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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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 30

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte NILS E.V. MARTENSSON and MICHAEL B. ASHDOWN

Appeal No. 1998-2936
Application No. 08/665,590

ON BRIEF

Before FLEMING, 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 16-20.
Claims 1-15 have been indicated as allowable by the examiner.

We AFFIRM.

BACKGROUND

The appellants' invention relates to a cordless telephone arrangement using a two step process in order to complete a call. An understanding of the invention can be derived from a reading of exemplary claim 16, which is reproduced below.

16. In a communication system comprising a wireless telephone and a base station capable of bidirectional wireless communications with said wireless telephone; a method for placing a telephone call comprising steps of:

in response to an input from a user of a wireless telephone, initiating the placement of a telephone call in accordance with signaling information exchanged between said telephone and said base station; and

completing the placement of the telephone call after the base station receives audio voice information transmitted from said wireless telephone to said base station, the audio voice information including an identification of a telephone number to be called.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Burke et al. (Burke)	4,677,656	Jun. 30, 1987
Gerson et al. (Gerson)	4,870,686	Sep. 26, 1989
Reed et al. (Reed)	5,371,901	Dec. 06, 1994

(Eff. filing date Jul. 08, 1991)

Claims 16 and 17 stand rejected under 35 U.S.C. § 103 as being unpatentable over Burke in view of Gerson. Claims 18-20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Burke and Gerson in view of Reed.

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Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 29, mailed Mar. 11, 1998) for the examiner's reasoning in support of the rejections, and to the appellants' brief (Paper No. 28, filed Jan. 8, 1998) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants 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 make the proposed combination or other modification. **See In re Lintner**, 9 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

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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).

Further, as pointed out by our reviewing court, we must first determine the scope of the claim. "[T]he name of the game is the claim." **In re Hiniker Co.**, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). Therefore, we look to the

limitations set forth in the claim. Here, we note that the language of claim 16 is quite broad in the recitation of the step of “initiating the placement of a telephone call in accordance with signaling information exchanged between said telephone and said base station.” We note that the language of the claim does not limit the type of input from the user, wherein it may be manual actuation of a key or a voice input. Further-more, the claim does not limit the signaling between the units.

Hence, the initiation of the call need only be “in accordance with signaling information exchanged between said telephone and said base station.” (Emphasis added.) In our view, all cellular telephones must communicate with the base station within each cell as a cellular telephone is moved from cell to cell wherein there is a required communication between a cellular telephone and a base station to register the phone within a cell. All calls made would be required to be made “in accordance with signaling information exchanged between said telephone and said base station.”

With this said, we turn to the rejection by the examiner. The examiner offers Burke and Gerson as evidence of obviousness. The examiner maintains that the user’s input from pressing the “telephone” key signals information exchange between the mobile unit and base station. (See answer at page 4 and Burke at col. 10.) It is unclear from the cited passage of Burke whether the actuation of the “telephone” key

transmits information between the units. Rather, the depression of the “transmit” key after input of the entire telephone number transmits the phone number to the base station in accordance with the signaling information exchanged between the telephone and the base station in the cell.

With an alternative interpretation, we view the acknowledge back signal or no acknowledge and retransmission of the signal as an exchange of signaling information between the telephone and the base station.

The examiner admits that Burke does not teach or suggest “completing the placement of the telephone call after the base station receives audio voice information transmitted from said wireless telephone to said base station, the audio voice information including an identification of a telephone number to be called.” Specifically the examiner admits that Burke does not disclose the use of “voice audio information.” (See answer at page 4.) We agree with the examiner.

The examiner offers Gerson as evidence of the use of voice audio information for input of a telephone number. We agree with the examiner that Gerson teaches the use of voice audio information to input both function commands and called party identification information. (See Gerson at col. 5.) Gerson teaches the inclusion of a telephone number in the voice audio information. **Id.** at lines 29-30. With the broad language of claim 16, as discussed above, it is our view that Gerson alone would read

on the claimed invention. Gerson further teaches that the input from the user of the wireless telephone may be an audio voice command or manual input to initiate a call to an identified party and number. With this input the system would initiate the call in accordance with signaling exchanged within the cell between the wireless unit and the base station. Gerson does not disclose whether any signal is transmitted prior to entry of the phone number, but with the breadth of the language of claim 16, in our view no separate user input is required.

Appellants argue that Burke does not teach or suggest the use of audio signals. (See brief at pages 3-4.) We agree with appellants, but the examiner admits that this is not taught and relies upon Gerson for this teaching. Appellants argue that Gerson does not disclose a two step method. (See brief at page 4.) We disagree with appellants as discussed above. Appellants do not dispute combination of Burke and Gerson, but maintain that the combination would not achieve the claimed invention. (See brief at page 4.) We disagree with appellants, as discussed above. Therefore, these arguments are not persuasive.

Appellants argue that the initiation of the call is in accordance with signaling information. (See brief at page 5.) We agree with appellants, but note the breadth of the limitation concerning "signaling information," as discussed above. Appellants further elaborate upon the actuation of the button and exchange of information at that

time. This argument is not persuasive because it is not supported by the express language of claim 16.

Appellants argue that there is no disclosure or suggestion in Burke or Gerson of replacing the data packets in Burke with audio voice information and having the base station use voice recognition to complete placement of the call. (See brief at pages 5-6.) This argument is not persuasive because it is not commensurate with the scope of claim 16. The language of claim 16 does not recite where the voice recognition is carried out wherein the audio voice information may be any analog or digital representation of the spoken utterances. Appellants argue that the radio terminal has insufficient power and processing to perform speech recognition and that is why the speech recognition is performed at the base station. (See brief at page 6.) The language of claim 16 recites no details of the audio voice information. Therefore, this argument is not persuasive since there is no basis in the language of the claim to support this argument. Therefore, we will sustain the rejection of claim 16 and its dependent claim 17 which has not been argued separately.

With respect to claims 18-20, appellants argue that the portion of Reed cited by the examiner does not teach “a fully completed initiating step (signaling information exchange).” We disagree with appellants whereas all signaling exchange would have

been completed upon entry into a cell, as discussed above. Furthermore, the input of a command, either keyed or uttered, would have been before the input of the desired number. Whether the command is processed or queued until the entry of the desired number would have been a design option for the skilled artisan, in our view. Therefore, this argument is not persuasive because the language of claim 18 does not require a step of exchanging at the time of initiating.

With respect to claim 19, appellants argue that although Reed discloses the base station having speech recognition for controlling a portable communication device, there is no disclosure of it being used to determine a telephone number. (See brief at page 7.) We agree with appellants. While Reed expressly states in column 3 that “[a] further benefit obtained by placing the voice recognizer 102 in or near the base 202 is that the voice recognizer 206 can now be shared by multiple remote units over the entire coverage range of the base station . . . the recognition circuitry can be used at maximal efficiency,” Reed does not specifically disclose the determination of the telephone number using voice recognition. But, the examiner relies on the teaching of Gerson with respect to the input of the audio voice information denoting a telephone number. (See answer at page 4 and Gerson at the abstract and column 5.) In our view, we agree with the examiner that it would have been obvious to one of ordinary

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skill in the art at the time of the invention that the input audio information may be either processed at the wireless telephone or at the base station as suggested by Reed.

With respect to claim 20, appellants argue that the audio voice signals are transmitted as audio voice signals to the base station and that the prior art does not teach this limitation. We disagree with appellants. Figure 3 of Reed teaches the transmission of voice signals to the base station and provides motivations for the skilled artisan to perform speech recognition at the base station. Therefore, this argument is not persuasive, and we will sustain the examiner's rejection of dependent claims 18-20.

CONCLUSION

To summarize, the decision of the examiner to reject claims 16-20 under 35 U.S.C. § 103 is affirmed.

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

AFFIRMED

MICHAEL R. FLEMING)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JOSEPH L. DIXON)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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