

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KATSUMI TAKAHASHI

Appeal No. 96-1489
Application 08/139,876¹

ON BRIEF

Before THOMAS, KRASS, and CARMICHAEL, Administrative Patent
Judges.

THOMAS, Administrative Patent Judge.

DECISION ON APPEAL

Appellant has appealed to the Board from the examiner's
final rejection of claims 1-6, which constitute all the claims

¹ Application for patent filed October 22, 1993. According to
appellant, this application is a continuation of Application 07/790,177,
filed November 12, 1991.

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in the application.

Representative claim 1 is reproduced below:

1. A dual mode mobile telephone apparatus for transmitting and receiving signals between a base station and a mobile station using a radio line comprising:

a transmitting/receiving portion for transmitting and receiving signals of different kinds of call modes, said different kinds of call modes comprising a digital call mode and an analog call mode;

an operation portion for assigning an available call mode for the mobile station selected by the user from among said different kinds of call modes;

a call mode detection portion for detecting the call mode selected from among said different call modes;

a call mode store portion for storing the call mode which is detected by the call mode detection portion; and

a response signal generating portion for receiving a calling signal from the base station and generating a response signal which is sent back to the base station in response to the calling signal from the base station, said response signal including the call mode detected by said call mode detection portion.

The following references are relied on by the examiner:

Dahlin et al. (Dahlin) 1992	5,119,397	June 2, (Filed 4/26/90)
Gillig et al. (Gillig) 1992	5,127,042	June 30, (Effective filing date 9/23/88)

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Claims 1-6 is rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner relies upon Dahlin in view of Gillig.²

Rather than repeat the positions of the appellant and the examiner, reference is made to the Briefs³ and the Answer for the respective details thereof.

OPINION

We will not sustain the rejection of claims 1-6 under 35 U.S.C. § 103.

After a careful study of the positions of the appellant and the examiner, as well as conducting a careful study of the two references relied upon by the examiner in the rejection of the claims on appeal, we conclude that we must reverse the rejection. The examiner's motivation rationale at pages 4 and

² A new ground of rejection in the Answer was later withdrawn as indicated by the examiner in separate communications mailed on May 16, 1995 and July 25, 1995.

³ We have not considered the Reply Brief filed on April 27, 1995 because the communication from the examiner on May 16, 1995, indicated the examiner had not entered it. However, we have considered the Reply Brief filed on May 30, 1995, since the examiner has noted its entry in the communication from the examiner on July 25, 1995.

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5 of the Answer and the additional rationale in the responsive arguments portion at page 9 of the Answer appear to us to be conclusory

and presumptive. We do not understand from the examiner's position why the artisan would have found it obvious to have used the capability of Gillig for the user to select between a cordless and cellular telephone mode and to translate this capability into an analog or digital selectability by the user in the analog/digital phone in Dahlin. The examiner simply has not developed any persuasive rationale for achieving this modification in Dahlin from Gillig's teachings other than simply concluding that the user would therefor have the ability to manually select analog or digital modes.

Additionally, to the extent the examiner's position that it would have been obvious to the artisan to make prior art devices nonautomatic or manually operable when the prior art teaches an automatic means to do so, or would have been obvious to the artisan because it involves only routine skill in the art, is also presumptuous and conclusory. Obviousness within 35 U.S.C.

§ 103 requires some degree of rationale to support such a

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conclusion, not merely per se rules, which rationale the examiner has not persuasively argued to us.

The prior art relied upon by itself does not suggest the desirability of the proposed modification. In re Fritch, 972 F.2d 1260, 1266, 23 F.2d 1780, 1783-84 (Fed. Cir. 1992). In order for us to sustain the examiner's rejection under 35 U.S.C. § 103, we would need to resort to speculation or unfounded assumptions or rationales to supply deficiencies in the factual basis of the rejection before us. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968), rehearing denied, 390 U.S. 1000 (1968).

In view of the foregoing, the decision of the examiner rejecting claims 1-6 under 35 U.S.C. § 103 is reversed.

REVERSED

JAMES D. THOMAS)
Administrative Patent Judge)
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PATENT	ERROL A. KRASS) BOARD OF
	Administrative Patent Judge) APPEALS AND
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