

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARC VOGELEISEN

Appeal No. 2002-1328
Application 08/970,883

ON BRIEF

Before JERRY SMITH, LEVY, and BLANKENSHIP, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 7 and 9, which constitute the only claims remaining in the application.

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The disclosed invention pertains to a communication device of the type comprising a personal device and a base station. The personal device has a transceiver, a microphone, a speaker and a keyboard. The invention uses an emergency key on the keyboard which dials a pre-stored number, activates the microphone and speaker of the personal device, and activates a speaker in the base unit.

Representative claim 7 is reproduced as follows:

7. A communication system comprising:

a personal device having a transceiver, a microphone, a speaker and a keyboard;

a base station connectable to said personal device by a radio link, said base station being connected to a switched network;

said keyboard including an emergency key which dials a pre-stored number and activates said microphone and said speaker for hands-free operation of said personal device; wherein said base station includes a base speaker which is activated by said emergency key.

The examiner relies on the following references:

Lewo	4,870,676	Sep. 26, 1989
Nakajima et al. (Nakajima)	5,802,476	Sep. 01, 1998 (filed Dec. 29, 1995)
Kim	5,960,357	Sep. 28, 1999 (filed Aug. 23, 1996)

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Claims 7 and 9 stand rejected under 35 U.S.C. § 103(a). As evidence of obviousness the examiner offers Kim in view of Lewo and Nakajima.

Rather than repeat the arguments of appellant or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellant's arguments set forth in the briefs along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 7 and 9. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to

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support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of

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the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered and are deemed to be waived [see 37 CFR § 1.192(a)].

The examiner has indicated how he finds the claimed invention to be obvious over the teachings of the applied prior art. Specifically, the examiner finds that Kim teaches the claimed invention except that Kim does not teach activating the speaker and microphone of the handset in response to a single key. The examiner cites Lewo as teaching this feature and asserts that it would have been obvious to the artisan to add this feature to the telephone system of Kim. The examiner acknowledges that the combination of Kim and Lewo still does not teach an emergency key that also activates a base station speaker. The examiner cites Nakajima as teaching this feature and asserts that it would have been obvious to the artisan to

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modify the system of Kim and Lewo with this feature from Nakajima for added convenience [answer, pages 4-5].

Appellant argues that the combined teachings of Kim, Lewo and Nakajima fail to teach or suggest a single button that activates the base speaker as well as the speaker and microphone of the handset. Appellant notes that different keys are used to activate the same functions in the applied prior art. Appellant argues that the motivation of convenience as asserted by the examiner does not support the rejection because the prior art does not disclose the emergency key as claimed [brief, pages 7-10].

The examiner responds that each of the three references teach telephone functions that are activated by a single key press. The examiner repeats his assertion that the claimed invention would have been obvious in view of the combined teachings of the applied prior art [answer, pages 5-7].

Appellant responds that the applied prior art fails to teach that a single emergency key dials a pre-stored number, activates the microphone and speaker of the personal device and activates the speaker of the base device [reply brief].

We will not sustain the examiner's rejection of claims 7 and 9. The claimed invention recites a system and method in

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which the depression of a single emergency key dials a pre-stored telephone number, activates the speaker and microphone of a personal device and activates the speaker of a base unit. The examiner has found a first reference which teaches that a single key can cause a pre-stored telephone number to be dialed, a second reference which teaches that a single key can cause the speaker and microphone of a personal device to be activated, and a third reference which teaches that a single key can cause the speaker of the base unit to be activated. Although the applied prior art teaches that the three functions of the claims can each be individually activated by depression of a single key, there is no teaching or suggestion of using a single emergency key to activate all three functions. Appellant's disclosure explains the need for activating the three functions at the same time in an expeditious manner using a single emergency key. The applied prior art does not recognize the need for the claimed three functions to be activated at the same time. Since the need is not recognized, the applied prior art makes no suggestion that the same key should be used to activate all three functions in the event of an emergency. The only suggestion to use a single emergency key to activate all three functions at the same time comes from appellant's specification. The examiner has provided

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no reasonable suggestion, based on the teachings of the references only, as to why the artisan would have been motivated to implement the three claimed functions based on a single emergency key as claimed. As far as the applied references are concerned, there is no interrelationship between the three functions. There would, therefore, appear to be no reason to use the same emergency key to activate all three functions when they have no apparent relationship within the applied prior art.

In summary, the decision of the examiner rejecting claims 7 and 9 is reversed.

REVERSED

JERRY SMITH)	
Administrative Patent Judge)	
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STUART S. LEVY)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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)	
HOWARD B. BLANKENSHIP)	
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