Paper No. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Ex parte ALAN R. REINBERG and GRAHAM R. WOLSTENHOLME

Appeal No. 2000-0588
Application No. 08/824,110

ON BRIEF

Before COHEN, STAAB and BAHR, Administrative Patent Judges.
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-17 and 19-22, which are all of the claims pending in this application. Claim 18 has been canceled.

We AFFIRM-IN-PART and enter a new rejection pursuant to 37 CFR § 1.196(b).

BACKGROUND

The appellants' invention relates to electronic toy telephones and pagers that realistically simulate receiving messages. A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

The examiner relied upon the following prior art references in rejecting the appealed claims:

Nakajima	4,104,821	Aug. 8, 1978
Sirota	4,777,938	Oct. 18, 1988
Rose	4,857,030	Aug. 15, 1989
Wingate	5,609,508	Mar. 11, 1997 (Filed Oct. 23, 1995)
Hughes et al. (Hughes)	5,646,593	Jul. 8, 1997 (Filed Apr. 26, 1995)

The following rejections are before us for review.

Claims 19-22 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellants regard as the invention.

Claims 19-22 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Sirota.

Claims 1 and 2 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sirota in view of Hughes.[1]

[1] Although the examiner did not expressly restate this rejection in the answer, it is apparent from the examiner's comments on page 5 of the answer that the examiner has not withdrawn this rejection and that its omission was mere inadvertence.

Claims 3-5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Wingate in view of Hughes and Rose.

Claims 12 and 15-17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Wingate in view of Nakajima.

Claims 6-9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Wingate.

Claims 10 and 11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Wingate in view of Hughes.

Claims 13 and 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Wingate in view of Nakajima and Rose.

Claim 5 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Wingate in view of Hughes and Sirota.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the final rejection and answer (Paper Nos. 5 and 10) for the examiner's complete reasoning in support of the rejections and to the brief (Paper No. 9) 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.

The indefiniteness rejection

The basis of the examiner's indefiniteness rejection of claims 19-22, as set forth on page 2 of the final rejection, reads as follows:

> These claims are drawn to circuits or circuit portions with little if any structure to make the subject matter an article which may be held and/or used as a toy. As such, all claims are seen to fail to define structure in such a manner to set forth a functional device. These claims fail to link all elements together, many standing alone without incorporation into the overall device.

Claims 19-22 are broad, in the sense that each is directed to a toy generally, or to a method for operating a toy, comprising a plurality of structural elements set forth in means-plus-function format, or a plurality of steps, without limiting the toy to, for example, a telephone or pager. However, just because a claim is broad does not mean that it is indefinite. See In re Johnson, 558 F.2d 1008, 1016 n.17, 194 USPQ 187, 194 n.17 (CCPA 1977); In re Miller, 441 F.2d 689, 693, 169 USPQ 597, 600 (CCPA 1971); In re Gardner, 427 F.2d 786, 788, 166 USPQ 138, 140 (CCPA 1970) and Ex parte Scherberich, 201 USPQ 397, 398 (Bd. App. 1977). The purpose of the second paragraph of § 112 is to provide those who would endeavor, in future enterprises, to

approach the area circumscribed by the claims of a patent, with adequate notice demanded by due process of law, so that they may more readily and accurately determine the boundaries of protection involved and evaluate the possibility of infringement and dominance. In re Hammack, 427 F.2d 1378, 1382, 166 USPQ 204, 208 (CCPA 1970). The examiner has not explained why one of ordinary skill in the art would not have been able to accurately determine the metes and bounds of claims 19-22. We disagree with the examiner that the recited elements of these claims are not linked together so as to set forth a functional device. Thus, we shall not sustain the examiner's rejection of claims 19-22 under the second paragraph of 35 U.S.C. § 112, second paragraph.[2]

The prior art rejections

Turning first to the examiner's rejection of claims 19-22 as being anticipated by Sirota, we note that claim 21 recites a means for generating a random timing signal and claim 22 recites a step of generating a random timing signal. Appellants' specification (page 7, lines 23-26) clearly sets forth a definition[3] of "random" which distinguishes it

[2] For the reasons discussed below in the new ground of rejection pursuant to 37 CFR § 1.196(b), however, we have determined that the recitation of a means or step of selecting said message "in response to said attention signal" in claims 19, 20 and 22 is inconsistent with appellants' underlying disclosure and consequently renders the metes and bounds of these claims indefinite.

[3] In proceedings before it, the PTO applies to the verbiage of claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, *taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant's specification*. In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997).

from irregular or different preselected time intervals. Rather, according to appellants' specification, timing signals at random intervals are produced by a "random number generator or other suitable means."

Sirota discloses a babysitter toy designed to help a child fall asleep, having time-setting devices 2-5 which are adjustable such that the times at which the toy is actuated to check for noise or movement by the child and play a recorded message, turn on a light or display a fairy tale can be set by the user. As such, the Sirota toy permits programming by the user to generate timing signals at intervals which may be arbitrarily set by the user to be irregular (different), but those intervals are preselected and, thus, are not "random" as that term is used by appellants. We thus conclude that the Sirota structure and operation relied upon by the examiner on pages 4-5 of the answer does not in fact respond to the means or step for generating a random timing signal as set forth in claims 21 and 22. Accordingly, we shall not sustain the examiner's rejection of these claims as being anticipated by Sirota.[4]

[4] We recognize the inconsistency implicit in our holding that claim 22 is rejectable under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the invention with a determination under 35 U.S.C. § 102. Normally, when substantial confusion exists as to the interpretation of a claim and no reasonably definite meaning can be ascribed to the terms in a claim, a determination as to patentability under 35 U.S.C. § 102 is not made. See In re Steele, 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962) and In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). However, in that we are able to determine, for the reasons discussed supra, that the examiner has not set forth a prima facie case of anticipation of this claim, without speculating as to the meaning of the problematic claim language addressed in the new ground of rejection, in this instance, we consider it to be desirable to avoid the inefficiency of piecemeal appellate review. See Ex parte Ionescu, 222 USPQ 537, 540 (Bd. App. 1984).

For the reasons expressed below in the new ground of rejection, claims 19 and 20 are indefinite. Therefore, the prior art rejection of these claims cannot be sustained because it is necessarily based on speculative assumption as to the meaning of the claims. See Steele, 305 F.2d at 862-63, 134 USPQ at 295. It should be understood, however, that our decision in this regard is based solely on the indefiniteness of the claimed subject matter, and does not reflect on the adequacy of the prior art evidence applied in support of the rejection.

Turning now to the examiner's rejection of claims 1 and 2 under 35 U.S.C. § 103 as being unpatentable over Sirota in view of Hughes, the examiner appears to concede that Sirota lacks a message timer "generating a random timing signal," as called for in claim 1, and hence claim 2 which depends from claim 1. To overcome this deficiency, the examiner relies upon the teaching in Hughes of a random number generator for a suggestion to provide a random number generator in Sirota, "in order to initiate output at any time, not just those times that are preprogrammed" (final rejection, page 3).

We find no suggestion, in Hughes' teaching (column 6, lines 6-9) of using a random number generator to assign an ID number to the parent unit of a child proximity detector system, to use a random number generator in the Sirota device to generate random timing signals. From our perspective, the only suggestion for modifying Sirota in the manner proposed by the examiner is found in the luxury of hindsight accorded one who first viewed the appellants' disclosure. This, of course, is not a proper basis

for a rejection. See In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992). Accordingly, we shall not sustain the examiner's rejection of claims 1 and 2 as being unpatentable over Sirota in view of Hughes.

The examiner has rejected claims 3 and 4, which depend from claims 2 and 1, respectively, and independent claim 5 as being unpatentable over Wingate in view of Hughes and Rose. Claims 4 and 5 call for the generation of first and second random signals or numbers, the first being used to generate an attention signal and the second being used to select one of a plurality of messages.

Wingate discloses a toy telephone which can be programmed by a parent, for example, to ring at a predetermined time and to cause a predetermined message, such as "it is time for bed," to be read out of memory and played for a child. As conceded by the examiner, Wingate lacks a message timer which generates a random timing signal, as called for in claims 3 and 4, a first and second random signal, as called for in claim 4, or first and second random numbers, as called for in claim 5. The examiner urges that it would have been obvious, in view of the teachings of Hughes of a random number generator, to employ a random number generator in Wingate to initiate ringing of the toy telephone at random times rather than predetermined times and, further, to have provided the Wingate toy "with a random choice of messages to be output, as taught by Rose, in order to make the toy less predictable and heighten the user's enjoyment of that unpredictability" (final rejection, page 3).

Rose discloses the use of a random number generator, in a system for conversing dolls, for determining which of a plurality of dolls will initiate conversation (doll A), which doll will respond to doll A (doll B) and which conversation routine will be followed. We find no teaching in Rose of using the random number generator for generating random timing signals or attention signals, as called for in claims 3-5.

As discussed above, Hughes uses a random number generator to assign an ID number to a parent unit in a child proximity detection system and does not teach or suggest using a random number generator for generating timing signals. We thus find no suggestion in Hughes to provide a random number generator in the Wingate toy to cause the toy telephone to ring and play a message at random times. Moreover, in that the objective of programming Wingate's toy telephone to ring at predetermined times and to play predetermined messages is to convey suitable predetermined instructions to children at suitable predetermined times, Wingate teaches away[5] from a modification thereof to cause the telephone to ring at random times and to select and play random messages. Where, as in this case, the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, the proposed modification would not have been obvious. See Tec Air Inc. v. Denso Mfg. Michigan Inc., 192 F.3d 1353, 1360, 52 USPQ2d 1294, 1298 (Fed. Cir. 1999); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Accordingly, we shall not

[5] See In re Gurley, 27 F.3d 551, 553, 31 USPQ2d 1130, 1131 (Fed. Cir. 1994).

sustain the examiner's rejection of claims 3-5 as being unpatentable over Wingate in view of Hughes and Rose.

The examiner has also rejected claim 5 under 35 U.S.C. § 103 as being unpatentable over Wingate in view of Hughes and Sirota. In that Sirota, discussed supra, also provides no cure for the above-noted deficiency of the Wingate and Hughes combination, it follows that we also shall not sustain this rejection.

Turning next to the examiner's rejection of claims 12 and 15-17, which depend from claim 12, as being unpatentable over Wingate in view of Nakajima, we note that Wingate discloses a toy telephone comprising a handset 18 having a small speaker 30 therein, a ringer (not specifically shown), a message timer (see column 1, lines 42-46; column 2, lines 3-10; column 4, lines 17-28) operatively coupled to the ringer for delivering a trigger signal to cause the telephone to ring (generating an attention signal) and a memory for storing a predetermined message which is to be played. While Wingate's disclosure in column 2, lines 3-10, is directed to a mode wherein the timer produces a trigger signal which causes the telephone to ring and the message to be delivered to a second speaker 32 on the main body of the telephone, Wingate's disclosure of programming the telephone to ring at predetermined times and to display an image while generating an audio message "in response to the 'call' being answered (column 1, lines 42-46)" is certainly suggestive of providing some sort of switch actuated by action simulating answering a telephone call in response to a ringing to

generate a second trigger signal to cause the audio message and/or image to be displayed. Nakajima discloses a switch arrangement comprising struts 40 mounted in the cradle 75 of the main body of a toy telephone which serve as a switch to detect when the headset 12 has been removed from the cradle. When the struts 40 are released, signaling removal of the headset from the cradle (the action to simulate answering the call), the bell 35 stops ringing and a message is played. To incorporate a switch arrangement of the type taught by Nakajima in Wingate's toy telephone to sense when the handset 18 has been removed from the main body to answer the "call" signaled by the telephone ringing to stop the ringing and to generate a trigger signal to cause the message to be read from memory and played on the small speaker 30 of the handset 18 in order to simulate answering of the "call" as disclosed by Wingate in column 1, lines 42-46, would have been obvious to one of ordinary skill in the art at the time of appellants' invention.

We note that appellants have not contested the combination of Wingate and Nakajima proposed by the examiner. Rather, appellants' only argument (brief, page 18) is that Nakajima does not teach a switch which is "coupled to the handset" as called for in claim 12. We disagree. The language "coupled to the handset" in claim 12 does not require that the switch be mounted on the handset, as appellants' argument seems to imply. The term "couple" is customarily understood to mean "to join together by fastening or by association" (Webster's New World Dictionary, Third College Edition

(Simon & Schuster, Inc. 1988)). As discussed above, in interpreting claims in proceedings before the PTO, the words in the claim are given their broadest reasonable meaning in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant's specification. Morris, 127 F.3d at 1054, 44 USPQ2d at 1027. Absent an express definition in their specification, the fact that appellants can point to definitions or usages that conform to their interpretation does not make the PTO's definition unreasonable when the PTO can point to other sources that support its interpretation. Id., 127 F.3d at 1056, 44 USPQ2d at 1029. In this case, appellants have not provided an express definition of the term “coupled” in their specification which would require any more than an association between the switch and the handset. In that a switch of the type taught by Nakajima, provided on the Wingate telephone as proposed by the examiner, contacts and senses the removal of the handset 18, it is “coupled to [associated with] the handset” as called for in claim 12.

Having found appellants’ argument as to the patentability of claim 12 over Wingate in view of Nakajima unpersuasive, we shall sustain the examiner’s rejection of claim 12. As the additional features recited in dependent claims 15 and 16 are disclosed by Wingate (see column 2, line 64 et seq.), we shall sustain the rejection of these claims as well.

As for claim 17, we note that, 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, 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, e.g., Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988). Claim 17 depends from claim 15 and further calls for a visual display displaying numbers associated with the actuation of said keys. We find no such disclosure in Wingate and the examiner neither pointed to any such disclosure in Wingate nor offered any explanation as to why such a feature would have been obvious. Thus, the examiner's rejection of claim 17 is not sustained.

The examiner's rejection of claims 6-9, which are directed to a toy pager, as being unpatentable over Wingate is grounded on the examiner's position that "[i]t would have been obvious to have made a Wingate toy in the form of a pager in order to appeal to the widely known desire for a pager of the very young that wish to emulate their older siblings or parents" (final rejection, page 4). Rejections based on 35 U.S.C. § 103 must rest on a factual basis. In making such a rejection, the examiner has the

initial duty of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968). The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification. See In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992); In re Mills, 916 F.2d 680, 682, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). The examiner has not pointed to any teaching or suggestion in Wingate to modify the Wingate telephone to make it a toy pager and we find none on our own. While pagers are akin to telephones in that they are both telecommunications devices, this similarity is not sufficient, in our opinion, to provide suggestion to modify the Wingate toy telephone so as to form a pager. From our perspective, the only suggestion for modifying the Wingate toy as proposed by the examiner to arrive at the subject matter of claims 6-9 is found in the luxury of hindsight accorded one who first viewed the appellants' disclosure.

The examiner further explains on page 6 of the answer that

> though the concept of “pager” has a non-specific meaning, there is no established definition of what a pager should look like or be sized to specific dimensions. As such, pagers are electronic message relaying units of indeterminate size and shape. It would have been obvious to one of ordinary skill in the art to have provided a Wingate toy with any appropriate

> size or shape, to include that of a pager, as an obvious design choice. Knowing that miniaturization is available, reducing a Wingate toy to a hand held device is not beyond the capability of ordinary skill.

One of ordinary skill in the art at the time of appellants' invention would not have considered the toy telephone of Wingate to be a pager and the mere change of size or shape of the Wingate device to make it a hand held device would not transform it into a pager as that term is understood in the art. Thus, even if the Wingate toy were miniaturized as proposed by the examiner, the subject matter of claims 6-9 would not result.

For the foregoing reasons, we shall not sustain the examiner's rejection of claims 6-9.

The examiner has rejected claims 10 and 11, which depend from claim 6, and thus also recite a toy pager, as being unpatentable over Wingate in view of Hughes. We cannot sustain this rejection for two reasons. First, Hughes does not overcome the deficiency of Wingate discussed above in regard to the rejection of claim 6. Second, claims 10 and 11 also call for the message timer to include a clock circuit for generating a clock signal, a random number generator for generating a first random number, which is used to generate a first trigger signal, a scaler for generating a timing signal correlative to the first random number, a counter for receiving the clock signal and generating a count signal correlative thereto, and a comparator for receiving the timing signal and count signal and generating a first trigger signal when the timing signal and

count signal are equal. As discussed above, neither Wingate nor Hughes teaches or suggests the use of a random number generator in a message timer.

Claims 13 and 14, which depend from claim 12 and also require a clock circuit for generating a clock signal, a random number generator for generating a first random number, which is used to generate a first trigger signal, a scaler for generating a timing signal correlative to the first random number, a counter for receiving the clock signal and generating a count signal correlative thereto, and a comparator for receiving the timing signal and count signal and generating a first trigger signal when the timing signal and count signal are equal, stand rejected as being unpatentable over Wingate in view of Nakajima and Rose. In that none of Wingate, Nakajima and Rose teaches or suggests the use of a random number generator in a message timer, we conclude that the applied references are insufficient to establish a prima facie case of obviousness of the claimed subject matter. We thus will not sustain this rejection.

NEW GROUND OF REJECTION

Pursuant to 37 CFR § 1.196(b), we enter the following new rejection.

Claims 2, 3, 19, 20 and 22 are rejected under 35 U.S.C. § 112, second paragraph, for failing to particularly point out and distinctly claim that which appellants regard as the invention.

As discussed above, the purpose of the second paragraph of § 112 is to provide those who would endeavor, in future enterprises, to approach the area circumscribed by

the claims of a patent, with adequate notice demanded by due process of law, so that they may more readily and accurately determine the boundaries of protection involved and evaluate the possibility of infringement and dominance. Hammack, 427 F.2d at 1382, 166 USPQ at 208. Moreover, in order to satisfy the requirements of the second paragraph of § 112, a claim must accurately define the invention in the technical sense. See In re Knowlton, 481 F.2d 1357, 1366, 178 USPQ 486, 492-93 (CCPA 1973). In addition, while the claim language of claims 2, 3, 19, 20 and 22 may appear, for the most part, to be understandable when read in the abstract, no claim may be read apart from and independent of the supporting disclosure on which it is based. See In re Cohn, 438 F.2d 989, 993, 169 USPQ 95, 98 (CCPA 1971).

Claim 2 recites that the "timing signal comprises a clock signal and a trigger signal." As set forth in appellants' underlying disclosure, however, the terms timing signal and trigger signal appear to be used interchangeably. Clock signals, on the other hand, are generated by a clock circuit 62 and counted by a counter 76. A random number generator 68 generates a first random number which is input to a scaler 74, which scales the random number to the number of clock signals generated by the clock circuit 62 in a nominal interval and stores the resulting value in a register 74. The value in register 74 and the number of signals in the counter 76 are then input into a comparator 78, which generates a first trigger signal when the value in register 74 and the number of signals in the counter 76 are equal. See appellants' Figure 4 and

specification, pages 13-14. Thus, the recitation of the timing signal as comprising a clock signal and a trigger signal is certainly not consistent with appellants' underlying disclosure. Consequently, when reading claim 2 in light of appellants' underlying disclosure, which we must do in interpreting the claim, it is impossible to determine with any certainty what is meant by a timing signal comprising a clock signal and a trigger signal. Claim 2 and claim 3 which depends therefrom are thus indefinite.

Claims 19, 20 and 22 each recite means or steps for generating an attention signal in response to said timing signal and for selecting a message in response to said attention signal. The sixth paragraph of 35 U.S.C. § 112 states:

> An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

As our reviewing court stated in In re Dossel, 115 F.3d 942, 946, 42 USPQ2d 1881, 1885 (Fed. Cir. 1997) (quoting In re Donaldson Co., 16 F.3d 1189, 1195, 29 USPQ2d 1845, 1850 (Fed. Cir. 1994)),

> [a]lthough paragraph six statutorily provides that one may use means-plus-function language in a claim, one is still subject to the requirement that a claim "particularly point out and distinctly claim" the invention. Therefore, if one employs means-plus-function language in a claim, one must set forth in the specification an adequate disclosure showing what is meant by that language. If an applicant fails to set forth an adequate disclosure, the applicant has in effect failed to

particularly point out and distinctly claim the invention as required by the second paragraph of section 112.

Consistent with appellants' underlying disclosure (specification, page 4, lines 16-17, page 5, lines 9-10 and page 9, lines 5-7), we understand the recited "attention signal" to be a signal, such as a ring, beep or vibration, generated by the display 16 (visual display 18, vibrator 22 or speaker 20 in the toy pager or ringer 46 of the toy telephone) in response to the first trigger signal to attract the user's attention and prompt the user to take action to receive a message. The message selector, as disclosed in appellants' specification, selects a message in response to the second random number generated by the random number generator 68 and displays that selected message in response to the generation of a first trigger signal by the comparator 78 and the generation of a second trigger signal by actuation of a switch 36 or 48, said second trigger signal also stopping the attention signal. Appellants' underlying disclosure reveals no means or step for selecting said message in response to said attention signal, as recited in claims 19, 20 and 22. Accordingly, it is impossible to ascertain what structure or step disclosed in appellants' specification corresponds to the recited means or step for "selecting said message in response to said attention signal" as set forth in the sixth paragraph of 35 U.S.C. § 112. Therefore, with regard to claims 19, 20 and 22, appellants have failed to particularly point out and distinctly claim the invention as required by the second paragraph of section 112.

CONCLUSION

To summarize, in this decision, we have:

(1) reversed the examiner's rejection of claims 19-22 under 35 U.S.C. § 112, second paragraph;

(2) reversed the examiner's rejections of claims 19-22 as being anticipated by Sirota and of claims 1 and 2 as being unpatentable over Sirota in view of Hughes;

(3) reversed the examiner's rejection of claims 3-5 as being unpatentable over Wingate in view of Hughes and Rose;

(4) affirmed the examiner's rejection of claims 12 and 15-17 as being unpatentable over Wingate in view of Nakajima as to claims 12, 15 and 16 and reversed the rejection as to claim 17;

(5) reversed the examiner's rejections of claims 6-9 as being unpatentable over Wingate, of claims 10 and 11 as being unpatentable over Wingate in view of Hughes, of claims 13 and 14 as being unpatentable over Wingate in view of Nakajima and Rose and of claim 5 as being unpatentable over Wingate in view of Hughes and Sirota; and

(6) entered a new rejection of claims 2, 3, 19, 20 and 22 under the second paragraph of 35 U.S.C. § 112 pursuant to 37 CFR § 1.196(b).

In addition to affirming the examiner's rejection of one or more claims, this decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b). 37 CFR

§ 1.196(b) provides, "A new ground of rejection shall not be considered final for purposes of judicial review."

Regarding any affirmed rejection, 37 CFR § 1.197(b) provides:

> (b) Appellant may file a single request for rehearing within two months from the date of the original decision . . . .

37 CFR § 1.196(b) also provides that appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

> (1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .
>
> (2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

Should appellants elect to prosecute further before the Primary Examiner pursuant to 37 CFR § 1.196(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If appellants elect prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be

returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

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; 37 CFR § 1.196(b)

IRWIN CHARLES COHEN Administrative Patent Judge	)
LAWRENCE J. STAAB Administrative Patent Judge	) BOARD OF PATENT) APPEALS) AND) INTERFERENCES
JENNIFER D. BAHR Administrative Patent Judge	)

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