

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte VIKTORS BERSTIS

Appeal No. 2002-0604
Application No. 09/240,926

ON BRIEF

Before ABRAMS, NASE, and BAHR, Administrative Patent Judges.
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 3, 6, 8-14, 17-23, 26-28 and 32-37. Claims 29-31 have been indicated as containing patentable subject matter and allowable if recast in independent form, and claims 1, 2, 4, 5, 7, 15, 16, 24 and 25 have been canceled.

We AFFIRM-IN-PART.

BACKGROUND

The appellant's invention relates to a portable electronic device. An understanding of the invention can be derived from a reading of exemplary claims 3 and 6, which appear in the appendix to the appellant's Brief.

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Neumann	5,956,660	Sep. 21, 1999
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Claim 3 stands rejected under 35 U.S.C. § 102(a) as being anticipated by Neumann.

Claims 6, 8-14, 17-23, 26-28 and 32-37 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Neumann.¹

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the Answer (Paper No. 12) for the examiner's complete reasoning in support of the rejections, and to the Brief (Paper No. 10) for the appellant's arguments thereagainst.

¹The statement of the rejection in the Answer erroneously included claims 29-31, which the examiner previously had indicated contained allowable subject matter.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The Rejection Under Section 102

The appellant's invention as manifested in claim 3 is a "mobile telephone" comprising data storage that stores a reference position, at least one inertial motion sensor that detects movement of the mobile telephone and outputs a signal indicative of the movement, computational circuitry coupled to the data storage and to the inertial motion sensor for computing the position of the mobile telephone in response to the reference position and the inertial motion sensor, and at least one input device and output device that receives user inputs and presents outputs.

The examiner is of the view that Neumann anticipates this claim. It is axiomatic that anticipation is established only when a single prior art reference discloses, either expressly or under the principles of inherency, each and every element of the claimed invention. See, for example, In re Paulsen, 30 F.3d 1475, 1480-1481, 31 USPQ2d 1671, 1675 (Fed. Cir. 1994) and In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990). However, we agree with the appellant that such is not the case

with Neumann, and therefore the rejection of claim 3 as being anticipated by Neumann cannot be sustained.

We arrive at this conclusion because Neumann does not disclose a “mobile telephone,” the common definition of which is a device that converts sound waves to electrical impulses for transmission.² Neumann is directed to a system for surveying which utilizes an inertial sensor carried by the surveyor to determine the surveyor’s position with respect to a reference point. While, as the examiner has pointed out, the Neumann device includes a GPS interface that transmits and receives data, there is no teaching in the reference that this data is in the form of sound waves, much less that the apparatus converts sound waves to electrical impulses for transmission. Moreover, the reference does not give any indication, nor would there be any reason for, voice or sound wave communication in the course of operating the system.

The Rejection Under Section 103

The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a prima facie case of obviousness, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See Ex parte Clapp,

²See, for example, Webster’s New Collegiate Dictionary, 1973, page 1198.

227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988).

Claims 6, 8-14, 17-23, 26-28 and 32-37 have been rejected as being unpatentable over Neumann. With regard to independent claims 6, 13 and 22, it is the examiner's position that all of the subject matter recited therein is disclosed in Neumann, except for the requirement that bearing information be computed and displayed. However, the examiner is of the opinion that because Neumann "can display" position, velocity or angular distance data, it would have been obvious to one of ordinary skill in the art that the Neumann system "inherently computes and displays bearing information" (Answer, page 4). The appellant disputes this finding, on the basis that any bearing information provided is obtained by the human user using an optical system, rather than by the "computational circuitry" required by claims 6 and 13, and the "instruction means for computing a bearing" in claim 22. We agree.

Neumann explains in lines 1-9 of column 3 that distances can be measured to remote objects by means of a sighting scope which can be used to provide precise angular measurement from two points along a baseline. After the length of the baseline

is determined by pacing it off, the measurements can be used to compute the distance to the object. However, there clearly is no teaching of providing computational circuitry coupled to a memory and a motion sensor, and using this system to compute and present an indication of the bearing, as is required by independent claims 6, 13 and 22. We are not convinced otherwise by the explanations provided by the examiner on pages 5 and 6 of the Answer, in response to the appellant's arguments. We also wish to point out that we do not agree with the examiner that the feature in claims 8, 17 and 26 of presenting a three-dimensional presentation on a two-dimensional display would have been obvious in view of Neumann.

It therefore is our conclusion that the teachings of Neumann do not establish a prima facie case of obviousness with regard to the subject matter recited in independent claims 6, 13 and 22 and, it follows, of claims 8-12, 14, 17-21, 23 and 26-28, which depend therefrom.

It is the examiner's view that the method of claims 32 and 33, the device of claims 34 and 35, and the program product of claims 36 and 37 would have been obvious to one of ordinary skill in the art in view of column 5, lines 27-42 and column 6, lines 20-37 of Neumann. The appellant has grouped these claims with claim 6, and has not provided in the Brief any argument separately challenging their rejection. This being the case, the position advanced by the examiner with regard to claims 32-37 stands uncontroverted, and we shall sustain the rejection of these claims.

SUMMARY

The rejection of claim 3 under 35 U.S.C. § 102(a) as being anticipated by Neumann is not sustained.

The rejection of claims 6, 8-14, 17-23 and 26-28 as being unpatentable over Neumann is not sustained.

The rejection of claims 32-37 as being unpatentable over Neumann is sustained.

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

AFFIRMED-IN-PART

NEAL E. ABRAMS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JEFFREY V. NASE)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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JENNIFER D. BAHR)	
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NEA/LBG

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RETURN TO LESLEY

APPEAL NO. 2002-0604 - JUDGE ABRAMS
APPLICATION NO. 09/240,926

APJ ABRAMS

APJ BAHR

APJ NASE

DECISION: AFFIRMED-IN-PART

Prepared By: Lesley Brooks

GAU: 3600

OB/HD

DRAFT TYPED: 07 Aug 03

FINAL TYPED: