

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(2) is not binding precedent of the Board.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. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THERESA S. PERRY
and PAMELA A. DILLARD

Appeal No. 1998-1259
Application 08/264,817

ON BRIEF

Before THOMAS, BARRETT and LEVY, Administrative Patent Judges.
LEVY, Administrative Patent Judge.

DECISION ON APPEAL

Appellants have appealed to the Board from the examiner's final rejection of claims 1 to 31, which constitute all the claims in the application. Subsequent to the January 23, 1997 final rejection of the claims, Appellants filed an amendment

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to claims 22 and 31 on July 23, 1997, concurrent with the filing of the notice of appeal and brief. Appellants state (brief, page 2) that the appendix of claims, as submitted, does not include the claims as amended. An advisory action issued on October 21, 1997 indicates that the amendment has been entered. The examiner (answer, page 2) notes the minor changes to claims 22 and 31 resulting from the July 23, 1997 amendment.

Representative claim 1 is reproduced below:

1. A wireless communication device comprising:

a receiver for receiving a desired communication signal;

a tactile alert generator for generating a tactile alert pattern when enabled; and

a controller, operably coupled to the receiver and the tactile alert generator, for enabling the tactile alert generator to generate a particular tactile alert pattern as one of a plurality of distinctive tactile alert patterns when a particular desired communication signal is received, wherein different particular tactile alert patterns are generated when different corresponding particular desired communication signals are received.

The following references are relied upon by the examiner:

MacDonald et al. (MacDonald)	5,293,161	Mar.
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8, 1994		
Connary et al. (Connary)	5,307,059	Apr.
26, 1994		

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Claims 1-31 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner relies upon MacDonald in view of Connary.¹

Rather than repeat the positions of the appellants and the examiner, reference is made to the brief and the answer for the respective details thereof.

OPINION

It is our view, with respect to the rejection of claims 1-8 and 11-31, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill

¹ Under the heading of "Grouping of Claims" (brief, page 4) appellants state that: "Under the restriction requirement, claims 1-31 stand or fall together." Review of the application file does not reflect any restriction requirement of record. Nor is there any indication in the record that this application is a divisional application. Nor is there a restriction requirement in S.N. 07/823,738 referred to on page 8 of the specification and incorporated therein by reference. The examiner makes no comment regarding appellants' statement referring to a restriction requirement. Moreover, while appellants state that claims 1-31 stand or fall together, in the brief, appellants separately argue claims 1, 6, 9, 10, 11 and 12.

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in the art the

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obviousness of the invention set forth. Accordingly, we affirm the stated rejection of claims 1-8 and 11-31 under 35 U.S.C. § 103.

It is our view, with respect to claims 9-10, 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. Accordingly, we reverse the rejection of claims 9-10 under 35 U.S.C. § 103.

The disclosed invention generally pertains to wireless communication devices having alert generators. Specifically, a wireless communications device is disclosed which generates a particular tactile alert pattern as one of a plurality of distinctive tactile alert patterns when a particular communications signal is received.

With respect to claims 1-5, 7, 8 and 13-31, only claim 1

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has been argued by appellants. Accordingly, the remaining claims will stand or fall with claim 1. Appellants assert that the prior art references to MacDonald and Connary, alone or in combination, do not teach or suggest that "'different particular tactile alert patterns are generated when different corresponding particular desired communication signals are received'" (brief, page 4). MacDonald discloses a selective call receiver having a variable frequency vibrator including a tactile alert generator 116, an audio alert 114 and a display 110 (figure 2). MacDonald recognizes the need for a tactile alert generator to have variable frequencies of vibration, disclosing that "in conventional selective call receivers, the frequency of the vibrator device is usually fixed at some predetermined frequency This causes some users, however, to consider the vibratory mode to be either too high or too low Accordingly, a need exists for a tactile alert having a variable frequency of vibration" (col. 1, lines 20-35). In addition to a tactile alert, the frequency of the tactile alert is modified by the frequency selector 120. However, once modified, the "preset frequency is held constant

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by a microcomputer or the like over an active range of the power supply" (col. 2, lines 62-64), and is modified when the battery power decreases to a point that there is insufficient current to maintain the present frequency of vibration at which time the microcomputer will select the next suitable frequency. (See col. 2, lines 21-23 and lines 65-68).

Both appellants and the examiner are in agreement that MacDonald does not disclose generation of different tactile alert patterns when different corresponding particular desired communications signals are received (answer, page 3 and brief, page 4). To remedy this deficiency in MacDonald, the examiner relies upon Connary, who discloses a selective call receiver 10 having one or more customized alert signals. The customized alert signals are created by entering into memory 14 one or more audio sounds such as a voice or tone combination (See col. 2, lines 33-38). When a signal 21 is received having a predetermined address, the customized alert signal for the predetermined address is retrieved from memory (See col. 2, lines 47-50). In contrast to the teachings of

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MacDonald, where the same alert is provided in response to each incoming communication signal (after being selected from one of a number of pre-determined alerts) Connary discloses providing a different customized audible alert for each address of a selective call

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receiver 10 having two or more addresses (col. 3, lines 1-4 and col. 1, lines 49-57).

We are not persuaded by appellants' line of reasoning (brief, page 5) that in Connary "one or more audio sounds, such as a voice or tone combination, which comprise a customized alert signal, ... does not teach or suggest 'different particular tactile alert patterns,' as claimed." As Connary is directed to providing a different customized audible alert for each address of a selective call receiver having two or more addresses, we are of the opinion that in view of the commonality of the different alerts in the prior art, that it would have been well within the level of skill of a routineer in the art to have customized the selective call receiver of MacDonald to provide different tactile alerts when different corresponding desired communications signals are received. While we do not favor the examiner's language that Connary's voice alert teachings are "functionally equivalent"

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as a basis for obviousness², looking at what the teachings of the references considered together fairly suggest, it would have been an obvious enhancement of the selectable frequency tactile alert of MacDonald to provide the tactile alert generator with different tactile alerts for particular desired communications signals received, as taught by Connary.

Additionally, with respect to appellants' statement (brief, page 6) that in Connary "the *same* customized alert signal is generated for *all signals* having the predetermined address identifying the particular selective call receiver 10 are received" we note that appellants' statement is correct, if the selective call received of Connary has a single predetermined address. However, we note that Connary additionally states that "In summary, a user of the selective call receiver 10 may create specialized custom alerts for the selective call receiver 10 or for each address of a selective

² We note that nonobvious structures may well be functionally equivalent; see In re Ruff, 256 F.2d 590, 587-98, 118 USPQ 340, 347 (CCPA 1958).

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call receiver 10 having two or more addresses." We are in agreement with the examiner that in Connary, personalized alert signals are stored and presented when an appropriate address code is detected in the received signal (see col. 1, lines 49-58 of Connary). Accordingly, the rejection of claims 1-5,7,8 and 13-31 under 35 U.S.C. § 103 is affirmed.

Turning now to claims 6, 11 and 12, all of which depend from claim 1, claim 6 requires that the desired communications signal is an incoming telephone call. Claim 11 sets forth that the wireless communications device is a radiotelephone. Claim 12 calls for the wireless communications device to be a pager. The issue regarding these claims centers around the types of different wireless communications device that are taught or suggested by MacDonald and Connary. At the outset, we note that MacDonald discloses the selective call receiver to be a pager (col. 1, lines 55-56) as required by claim 12. In addition, col. 1, lines 15-16 of MacDonald discloses that "Electronic devices such as selective call receivers have different methods of alerting a user that a message has been

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received." Similar language is found in col. 1, lines 14-15 of Connary which discloses "Selective call radio receivers such as pagers...." The language "such as" makes clear that the inventions of MacDonald and Connary can be extended to other wireless communication devices such as a radiotelephone, and we consider it to have been well within the ordinary skill of a skilled artisan to have utilized the wireless communication devices of MacDonald and Connary in a radiotelephone environment.

As noted by the examiner (answer, page 5) in the Background of the Invention, set forth on page 5, lines 24 and 25 of the specification, wireless communication devices are known to include radiotelephones and pagers. We are unpersuaded by appellants' assertion with respect to claim 11 that the examiner is improperly using appellants' own teaching to reject appellants' own claims. The Background of the Invention set forth in the specification discloses what is presumed to be known in the prior art. Appellants have not specifically refuted the examiner's factual finding that

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appellants' specification discloses it to be known in the prior art that wireless communication devices include both radiotelephones and pagers. We note that both references relied upon by the examiner as well as the specification use similar language in referring to battery operated communication devices that operate in the radio frequency (RF) range and that all three of these documents have the same assignee.

In response to the examiner's taking "Official Notice that an incoming signal to a selective call receiver by means of a telephone call is known in the art" (answer, page 4) appellants assert that the term "is" in claim 6 has been misconstrued by the examiner as "by means of." Appellants maintain that in MacDonald and Connary, the selective call receiver is not capable of receiving an incoming telephone call because the selective call receiver is not capable of telephone transmit functions (See brief, page 6). We also find this argument unpersuasive for the same reason stated above that we are of the opinion that the inventions of

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MacDonald and Connary can be extended to other wireless communication devices such as a radiotelephone, and that it would have been well within the ordinary skill of an artisan to have utilized the wireless communication devices of MacDonald and Connary in a radiotelephone environment. Accordingly, the rejection of claims 6, 11, and 12 under 35 U.S.C. § 103 is affirmed.

Turning now to the rejection of claims 9 and 10, claim 9, which depends from claim 1, additionally requires that the controller enable an audible alert generator, to generate an audible alert pattern as one of a plurality of distinct audible alert patterns when a desired communication signal is received, wherein the one of the plurality of distinctive audible alert patterns and the one of the plurality of distinctive tactile alert patterns have substantially the same distinctive alert patterns. Claim 10, which also depends from claim 1, differs from claim 9 to the extent that a visual alert is substituted for an audible alert. In MacDonald, controller 112 controls the operation of the visual display

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110, the audio alert 116 and the tactile alert 116. However, the frequency is set by frequency selector 120, and in a second embodiment disclosed in figure 2, the frequency is set by a tunable resistor 130. Col. 2, lines 56-59 of MacDonald disclose that "After measuring the vibration of the tactile alert 116, information relating to the selected frequency may be displayed on the display 110 of the selective call receiver 100." In addition, col. 2, line 68 through col. 3, lines 1 and 2 of MacDonald set forth that "Additionally, the selective call receiver 100 may display the selected frequency of vibration setting on the display 110." While information related to the frequency itself is displayed, this is not the same as having the distinctive alert patterns themselves be substantially the same. The reference is silent as to whether the tactile alert, and the audio alert or display have substantially the same distinctive alert pattern. Because the frequency of the tactile alert generator is set by a frequency selector or tunable resistor, it does not appear to us that the distinctive alert patterns are substantially the same as required by claims 9 and 10.

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Connary's selective call receiver relates to an audible alert and adds nothing with respect to this claim limitation.

The examiner's position is that generation of alert patterns wherein tactile and audible alert patterns are substantially the same as claimed is "considered to be within the skill of the artisan" (answer, page 5) with the rationale that the skill of the artisan is the capability to generate audible, visual and tactile alert patterns which in and of themselves are substantially the same as they all convey alerting information (answer, page 7). While we are in agreement with the examiner that the prior art suggests audible, visual and tactile alert patterns that provide alerting information, review of claims 9 and 10 reveals that the claims require more. Claims 9 and 10 each require that the distinctive alerts are generated to have substantially the same patterns. The mere fact that there are plural alerts does not meet the claim requirement that the pattern of the alerts are substantially the same. In the absence of any persuasive reasoning advanced by the examiner in the answer, it is our judgment that it would not have been obvious to the

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artisan to have one of the plurality of distinctive audible (or visual as per claim 10) alert patterns and one of the distinctive tactile alert patterns have substantially the same distinctive alert pattern as recited in claims 9 and 10 on the basis of the evidence provided.

We are in agreement with appellants that there is no teaching or suggestion in MacDonald or Connary, alone or in combination, of having the patterns of the audible, visual and tactile alerts correspond³ when the particular desired communication signal is received. Accordingly, we reverse the rejection of claims 9 and 10 under 35 U.S.C. § 103.

³ We construe appellants' use of the term "correspond" in the brief to mean "substantially the same" as set forth on the claims.

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SUMMARY

The rejection of claims 1-8, and 11-31 under 35 U.S.C. § 103 is affirmed. The rejection of claims 9 and 10 under 35 U.S.C. § 103 is reversed.

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-IN-PART

JAMES D. THOMAS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
LEE E. BARRETT)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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