UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte Hea-Jeung Lee and Gye-Baeg Lee

Appeal 2007-0642
Application 10/267,877
Technology Center 2600

Decided: May 23, 2007

Before JAMES D. THOMAS, JOSEPH L. DIXON, and
JEAN R. HOMERE, *Administrative Patent Judges.*
DIXON, *Administrative Patent Judge.*

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. §§ 6(b) and 134 from the Examiner's Final Rejection of claims 1-8 and 10-16.

We AFFIRM.

BACKGROUND

Appellants' invention relates to a telephone apparatus for stabilizing a call in a no power operation mode and method for controlling the same. (Specification 1). An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

> 1. A telephone apparatus which has at least two processors and stabilizes a call in a no power operation (NPO) mode, said telephone apparatus comprising:
>
> a power-on detector for detecting a power-on state of an external supply voltage to generate a power-on detection signal when said telephone apparatus is operating in said no power operation mode;
>
> a power switch receiving a central office telephone line loop voltage outputted from a telephone circuit in a hook-off state and the external supply voltage, said power switch selectively outputting at least one of the received voltages as an operating voltage to the telephone circuit;
>
> said telephone circuit being connected to a central office telephone line, said telephone circuit being operated in response to said loop voltage on said telephone line during said no power operation mode and being operated in response to said external supply voltage when said external supply voltage is received by said power switch; and
>
> a main controller having an operation control port, said main controller performing a power-on reset operation to boot an internal system program when said external supply voltage is received by said main controller during said no power operation mode;
>
> a sub-controller included in said telephone circuit, said sub-controller outputting a booting prevention signal to said operation control port of said main controller in response to said power-on detection signal to prevent said main controller from performing the power-on reset operation.

PRIOR ART

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

WALLACE	US 6,647,117 B1	Nov. 11, 2003 (filed Aug. 16, 1999)
FOX	5,014,308	May 7, 1991
IIDA	4,916,735	Apr. 10, 1990

REJECTIONS

Claims 1-6 and 13-16 stand rejected under 35 U.S.C. 102(e) as being anticipated by Wallace.

Claim 12 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Wallace.

Claim 10 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Wallace in view of Fox.

Claims 7, 8, and 11 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Wallace in view of Fox and Iida.

Rather than reiterate the conflicting viewpoints advanced by the Examiner and the Appellants regarding the above-noted rejection, we make reference to the Examiner's Answer (mailed Jun. 2, 2006) for the reasoning in support of the rejections, and to Appellants' Brief (filed Mar. 3, 2006) and Reply Brief (filed Jul. 28, 2006) for the 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 that follow.

At the outset, we note that Appellants have not provided a Brief in compliance with 37 CFR § 41.37 wherein the Summary of the Claimed Invention does not include a concise summary of each of the independent claims. The Brief does not include a summary of independent claim 13. Furthermore, Appellants have not separately argued this claim beyond any assertions that were argued with respect to independent claim 1 that there is no booting prevention signal and no disclosure of a masked program. We find no limitation in independent claim 1 of a masked program and find that Appellants have identified no express support in the Specification for the masked program. We will therefore group independent claim 13 with independent claim 1.

35 U.S.C. § 102

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. Inc. v. Union Oil Co.,* 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The inquiry as to whether a reference anticipates a claim must focus on what subject matter is encompassed by the claim and what subject matter is described by the reference. As set forth by the court in *Kalman v. Kimberly-Clark Corp.*, 713

F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), it is only necessary for the claims to "'read on' something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or 'fully met' by it." While all elements of the claimed invention must appear in a single reference, additional references may be used to interpret the anticipating reference and to shed light on its meaning, particularly to those skilled in the art at the relevant time. *See Studiengesellschaft Kohle, M.B.H. v. Dart Indus., Inc.*, 726 F.2d 724, 726-27, 220 USPQ 841, 842-43 (Fed. Cir. 1984).

With respect to independent claim 1, Appellants argue that Wallace does not discuss the operation control port and a booting prevention signal to said operation control port (Br. 9-11). We disagree with Appellants and find that Wallace teaches the use of a port for communication between various elements in the system. While not expressly shown in the drawings, Wallace describes at column 7, lines 10-15, that the power monitor 370 indicates a failure of power and has an interface to the microprocessor 363 to generate an interrupt or allow polling. Therefore, Wallace contains communication between the various units.

Similarly, Wallace states, at column 8, lines 39-43, that upon power restoration, the changes must be reversed without requiring a full retrain. Here, we find that there would be some required communication between the Discrete Multi-Tone (DMT) modem 364 (with a Digital Signal Processor (DSP)) and the microprocessor 363 to allow the modem to either fully retrain or limit the retraining of the modem. The Examiner has identified the modem 364 as the main controller and the microprocessor 363 as the sub-controller (Answer 4). We agree with the Examiner's correlation of independent claim 1 to the teachings of Wallace.

Appellants argue that if the modem 364 had a power-on reset operation to boot an internal system program when supply voltage is received at the main controller then the modem would boot and cause the call to be lost (Br. 12). Here, Appellants seem to interpret the supply of the voltage as the trigger for the system program, but we find that Wallace would have the program for retraining or limited retraining responsive to the signal from the microprocessor which gets an indication from the power supply monitor. We cannot agree with Appellants' implied narrow interpretation of independent claim 1.

Appellants argue that the Examiner is speculating as to the operation of Wallace (Br. 13). We disagree with Appellants' argument and do not find that Appellants have identified any specific error in the Examiner's correlation to the express limitations recited in independent claim 1. Therefore, Appellants' argument is not persuasive, and we will sustain the rejection of independent claim 1.

With respect to dependent claim 2, the Examiner has identified that the microprocessor or sub-controller blocks the output of the booting prevention signal to the operation port of the main controller (Answer 6). We understand the Examiner to maintain that the microprocessor uses the hook-on state of the telephone to allow the modem to perform a full retrain operation. The Examiner finds that this meets the feature "adapted to block the output of said booting prevention signal." We agree with the Examiner that the change of the output of the microprocessor or the lack of an output in response to the change in state would have met the broad language of dependent claim 2. Since we do not find that Appellants have shown error

in the Examiner rejection of dependent claim 2, we will sustain the rejection of dependent claim 2.

With respect to dependent claims 3 and 5, Appellants rely upon the base argument that modem 364 of Wallace does not have the function of a performing power-on reset operation to boot an internal system program (Br. 14-15). As discussed above, we did not find this argument persuasive with respect to independent claim 1. Therefore, Appellants' argument is not persuasive with respect to dependent claims 3 and 5. Appellants argue that there is no showing by the Examiner that the prevention signal if it existed would be both a hold signal and a reset signal (Br. 15). This argument is not commensurate in scope with the express limitations of dependent claims 3 and 5 since each claim only has one of the signals recited. Therefore, Appellants' argument is not persuasive. Additionally, Appellants have elected to group both dependent claims 3 and 5 together under a single heading. Therefore, since we find no persuasive argument to dependent claim 3, we sustain the rejection thereof and further sustain the rejection of dependent claims 4, 5, and 6 as being not separately argued.

With respect to independent claim 13, Appellants rely upon the same arguments as advanced with respect to independent claim 1 (Br. 16). Since we did not find those arguments persuasive with respect to independent claim 1, we similarly do not find reliance thereon persuasive with respect to independent claim 13. We find no limitation in independent claim 1 of a masked program and find that Appellants have identified no express support in the Specification for the masked program. We will therefore group independent claim 13 with independent claim 1.

Additionally, since the language in independent claim 13 is not commensurate in scope with the limitations in independent claim 1, we cannot find the arguments directed to independent claim 1 persuasive with respect to independent claim 13. Therefore, we will sustain the rejection of independent claim 13.

35 U.S.C. § 103

At the outset, we note that to reach a proper conclusion under § 103, the Examiner, as finder of fact, must step backward in time and into the mind of a person of ordinary skill in the art at a time when the invention was unknown, and just before it was made. In light of all the evidence, we review the specific factual determinations of the Examiner to ascertain whether the Examiner has convincingly established that the claimed invention as a whole would have been obvious at the time of the invention to a person of ordinary skill in the art. When claim elements are found in more than one prior art reference, the fact finder must determine "whether a person of ordinary skill in the art, possessed with the understandings and knowledge reflected in the prior art, and motivated by the general problem facing the inventor, would have been led to make the combination recited in the claims." *In re Kahn,* 441 F.3d 977, 988, 78 USPQ2d 1329, 1337 (Fed. Cir. 2006). With respect to the role of the Examiner as finder of fact, the Court of Appeals for the Federal Circuit has stated: "the examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability." *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The Court of Appeals for the Federal Circuit has also noted: "[w]hat the prior art teaches, whether

it teaches away from the claimed invention, and whether it motivates a combination of teachings from different references are questions of fact." *In re Fulton,* 391 F.3d 1195, 1199-1200, 73 USPQ2d 1141, 1144 (Fed. Cir. 2004) (internal citations omitted). 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 must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966). Furthermore, "'there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness' . . . . [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." KSR Int'l v. Teleflex Inc., 127 S. Ct. 1727, 82 USPQ2d 1385 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

With respect to dependent claims 7, 8, and 10-12, Appellants rely upon the same arguments as advanced with respect to independent claim 1 (Br. 16-17). Since we did not find those arguments persuasive with respect to independent claim 1, we similarly do not find reliance thereon persuasive with respect to dependent claims 7, 8, and 10-12**.**

CONCLUSION

To summarize, we have sustained the rejection of claims 1-6 and 13-16 under 35 U.S.C. § 102, and we have sustained the rejection of claims 7, 8, and 10-12 under 35 U.S.C. § 103(a).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

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