

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 36

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

Ex parte ALEX K. RAITH, RAJARAM RAMESH, R. DAVID KOILPILLAI,  
GREGORY E. BOTTOMLEY, and HAVISH KOORAPATY

---

Appeal No. 2002-2179  
Application No. 08/839,861

---

ON BRIEF

---

Before KRASS, BARRY, and BLANKENSHIP, Administrative Patent Judges.

BLANKENSHIP, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 5, 10, 12, and 13.

We affirm-in-part.

BACKGROUND

The invention relates to radiocommunication systems and, in particular, techniques for supporting emergency calling procedures in such systems. Claims 10 and 12 are reproduced below.

10. A method for handling an emergency call in a radiocommunication system comprising the steps of:

identifying, in said system, a call as said emergency call;

transmitting, from said system, an indication to a mobile unit which is associated with said emergency call to transmit with at least one of: maximum power, continuous transmission and unencrypted data.

12. A mobile unit comprising:

means for identifying that an emergency call has been placed; and

means, responsive to said identifying means, to enter a low power mode to reduce battery drain.

The examiner relies on the following references:

Cox et al. (Cox)	3,764,915	Oct. 9, 1973
Johnson et al. (Johnson)	4,977,589	Dec. 11, 1990
Brickell	5,554,993	Sep. 10, 1996 (filed Jan. 4, 1994)
Uola	5,603,095	Feb. 11, 1997 (effectively filed May 26, 1995)
Ishikawa et al. (Ishikawa)	5,666,655	Sep. 9, 1997 (filed Feb. 2, 1995)

Appeal No. 2002-2179  
Application No. 08/839,861

Claim 10 stands rejected under 35 U.S.C. § 102 as being anticipated by Johnson.

Claim 12 stands rejected under 35 U.S.C. § 102 as being anticipated by Brickell.

Claim 5 stands rejected under 35 U.S.C. § 103 as being unpatentable over Ishikawa or Cox.

Claim 13 stands rejected under 35 U.S.C. § 103 as being unpatentable over Brickell and Uola.

Claims 1-4 and 7-9 stand allowed. A rejection against claim 11 was withdrawn subsequent to the final rejection. Claim 11 stands objected to as depending from a rejected claim.

We refer to the Final Rejection (Paper No. 18) and the Examiner's Answer (Paper No. 25) for a statement of the examiner's position and to the Brief (Paper No. 24) and the Reply Brief (Paper No. 31) for appellants' position with respect to the claims which stand rejected.

### OPINION

#### Claim 10

The examiner contends that Johnson anticipates instant claim 10 because the reference discloses, inter alia, a radiocommunication system transmitting, associated with an emergency call, an indication to a mobile unit to transmit with "continuous transmission." The central station grants a communication channel to any subscriber

Appeal No. 2002-2179  
Application No. 08/839,861

unit transmitting an emergency call request. Communication between other subscriber units may be preempted, allowing the subscriber unit with the emergency call to have immediate and unlimited access to the communication channel. Johnson col. 3, ll. 17-31; col. 4, l. 46 - col. 5, l. 8.

Appellants submit that Johnson does not disclose all the elements of instant claim 10. (Brief at 7-8.) Appellants' argument appears to be that Johnson does not use the term "continuous transmission." However, anticipation is not an "ipsissimis verbis" test. Akzo N.V. v. ITC, 808 F.2d 1471, 1479, 1 USPQ2d 1241, 1245 (Fed. Cir. 1986). The proper standard for determining anticipation focuses, in the instant case, on whether the artisan would consider the claims, as properly interpreted, to be fully met by the embodiment described by Johnson -- even if Johnson does not describe the invention using the same terms as the instant claims.

Appellants further argue that the rejection improperly applies the law of inherency to support the finding of anticipation. (Brief at 8-9.) We consider the argument to be inapposite. The rejection is founded on the view that the method expressly described by Johnson falls within the meaning of "continuous transmission" as set forth by instant claim 10. Appellants submit that it does not. (Brief at 9-10.)

Appellants link the claim language "continuous transmission" with a mobile unit being ordered not to activate a "Discontinuous Transmission" (DTX) feature, described at the bottom of page 9 of the specification. Appellants do not appear to argue, however, that "continuous transmission" must be interpreted as limited to preventing

activation of a DTX feature. Nor do appellants appear to offer any limiting definition in the briefs, other than what one might infer from appellants' position that Johnson fails to meet the terms of the claim. Nor does the relevant instant specification section set forth any particular definition for "continuous transmission." In our view, the section conveys that preventing activation of a DTX feature is but one example of a "continuous transmission." We further note that the literal language of the claim does not include limitations referring to any DTX feature.

Claims are to be given their broadest reasonable interpretation during prosecution, and the scope of a claim cannot be narrowed by reading disclosed limitations into the claim. See In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989); In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550 (CCPA 1969). "An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process." Zletz, 893 F.2d at 321, 13 USPQ2d at 1322.

On this record, we are unconvinced that the examiner's broad reading of "continuous transmission" is in error. We sustain the rejection of claim 10 under 35 U.S.C. § 102 as being anticipated by Johnson.

Claim 12

Brickell relates to emergency radio beacons. According to the reference, prior art emergency beacons normally transmitted a homing signal continuously. The beacon battery was thus susceptible to discharging prematurely. Col. 1, l. 60 - col. 2, l. 13. In Brickell's improvement, a user terminal transmits an approximate position signal to initiate a search mission. The user terminal then transmits a continuous wave homing beacon, but only in response to radio reception of a homing beacon activation command which indicates that a search team is nearby. The user terminal thus conserves battery power. Col. 2, l. 60 - col. 3, l. 2.

The examiner finds that Brickell meets the terms of instant claim 12 because, inter alia, the user terminal enters a low power mode by waiting to receive the signal from the search team before transmitting the homing beacon. Appellants argue that the Brickell system does not enter a low power mode subsequent to the emergency call because the reference teaches at column 4, lines 59 through 61 that the user terminal may require 7.5 minutes of measurement time in order to calculate its position. According to appellants, a mode which takes 7.5 minutes to determine a user terminal position is not a low power mode. Appellants further argue that Brickell does not disclose that the user terminal enters a low power mode after sending the "help" message. Appellants assert there is nothing in Brickell which indicates that waiting for a homing beacon is a low power mode compared to normal operation. (Brief at 11-12.)

The examiner responds, in relation to the “7.5 minutes of measurement time,” that claim 12 does not require immediate entry into a low power mode, nor any particular time limit for entering the mode. (Answer at 6.)

Brickell teaches that the user terminal may send its position automatically, with no further user intervention after sending the “help” signal. After calculating and sending its position, the user terminal may continue to refine its position. Alternatively, the user terminal may wait for receipt of an “activate homing beacon” signal. Col. 5, ll. 19-27. To conserve battery power, the user terminal would not broadcast a homing beacon until a search team is in the area. Id. at ll. 53-58.

Contrary to appellants’ position, we find that (1) the user terminal of Brickell enters a low power mode after sending the “help” message and (2) the user terminal is in a low power mode while waiting for activation of the homing beacon signal, in comparison to other modes of operation. The express purpose of the Brickell invention is to conserve battery power after sending of the initial “help” message. The user terminal enters a low power mode to reduce battery drain at least between the time of sending position information and activation of the homing beacon. We agree with the examiner that claim 12 does not preclude other -- i.e., not necessarily low power -- modes between the time of identification that an emergency call has been placed and entry to the low power mode.

We agree with appellants to the extent that the low power, continuous wave homing beacon described by Brickell is not responsive to the identifying means, as

Appeal No. 2002-2179  
Application No. 08/839,861

required by instant claim 12. However, just as claim 12 does not preclude other modes between identification of an emergency call and entry of the low power mode, the claim does not preclude other modes responsive to other means.

For the foregoing reasons we sustain the rejection of claim 12 under 35 U.S.C. § 102 as being anticipated by Brickell.

#### Claim 13

The examiner offers the combination of Brickell and Uola to show prima facie obviousness of the subject matter of instant claim 13. (Final Rejection at 4.) We consider the rejection to be well founded. Appellants have provided no separate arguments in defense of claim 13, which depends from claim 12. We sustain the rejection of claim 13 under 35 U.S.C. § 103 as being unpatentable over Brickell and Uola.

#### Claim 5

The examiner contends that both Ishikawa and Cox disclose that dynamic channel allocation is based on position or location of mobile units. The examiner takes "Official Notice" that using an "adjunct system," such as GPS or LORAN, to "receive position information" was well known in the art. The examiner concludes that it would have been obvious to modify Ishikawa and Cox "with a known adjunct system" such as GPS or LORAN to receive the position information so as to receive accurate position

Appeal No. 2002-2179  
Application No. 08/839,861

information. (Final Rejection at 3.) The examiner further asserts that using an “adjunct system” is admitted to be well known in the instant specification, at Figure 1 and page 2, lines 9 through 15. (Answer at 7.)

We note that the specification draws distinctions between an “adjunct system,” described at page 2, and the use of GPS receivers, described at page 1, lines 20 through 28. In any event, we agree with appellants there is no showing, on this record, of suggestion from the prior art to use position information from an adjunct system to perform dynamic channel allocation, as required by instant claim 5.

The allocation of burdens requires that the USPTO produce the factual basis for its rejection of an application under 35 U.S.C. § § 102 and 103. In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984) (citing In re Warner, 379 F.2d 1011, 1016, 154 USPQ 173, 177 (CCPA 1967)). Although the examiner’s conclusion that the subject matter as a whole of the claim would have been obvious may appear sound in hindsight, the required factual foundation for the rejection is lacking. We do not sustain the rejection of claim 5 under 35 U.S.C. § 103 as being unpatentable over Ishikawa or Cox.

Appeal No. 2002-2179  
Application No. 08/839,861

CONCLUSION

The rejection of claims 10 and 12 under 35 U.S.C. § 102 is affirmed. The rejection of claim 13 under 35 U.S.C. § 103 is affirmed. The rejection of claim 5 under 35 U.S.C. § 103 is reversed.

The examiner's decision in rejecting claims 5, 10, 12, and 13 is thus 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

ERROL A. KRASS	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
LANCE LEONARD BARRY	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
HOWARD B. BLANKENSHIP	)	
Administrative Patent Judge	)	

Appeal No. 2002-2179  
Application No. 08/839,861

MYERS BIGEL SIBLEY & SAJOVEC  
PO BOX 37428  
RALEIGH , NC 27627