

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte PAUL MICHAEL KINGSLEY  
and BRADLEY SCOTT DOERR

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Appeal No. 2004-1822  
Application 09/550,863

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ON BRIEF

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Before GARRIS, HAIRSTON, and PAWLIKOWSKI, Administrative Patent Judges.

PAWLIKOWSKI, Administrative Patent Judge.

**DECISION ON APPEAL**

This is a decision on appeal from the examiner's final rejection of claims 1-13.

Claims 1, 5, 8, and 12 are set forth below:

1. An echo plug apparatus for use with a wireless telephone having a hands-free jack, the echo plug apparatus comprising:  
a pin that is physically compatible with the hands-free jack of the wireless telephone and that is configured with a speaker connection and a microphone connection; and  
a circuit configured to couple the speaker connection to the microphone connection.

5. An echo plug apparatus for use with a first wireless telephone having a first hands-free jack and a second wireless telephone having a second hands-free jack, the echo plug apparatus comprising:

a first pin that is physically compatible with the first hands-free jack of the first wireless telephone and that is configured with a speaker connection;

a second pin that is physically compatible with the second hands-free jack of the second wireless telephone and that is configured with a microphone connection; and

a circuit configured to couple the speaker connection to the microphone connection.

8. A method of operating an echo plug for use with a wireless telephone having a hands-free jack, the method comprising:

receiving a signal from a speaker connection of the hands-free jack of the wireless telephone; and

transferring the signal from the speaker connection to a microphone connection of the hands-free jack of the wireless telephone.

12. A method of operating an echo plug for use with a first wireless telephone having a first hands-free jack and a second wireless telephone having a second hands-free jack, the method comprising:

receiving a signal from a speaker connection of the first hands-free jack of the first wireless telephone; and

transferring the signal from the speaker connection to a microphone connection of the second hands-free jack of the second wireless telephone.

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The examiner relies upon the following references as evidence of unpatentability:

Hendershot	4,903,323	Feb. 20, 1990
Larkin	5,687,213	Nov. 11, 1997
Sears	5,696,813	Dec. 9, 1997
DeJaco et al. (DeJaco)	5,784,406	July 21, 1998
Fujiwara	5,790,657	Aug. 4, 1998
Snapp	5,875,398	Feb. 23, 1999
Hardy et al. (Hardy)	6,108,404	Aug. 22, 2000

As a preliminary matter, we note that appellants filed an appeal brief on June 26, 2003 (Paper No. 9). In response thereto, the examiner reopened prosecution in the office action mailed August 5, 2003 (Paper No. 10). In response thereto, appellants filed the supplemental appeal brief on November 10, 2003 (Paper No. 11). We use the supplemental appeal brief of Paper No. 11, as well as the reply brief of Paper No. 13 in making our determinations herein. We further note that in the examiner's answer, while the examiner refers to the rejections as set forth in Paper No. 4, we believe the examiner's intent was to refer to Paper No. 10. We also note that on page 3 of the answer, the examiner lists the grounds of rejections, and does not include the 35 U.S.C. §112 rejection. However, the examiner argues this rejection on pages 3-5 of the answer, and we include the 35 U.S.C. §112, second paragraph rejection among the issues in this appeal.

Claims 1-13 stand rejected under 35 U.S.C. §112, second paragraph (indefiniteness).

Claims 1-3 and 8-10 stand rejected under 35 U.S.C. §103 as being unpatentable over DeJaco in view of Fujiwara, Hardy,

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Larkin, and Hendershot.

Claims 4 and 11<sup>1</sup> stand rejected under 35 U.S.C. §103 as being unpatentable over DeJaco and Fujiwara and further in view of Sears.

Claims 5-7, 12, and 13 stand rejected under 35 U.S.C. §103 as being unpatentable over DeJaco and Fujiwara and further in view of Snapp.

On page 6 of the supplemental brief, appellants group the claims into four groupings. Based upon these groupings, we select the broadest claim from each group, which are: claims 1, 5, 8, and 12. Also, to the extent that any other claim is argued separately, we consider such claim in this appeal.

#### **OPINION**

We have carefully reviewed appellants' supplemental brief and reply brief, and the examiner's answer, and applied art in making the determinations below. We refer to these papers regarding the respective positions in this appeal.

#### **I. The 35 U.S.C. §112, second paragraph (indefiniteness) rejection**

We refer to page 2 of the Office action of Paper No. 10 with regard to the examiner's position in this rejection. Basically, the examiner asserts that the term "echo" is used in a way that is contrary to its ordinary meaning, and because appellants' written description does not clearly re-define this term, the examiner concludes that the term is indefinite. The examiner states that the term should be changed to a loop back plug.

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<sup>1</sup> Claims 4 and 11 depend from claims 1 and 8, respectively, but are rejected on less than the total number of references used to reject claims 1 and 8.

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Beginning on page 9 of the supplemental brief, appellants argue that their use of the term "echo" is not contrary to the ordinary meaning of the word "echo." Appellants refer to U.S. Patent No. 6,108,404 to Hardy, to show that appellants' use of the term "echo" is not contrary to the ordinary meaning of the word "echo." Beginning on page 2 of the reply brief, appellants also argue that 35 U.S.C. § 112, second paragraph, regarding indefiniteness is whether the claim meets the threshold requirements of clarity and precision, not whether a more suitable language or mode of expression is available. We agree, and we refer to the following excerpts from appellants' specification in support thereof.

Beginning on page 2, at line 17, the specification states:

"[t]he invention solves the above problems with an echo plug that facilitates robust testing under dynamic test conditions by looping test signals through a wireless telephone back to a test system. The echo plug fits into the hands-free jack of a wireless telephone and is easily moved from one wireless telephone to another. The wireless telephones retain their mobility with the echo plug attached. The echo plug facilitates the testing of different wireless telephones at various locations over different communication systems."

On page 2, at line 24, the specification states:

"[o]ne echo plug has a pin and a circuit. The pin is physically compatible with the hands-free jack of a wireless telephone. The pin has a speaker connection and a microphone connection. The circuit couples the speaker connection to the microphone connection. In operation, this echo plug receives a signal from the speaker connection of the hands-free jack and transfers the signal to the microphone connection of the hands-free jack."

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The specification has a similar description on page 4, at lines 8-17.

In view of the above excerpts from appellants' specification, we determine that the use of the word "echo" in the claims is not indefinite, as the specification adequately details the function of the echo plug such that this term is definite as used in the claims.

We therefore reverse the 35 U.S.C. § 112, second paragraph, rejection.

II. The 35 U.S.C. §103 rejection of claims 1-3 and 8-10 under 35 U.S.C. §103 as being unpatentable over DeJaco in view of Fujiwara and Hardy and Larkin and Hendershot

We consider claims 1 and 8 in this rejection.

Claim 1

Claim 1 requires, *inter alia*, "a **circuit** configured to couple the speaker connection to the microphone connection" [emphasis added].

The examiner's position with regard to claim 1 is set forth on pages 3-4 of Paper No. 10.

Upon our review of the applied art and the examiner's position, we find that DeJaco discloses a loopback in a mobile station, and not within a phone. Fujiwara does not disclose a circuit configured to couple the speaker connection to the microphone connection; rather Fujiwara discloses an acoustic path 18 (see Figure 1 and column 4, lines 16-23).<sup>2</sup>

Because claim 1 requires that the echo plug apparatus includes a circuit configured to couple a speaker connection to a microphone connection, we determine that the combination of

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<sup>2</sup> The examiner discusses Hardy, Hendershot, and Larkin for teaching systems involving a loopback function. See page 5 of Paper No. 10. These references do not cure the above-mentioned deficiencies of

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references does not suggest the claimed invention.

In view of the above, we reverse the rejection of claim 1 (and also dependent claims 2-3).

#### Claim 8

With regard to claim 8, we observe that claim 8 is different from claim 1 because it does not require a circuit configured to couple the speaker connection to the microphone connection.

We find that Fujiwara teaches acoustic coupling between receiver 12 and microphone 15, for a radio phone, which is a wireless phone. See Figure 1, column 4, lines 16-32, and column 1, lines 9-14 of Fujiwara.

The above-mentioned teaching of Fujiwara makes obvious the subject matter of claim 8 because claim 8 merely requires a method comprising receiving a signal from a speaker connection and transferring that signal from the speaker connection to a microphone connection. Claims 9-11 depend upon claim 8. The subject matter of claim 9 (attenuation) is suggested by Fujiwara (see item 16 in Figure 1). The subject matter of claim 10 (delaying the signal) is also suggested in Fujiwara (column 4, lines 46-47).

In view of the above, we affirm the rejection of claims 8-10.

In summary, we reverse the rejection of claims 1-3, but affirm the rejection of claims 8-10, under 35 U.S.C. §103 as being unpatentable over DeJaco in view of Fujiwara and Hardy and Larkin and Hendershot.

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III. The 35 U.S.C. §103 rejection of claims 4 and 11

With regard to claim 4, because claim 4 depends upon claim 1, we also reverse the rejection of claim 4.

With regard to claim 11, claim 11 depends upon claim 8. Claim 11 concerns canceling side-tones from the signal. The examiner relies upon Sears for teaching this aspect of the claimed invention. Appellants do not dispute the findings made by the examiner regarding Sears. See pages 30-31 of the supplemental brief. Hence, we affirm the rejection of claim 11.

In summary, we therefore reverse the rejection of claim 4, but affirm the rejection of claim 11, under 35 U.S.C. §103 as being unpatentable over DeJaco and Fujiwara and further in view of Sears.

IV. The rejection of claims 5-7, 12 and 13 under 35 U.S.C. §103 as being unpatentable over DeJaco and Fujiwara and further in view of Snapp

Claim 5 also requires a circuit configured to couple a speaker connection to a microphone connection. Hence, for the same reasons that we reversed the rejection of claim 1, we also reverse the rejection of claim 5 (and dependent claims 6 and 7).

With regard to claim 12, claim 12 does not require a circuit configured to couple a speaker connection to a microphone connection. Claim 12 recites receiving a signal from a speaker connection of a first hands-free jack and transferring that signal from the speaker connection to a microphone connection of a second hands-free jack of a second wireless telephone.

The examiner basically relies upon Snapp for teaching a remote cellular test set that can connect to multiple cellular phones that are coupled together via a loop access. The phones

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have individual communication links as well. The examiner focuses mainly on Snapp's conceptual teachings of simultaneous testing/connection, multiple cellular phones and a connection between both phones. See pages 7-9 of the office action of Paper No. 10. Also, on page 6 of the answer, the examiner states that Snapp discloses a remote cellular test set that can connect to multiple cellular phones that are coupled together via loop access, and refers to figure 2, item 230 of Snapp. The examiner then states that it would have been obvious to have utilized two wireless telephones as means to test wall-to-wall phones at once which increases efficiency of the tester. Answer, page 7. We agree. We believe that testing of one phone or multiple phones would have been obvious as explained by the examiner.

Appellants argue this rejection on pages 32-35 of the brief and pages 12-13 of the reply brief. Appellants emphasize the import of a wireless phone. Fujiwara uses a radio phone which is a wireless phone. Hence, we are not convinced by such argument.

Claim 13 is directed to attenuation, and as discussed supra, Fujiwara teaches attenuation.

In view of the above, we affirm the rejection of claims 12 and 13.

#### V. Conclusion

We reverse the rejection of claims 1-13 under 35 U.S.C. §112, second paragraph.

We reverse the rejection of claims 1-3, but we affirm the rejection of claims 8-10, under 35 U.S.C. §103, as being unpatentable over DeJaco in view of Fujiwara, and Hardy, Larkin and Hendershot.

We reverse the rejection of claim 4, but we affirm the rejection of claim 11, under 35 U.S.C. §103 as being unpatentable over DeJaco and Fujiwara and further in view of Sears.

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We reverse the rejection of claims 5-7, but affirm the rejection of claims 12-13, under 35 U.S.C. §103 as being unpatentable over DeJaco and Fujiwara and further in view of Snapp.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv)(effective Sept. 13, 2003; 69 Fed. Reg. 49960 (Aug. 12, 2004); 1286 Off. Gaz. Pat., Office 21 (Sept. 7, 2004)).

**AFFIRMED-IN-PART**

Bradley R. Garris	)	
Administrative Patent Judge	)	
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	)	BOARD OF PATENT
Kenneth W. Hairston	)	APPEALS AND
Administrative Patent Judge	)	INTERFERENCES
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Administrative Patent Judge	)	

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