

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 38

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte YOICHI YAMAKI

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Appeal No. 1997-0636  
Application No. 08/312,959

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HEARD: May 4, 2000

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Before JERRY SMITH, RUGGIERO, and LALL, Administrative Patent Judges.

RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1 through 5. Claims 6 and 7 have been canceled. The amendment after final rejection filed May 28, 1996 was denied entry by the Examiner.

The claimed invention relates to a selective call receiver which includes a memory for storing test mode setting data, the receiver being changed from an ordinary reception state to a test mode state when such setting data is present. More particularly, Appellant indicates at pages 4 through 6 of the specification that a battery saving operation is suspended when test mode data is present and enabled when test mode data is determined not to be present.

Claim 1 is illustrative of the invention and reads as follows:

1. A selective call receiver comprising:

a receiving unit for receiving a selective calling number allocated thereto;

means for selectively enabling a battery saving operation of said selective call receiver;

a memory for storing therein test mode setting data for setting the receiving unit in a test mode;

a control switch for controlling data writing to said memory and initiating of said test mode; and

control means for analyzing data read out from said memory through operation of said control switch and for suspending said battery saving operation to set said selective call receiver in the test mode when said control means determines said test mode data to be present.

The Examiner relies on the following prior art:

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Mori	(Great Britain)	2,105,077	Mar. 16, 1983
Akahori et al.	(Akahori)	2,124,001	Feb. 08, 1984
	(Great Britain)		
Yamada et al.	(Yamada)	2,145,259	Mar. 20, 1985
	(Great Britain)		

Claims 1 and 3 through 5 stand finally rejected under 35 U.S.C. § 103 as being unpatentable over Akahori in view of Yamada. Claim 2 stands finally rejected under 35 U.S.C. § 103 as being unpatentable over Akahori in view of Yamada and further in view of Mori.

Rather than reiterate the arguments of Appellant and the Examiner, reference is made to the Briefs<sup>1</sup> and Answer for the respective details.

#### OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the Examiner and the evidence of obviousness relied upon by the Examiner as support

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<sup>1</sup> The Appeal Brief was filed May 28, 1996. In response to the Examiner's Answer dated August 30, 1996, a Reply Brief was filed October 21, 1996 which was acknowledged and entered by the Examiner without further comment on November 19, 1996.

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for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellant's arguments set forth in the Briefs along with the Examiner's rationale in support of the rejection and arguments in rebuttal set forth in the Examiner's Answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 1-4. We reach the opposite conclusion with respect to claim 5. Accordingly, we affirm-in-part.

As a general proposition in an appeal involving a rejection under 35 U.S.C. § 103, an Examiner is under a burden to make out a prima facie case of obviousness. If that burden is met, the burden of going forward then shifts to Appellant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745

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F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

With respect to independent claim 1, the Examiner, as the basis for the obviousness rejection, proposes to modify the selective call receiver disclosure of Akahori which includes a plurality of test modes. In the Examiner's view (Answer, page 5), Akahori discloses all of the limitations of claim 1 except that Akahori relies on an external signal to initiate testing rather than a user-controlled test switch. To address this deficiency, the Examiner turns to Yamada which is also directed to a selective call receiver but which initiates testing by operation of a reset switch 11 illustrated in Yamada's Figure 2. The Examiner's line of reasoning at pages 5 and 6 of the Answer is expressed as follows:

It would have been obvious at the time of the invention to an artisan that the reset switch (11) to [sic, of] Akahori which is used to set test modes 2-4 would be modified such that it would also initiate test mode 1 thus making the selective call receiver more user friendly by allowing the user to initiate a test mode as evidenced by Yamada.

In response, Appellant, aside from a broad general assertion at page 9 of the Brief, does not attack the

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combinability of Akahori and Yamada. Rather, Appellant's main point of contention (Brief, page 5) is that neither of the applied Akahori and Yamada references discloses a key feature of independent claim 1, i.e. a control switch which performs both control of data writing to a test mode data setting memory and initiating of the test mode.

After careful review of the Akahori and Yamada references we are in agreement with Appellant's stated position in the Briefs. In addition to Akahori's failure to disclose initiation of the test mode of operation by reset switch 11 as recognized by the Examiner, we also find no disclosure in Akahori of the control of data writing to a test data memory by the reset control switch. We do note that page 2, lines 35-37 of Akahori, referenced by the Examiner (Answer, page 5), describes the writing and storing of test mode instructions in program memory 301; however, there is no disclosure that this data writing operation is controlled by reset switch 11.

Similarly, while the Examiner is correct in his assertion that Yamada initiates testing operation by operation of reset switch 11, Yamada also lacks any disclosure of the control of data writing into a test data memory by such reset switch. As

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with Akahori, Yamada describes the storing of test instructions in a program memory 301 (Yamada, page 2, lines 15-17), but is silent as to any control of such operation by reset control switch 11.

In view of the above discussion, it is our opinion that, since all of the limitations of independent claim 1 are not taught or suggested by the applied prior art, the Examiner has not established a prima facie case of obviousness.

Accordingly, we do not sustain the 35 U.S.C. § 103 rejection of independent claim 1, nor of claims 3 and 4 dependent thereon.

With respect to dependent claim 2, it is apparent from the Examiner's analysis at page 6 of the Answer that Mori was added to the combination of Akahori and Yamada for the sole purpose of addressing the logical "OR" circuitry limitation. The Mori reference is directed to a battery saving feature in a radio paging receiver; however, we can find no teaching or suggestion of a control switch which performs both data writing control and test mode initiating. As such, Mori has no disclosure which would overcome the innate deficiencies of

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Akahori and Yamada and, therefore, we do not sustain the obviousness rejection of dependent claim 2.

Turning to a consideration of the obviousness rejection of independent claim 5 based on the combination of Akahori and Yamada, we note that, while we found Appellant's arguments to be persuasive with respect to the rejection of claims 1-4 discussed supra, we reach the opposite conclusion with respect to claim 5. Independent claim 5 is directed to the selective enabling of continuous or intermittent operation of a receiver dependent on the analysis of stored data from a memory. Initially, after reviewing the language of claim 5 in light of the applied prior art, we find Akahori's teaching of a selective mode receiver to be cumulative to that of Yamada. Further, it is our view that the Figure 2 illustration and accompanying description in Yamada discloses all of the elements of claim 5. In particular, the disclosure at page 1, lines 33-35 and the Figure 3 flow chart in Yamada describe the intermittent and continuous operation modes of a receiver as a result of the analysis of data from a memory. A disclosure that anticipates under 35 U.S.C. § 102 also renders the claim unpatentable under 35 U.S.C. § 103, for "anticipation is the

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epitome of obviousness." Jones v. Hardy, 727 F.2d 1524, 1529, 220 USPQ 1021, 1025 (Fed. Cir. 1984). See also In re Fracalossi, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982); In re Pearson, 494 F.2d 1399, 1402, 181 USPQ 641, 644 (CCPA 1974). Thus, we sustain the Examiner's rejection of appealed claim 5 under 35 U.S.C. § 103.<sup>2</sup>

In summary, we have sustained the 35 U.S.C. § 103 rejection of claim 5, but have not sustained the 35 U.S.C. § 103 rejection of claims 1-4. Accordingly, the Examiner's decision rejecting claims 1-5 is affirmed-in-part.

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

AFFIRMED-IN-PART

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<sup>2</sup> The Board may rely on one reference alone in an obviousness rationale without designating it as a new ground of rejection. In re Bush, 296 F.2d 491, 496, 131 USPQ 263, 266-67 (CCPA 1961); In re Boyer, 363 F.2d 455, 458, n.2, 150 USPQ 441, 444, n.2 (CCPA 1966).

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JERRY SMITH	)	
Administrative Patent Judge	)	
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	)	BOARD OF PATENT
JOSEPH F. RUGGIERO	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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DECISION: AFFIRMED-IN-PART  
Send Reference(s): Yes No  
or Translation (s)  
Panel Change: Yes No  
Index Sheet-2901 Rejection(s):

Prepared: January 24, 2001

Draft                  Final

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PALM / ACTS 2 / BOOK  
DISK (FOIA) / REPORT