UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte AKIHIKO TOYOSHIMA

Appeal 2008-6185
Application 09/972,760
Technology Center 2600

Decided: January 8, 2009

Before ROBERT E. NAPPI, JOHN A. JEFFERY,
and KARL D. EASTHOM, *Administrative Patent Judges*.

EASTHOM, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134 from the Examiner's Final Rejection of claims 1-5, 10, 11, 13, 15, 17-19, and 21. (App. Br. 2).[1] We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

Appellant discloses and claims a wireless phone that communicates in different formats. (Spec.: Abstract). A wireless module stores data, such as an electronic serial number and a mobile identification number, to a wireless phone, upon determination of proper operation. (Spec. 6: 4-20; Abstract; Fig. 3).

Claim 1, illustrative of the invention, follows:

A method for providing a multiple format wireless phone, said method comprising:

formatting at least one wireless module, the wireless module storing at least a first wireless communication, [sic] format;

removably engaging the wireless module with a wireless phone having a second wireless communication format different from the first format;

said wireless module having a mobile station identification number, the method further including storing said mobile station identification number to said wireless phone only upon determination that the wireless module provides proper operation in an intended area to facilitate communication using a common phone number with either format.

[1] The Appellant's Brief (filed, Jan. 28, 2008) ("App. Br.") and Reply Brief (filed May 13, 2008) ("Reply Br."), and the Examiner's Answer (mailed May 8, 2008) ("Ans."), detail the parties' positions.

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

Metroka	US 5,249,302	Sept. 28, 1993
Hanawa	US 5,450,471	Sept. 12, 1995

The Examiner rejected claims 1, 11, 17, and 18 under 35 U.S.C. § 102(b) based upon Hanawa.

The Examiner rejected claims 2-5, 10, 13, 15, 19, and 21 under 35 U.S.C. § 103(a) based upon the teachings of Hanawa and Metroka.

ISSUE

Appellant asserts that Hanawa does not anticipate claims 1, 11, 17, and 18. (App. Br. 4-7). Appellant focuses on the final clause of claim 1, and states, "[c]laim 1 requires storing the mobile station identification number to the wireless phone *only upon determination that the wireless module provides proper operation in an intended area*, to facilitate communication using a common telephone number with either format." (App. Br. 4). Appellant argues that Hanawa does not teach two wireless formats, because "multiple frequencies/control channels" do not constitute two formats. Appellants further argue that Hanawa does not teach both an analog channel and a digital channel in any one device, and even if Hanawa did, analog and digital channels constitute the same format. (*Compare* App. Br. 6 *with* App. Br. 7). Appellant also asserts Hanawa does not teach determining if the module operates properly, nor, only upon making that determination, storing a number as claimed. (Reply Br. 3). Finally, with respect to claim 11, Appellant also asserts that Hanawa does not teach using

a common telephone number with the two formats. (App. Br. 7). Claim 1 recites a similar limitation.

Thus, the primary issue with respect to the anticipatory rejection of claims 1, 11, 17, and 18 is:

Did Appellant demonstrate that the Examiner erred in finding that Hanawa's disclosure of using a common telephone number with either of two formats, and storing data to a wireless phone only upon a determination that the wireless module provides proper operation, anticipates claim 1?

Appellant also contends that the Examiner erred in combining Hanawa and Metroka to reject the group of dependent claims 2-5, 10, 13, 15, 19 and 21 (App. Br. 7-8). Appellant asserts that combining Metroka would "defeat a purpose of Hanawa." (App. Br. 8). Appellant bases the contention on the premise that Hanawa teaches only analog systems, while Metroka teaches digital systems. (App. Br. 7-8). Appellant also argues that "the conferees are making up possible reasons to combine the references without any evidence that these reasons are valid." (Reply Br. 4). Thus, the issue for the obviousness rejection of the group of dependent claims represented by claim 2, is:

Did Appellant demonstrate error in the Examiner's obviousness rationale for combining the references to meet dependent claim 2?

FINDINGS OF FACT (FF)

1. Appellant does not define "wireless communication format" or "format" either in their Specification or their arguments. Appellant discloses and/or claims the following wireless formats CDMA ONE, CDMA 2000 IX,

CDMA 2000 3X, CDMA IX EV, Wideband CDMA, GSM, GPRS and EDGE. (Spec. 6; Claims 2, 3, 13, and 21).

2. Hanawa discloses a portable telephone 8, 13 connected to an automobile telephone/communications unit 1, 11 via a buffer unit 7, 12 (Figs. 6, 7). Figure 7 depicts the portable telephone unit 13 removably mounted to a buffer unit 12 that is, in turn, removably mounted to an automobile telephone unit 11.

3. The Examiner interpreted, without challenge by Appellant, Hanawa's portable telephone unit 8, 13 and automobile telephone/communications unit 1, 11 respectively as the wireless module and phone of claim 1. The Examiner also interpreted the buffer portions 9, 10 (Fig. 6) as a portion of the wireless module transferring data to the phone. (*See* Ans. 3; Figs. 6-8).[2]

4. Hanawa discloses a need to solve prior art dual telephone shortcomings including, *inter alia*, the problem that portable telephones and automobile phones operate on different incompatible communications systems. (Col. 2, l. 64 - col. 3. l. 13). Hanawa states: "Moreover, the communication system may be different among the communication companies, that is, *one communications company may employ an analog system and another communications system may employ a digital system*." (Col. 3, ll. 9-13).

[2] Hanawa Figure 7 provides more detail than Figure 6, and uses different numbers to represent the same parts. Similarly, Figure 8 provides more detail than Figure 7.

5. Hanawa's system solves the prior art problem by employing a dual system that allows portable telephones to connect and operate on the automobile telephone systems. (Col. 7, ll. 8-11, col. 8, ll. 14-20). Hanawa states: "According to the mobile telephone unit of the present invention, it is possible to selectively communicate with either the first communication system or the second communication system in a state where the portable mobile telephone is coupled to the automobile telephone." (Col. 8, ll. 14-19). Hanawa concludes: "Of course, in the embodiments described above, the communication system to which the portable telephone can originally communicate and the communication system to which the automobile telephone can originally communicate may be mutually different or may be the same." (Col. 22, ll. 28-32). (*See also* Abstract – the controller "adjusts the communication conditions" so that the portable telephone can communicate through the buffer and communication unit).

6. Hanawa discloses one "operating principle"[3] as follows:

> The identifying means 9 of the buffer unit 7 identifies the communication conditions such as the radio frequency and the control channel for the connection, and also identifies the subscriber's number and the like. The communication conditions and the subscriber's number identified by the identifying means 9 are transmitted to the communication unit body 1 via the control signal transmitting means 10. The communication control part 4 of the communication unit body 1 *changes the communication conditions to those conforming to the communications conditions of the portable telephone 8, or converts the communication conditions*. Accordingly, it is

[3] This operating principle, described with reference to Figure 6 using different numbers, applies to the Figures 7 and 8 embodiments. (*See* n.2, *supra*; and col. 9, ll. 4-6, col. 10, ll. 29-39).

> possible to use the portable telephone 8 as an automobile telephone.

(Col. 9, ll. 48-64) (emphasis added).

7. Hanawa's Figure 7 embodiment includes a FAX machine 29 and a personal computer 30 connected directly to the automobile telephone 11 and indirectly to the portable telephone 13. The FAX and personal computer communicate digitally.

8. The portable telephone unit can communicate on either its communication system or that of the automobile system, in either case, using only the telephone number of the portable telephone unit. Push-button dials allow the user to select which telephone number to employ for either system. (Hanawa, col. 12, ll. 9-45).

9. In another embodiment similar to that of Figure 7, FAX machines or the computer communicate data using the same telephone number of the portable telephones. (Hanawa, col. 13, ll. 15-22; col. 14, ll. 13-17; Fig. 10).

10. Mounting the portable telephone, buffer, and automobile telephone units together causes the buffer to detect the portable telephone unit which then automatically transfers its subscriber telephone number to the buffer. The buffer then uses that number to recognize the subscriber communications company and radio frequency band of the portable telephone unit, and then transfers all three data items to the automobile telephone unit. (Hanawa, col. 11, l. 55 to col. 12, l. 8; *see also* col. 8, ll. 48-50). If any of the three units do not operate properly, i.e., are broken, data cannot be transferred to the automobile telephone unit.

11. Metroka similarly discloses a dual telephone cellular/automobile system (col. 6, ll. 23-31). Cellular telephones offer the advantage of

increased capacity based on digital modulation, while automobile telephones provide increased power (col. 4, ll. 1-4; col. 5, ll. 4-14). Coupling the telephones together offers the advantages of each at reduced cost (col. 6, ll. 13-17). To this end, Metroka discloses cellular CDMA, TDMA and GSM digital formats, coupled with automobile radio telephone analog formats, to increase power and capacity, and for mutual communication among the different formats (col. 11, l. 58 to col. 12, l. 60).

PRINCIPLES OF LAW

"On appeal to the Board, an applicant can overcome a rejection by showing insufficient evidence of *prima facie* obviousness . . . ." *In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) (*quoting In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998).

Anticipation is established when a single prior art reference discloses expressly or under the principles of inherency each and every limitation of the claimed invention. *Atlas Powder Co. v. IRECO, Inc*., 190 F.3d 1342, 1347 (Fed. Cir. 1999); *In re Paulsen*, 30 F.3d 1475, 1478-79 (Fed. Cir. 1994).

"[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *Kahn*, 441 F.3d at 988.

During examination of a patent application, a claim is given its broadest reasonable construction consistent with the specification. *In re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969). "[T]he words of a claim 'are

generally given their ordinary and customary meaning." *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (en banc) (internal citations omitted).

"The problem in this case is that the appellants failed to make their intended meaning explicitly clear." *In re Morris*, 127 F.3d 1048, 1056 (Fed. Cir. 1997). "It is the applicant's burden to precisely define their invention, not the PTO's." *Id*.

ANALYSIS

Appellant asserts that "another unsupported decree . . .has no roots in any evidence of record, namely, an insistence that the claimed 'changing formats' is the same thing as changing between analog and digital." (App. Br. 7). Under *Morris*, such an assertion, like Appellant's related assertions outlined *supra* regarding "format" as recited in claim 1, improperly places the burden on the Examiner. Appellant fails to define what constitutes a format. (FF 1).

While Appellant discloses examples of different formats in the Specification (FF 1), no clear meaning arises therefrom. Appellant's examples do not appear to constitute, necessarily, changes in modulation techniques, but some modulation changes may arise. Changes in control and/or the number and types of orthogonal codes also appear reasonable. (*See* FF 1).

Without any argument or supporting definition to carry the burden, no clear line of demarcation emerges between a broad format change (i.e., "format different from the first format") recited in claim 1 and the narrow format examples recited in some of the dependent claims (*see id*.). "Such

evasiveness we cannot condone, particularly when the public must rely on the written record to define the resulting property right." *Morris*, 127 F.3d at 1056. Moreover, claim differentiation principles alone suggest that Appellant envisioned the "format" of claim 1 not to be limited to the formats recited in claim 2. *See, e.g., Free Motion Fitness, Inc. v. Cybex Int'l, Inc.*, 423 F.3d 1343, 1351 (Fed. Cir. 2005) ("The doctrine of claim differentiation 'creates a presumption that each claim in a patent has a different scope' …The difference in meaning and scope between claims is presumed 'to be significant to the extent that the absence of such difference in meaning and scope would make a claim superfluous.'" (citations omitted).

Consequently, as the Examiner generally asserted (Ans. 3-4, 6), Hanawa's analog and digital modulation schemes constitute two formats, thereby meeting the format elements of claim 1. Similarly, Hanawa's changing of frequency channels/bands and control thereof also constitutes changing to two formats, also thereby meeting the format elements of claim 1. (Ans. 6, FF 4-6).

Appellant's assertion, noted *supra*, that no single device specifically discloses both analog and digital formats does not refute the proposition that Hanawa generally teaches such formats for each embodiment. For example, Hanawa teaches digital FAX and computer machines that communicate through telephone channels (that Appellant asserts are analog). (FF 7, 9, App. Br. 6-7). Such a specific teaching for one embodiment, the general teachings of overcoming prior art problems of communicating in different telephone systems, and the specific teaching that such differences include analog and digital systems, would have led a skilled artisan to conclude that Hanawa's Figures 7 and 8 embodiment also contemplates a digital portable

telephone format (i.e., wireless module) with an analog automobile telephone format (i.e. "wireless phone"). (FF 4-7, 9).

Hanawa also teaches using each different format with a common telephone number selected by the push-button dials on either telephone. (FF 8, *see also* FF 9). Appellant's response with respect to claim 11, pointing to other possible accounting choices based on telephone numbers (Reply Br. 3; App. Br. 5, 7), does not refute the clear teaching.

Hanawa also teaches storing at least three types of data (identifying the subscriber and/or company) from the portable telephone and buffer unit (i.e., both together constitute the "wireless module"), to the automobile telephone (i.e., the "wireless phone"). (FF 10). While the data does not specifically include the "mobile station identification number" recited in claim 1, the claimed data type number constitutes nonfunctional descriptive material because it does not alter how the system functions. Non-functional descriptive material cannot render patentable an otherwise unpatentable product or process. *In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004).[4] Therefore, Hanawa's transfer and necessary storage of any one of the three data types, only upon determination of proper operation (FF 10), meets claim 1.

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[4] *See also Ex parte Curry*, 84 USPQ2d 1272, 1275 (BPAI 2005) (Informative Opinion) (Affirmed, Rule 36, Fed. Cir., slip op. 06-1003, June 2006) ("Common situations involving non-functional descriptive material [include] . . . .a computer that differs from the prior art solely with respect to nonfunctional descriptive material that cannot alter how the machine functions (i.e., the descriptive material does not reconfigure the computer) . . . .").

That is, the transfer and storing of the data occurs only upon connecting the portable telephone, buffer and automobile telephone modules together. (FF 10). Such a data transfer, occurring only upon the connection, proves "storing . . . only upon . . . determination . . . [of] proper operation in an intended area," as claim 1 requires, because no such transfer and storage would otherwise occur in any area.[5] In other words, a malfunctioning telephone in any area, or one operating in an extreme environment (i.e., in the desert, under water, or in moist, hot, or cold, etc. conditions), could not transfer any data upon connection. (*See id*.). Thus, Appellant did not demonstrate that the Examiner erred in finding that Hanawa anticipates claims 1, 11, 17, and 18.

With respect to the Examiner's rejection under 35 U.S.C. § 103(a), as found *supra*, Hanawa teaches digital communications. Therefore, Appellant's argument noted *supra* challenging the Examiner's rejection of the dependent claims, premised on an alleged lack of such a digital format teaching in Hanawa, must fail. As the Examiner generally found, Metroka teaches cost and bandwidth benefits of including digital communication formats with analog telephones, and Metroka's dual system is similar to Hanawa's dual system. (Ans. 7, *compare* FF 4-6 *with* FF 11). Under *Kahn*, *supra*, Appellant fails to demonstrate error in the Examiner's well reasoned rationale.

[5] Claim 11, argued together with claim 1 as to this issue, does not require "storing" the number, but rather, requires only "providing" the number.

SUMMARY

Appellant did not demonstrate that the Examiner erred in finding that Hanawa's disclosure of using a common telephone number with either of two formats, and storing data to a wireless phone only upon a determination that the wireless module provides proper operation, anticipates claims 1 and 11. Accordingly, we sustain the Examiner's anticipatory rejection of claims 1 and 11, and claims 17 and 18, not separately argued. Appellant also did not demonstrate error in the Examiner's rationale for combining the references to meet dependent claim 2. Thus, we also sustain the Examiner's obviousness rejection of dependent claim 2, and dependent claims 3-5, 10, 13, 15, 19 and 21, not separately argued.

DECISION

We affirm the Examiner's decision rejecting claims 1-5, 10, 11, 13, 15, 17-19 and 21.

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).

<u>AFFIRMED</u>

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ROGITZ & ASSOCIATES
750 B STREET
SUITE 3120
SAN DIEGO, CA 92101