

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. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

**Ex parte** JOO-SEUNG PARK

---

Appeal No. 2002-1400  
Application No. 09/131,279

---

ON BRIEF<sup>1</sup>

---

Before RUGGIERO, DIXON and BLANKENSHIP, **Administrative Patent Judges**.  
DIXON, **Administrative Patent Judge**.

**DECISION ON APPEAL**

This is a decision on appeal from the examiner's final rejection of claims 1-15, which are all of the claims pending in this application.<sup>2</sup>

We REVERSE.

---

<sup>1</sup> The panel decided that a reversal of the examiner's rejection was necessary based upon the showing in the brief due to a lack of a *prima facie* case by the examiner and notified appellant's representative that an Oral Hearing was not necessary.

<sup>2</sup> The examiner has withdrawn the rejection under 35 USC § 112, first paragraph.

## BACKGROUND

Appellant's invention relates to a cordless facsimile system with telephone answering function incorporated into the portable cordless unit. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. A unitary, portable, wireless, cordless facsimile unit with a telephone answering function, said facsimile unit adapted to communicate via a base unit connected to a telephone network, said facsimile unit comprising a single housing in which is located:

a radio circuit for demodulating a reception signal received from the base unit via an antenna, and for modulating a transmission signal for transmission to the base unit via said antenna;

a voice processor for converting an analog voice signal output from the radio circuit into digital voice data and converting the digital voice data into the analog voice signal for transmission to the radio circuit;

a memory for storing voice data for an outgoing message and an incoming message;

a controller having means for establishing a speech path with the telephone network via the base unit upon receiving a ring signal reflecting an incoming call from the base unit, means for reading the voice data for the outgoing message stored in the memory to transmit the read voice data to the base unit through the voice processor and the radio circuit, and means for storing in the memory the voice data for the incoming message received from the telephone network through the radio circuit and the voice processor.

The prior art reference of record relied upon by the examiner in rejecting the

Appeal No. 2002-1400  
Application No. 09/131,279

appealed claims is:

Payne et al. (Payne)	5,854,694	Dec. 29, 1998
----------------------	-----------	---------------

Claims 1-15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Payne.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellant regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 15, mailed Sep. 13, 2001) for the examiner's reasoning in support of the rejections, and to appellant's brief (Paper No. 14, filed Jun. 21, 2001) and reply brief (Paper No. 17, filed Nov. 13, 2001) for appellant's arguments thereagainst.

### OPINION

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

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness. **See In re Rijckaert**, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A *prima facie* case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to

Appeal No. 2002-1400  
Application No. 09/131,279

make the proposed combination or other modification. **See In re Lintner**, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is *prima facie* obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. **See In re Fine**, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Rejections based on § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. **See In re Warner**, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), **cert. denied**, 389 U.S. 1057 (1968). Our reviewing court has repeatedly cautioned against employing hindsight by using the appellant's disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings of the prior art. **See, e.g., Grain Processing Corp. v. American Maize-Products Co.**, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

The examiner has continually maintained that Payne teaches a unitary portable, wireless, cordless facsimile unit with a telephone answering function and that the facsimile unit contains a voice processor for converting an analog voice signal output

from the radio circuit into digital voice data and converting the digital voice data into the analog voice signal for transmission to the radio circuit and the memory for storing voice data for an outgoing message and an incoming message. (See answer at pages 3-5 and 12-17.) The examiner repeatedly cites to column 4, lines 48-54 and 57-67 along with a select other few lines in Payne.

Appellant argues that Payne does not teach all the elements of the claimed invention as recited in the independent claims and that the answering machine and voice processor are not in the portable unit. (See brief at page 11 et seq.) We fully agree with appellant. From our review of the express teachings of Payne and with special attention to the portions cited by the examiner, we find no express or implicit teaching or suggestion of incorporating the additional use of an answering machine connected to the “base station” or “non-portable apparatus” (Payne at column 2, lines 20-33) into the integral hand held device. While the examiner repeatedly incorporates citations to portions of Payne, we find that none of these portions teach or suggest the use of an answering machine anywhere but in the base station which is not integral with the portable unit. Additionally, we do not find any teaching that the answering machine would have been a digital device which would have included a voice processor and corresponding memory. While we do not preclude a finding that the use of a digital answering machine may have been obvious, the examiner has not set this forth as a rejection based upon obviousness and has not provided any teaching thereof in the

stated rejection. Therefore, we find no evidence of record to support the rejection and find that the examiner has not set forth a *prima facie* case of obviousness.

From the portions of Payne cited by the examiner, it appears that the examiner may have misplaced the reliance on the image processing and data transmission as also teaching the processing a transmission of voice data. We cannot agree with the examiner's correspondence of the teachings of Payne to the instant claimed invention. Our reviewing Court has made it clear in **In re Lee**, 277 F.3d 1338, 1344-1345, 61 USPQ2d 1430, 1434-1435 (Fed. Cir, 2002) and **In re Zurko**, 258 F.3d 1379, 1386, 59 USPQ2d. 1693, 1697 (Fed. Cir. 2001) that rejections must be supported by the administrative record and that where the record is lacking in evidence, this Board cannot and should not resort to unsupported speculation. (See also **In re Warner**, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967)). Therefore, we limit our decision to the limited facts relied upon by the examiner in the rejection and the limited teachings of the sole reference. We make no findings concerning the obviousness or combinability of Payne with any other facsimile machine which may teach the well-known incorporation within a non-portable facsimile machine of multiple functions within a single unitary device such as facsimile, telephone and digital answering machine functionalities since the examiner has not applied such a combination. As discussed above, we find that the examiner has not set forth a *prima facie* case of obviousness based solely upon the teachings of Payne, and we cannot sustain the rejection of

Appeal No. 2002-1400  
Application No. 09/131,279

independent claims 1, 6, and 11 and their corresponding dependent claims.

### **CONCLUSION**

To summarize, the decision of the examiner to reject claims 1-15 under 35 U.S.C. § 103 is reversed.

**REVERSED**

Appeal No. 2002-1400  
Application No. 09/131,279

JOSEPH F. RUGGIERO  
Administrative Patent Judge

JOSEPH L. DIXON  
Administrative Patent Judge

HOWARD B. BLANKENSHIP  
Administrative Patent Judge

)  
)  
)  
)  
)  
) BOARD OF PATENT  
) APPEALS  
) AND  
) INTERFERENCES  
)  
)  
)  
)

JD/RWK

Appeal No. 2002-1400  
Application No. 09/131,279

ROBERT E. BUSHNELL, ATTORNEY-AT-LAW  
1522 K STREET, NW  
SUITE 300  
WASHINGTON, D.C. 20005-1202