

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. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT A. HEDINGER

Appeal No. 2002-1627
Application No. 09/132,450

ON BRIEF

Before RUGGIERO, BARRY, and LEVY, Administrative Patent Judges.
RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the final rejection of claims 1-8 and 10-15. Claims 9, 16, and 17 have been canceled. An amendment filed March 27, 2001 after final rejection was approved for entry by the Examiner.

The claimed invention relates to a system and method for use in communicating over a mobile communications link. Spoken words are converted into a sequence of letters and gaps and an encoder is utilized to convert the letters into a digital message. After transmission, the digital message is received and decoded and a

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speech synthesizer is utilized to convert the decoded message into spoken words.

Claim 1 is illustrative of the invention and reads as follows:

1. A communication system for use with a mobile communications link having a limited bandwidth, comprising:

a plurality of mobile communication devices that communicate with each other and that each comprise:

a microphone into which words are spoken that are to be transmitted;

a voice recognition system coupled to the microphone for converting the spoken words into a sequence of letters and gaps;

an encoder coupled to the voice recognition system for coding the letters into highly compressed digital messages;

a transmitter coupled to the encoder for transmitting the highly compressed digital messages over a low frequency mobile communications link having a limited transmission bandwidth;

a receiver for receiving the transmitted digital messages for processing;

a decoder coupled to the receiver for decoding the digital messages;

a speech synthesizer coupled to the decoder for converting the decoded messages into spoken words; and

a speaker coupled to the speech synthesizer for outputting the converted spoken words.

The Examiner relies on the following prior art:

Ichikawa et al. (Ichikawa)	4,975,957	Dec. 04, 1990
Yamakita	5,956,681	Sep. 21, 1999
		(filed Nov. 06, 1997)

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Claims 1-8 and 10-15, all of the appealed claims, stand finally rejected under 35 U.S.C. § 103 as being unpatentable over, in the alternative, Ichikawa or Yamakita.

Rather than reiterate the arguments of Appellant and the Examiner, reference is made to the Brief (Paper No. 11) and the Answer (Paper No. 14) for the respective details.¹

OPINION

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

With respect to the Examiner's 35 U.S.C. § 103 rejection of claims 1-8 and 10-15 based on Ichikawa and the 35 U.S.C. § 103 rejection of claims 1-7 based on Yamakita, it is our view 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

¹ In response to Notification of Non-Compliance, Appellant filed (Paper No. 13) a corrected appendix containing a correct copy of the appealed claims.

invention as claimed. We reach the opposite conclusion with respect to the Examiner's 35 U.S.C. § 103 rejection of claims 8 and 10-15 based on Yamakita. Accordingly, we affirm-in-part.

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

We consider first the Examiner's 35 U.S.C. § 103 rejection of claims 1-8 and 10-15 based on Ichikawa and note that Appellant's arguments in response assert that the Examiner has failed to establish a prima facie case of obviousness since all of the claimed limitations are not taught or suggested by the Ichikawa reference. With respect to independent claims 1 and 8, Appellant initially contends (Brief, pages 5 and 8) that Ichikawa lacks a disclosure of converting spoken words into a "sequence of letters and gaps" as claimed. We find ourselves, however, in agreement with the Examiner (Answer, pages 4 and 5) that, although Ichikawa has no specific mention of "gaps" being created when spoken words are converted to characters, the skilled artisan would have recognized and appreciated that spaces or "gaps" are necessary to delineate the beginning and ending of words in order to create intelligible text. We further agree with the Examiner that Appellant has provided no basis for the assertion that Ichikawa's extraction and subsequent processing of spectrum envelope information from spoken word input supports the conclusion that letters and gaps are not created.

We are in agreement, however, with Appellant's further argument (Brief, pages 5, 8, and 9) that, in contrast to the

claimed invention, which requires a mobile communications device with transmission over a mobile communications link, Ichikawa is a hardwired telex system designed for a desktop environment and not for mobile communications. While the Examiner suggests the obviousness of employing a mobile communications link in Ichikawa and substituting wireless for hard wired connections (Answer, pages 5 and 6), there is no evidence of record to support such an assertion. The Examiner must not only make requisite findings, based on the evidence of record, but must also explain the reasoning by which the findings are deemed to support the asserted conclusion. See In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002).

We do not dispute the Examiner's assertion (Answer, page 5) that "wireless as well as wired communications links are notoriously well known" The mere fact, however, that system or elements are well known does not support the conclusion that it would have been obvious for one system or element to be substituted for another. Independent claims 1 and 8 are directed to particular elements and steps for processing communications specifically tied to a mobile communications network. In our view, any teaching or suggestion to modify Ichikawa to implement a mobile wireless communications system could come only from Appellant's own

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disclosure and not from any teaching or suggestion in the reference itself.

As noted above, the Examiner has the burden of initially presenting a prima facie case of obviousness. The Examiner cannot satisfy this burden by simply dismissing differences between the claimed invention and the teachings of the prior art as being obvious. The Examiner must present us with an evidentiary record which supports the finding of obviousness. It does not matter how strong the Examiner's convictions are that the claimed invention would have been obvious, or whether we might have an intuitive belief that the claimed invention would have been obvious within the meaning of 35 U.S.C. § 103. Neither circumstance is a substitute for evidence lacking in the record before us.

In view of the above discussion, since the Examiner has not established a prima facie case of obviousness, the 35 U.S.C. § 103 rejection of independent claims 1 and 8, as well as claims 2-7 and 10-15 dependent thereon, based on Ichikawa is not sustained.

We next consider the Examiner's 35 U.S.C. § 103 rejection of appealed claims 1-8 and 10-15 based on Yamakita. With respect to independent claim 1, Appellant reiterates the argument, asserted with respect to Ichikawa, that Yamakita has no disclosure of a voice recognition system that converts spoken words into a

"sequence of letters and gaps." For all of the reasons discussed supra with regard to Ichikawa, we remain of the opinion that the skilled artisan would have recognized that the conversion of spoken words into text would necessarily create gaps between words to provide intelligible communication.

We are in agreement, however, with Appellant's further argument that, unlike independent claim 1 which requires that speech processing involving conversion of spoken words into text takes place at the mobile communication device, Yamakita's speech processing occurs at the receiving end of the communication network and not at the mobile terminal. In this regard, our interpretation of the disclosure of Yamakita coincides with that of Appellant, i.e., no conversion of speech into text takes place at the mobile terminal 101 illustrated in Figures 1-3. We further note that the Examiner has identified (Answer, page 4) the unit illustrated in Figure 11 of Yamakita as corresponding to the claimed voice recognition unit. It is clear from Yamakita (column 31, lines 38-47), however, that Figure 11 is a functional block diagram of speech recognition section 117 which, as illustrated in Yamakita's Figure 1, is not part of the mobile terminal 110 but rather a part of speech control host unit 108.

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Accordingly, since all of the limitations of independent claim 1 are not taught or suggested by the applied Yamakita reference, the Examiner has not established a prima facie case of obviousness. Therefore the 35 U.S.C. § 103 rejection of independent claim 1, as well as claims 2-7 dependent thereon, based on Yamakita is not sustained.

Turning to a consideration of the Examiner's 35 U.S.C. § 103 rejection of claims 8 and 10-15 based on Yamakita, we note that while we found Appellants' arguments to be persuasive with respect to the obviousness rejection of claims 1-7, we reach the opposite conclusion with respect to claims 8 and 10-15. A review of the language of independent method claim 8 reveals that, in contrast to independent system claim 1 which specifically requires the voice recognition system to be included in the mobile communication terminal, the step of converting spoken word to text is not required to be performed at the mobile terminal. In fact, according to the express language of claim 8, the only steps required to be performed by mobile terminals are the speaking of words into a microphone at the transmitting end and the decoding of a converted digital message at the receiving end. In our view, while the voice recognition unit in Yamakita (117, Figure 11) is not part of the mobile terminal 101, as discussed previously with

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regard to claim 1, there is no such limiting requirement in claim 8.

In view of the above discussion, it is our opinion that the Examiner has established a prima facie case of obviousness with respect to claim 8 based on the disclosure of Yamakita which has not been overcome by any convincing arguments from Appellant. Accordingly, the Examiner's 35 U.S.C. § 103 rejection of claim 8 based on Yamakita is sustained.

We also sustain the Examiner's 35 U.S.C. § 103 rejection of dependent claims 10-15 based on Yamakita. Appellant's sole argument (Brief, pages 9 and 10) in response to the Examiner's rejection refers to the arguments made with respect to dependent claims 2-7 which are the apparatus counterparts of method claims 10-15. These arguments, however, specifically mention only claims 2 and 3 and the extent of the arguments is to repeat the language of the claims. Simply pointing out what a claim requires with no attempt to point out how the claims patentably distinguish over the prior art does not comply with 37 CFR § 1.192(c)(8) and does not amount to a separate argument for patentability. In re Nielson, 816 F.2d 1567, 1572, 2 USPQ2d 1525,1528 (Fed. Cir. 1987).

In summary, we have not sustained the Examiner's 35 U.S.C. § 103 rejection of claims 1-8 and 10-15 based on Ichikawa. With

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respect to the Examiner's 35 U.S.C. § 103(a) rejection of appealed claims 1-8 and 10-15 based on Yamakita, we have not sustained the rejection of claims 1-7, but have sustained the rejection of claims 8 and 10-15. Therefore, the Examiner's decision rejecting claims 1-8 and 10-15 is affirmed-in-part.

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

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Administrative Patent Judge)	
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