UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DENNIS SUNGA FERNANDEZ
and IRENE HU FERNANDEZ

Appeal 2008-1046
Application 09/823,089
Technology Center 2600

Decided: September 29, 2008

Before KENNETH W. HAIRSTON, JOHN A. JEFFERY,
and R. EUGENE VARNDELL, JR., *Administrative Patent Judges*.

VARNDELL, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134 from the Examiner's rejections of claims 37-66. We have jurisdiction under 35 U.S.C. § 6(b). We AFFIRM-IN-PART.

STATEMENT OF THE CASE

Appellants' invention relates to a cellphone and a method for cellphone communication (Spec. 12). The cellphone or method claimed on appeal includes a communication module comprising a user-customizable or reconfigurable software program, firmware or circuit accessible locally in the cellphone or remotely via the network, the communication module being partitionable or uninstallable (Spec. 9, 14-16). The claimed cellphone or method also includes a sensor comprising a camera capable of recording the image, audio or video signal, and recognizing the cellphone user voice or image (Spec. 10). The cellphone or method on appeal further includes a wireless communicator that communicates within a group of cellphones chatting privately in multi-cast mode using an embedded watermark or digital certificate, thereby securing such group communication electronically (Spec. 14).

Claims 37, 39, 43, 52, and 54, which further illustrate the invention, follow:

> 37. Cellphone for communicating with a networked controller comprising:
>
> a wireless communicator for communicating remotely with a networked controller via a network;
>
> a locator for providing a cellphone location to the networked controller via the wireless communicator;
>
> a sensor for providing an image, audio, or video signal of a cellphone user for transmission to the networked controller via the wireless communicator; and
>
> a processor for accessing a communication module for enabling voice or video over Internet-Protocol streaming via the wireless communicator, the communication module comprising a user-customizable or reconfigurable software program, firmware or circuit accessible locally in the cellphone or remotely via the network, the communication module being

partitionable or uninstallable as functional component, the voice or video stream being wirelessly communicated by the wireless communicator effectively via a data channel to a wireless Internet service provider;

wherein the communication module is provided in layered or hierarchical arrangement, such that a first-level functionality is provided by a database and an object movement module, and a next-level functionality is provided by the communication module and a security module.

39. The cellphone of Claim 37 wherein:

the sensor comprises a camera capable of recording the image, audio or video signal, and recognizing the cellphone user voice or image.

43. The cellphone of Claim 37 wherein:

the wireless communicator communicates within a group of cellphones chatting privately in multi-cast mode using an embedded watermark or digital certificate, thereby securing such group communication electronically.

52. Method for cellphone communication with a networked controller comprising the steps of:

communicating by a cellphone with a networked controller via a network; and

providing a cellphone location, and an image, audio, or video signal of a cellphone user to the networked controller;

wherein the cellphone accesses a communication module for enabling voice or video over Internet-Protocol streaming, the communication module comprising a user-customizable or reconfigurable software program, firmware or circuit accessible locally in the cellphone or remotely via the network, the communication module being partitionable or uninstallable as functional component, the voice or video stream being wirelessly communicated effectively via a data channel to a wireless Internet service provider;

wherein the communication module is provided in layered or hierarchical arrangement, such that a first-level functionality is provided by a database and an object movement

module, and a next-level functionality is provided by the communication module and a security module.

54. The method of Claim 52 wherein:
the cellphone user voice or image is recognized from the image, audio or video signal.

The Examiner relies on the following prior art references to show unpatentability:

David	US 5,441,047	Aug. 15, 1995
Uppaluru	US 5,915,001	Jun. 22, 1999
Heiskari	US 5,930,723	Jul. 27, 1999
DeLorme	US 5,948,040	Sep. 7, 1999
Joao	US 6,047,270	Apr. 4, 2000
Rudrapatna	US 6,052,598	Apr. 18, 2000
Hollenberg	US 6,091,956	Jul. 18, 2000
McGregor	US 6,243,574 B1	Jun. 5, 2001
Kennedy	US 6,301,480 B1	Oct. 9, 2001
Almeida	US 6,356,758 B1	Mar. 12, 2002

The Final Rejection mailed on October 13, 2005 set forth the following rejections of claims 37-66 on appeal:

1. Claims 37, 38, 42, 44, 52-54, 57, and 59 stand rejected as being unpatentable under 35 U.S.C. § 102(e) as being anticipated by DeLorme.
2. Claim 39 stands rejected as being unpatentable under 35 U.S.C. § 103(a) over DeLorme in view of Hollenberg.
3. Claims 43 and 58 stand rejected as being unpatentable under 35 U.S.C. § 103(a) over DeLorme in view of Heiskari.

4. Claims 40, 41, 55 and 56 stand rejected as being unpatentable under 35 U.S.C. § 103(a) over DeLorme in view of Joao.
5. Claims 45 and 60 stand rejected as being unpatentable under 35 U.S.C. § 103(a) over DeLorme in view of McGregor.
6. Claims 46 and 61 stand rejected as being unpatentable under 35 U.S.C. § 103(a) over DeLorme in view of Rudrapatna.
7. Claims 47, 48, 62, and 63 stand rejected as being unpatentable under 35 U.S.C. § 103(a) over DeLorme in view of Kennedy.
8. Claims 49 and 64 stand rejected as being unpatentable under 35 U.S.C. § 103(a) over DeLorme in view of David.
9. Claims 50 and 65 stand rejected as being unpatentable under 35 U.S.C. § 103(a) over DeLorme in view of Uppaluru.
10. Claims 51 and 66 stand rejected as being unpatentable under 35 U.S.C. § 103(a) over DeLorme in view of Almeida.

Appellants submitted Appeal Briefs on August 17, 2006 and November 29, 2006. On January 29, 2007, the Examiner mailed a Notification of Non-Compliant Appeal Brief. Appellants submitted an Amended Appeal Brief on February 9, 2007 (hereinafter referred to as the "Brief" or "Br.").

GROUPING OF CLAIMS

Only those arguments actually made by Appellants have been considered in this decision. Arguments that Appellants could have made but chose not to make in the brief have not been considered. *See* 37 C.F.R. § 41.37(c)(1)(vii).

While the Final Rejection rejects the 30 claims on appeal over nine prior art references in 10 prior art rejections, Appellants' Amended Brief only argues the patentability of four groupings of claims as follows:

1. The patentability of claims 37 and 52 over DeLorme in the Argument section Ai on pages 8-11 of the Amended Brief;
2. The patentability of claim 54 over DeLorme in the Argument section Aii on pages 11 and 12 of the Amended Brief;
3. The patentability of claim 39 over DeLorme and Hollenberg in the Argument section B on pages 12 and 13 of the Amended Brief, and
4. The patentability of claims 43 and 58 over DeLorme and Heiskari in the Argument section C on page 14 of the Amended Brief.

Appellants do not argue dependent claims 38, 40-42, 44-51, 53, 55-57, and 59-66 separately nor explain why these claims are believed to be separately patentable. Rather, Appellants repeat the same arguments for claims 37 and 52. See, for example, Argument section Aiii on page 12 of the Amended Brief, and Arguments D to J on pages 15-26 of the Amended Brief. Therefore, for purposes of this appeal, dependent claims 38, 40-42, 44-51, 53, 55-57, and 59-66 stand or fall with the patentability of independent claims 37 and 52. *See* 37 C.F.R. § 41.37(c)(1)(vii).

The issues raised on appeal are:

1. Did the Examiner err in rejecting claims 37 and 52 as being unpatentable under 35 U.S.C. § 102(e) over DeLorme? This issue turns on whether DeLorme teaches the communication module recited in claims 37 and 52.
2. Did the Examiner err in rejecting claim 54 as being unpatentable under 35 U.S.C. § 103(a) over DeLorme? This issue turns on

whether DeLorme teaches the cellphone user voice or image being recognized from an image, audio or video signal, as required in claim 54.

3. Did the Examiner err in rejecting claim 39 as being unpatentable under 35 U.S.C. § 103(a) over DeLorme in view of Hollenberg. This issue turns on whether DeLorme or Hollenberg teach image or voice recognition capabilities required in claim 39, and whether the combination of DeLorme and Hollenberg is proper.
4. Did the Examiner err in rejecting claims 43 and 58 as being unpatentable under 35 U.S.C. § 103(a) over DeLorme and Heiskari? This issue turns on whether DeLorme and Heiskari teach a group of cellphones chatting privately in multi-case mode using an embedded watermark or digital certificate.

OPINON

Claims 37 and 52

"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. of California* , 814 F.2d 628, 631 (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. The properly interpreted claim must then be compared with the prior art.

On pages 4 and 5 of the Examiner's Answer, the Examiner set forth factual findings where DeLorme teach every element of claims 37, 38, 42,

44, 52-54, 57, and 59. Appellants do not traverse or challenge these factual findings of the Examiner, except for the following language in independent claims 37 and 52:

> the communication module comprising a user-customizable or reconfigurable software program, firmware, or circuit accessible locally in the cellphone or remotely via the network, the communication module being partitionable or uninstallabe as functional component (Amend. Br. 8)

During patent examination, the pending claims must be given their broadest reasonable interpretation "consistent with the specification." *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc). The following interpretation of the "communication module" in claims 37 and 52 on appeal takes into consideration the repeated use of alternative language in these claims. Specifically, the communication module includes one member from Groups I and II below:

Group I

(a) a user-customizable software program accessible locally in the cell phone,

(b) a user-customizable software program accessible remotely via the network,

(c) a reconfigurable software program accessible locally in the cell phone,

(d) a reconfigurable software program accessible via the network,

(e) a user-customizable firmware accessible locally in the cell phone,

(f) a user-customizable firmware accessible remotely via the network,

(g) a reconfigurable firmware accessible locally in the cell phone,

(h) a reconfigurable firmware accessible via the network,

(i) a user-customizable circuit accessible locally in the cell phone,

(j) a user-customizable circuit accessible remotely via the network,

(k) a reconfigurable circuit accessible locally in the cell phone, or

(l) a reconfigurable circuit accessible via the network, and

Group II

(a) a partitionable as functional component, or

(b) an uninstallable as functional component.

Accordingly, the communication module in claims 37 and 52 on appeal includes one of (a) to (l) for Group I and one of (a) and (b) for Group II. Furthermore, the present Specification defines that software (e.g., 66) encompasses an object and map database structure (e.g., 161), a database (e.g., 162), and other similar data structures (Spec. Figs 1, 3; p. 11-14).

We find that the Examiner has established a factual finding where DeLorme teaches the communication module in the claims on appeal, and we are not persuaded by Appellants' arguments that the Examiner erred. Appellants admit that DeLorme teaches a computerized system for travel information queries and provides the user with maps, travel directions and supplemental text, audio or graphics about specific locations or points of interest (Amend. Br. 9). Appellants further admit that DeLorme allows a user to carry out a travel planning session and creates an individualized travel plan in response to user input of 1) WHERE? (Places), 2) WHAT?/WHO? (Topics), 3) WHEN? (Times), and/or 4) HOW TO GO & HOW MUCH COST? (Accounts) at column 16, lines 60-65 (Amend. Br. 9). The Examiner concurs with these positions (Ans. 5). However, Appellants argue that DeLorme does not teach a "user-customizable or reconfigurable software program" as claimed on appeal.

As discussed above, the communication module in claims 37 and 52 on appeal includes any one of 12 items of (a) to (l) for Group I and

Appellants' Specification explains that software encompasses an object and map database structure or a database. Based thereon, we find no error in the Examiner's factual finding that DeLorme teaches a user-customizable or reconfigurable software program, as broadly defined as the communication module on appeal (Ans. 5). Namely, the individualized travel plan taught by DeLorme is a user-customizable or reconfigurable software program (e.g., object and map database structure or a database) that encompasses the communication module on appeal. Accordingly, DeLorme teaches Group I of the communication module.

Concerning the communication module of the previously-defined Group II, Appellants argue that DeLorme does not disclose, either expressly or inherently, the partitionable or uninstallable and updatable software components of modules (Amended Br. 9-11). The Examiner finds that DeLorme at column 7, line 22 to column 9, line 2 and column 10, lines 10-18 teaches, among other things, a replace function for updating the electronic maps and TRIPS (Travel Reservation and Information System) which corresponds to uninstalling software and updating software (e.g., database), as required for Group II of the communication module. Further, DeLorme teaches transferring all or a part (i.e., partitioning) of the output from a TRIPS travel planning session to another computer (col. 16, ll. 32-59). Accordingly, DeLorme teaches Group II of the communication module as claimed on appeal.

For these reasons, we affirm the Examiner's §102(e) rejection of claims 37, 38, 42, 44, 52-54, 57, and 59 as anticipated by DeLorme. For similar reasons and because "anticipation is the epitome of obviousness," *Connell v. Sears, Roebuck & Co*., 722 F.2d 1542, 1548 (Fed. Cir. 1983), we

affirm the Examiner's §103 rejections of claims 40, 41, 44-53, 55, 56, and 59-66 over DeLorme and any of Joao, McGregor, Rudrapatna, Kennedy, David, Uppaluru, and Almeida.

Claim 54

With respect to claim 54, Appellants argue that the claimed limitation "the cellphone user voice or image is recognized from the image, audio or video signal" is not found in the Examiner's rejection of claim 54 on appeal. Claim 54 also uses alternative language that broadens the claim to define alternative functions or structures, only one of which need be present in the prior art to anticipate the claim limitation. For example, the limitation in claim 54 is met by a cellphone having voice recognition. As noted by the Examiner on page 16 of the Answer, DeLorme discloses various portable devices can perform the functions of the wireless communication unit (WCU) (907 in Fig. 9), e.g. a notebook or laptop personal computer, a personal digital assistant or PDA, a "smart" cellular phone, two-way pager, an "accessorized" GPS sensor, as well as a dedicated or specially manufactured appliance, and so forth--provided that the device includes appropriate embedded and/or attached elements (col. 75, ll. 33-45). Further, the WCU, such as a cellphone, includes voice recognition (col. 77, ll. 50-59). Accordingly, DeLorme teaches the limitation of claim 54 on appeal.

For these reasons, we find no error in the Examiner's finding that DeLorme anticipates the limitations in claim 54 on appeal.

Claim 39

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 (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 (1966).

Appellants argue that the language of claim 39 requires image *and* voice recognition capabilities and apparently neither DeLorme nor Hollenberg teaches the combination of these capabilities. Appellants acknowledge that Hollenberg discloses a digital camera for recording image and video information, and DeLorme discloses voice recognition functions (Amend. Br. 12-13). We conclude that Appellants admit that either DeLorme or Hollenberg teaches the limitations of claim 39.

Appellants' claim interpretation is wrong. Appellants argue that claim 39 requires image *and* voice recognition capabilities. Appellants incorrectly use the conjunction "and" here. Claim 39 uses the conjunction "or" between some of the listed capabilities or functions of the camera. Accordingly, claim 39 is encompassed by a digital camera for recording image and video information as taught by Hollenberg or a device having voice recognition functions as taught by DeLorme.

We are not convinced by the Appellants' arguments that the combination of DeLorme and Hollenberg is improper. As explained by the Examiner, DeLorme and Hollenberg teach communications between a mobile unit and a remote location with video, audio, and text information, together with various substitutions, modifications, changes, and omissions thereto (DeLorme Fig. 9; Hollenberg Figs. 1, 4) (Ans. 19-20). These are

sufficient reasons for one of ordinary skill in the art to combine the suggested teachings of DeLorme and Hollenberg to make the claimed invention obvious. In *KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007), the Supreme Court emphasized the need to account for common sense when considering whether a combination of references would have been obvious: "[c]ommon sense teaches, however, that familiar items may have obvious uses beyond their primary purposes, and in many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like the pieces of a puzzle." *Id*. at 1742.

For the above reasons, either Hollenberg or DeLorme anticipate claim 39 on appeal or a combination of Hollenberg and DeLorme make this claim obvious. Accordingly, we affirm the Examiner's rejection of claim 39.

Claims 43 and 58

Claims 43 and 58 on appeal require a "group of cellphones chatting privately in multi-case mode using an embedded watermark or digital certificate." These claims were rejected over DeLorme and Heiskari. The Examiner acknowledges that DeLorme does not teach a group of cell-phones chatting privately in multi-cast mode using an embedded watermark or digital certificate, as required in claims 43 and 58 on appeal. The Examiner cites column 6 together with Figs. 5 and 6 of Heiskari as teaching a wireless communicator (radiophones, M1, M2) that communicates within a group of cell-phones chatting in multi-case mode (IDENTIFIER OF CALL GROUP) using an embedded watermark or digital certificate (name, number, or address), thereby securing such group communication electronically (Ans.

7). The Examiner notes that mobile communication systems often include especially private mobile radio systems used by the authorities (Ans. 7).

We cannot find a factually sufficient disclosure of using an embedded watermark or digital certificate within Heiskari. The terms watermark and digital certificate have established meanings in the art, which are not encompassed by the showings in Figs. 5 and 7 and the accompanying disclosure in Heiskari. For example, it is well known that an embedded watermark is an invisible watermarking, which is information added as digital data to audio, picture or video, but which cannot be perceived as such. An application of digital watermarking could be where two parties communicate a secret message embedded in a digital signal. On the other hand, digital certificates are specialized computer security methods that comprise public-key cryptography technology that are attestations by a certificate authority as to the pairing of identification and public key information. Such an embedded watermark or digital certificate is not found or described in Figs. 5 and 7 and the accompanying disclosure in Heiskari.

For these reasons, the Examiner has not established that a group of cellphones chatting privately in multi-case mode using an embedded watermark or digital certificate is known in the art. Accordingly, the skilled artisan could not have found it obvious to include a group of cellphones chatting privately in multi-case mode using an embedded watermark or digital certificate from Heiskari in the method and structure proposed by DeLorme, because Heiskari does not disclose or suggest this limitation.

In conclusion, the Examiner failed to establish a factual basis for the embedded watermark or digital certificate limitation on appeal,

which is necessary to support the legal conclusion of obviousness. *Fine* at 1073. Therefore, we reverse the rejection of claims 43 and 58 as being unpatentable under 35 U.S.C. § 103(a) over DeLorme in view of Heiskari.

CONCLUSION

1. The Examiner's decision rejecting claims 37, 38, 42, 44, 52-54, 57, and 59 as being unpatentable under 35 U.S.C. § 102(e) over DeLorme is affirmed.
2. The Examiner's decision rejecting claim 39 as being unpatentable under 35 U.S.C. § 103(a) over DeLorme in view of Hollenberg is affirmed.
3. The Examiner's decision rejecting claims 43 and 58 as being unpatentable under 35 U.S.C. 103(a) over DeLorme in view of Heiskari is reversed.
4. The Examiner's decision rejecting claims 40, 41, 55, and 56 as being unpatentable under 35 U.S.C. 103(a) over DeLorme in view of Joao is affirmed.
5. The Examiner's decision rejecting claims 45 and 60 as being unpatentable under 35 U.S.C. 103(a) over DeLorme in view of McGregor is affirmed.
6. The Examiner's decision rejecting claims 46 and 61 as being unpatentable under 35 U.S.C. 103(a) over DeLorme in view of Rudrapatna is affirmed.

7. The Examiner's decision rejecting claims 47, 48, 62, and 63 as being unpatentable under 35 U.S.C. 103(a) over DeLorme in view of Kennedy is affirmed.
8. The Examiner's decision rejecting claims 49 and 64 as being unpatentable under 35 U.S.C. 103(a) over DeLorme in view of David is affirmed.
9. The Examiner's decision rejecting claims 50 and 65 as being unpatentable under 35 U.S.C. 103(a) over DeLorme in view of Uppaluru is affirmed.
10. The Examiner's decision rejecting claims 51 and 66 as being unpatentable under 35 U.S.C. 103(a) over DeLorme in view of Almeida is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

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