

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 35

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MIKA NIEMIO,
JARI OLKKOLA, and ARI LEMAN

Appeal No. 96-2741
Application 08/227,093¹

ON BRIEF

Before THOMAS, BARRETT, and TORCZON, Administrative Patent Judges.

BARRETT, Administrative Patent Judge.

¹ Application for patent filed April 13, 1994, entitled "Telephone Holder With Automatically Moved Retaining Members," which is a continuation of Application 07/985,185, filed December 2, 1992, now abandoned, which claims the priority benefit under 35 U.S.C. § 119 of Finland Application 915765, filed December 5, 1991.

Appeal No. 96-2741
Application 08/227,093

ON REQUEST FOR REHEARING

Appellants request rehearing of our decision entered September 24, 1997 (Paper No. 33). Specifically, appellants request rehearing of those portions of the decision sustaining the rejections of: (1) claim 11 over Kotitalo and over Watanabe based on the interpretation of "cradle"; (2) claim 15 over Kotitalo and over Watanabe in view of Takagi based on the interpretation of "deflectable"; and (3) claim 11 over Umezawa based on not giving weight to the term "members" (plural).

The request for rehearing is granted-in-part.

We refer to pages of our original decision as "D__" and to pages of appellants' Request for Reconsideration as "RR__." We refer to the pages of the Final Rejection as "FR__", to the pages of the Examiner's Answer as "EA__", and to the pages of the appeal Brief as "Br__."

OPINION

1. Claim Interpretation of "Cradle"

Appellants request that we reconsider the rejections of claim 11 over Kotitalo and over Watanabe based on an alleged error in our interpretation of "cradle."

Appeal No. 96-2741
Application 08/227,093

Appellants argue that "[a] person skilled in the art knows that a telephone holder has one cradle to hold one telephone handset" (RR2) and that "[a] person skilled in the art is not going to view Kotitalo as having two cradles to hold a single handset" (emphasis omitted) (RR2). Appellants argue that the only cradle in Kotitalo is element 1.

At the time appellants' brief was filed, Patent and Trademark Office (PTO) rules required: "For each rejection under 35 U.S.C. 102, the argument shall specify the errors in the rejection and why the rejected claims are patentable under 35 U.S.C. 102, including any specific limitations in the rejected claims which are not described in the prior art relied upon in the rejection." 37 CFR § 1.192(c)(8)(iii)(1995). The examiner found Kotitalo to have a "cradle (5, 7)" (FR3; EA6). Appellants did not address the error in the examiner's interpretation in their appeal brief. In their reply brief, appellants asserted that "'1' is the cradle." Arguments made for the first time in a reply brief are generally not considered. See 37 CFR § 1.193(b) ("The appellant may file a reply brief directed only to such new points of argument as may be raised in the examiner's

Appeal No. 96-2741
Application 08/227,093

answer."); McBride v. Merrell Dow and Pharmaceuticals, Inc.,
800 F.2d 1208, 1210-11 (D.C. 1986). Nevertheless, our
decision considered the broadest reasonable interpretation of
"cradle" and stated (D9):

We agree with the examiner that the "cradle" of
claim 11 broadly reads on clamps 5 and 7 in Kotitalo.
Claim 11 does not state that the telephone is supported
by the cradle or recite any other structure of the cradle
and so does not require that we interpret the structure
in Kotitalo that supports the handset (center part 17,
bottom part 16, bridge part 16', prongs 16'', and fluting
16''' described at column 2, lines 2-11) to be the
cradle.

Appellants do not address our reasoning as to the
broadest reasonable interpretation. That appellants wish to
have a narrower interpretation of the word "cradle" to avoid
the prior art is not persuasive of error. The telephone in
Kotitalo is cradled both by clamps 5 and 7 and by the support
structure described at column 2, lines 2-11. Appellants have
not convinced us that a telephone can have only a single
cradle or that part of the structure that supports the
telephone cannot be termed a cradle. Appellants have not
convinced us that it was error to consider the structure of
clamps 5 and 7, which keep the handset in place (col. 2, lines
66-68), to be a cradle. Accordingly, we deny appellants'

Appeal No. 96-2741
Application 08/227,093

request for rehearing to the extent it requests reversal of our decision with respect to the rejection of claim 11 over Kotitalo.

Appellants similarly argue that "[Watanabe] only discloses one cradle which the door 2 is pivotably mounted to" (RR4). The same arguments made with respect to Kotitalo apply to Watanabe. The telephone in Watanabe is cradled both by the holder 3 and by the door 2 (figure 8). Appellants have not convinced us that a telephone can have only a single cradle or that part of the structure that supports the telephone cannot be termed a cradle. Appellants have not convinced us that it was error to consider the door 2 to be a cradle. Accordingly, we deny appellants' request for rehearing to the extent it requests reversal of our decision with respect to the rejection of claim 11 over Watanabe.

2. Claim Interpretation of "Deflectable"

Appellants request that we reconsider the rejections of claim 15 over Kotitalo and over Watanabe and Takagi based on an alleged error in our interpretation of "deflectable."

Appellants argue that the dictionary definition of "deflectable" means "capable of being deflected" and "deflected" means "turned aside, or from a direct line or course." Appellants argue that our interpretation of "deflectable" as "movable" was a clear error (RR3).

As we stated in our decision (D11-12):

We interpret the term "deflectable" in claim 15 broadly to mean "movable" because appellants disclose a tongue 12 that bends and a tongue 22 that translates and both are claimed to be "deflectable"; compare claims 11 and 18.

Appellants do not address the context in which we made the statement, nor do appellants try to explain how the definition of "turned aside, or from a direct line or course" requires a certain structure that is not shown in the references. It is possible to define "deflectable" to mean capable of being displaced due to bending, like the deflection (i.e., turning aside) of a beam under a load. Appellants' tongues 12 in figure 2 bend. We noted, however, that appellants also used the term "deflectable" to apply to the "tongue" in claim 18

Appeal No. 96-2741
Application 08/227,093

and, as shown in appellants' figures 2 and 3, the tongue 22 translates, i.e., moves in a straight line, but does not bend. In our opinion, "deflectable" is broad enough to encompass both situations where the tongues move aside by bending or by translating, which is all that we meant by "movable." This interpretation of "deflectable" is consistent with the definition of "turned aside." However, the real issue is whether we were wrong in our finding that the ends of the clamps 5, 7 with the projections are "cantilevers [sic, cantilevered] deflectable tongues," which issue is not addressed by appellants. Appellants have not convinced us of error in our finding. Accordingly, we deny appellants' request for rehearing to the extent it requests reversal of our decision with respect to the rejection of claim 15 over Kotitalo.

Appellants similarly argue the "projections and upright arms on the hinged front door 2 of Watanabe are certainly movable with the door when the door is moved, but they are not 'deflectable' (i.e.: capable of being turned aside, or from a direct line or course)" (RR5). As explained supra, "deflectable" is interpreted to mean "movable" in the sense

Appeal No. 96-2741
Application 08/227,093

that the tongue is movable to the side and does not require any particular physical kind of movement like bending or translation, because appellants have used the term "deflectable" to describe both kinds of movement. The projections on the hinged front member in Watanabe are considered "cantilevers [sic, cantilevered] deflectable tongues." The tongues are "deflectable" (movable) because they are moved out of position when the hinged front member is rotated. Appellants have not convinced us of any error in our finding that the projections in Watanabe are cantilevered deflectable tongues. Accordingly, we deny appellants' request for rehearing to the extent it requests reversal of our decision with respect to the rejection of claim 15 over Watanabe and Takagi.

3. Patentable Weight of Claim Language "Members" (Plural)

Appellants argue that it was inappropriate to not address the limitation of "members" (plural) (RR3). Appellants argue that "[t]he Board cannot ignore the actual claim language because Appellants did not argue it" (RR3).

Appeal No. 96-2741
Application 08/227,093

At the time appellants' brief was filed, PTO rules required: "For each rejection under 35 U.S.C. 103, the argument shall specify the errors in the rejection and, if appropriate, the specific limitations in the rejected claims which are not described in the prior art relied on in the rejection, and shall explain how such limitations render the claimed subject matter unobvious over the prior art." 37 CFR § 1.192(c)(8)(iv). Because the PTO has a rule requiring appellants to argue contested limitations we, like our reviewing court, are not required to look for differences beyond those which are discussed in appellants' brief. Cf. In re Baxter Travenol Labs., 952 F.2d 388, 391, 21 USPQ2d 1281, 1285 (Fed. Cir. 1991) ("It is not the function of this court to examine the claims in greater detail than argued by an appellant, looking for nonobvious distinctions over the prior art."); In re Wiechert, 370 F.2d 927, 936, 152 USPQ 247, 254 (CCPA 1967) ("This court has uniformly followed the sound rule that an issue raised below which is not argued in this court, even if it has been properly brought here by a reason of appeal, is regarded as abandoned and will not be considered. It is our function as a court to decide

Appeal No. 96-2741
Application 08/227,093

disputed issues, not to create them."); In re Wiseman,
596 F.2d 1019, 1022, 201 USPQ 658, 661 (CCPA 1979) (arguments
must first be presented to the Board before they can be argued
on appeal). It is not prudent to reverse a rejection based on
an uncontested limitation because, for all we know, an
appellant's reason for not contesting the limitation may be
that appellant knows it constitutes obvious subject matter.
Also, we do not have the benefit of the examiner's views.
Because the PTO has a rule which requires appellants to argue
contested limitations and because it is sound legal policy not
to get into undisputed issues, it is proper to address only
the argued limitations.

Appellants argue that they did argue that Umezawa did not
disclose locking members (plural) at page 7, second paragraph.
That portion of the Brief states that "there is no disclosure
or suggestion in Umezawa that slide member (8) has movable
locking members" (Brief, page 7). Although appellants did not
address the examiner's interpretation of elements 19-21 as
being the "movable locking members" in the Brief, since
appellants denied that the limitation was found in Umezawa we
will consider the limitation to have been argued as required

Appeal No. 96-2741
Application 08/227,093

by 37 CFR § 1.192(c)(8)(iv). We noted in our decision (D14-15) that Umezawa has only one locking member 21 and that elements 19 and 20 noted by the examiner cannot be considered locking members. Accordingly, we now reverse the anticipation rejection of claims 11 and 13 over Umezawa.

Appeal No. 96-2741
Application 08/227,093

CONCLUSION

Upon consideration of appellants' request for rehearing, we have denied the request with respect to making any changes in our decision regarding the rejections of claim 11 over Kotitalo and over Watanabe, and the rejections of claim 15 over Kotitalo and over Watanabe and Takagi, but we have modified our decision to the extent that the rejection of claims 11 and 13 over Umezawa is now reversed. Accordingly, the request for rehearing has been granted-in-part and the original decision is modified.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

GRANTED-IN-PART

JAMES D. THOMAS)
Administrative Patent Judge)
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) BOARD OF PATENT
LEE E. BARRETT) APPEALS

Appeal No. 96-2741
Application 08/227,093

Administrative Patent Judge)	AND
)	INTERFERENCES
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Appeal No. 96-2741
Application 08/227,093

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