

The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GAROLD B. GASKILL

Appeal No. 1998-2693
Application No. 08/569,976

ON BRIEF

Before HAIRSTON, BARRETT, and BARRY, Administrative Patent Judges.

BARRY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the rejection of claims 1 and 15-17. We reverse.

BACKGROUND

The invention at issue in this appeal relates to paging. Paging systems identify messages sent to paging receivers, commonly called "pagers," based on addresses stored therein. Such a pager monitors transmitted signals for messages with a

destination address matching an address of the pager. If the destination address of a message matches a pager's address, the pager processes and displays the message.

A pager can be shared by plural persons, e.g., a family. Because every message transmitted to the pager is displayed, the person currently having the pager receives all messages sent to family members. That person, however, may not want to be disrupted by messages for other family members.

The appellant's pager permits a user to select locally and manually at least one of several stored addresses. Accordingly, the pager can be set to respond to different addresses at different times. At any given time, if the destination address of a transmitted message matches at least one of the selected addresses, the pager processes and displays the message. Otherwise, the message is neither processed nor displayed so that the user is undisturbed.

Claim 1, which is representative for our purposes, follows:

1. A RF receiver for receiving wireless RF transmission data including associated transmitted receiver addresses, comprising:

an output device for supplying the transmission data;

multiple storage locations containing stored Selectable receiver addresses;

a manually operable selection means located on said receiver for enabling and disabling stored receiver addresses; and

a processor coupled to the output device, storage locations and selection device, the processor supplying data to the output device having a data address matching at least one of the enabled receiver addresses.

The references relied on in rejecting the claims follow:

Moore (Moore '121) 1990	4,964,121	Oct. 16,
Berry et al. (Berry) 1992	5,117,460	May 26,
Moore (Moore '021	5,398,021	Mar. 14, 1995.

Claims 1 and 15-17 stand rejected under 35 U.S.C. §
103(a) as obvious over Moore '021 in view of Moore '121
further in view of Berry. Rather than repeat the arguments of

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the appellant or examiner in toto, we refer the reader to the
brief and answer for the respective details thereof.

OPINION

In deciding this appeal, we considered the subject matter on appeal and the rejection advanced by the examiner. Furthermore, we duly considered the arguments and evidence of the appellant and examiner. After considering the totality of the record, we are persuaded that the examiner erred in rejecting claims 1 and 15-17. Accordingly, we reverse.

We begin by noting the following principles from In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993).

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).... "A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." In re Bell, 991 F.2d 781, 782, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) (quoting In re Rinehart, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976)).

With these principles and finding in mind, we consider the examiner's rejection and appellant's argument.

The examiner alleges, "switch 44 in Berry et al. is manually operable to provide full control of the receiver; one skilled in the art would have recognized full control to include 'enabling and disabling the receiver's stored addresses.'" (Examiner's Answer at 7.) The appellant argues that in Berry "there is no command to change the address to which the receiver responds." (Appeal Br. at 4.)

Claims 1 and 15 specify in pertinent part the following limitations: "multiple storage locations containing stored Selectable receiver addresses; a manually operable selection means located on said receiver for enabling and disabling stored receiver addresses" Similarly, claims 16 and 17 specify in pertinent part the following limitations: "storing multiple receiver addresses in each one of the receivers, each stored receiver address associated with a different receiver user; receiving the signals with the RF receivers; ... and manually selectively enabling and disabling at said receiver the stored receiver addresses thereby selectively changing the data supplied to the receivers for each user." Accordingly, claims

1 and 15-17 require manual, local enabling and disabling of a receiver's addresses.

The examiner fails to show a suggestion of the limitations in the prior art. "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 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995), cert. denied, 519 U.S. 822 (1996)(citing W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1551, 1553, 220 USPQ 303, 311, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984)). "It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992) (citing In re Gorman, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991)). "The mere fact that 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." Id. at 1266,

23 USPQ2d at 1784 (citing In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984)).

The examiner admits that Moore '021 "fails to specifically teach the enabling/disabling of the receiver addresses is achieved by manually operating the selection means" (Examiner's Answer at 5.) Rather than manual, local enabling and disabling of the addresses to which a pager responds, the reference discloses that the addresses are controlled by signals sent from a central controller. Specifically, "the paging system **106** will then verify if the receiver is authorized to receive the subscription, at step **524**. If not authorized, then the paging system **106** will send the disable code at step **526**." Col. 8, ll. 57-61.

Although Berry teaches that "voice commands may be used in conjunction with manually entered commands (or vice versa) to execute a desired function[,]" col. 5, ll. 23-26, the reference does not mention a command or function for enabling and disabling a pager's address. To the contrary, Berry

suggests that only a single address is stored in the pager. Specifically, "pagers are typically provided with subscriber specific information, such as, for example, an identification code. However, this type of information may be readily generated and stored within the pager." Col. 1, ll. 43-47. Relying on Moore '121 only to teach "transmission of RF signals ... in a time division multiplexed format." (Examiner's Answer at 6), the examiner fails to allege, let alone show, that Moore '121 cures the deficiency of Moore '021 and Berry.

Because Berry does not teach a command or function for enabling and disabling a pager's address, we are not persuaded that teachings from the prior art would have suggested the limitations of "multiple storage locations containing stored Selectable receiver addresses; a manually operable selection means located on said receiver for enabling and disabling stored receiver addresses" or "storing multiple receiver addresses in each one of the receivers, each stored receiver address associated with a different receiver user; receiving the signals with the RF receivers; ... and manually

selectively enabling and disabling at said receiver the stored receiver addresses thereby selectively changing the data supplied to the receivers for each user." Therefore, we reverse the rejection of claims 1 and 15-17 as obvious over Moore '021 in view of Moore '121 further in view of Berry.

CONCLUSION

In summary, the rejection of claims 1 and 15-17 under 35 U.S.C. § 103(a) as obvious over Moore '021 in view of Moore '121 further in view of Berry is reversed.

REVERSED

KENNETH W. HAIRSTON)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
LEE E. BARRETT)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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LANCE LEONARD BARRY)	
Administrative Patent Judge)	

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ELMER W. GALBI
SEIKO COMMUNICATION SYSTEMS INC.
1625 NW AMBER GLEN COURT SUITE 140
BEAVERTON, OR 97006

LLB/dal