

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 36

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ERIC DESBLANCS and BRIGITTE COZ

Appeal No. 1999-0877
Application No. 08/204,441

HEARD: July 10, 2001

Before KRASS, LALL, and BLANKENSHIP, Administrative Patent Judges.

LALL, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the Examiner's final rejection¹ of claims 1 to 3, and 5 to 10. Claim 4 has been canceled.

¹ The two rejections in the final rejection on two separate combinations of the references were replaced in the Examiner's answer by a single rejection based on a combination of the references used in the final rejection. Appellants have had an opportunity to respond, and have responded, to this rejection. Therefore, for the purpose of this appeal the rejection based on the combination of Rasmussen, Endo and Nokia is considered.

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The claimed invention relates to the field of telephone systems and telephone handsets, wherein a subscriber of the system is issued a smart card which allows the subscriber to use any handset which is configured for use in the system. The subscriber carries the smart card with him, and merely inserts the card in the handset to gain access to the system; however, such a system also requires the subscriber to key in the subscriber's own telephone number for verification. Often the subscriber may have forgotten his assigned telephone number, and for security reasons it is undesirable to label even the subscriber's own handset with the telephone number in printed form. Thus, the method and telephone set of the claimed invention provides for delivering (and displaying) the subscriber's own telephone number to the subscriber upon the subscriber's request to do so. When the telephone is switched on to activate the power supply the user must initially insert the smart card into the reader and then use the keypad to insert his PIN. When the subscriber keys in a request for the subscriber's own telephone number, his telephone number is delivered to the subscriber by being displayed on the display

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screen. Further understanding of the invention can be obtained by the following claim.

1. A method of delivering a telephone number associated with a telephone subscription to the user of a telephone set, use of said set requiring the user to provide subscription identification data stored in a data medium held by the owner of said subscription and co-operating with said telephone set, wherein the telephone number is stored in the data medium, wherein the data medium is removably coupled to said telephone set, and wherein the telephone number only then is transferred from the coupled data medium into the telephone set at the request of the user, to be delivered to the user of said set, and wherein, after the telephone number has been transferred into the telephone set, it is displayed on display means provided in said telephone set.

The Examiner relies on the following references:

Rasmussen	5,134,717	July 28, 1992
Endo et al. (Endo)	5,467,389	Nov. 14, 1995

Nokia LX11C/LX11T Brochure, May 1990, pages 1-4

Claims 1 to 3 and 5 to 10 stand rejected under 35 U.S.C. § 103 as being unpatentable over Rasmussen, Endo and Nokia.

Rather than repeat the arguments of Appellants and the Examiner, we make reference to the briefs² and the answer for their respective details thereof.

² A reply brief was filed as Paper No. 28 and the Examiner noted its entry without any further response. See Paper No. 29.

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OPINION

We have considered the rejections advanced by the Examiner and the supporting arguments. We have, likewise, reviewed the Appellants' arguments set forth in the briefs.

We reverse.

In our analysis, we are guided by the general proposition that 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 the applicant 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 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). We are further guided by the precedent of our reviewing court that the limitations from the

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disclosure are not to be imported into the claims. In re Lundberg, 244 F.2d 543, 113 USPQ 530 (CCPA 1957); In re Queener, 796 F.2d 461, 230 USPQ 438 (Fed. Cir. 1986). We also note that the arguments not made separately for any individual claim or claims are considered waived. See 37 CFR § 1.192(a) and (c). In re Baxter Travenol Labs., 952 F.2d 388, 391, 21 USPQ2d 1281, 1285 (Fed. Cir. 1991) ("It is not the function of that court to examine the claims in greater detail than argued by an appellant, looking for nonobviousness distinctions over the prior art."); In re Wiechert, 370 F.2d 927, 936, 152 USPQ 247, 254 (CCPA 1967)("This court has uniformly followed the sound rule that an issue raised below which is not argued in that court, even if it has been properly brought here by reason of appeal is regarded as abandoned and will not be considered. It is our function as a court to decide disputed issues, not to create them.").

The Examiner gives a detailed explanation of the rejection on pages 4 to 7 of the Examiner's answer³. The Examiner concludes, answer at page 3, that "it would have been

³ The pages in the Examiner's answer have been serially renumbered.

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obvious ... to include subscriber information [in Ramussen] and include a way to display the phone number, in order to prevent fraudulent use by identifying each subscriber within the network and in order to verify the telephone number that the user is allocated, respectively [in view of such teachings of Endo and Nokia]."

Appellants argue, reply brief at page 3, that "when considering Rasmussen disclosure **in its entirety**, the type of 'other information' to which the concept taught by Rasmussen may be applied, is only the information that is **automatically dialed** when accessed. In contrast, Applicant's (sic) claimed invention involves displaying a user's own telephone number. It is only common sense that the user will **not** try to dial his own telephone number from his own telephone set." Appellents further argue, reply brief at page 5, that "[s]ince the PSI is secret, the PID is not to be published, and cannot be considered as equivalent to the telephone number within the meaning of Applicant's invention." Appellants further argue, reply brief at page 5,

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that "with respect to Nokia, ... the feature of 'own number display' has nothing to do with Applicant's claimed invention." We agree with the Appellants' position. In none of the references there is any need for displaying a user's own telephone number with the use of a smart card. Rasmussen is designed to make it easy for the user to telephone a desired party by the use of a smart card which carries in its memory telephone numbers assigned to other parties. Endo merely enables a user access to a telephone network exchange by the use of a smart card and by putting in the access code, see Fig. 5. Nokia only displays the telephone number of the owner of the hand set corresponding to the owner's registration code, rather than trying to display the telephone number on request. It is to be noted that the applied references are not designed to meet the requirement or a need which is encountered in the European telephone system, where there is a need for the subscriber-user to display his own telephone number on the display of a public exchange set, assuming that the user forgot his telephone number. In the United States, a smart card is not used to learn the telephone number of the smart

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card owner. As the applied prior art shows, the telephone number of the user is presumed to be known to the user. In Rasmussen it is the telephone number of the desired party being called that is automatically dialed.

In Endo too, there is no provision where the display of the telephone number of the user is shown, only access to a telephone exchange is granted by the use of the smart card and by punching of a secret code at keypad, see Fig. 5. In Nokia, as soon as the telephone is turned on, its display will automatically show the telephone number of the owner of that telephone set. It is not responsive to the insertion of a smart card and the request of the user. The telephone number simply is coded to be in the name of the owner and that owner's telephone number name is displayed when the telephone is turned on.

Therefore, we agree with Appellants that the suggested combination of Rasmussen, Endo and Nokia does not render obvious the claimed invention.

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The decision of the Examiner rejecting claims 1 to 3,
and 5 to 10 under 35 U.S.C. § 103 is reversed.

REVERSED

ERROL A. KRASS)	
Administrative Patent Judge)	
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)	
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)	BOARD OF PATENT
PARSHOTAM S. LALL)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
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HOWARD B. BLANKENSHIP)	
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