder	5,103,376	Apr. 7, 1992
Hawkins et al.	5,200,913	Apr. 6, 1993 (filed Feb. 14, 1992)
Moser et al. (Moser)	5,237,488	Aug. 17, 1993 (filed May 11, 1992)

Claims 1 through 3, 8, 9, 11 through 13, 15 through 18 and 20 stand rejected under 35 U.S.C. 103. The examiner advances two alternate theories of obviousness, one based on Derocher, alone, and the other based on the combination of York, Moser and either one of Hawkins or Blonder.

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

#### OPINION

The burden of establishing unpatentability of a claimed invention rests upon the examiner. In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988); In re Thorpe, 777

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F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985); In re Piasecki, 745 F.2d 1468, 1471, 223 USPQ 785, 787-88 (Fed. Cir. 1984).

In rejecting claims under 35 U.S.C. 103, it is incumbent upon the examiner to provide a reason why one having ordinary skill in the 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 inference in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley, 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir. 1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 291, 227 USPQ 657, 662 (Fed. Cir. 1985); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984); In re Sernaker, 702 F.2d 989, 994, 217 USPQ 1, 5 (Fed. Cir. 1983). It is imperative for the decision maker to place himself back in time to when the invention was unknown, i.e., without the appellants' disclosure at his side, and determine, in light of all the objective evidence bearing on the issue of obviousness, whether one having ordinary skill in the art would have found the claimed invention as a whole obvious under 35 U.S.C. 103. Panduit

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v. Dennison Mfg. Co., 774 F.2 1082, 1092, 227 USPQ 337, 343 (Fed. Cir. 1985), vacated, 475 U.S. 809, 229 USPQ 478 (1986), aff'd. on remand, 810 F.2d 1561, 1 USPQ2d 1593 (Fed. Cir. 1987). It should be recognized that the fact that the prior art could be modified so as to result in the combination defined by the claims at bar would not have made the modification obvious unless the prior art suggests the desirability of the modification. In re Deminski, 796 F.2d 436, 442, 230 USPQ 313, 315 (Fed. Cir. 1986).

No rationale has been presented as to why the artisan would have been led by the references to include a cover having a window for permitting a portion of the computer screen to be viewed with the cover in a closed position. As such, the examiner has failed to establish a case of prima facie obviousness necessary to support a rejection under 35 U.S.C. 103.

More particularly, with regard to the rejection of all claims relying on Derocher, alone, the examiner recognizes that the reference lacks a teaching of the "window" feature claimed. The examiner then relies on this feature to have been "old and well known," citing "cassette player, CD player" and concluding that it would have been obvious to apply this "window" feature in Derocher [answer, page 4].

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The examiner has presented no evidence of any computer cover having a window. But, even if we agree that some cassette players might have a window through a cover so as to permit inspection of the amount of audio or video tape on the feed and take-up spools, the examiner has given us no evidence to suggest why a skilled artisan would have been led to adapt such a teaching to provide for a window in the cover of a computer so that a portion of the computer screen may be viewed with the cover in the closed position.

Of course, we can agree that windows, per se, were old and well known, but that is no reason, without more, to include a window in the cover of a computer. A window in cassette players for observing tape quantity used and/or remaining is simply not relevant, in our view, to placing a window in the cover of a computer to permit viewing of a portion of a computer screen with the cover in the closed position. It would appear that the only suggestion for providing such a window comes from appellants' own disclosure and that disclosure may not properly be the basis for a finding of obviousness under 35 U.S.C. 103.

In the alternative rejection of the claims under 35 U.S.C. 103, the examiner relies on York for everything but the claimed hinges and write-on features and cites Moser for the

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hinges and either one of Hawkins or Blonder for the write-on features.

Thus, the examiner has cited four references in the rejection and not one of these applied references teaches or suggests the claimed window in the computer housing cover. The rationale for this rejection is set forth, in its entirety, in one paragraph at page 5 of the answer and no mention is made there at all as to what the examiner's rationale is with regard to the claimed window. Nowhere in the answer does the examiner explain how the claimed subject matter, including the window, is made obvious by the applied references, but we might infer, from the penultimate paragraph in the answer, that the examiner relies on the same reasoning, i.e., cassette or CD player, he applied with regard to the rejection over Derocher.

To the extent that the examiner does, indeed, rely on a "cassette or CD player" to provide for the teaching of a window in the cover of a computer housing, we reject this line of reasoning for the reasons explained supra.

Since the examiner has failed to set forth a prima facie case of obviousness with regard to the claimed subject matter, the examiner's decision is reversed.

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**REVERSED**

KENNETH W. HAIRSTON	)	
Administrative Patent Judge	)	
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ERROL A. KRASS	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
JERRY SMITH	)	
Administrative Patent Judge	)	

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