

The opinion in support of the decision being entered
today is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KEVIN E. DOMBKOWSKI, RICHARD T. EMERY, and
CHARLES A. WITSCHORIK

Appeal 2007-1472
Application 10/440,770
Technology Center 2600

Decided: September 20, 2007

Before JOSEPH F. RUGGIERO, JOSEPH L. DIXON, and
JOHN A. JEFFERY, *Administrative Patent Judges*.
DIXON, *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 1-20.

We AFFIRM.

BACKGROUND

Appellants' invention relates to a system for providing unified cellular and a wire-line service using a home cell. An understanding of the invention can be derived from a reading of exemplary claim 11, which is reproduced below.

11. A method for providing unified cellular and wire-line telephone service to a plurality of wire-line telephones via a serving cellular mobile switching center which is equipped with at least one Radio Network Subsystem, comprising:

concurrently exchanging, via a cellular interface that is connected to a plurality of wire-line telephones, each having a single assigned directory number, voice encoding and protocols with at least two of said plurality of wire-line telephones;

generating, in a home cell site interface that is connected to said serving cellular mobile switching center, control and bearer information expected by said at least one Radio Network Subsystem;

formatting, in a converter, voice encoding and protocols received from said cellular interface and representative of signals generated by said plurality of wire-line telephones into control and bearer information expected by said at least one Radio Network Subsystem and control and bearer information received from said home cell site interface and representative of signals generated by said at least one Radio Network Subsystem into voice encoding and protocols expected by said plurality of wire-line telephones; and

extending, in response to said plurality of wire-line telephones originating outgoing calls, said outgoing calls through said cellular interface, said converter, and said home cell site interface to said serving cellular mobile switching center for completion of said outgoing calls to a destination identified by said plurality of wire-line telephones via said serving cellular mobile switching center.

PRIOR ART

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

Malmstrom	US 5,901,359	May 4, 1999
Pulver	US 6,741,835 B2	May 25, 2004 (filed Jan. 11, 2002)
Torrey	US 6,751,462 B1	Jun. 15, 2004 (filed Aug. 19, 2002)

REJECTIONS

Claims 1, 3, 10, 11, 13, and 20 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Torrey.

Claims 2 and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Torrey in view of Malmstrom.

Claims 4-9 and 14-19 stand rejected under 35 § U.S.C. 103(a) as being unpatentable over Torrey in view of Pulver.

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 December 13, 2006) for the reasoning in support of the rejections, and to Appellants' Brief (filed September 20, 2006) and Reply Brief (filed February 13, 2007) 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.

ANTICIPATION

“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. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Analysis of whether a claim is patentable over the prior art under 35 U.S.C. § 102 begins with a determination of the scope of the claim. We determine the scope of the claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364, 70 USPQ2d 1827, 1830 (Fed. Cir. 2004). The properly interpreted claim must then be compared with the prior art.

“It is well settled that a prior art reference may anticipate when the claim limitations not expressly found in that reference are nonetheless inherent in it. Under the principles of inherency, if the prior art necessarily functions in accordance with, or includes, the claimed limitations, it anticipates.” *In re Cruciferous Sprout Litig.*, 301 F.3d 1343, 1349, 64 USPQ2d 1202, 1206 (Fed. Cir. 2002) (citations and internal quotation marks omitted). “Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *In re Robertson*,

169 F.3d 743, 745, 49 USPQ2d 1949, 1951 (Fed. Cir. 1999) (citations and internal quotation marks omitted).

"[A] prima facie case of anticipation [may be] based on inherency."
In re King, 801 F.2d 1324, 1327, 231 USPQ 136, 138-39 (Fed. Cir. 1986). Once a prima facie case of anticipation has been established, the burden shifts to the Appellants to prove that the prior art product does not necessarily or inherently possess the characteristics of the claimed product.
In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977) ("Where, as here, the claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes, the PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed product."). *See also In re Spada*, 911 F.2d 705, 708-09, 15 USPQ2d 1655, 1657-58 (Fed. Cir. 1990).

At the outset, we note that Appellants have addressed independent claim 1 in the same grouping as independent claim 11. We find the method of independent claim 11 to be broader than the system with "means plus function" limitations recited in independent claim 1. Therefore, we select independent claim 11 as the representative claim for the group, and we will address Appellants' arguments as they apply to our selected representative claim 11. Additionally, we note that the Reply Brief merely repeats the same arguments advanced in the Brief.

From our review of the teachings of Torrey, we agree with Appellants' correlation of the teachings of Torrey at pages 7-11 of the Brief, but we cannot agree with Appellants' final conclusion that Torrey does not

teach the invention as recited in independent claim 11. We find that Appellants main contention lies in the following argument:

Thus, the system of the Torrey patent uses the wireless telephone to interface a plurality of wire-line extension telephones with the wireless network. The wire-line extension telephones share a common telephone number (assigned to the telephone line) and can only originate or receive calls when the wireless handset is not in use. Thus, the wire-line telephones are slave devices to the wireless telephone in the case of originating and receiving cellular calls.

(Br. 8 and repeated in Reply Brief at 7). We do not find Appellants' argument to be persuasive since we find no element of the claim to be missing from Torrey as long as the wireless handset is not in use. We conclude, that when the handset is not in use, Torrey teaches the invention as recited in independent claim 11, and we will sustain the Examiner's rejection of independent claim 11 and claims 1, 3, 10, 13, and 20 grouped therewith.

OBVIOUSNESS

With respect to dependent claims 2, 4-9, 12, and 14-19, Appellants rely upon the same argument advanced regarding independent claim 11. Appellants contend that the Examiner has not set forth a *prima facie* case of obviousness since those elements missing in Torrey are neither taught by Malmstrom nor Pulver. We disagree with Appellants, as discussed above, and find no deficiency in Torrey. Therefore, Appellants' argument is not persuasive, and we will sustain the rejection of dependent claims 2, 4-9, 12, and 14-19 since Appellants have not shown error in the Examiner's initial showing.

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CONCLUSION

To summarize, we have sustained the rejection of claims 1, 3, 10, 11, 13 and 20 under 35 U.S.C. § 102, and we have sustained the rejection of claims 2, 4-9, 12, and 14-19 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 C.F.R. § 1.136(a).

AFFIRMED

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