

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. 31

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KOJI SHINOHARA and KOKI HAMADA

Appeal No. 2002-1236
Application No. 08/359,743

ON BRIEF

Before DIXON, GROSS, and BARRY, **Administrative Patent Judges**.
DIXON, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1,3-6, 8, 9, 13-22, 31 and 32. The examiner has indicated that claims 13-30 are now allowable. Therefore, we limit our review to claims 1,3-6, 8, 9, 31, and 32.

We AFFIRM.

BACKGROUND

Appellants' invention relates to a radio telephone system. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. A radio telephone system including a base station connected to a wire circuit and a plurality of mobile stations which perform radio communications with the base station, respectively, said radio telephone system comprising:

a base station echo-back transmit-receive section provided in said base station for transmitting echo-back request signals to said mobile stations, respectively, located in a radio zone of said base station and for receiving echo-back response signals transmitted from said mobile stations; and

a mobile station echo-back transmit-receive section provided in each of said mobile stations for transmitting one of the echo-back response signals in response to a corresponding one of the echo-back request signals transmitted from said base station, so that all the mobile station echo-back transmit-receive sections of said mobile stations which received one of the echo-back request signals from said base station transmit the echo-back response signals to notify said base station of their presence in said radio zone.

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

Boudreau et al. (Boudreau)	5,369,681	Nov. 29, 1994
Simpson et al. (Simpson)	5,475,863	Dec. 12, 1995 (filed Oct. 4, 1993)

Claims 1 and 3 stand rejected under 35 U.S.C. § 102 as being anticipated by Boudreau. Claims 4-6, 8, and 9 stand rejected under 35 U.S.C. § 103 as being

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unpatentable over Boudreau. Claims 31 and 32 stand rejected under 35 U.S.C. § 103 as being unpatentable over Boudreau in view of Simpson.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejections, we make reference to the examiner's final rejection (Paper No. 23, mailed Jun. 7, 2000) and examiner's answer (Paper No. 29, mailed Nov. 8, 2001) for the examiner's reasoning in support of the rejections, and to appellants' brief (Paper No. 24, filed Mar. 28, 2001) for appellants' arguments thereagainst.

OPINION

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

At the outset, we note that appellants have elected to group claims 1, 3, 4, and 31 together in a first group and claims 5, 6, 8, 9 and 32 together in a second group. (See brief at page 8.) Therefore, we select independent claim 1 and dependent claim 5 as the representative claims from each grouping and will address appellants' arguments thereto.

35 U.S.C. § 102

A patent is invalid for anticipation when the same device or method, having all of the elements contained in the claim limitations, is described in a single prior art reference. **Richardson v. Suzuki Motor Co.**, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); **Perkin-Elmer Corp. v. Computervision Corp.**, 732 F.2d 888, 894, 221 USPQ 669, 673 (Fed. Cir. 1984). An anticipating reference must describe the patented subject matter with sufficient clarity and detail to establish that the subject matter existed in the prior art and that such existence would be recognized by persons of ordinary skill in the field of the invention. **See In re Spada**, 911 F.2d 705, 708, 15 USPQ 1655, 1657 (Fed. Cir. 1990); **Diversitech Corp. v. Century Steps, Inc.**, 850 F.2d 675, 678, 7 USPQ2d 1315, 1317 (Fed. Cir. 1988).

Here, we find that the examiner has established a *prima facie* case of anticipation. The examiner has addressed the claim limitations and shown where Boudreau teaches the express limitations of independent claim 1. (See final rejection at pages 2-3.) Appellants' sole argument is that Boudreau sends a unique echo-back request signal that corresponds to particular mobile units in contrast to appellants' claimed invention which sends echo-back request signals that are common or generic to all mobile units. (See brief at page 9.) The examiner maintains that common or generic echo-back request signals are not recited in the language of independent claim 1. (See answer at page 3.) We agree with the examiner. Therefore, this argument is

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not persuasive, and we will sustain the rejection of independent claim 1. Appellants rely upon this same argument for dependent claims 3, 4, and 31. Therefore, we will sustain the rejection of dependent claim 3, 4, and 31.

35 U.S.C. § 103

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**, 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**

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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-Prods. Co.**, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

When determining obviousness, "the [E]xaminer can satisfy the burden of showing obviousness of the combination `only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.'" **In re Lee**, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002), citing **In re Fritch**, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). "Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence.'" **In re Dembiczak**, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). "Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact." **Dembiczak**, 175 F.3d at 999-1000, 50 USPQ2d at 1617, citing **McElmurry v. Arkansas Power & Light Co.**, 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993).

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 language of dependent claim 5. Again, appellants argue that parent claim 1 sets forth that the base station sends an echo-back request signal that is common or generic to all the mobile units. (See brief at page 11.) As discussed above, we disagree with appellants. Appellants argue that additionally when the control section of the base station fails to receive an echo-back response from a given mobile station, it deletes the data of the mobile station from the managing table. (See brief at page 11.) Again, appellants have argued a limitation for which we find no express support in the language of representative claim 5 for the argument that data is (immediately) deleted. The examiner maintains that claim 5 is totally silent about deleting mobile station data. (See answer at page 4.) We agree with the examiner that claim 5 merely recites updating the managing table when the mobile station fails to transmit and echo-back response signal.¹ Appellants argue that the examiner does not address “an essential feature of the claims 5 and 6, which is affirmatively deleting mobile station data from a managing table whenever a mobile station leaves a radio zone of a base station,” but appellants do not cite to any specific language in either claim to support this position. (See brief at pages 12-13.) The examiner maintains that there is no support for this argument. We agree with the examiner that appellants have not shown any claim

¹ Here, we note that the language of dependent claim 5 is recited in terms of a failure to transmit rather than a failure to receive a transmission from the mobile unit as in independent claim 6. We find no difference in our interpretation for the present rejection.

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language to support this argument. Therefore, we will sustain the examiner's rejection of dependent claim 5 and claims 6, 8, 9, and 32 which appellants have grouped therewith.

The examiner goes on to address claim 6 even though appellants have elected to group this claim with dependent claim 5. The examiner explains that when a mobile station does not respond with a page response in its last known location, then it is next paged in the paging area, and the old location is deleted from the database and the new location replaces the old location. The examiner maintains that this meets the language of claim 6. (See answer at page 5.) We agree with the examiner's application of the teachings of Boudreau, and appellants have presented no evidence to rebut this specific and reasonable interpretation. Additionally, we will sustain the examiner's rejection of independent claim 6 independently of appellants' grouping with claim 5.

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CONCLUSION

To summarize, the decision of the examiner to reject claims 1 and 3 under 35 U.S.C. § 102 is affirmed, and the decision of the examiner to reject claims 4-6, 8, 9, 31, and 32 under U.S.C. § 103 is affirmed.

AFFIRMED

JOSEPH L. DIXON)	
Administrative Patent Judge)	
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ANITA PELLMAN GROSS)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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LANCE LEONARD BARRY)	
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