

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. 43

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RALPH CARLSEN, MARC P. KAPLAN
and JOHN S. ROBERTSON

Appeal No. 1997-0402
Application 07/843,685

HEARD: AUGUST 17, 2000

Before BARRETT, HECKER and LALL, **Administrative Patent Judges**.

HECKER, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1 through 22. The Examiner's Answer, paper no. 34, withdrew all outstanding grounds of rejection and stated new grounds of rejection for claims 1 through 6, 8 through 15 and 18 through 22. The Examiner indicated that

claims 7, 16 and 17 would be allowable if rewritten in independent form to include all limitations of any base claims.¹ Claims 23 through 41 have been canceled.

The invention relates to a portable communication unit. When a caller places a telephone call to a called party, the called party's portable unit receives paging signals and automatically initiates a return telephone call without alerting (e.g., ringing) the called party. If the portable unit receives an "in-progress" signal via the return call, the portable unit alerts (e.g., rings) so that the called party becomes aware of the call. If there is no "in-progress" signal via the return call, meaning the caller is no longer connected, the portable unit does not alert the called party. Consequently, once the "in-progress" signal ceases to be received at the portable unit, the portable unit will stop supplying the alerting indication. Thus, if a caller who originates a telephone call to a called party hangs up at any

¹ Although the Examiner's Answer also stated that claims 7, 16 and 17 must be rewritten to overcome a rejection under 35 U.S.C. § 112, we note this rejection had been withdrawn. This is acknowledged in the Examiner's Supplemental Answer, page 1.

Appeal No. 1997-0402
Application 07/843,685

point prior to the "in-progress" signal being received over the return telephone call, the personal unit will never alert for that telephone call. Likewise, if the caller hangs up while the personal unit is alerting but prior to the called party having picked up the telephone, the alerting will cease, as for a conventional telephone call.

Representative independent claim 1 is reproduced as follows:

1. Portable apparatus for use in completing a telephone call that is initiated from a calling telephone to a called individual comprising:

means for receiving an actuation signal in response to said telephone call placed to said called individual;

means responsive to reception of said actuation signal for placing a second telephone call over a telephone channel through a switched telephone network to a predetermined location;

means for receiving from said location over said telephone channel an indication that said telephone call from said calling telephone continues to be in progress; and

means responsive to continued reception of said indication for supplying an alerting indication from said portable device.

The Examiner relies on the following references:

Gillig et al. (Gillig)	5,127,042	Jun. 30, 1992
	(effectively filed Sep. 23, 1988)	

Appeal No. 1997-0402
Application 07/843,685

The Examiner has failed to set forth a *prima facie* case. It is the burden of the Examiner to establish why one having ordinary skill in the art would have been led to the claimed invention by the reasonable teachings or suggestions found in the prior art, or by a reasonable inference to the artisan contained in such teachings or suggestions. *In re Sernaker*, 702 F.2d 989, 995, 217 USPQ 1, 6 (Fed. Cir. 1983). "Additionally, when determining obviousness, the claimed invention should be considered as a whole; there is no legally recognizable 'heart' of the invention." *Para-Ordnance Mfg. v. SGS Importers Int'l, Inc.*, 73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995) (*citing W. L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1548, 220 USPQ 303, 309 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984)).

With regard to the rejection of claim 1, the Examiner reasons that Miska teaches the claimed invention except for placing the second call automatically, instead of manually (answer-pages 7 and 8). The Examiner states:

It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the means responsive to reception of

Appeal No. 1997-0402
Application 07/843,685

the actuation signal for placing a second call over a telephone channel through a switched telephone network in the portable apparatus of [Miska], since it has been held that broadly providing a mechanical or automatic means to replace manual activity which has accomplished the same result involves only routine skill in the art. *In re Venner*, 120 USPQ 192. [Answer-page 8.]

Appellants argue that the playing of an announcement in Miska is **not** an alerting indication as that term is recognized in the art and used in Appellants' specification. (Reply brief-page 3.)

The Examiner responds that he is giving the claim language its broadest reasonable interpretation and Appellants may not impute limitations in the specification to the claims. (Supplemental Answer-page 5.)

We agree with Appellants. The Examiner's broad interpretation should not go beyond that which is ordinarily understood in the art. Miska's recorded message is quite different than the typical ringing **alert** given by a telephone.

Even if the Examiner's interpretation were acceptable, Appellants' reliance on their specification, for the type of alert claimed, is justified by their "means for" claiming

Appeal No. 1997-0402
Application 07/843,685

under 35 U.S.C. § 112, paragraph 6. With respect to Appellants' complaint that Miska's pager 114 gives an alert that is not claimed, the Examiner is correct that the additional alert is irrelevant.

We note further that the Examiner has designated Miska's cell phone 102 as the means for placing a second call, and at the same time designated Miska's 102 as the portable device supplying the alert (answer-pages 6 and 7).

Appellants' claims, couched in "mean for" language, and their disclosure, clearly call for these elements to be separate and different, note Figure 1, elements 125 and 103.

Additionally we note, the claimed "means responsive to reception of said actuation signal for placing a second telephone call" is disclosed as an automatic means. We do not agree with the Examiner that *In re Venner* makes converting **any** manual operation to an automatic operation routine in the art. There must be some evidence to show the simplicity of converting a particular operation. The mere allegation that it can be done is not convincing.

The Federal Circuit states that "[the mere fact that

Appeal No. 1997-0402
Application 07/843,685

the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." **In re Fritch**, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992), **citing In re Gordon**, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). "Obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor." **Para-Ordnance Mfg. v. SGS Importers Int'l**, 73 F.3d at 1087, 37 USPQ2d at 1239, **citing W. L. Gore & Assocs., Inc. v. Garlock, Inc.**, 721 F.2d at 1551, 1553, 220 USPQ at 311, 312-13.

In view of the foregoing, we will not sustain the Examiner's rejection of claim 1. The remaining claims on appeal, dependent directly or indirectly from claim 1, also contain the above limitations discussed in regard to claim 1 and thereby, we will not sustain the rejection as to these claims.

We have not sustained the rejection of claims 1 through 6, 8 through 15 and 18 through 22 under 35 U.S.C. § 103. Accordingly, the Examiner's decision is reversed.

Appeal No. 1997-0402
Application 07/843,685

REVERSED

LEE E. BARRETT)	
Administrative Patent Judge)	
)	
)	
STUART N. HECKER)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
PARSHOTAM S. LALL)	
Administrative Patent Judge)	

SNH/ki

James A. Oliff
Oliff & Berridge, PLC
P.O. Box 19928
Alexandria, VA 22320