

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GREGORY J. FUNK
AND RONALD J. VANDERHELM

Appeal No. 2000-1593
Application 08/724,459

ON BRIEF

Before JERRY SMITH, GROSS and BLANKENSHIP, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-4 and 6-8. Claim 5 has been indicated to contain allowable subject matter by the examiner.

The disclosed invention pertains to a radio transceiver which has a first interface for receiving commands from a separate baseband modem and a second interface for allowing the

Appeal No. 2000-1593
Application 08/724,459

radio transceiver to be received within a PCMCIA slot.

Representative claim 1 is reproduced as follows:

1. A wireless modem comprising:

a radio transceiver having a first interface and a second interface, the second interface allowing the radio transceiver to be received within a PCMCIA slot;

a baseband modem having a first interface; and

means for establishing communication between the radio transceiver through the first interface thereof and the baseband modem through the first interface thereof.

The examiner relies on the following references:

Robinson et al. (Robinson)	5,544,222	Aug. 06, 1996
Suomi et al. (Suomi)	5,657,371	Aug. 12, 1997 (filed Aug. 26, 1996)
Gradeler	5,701,515	Dec. 23, 1997 (filed June 16, 1994)

Claims 1-4 and 6-8 stand rejected under 35 U.S.C. § 103.

As evidence of obviousness the examiner offers Suomi in view of Gradeler with respect to claims 1 and 6-8, and the examiner adds Robinson with respect to claims 2-4.

Rather than repeat the arguments of appellants or the examiner, we make reference to the brief and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence

Appeal No. 2000-1593
Application 08/724,459

of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the brief along with the examiner's rationale in support of the rejections and arguments in rebuttal as 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 have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 1-4 and 6-8. Accordingly, we affirm.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole

Appeal No. 2000-1593
Application 08/724,459

or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden 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 Id.; 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). Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered [see 37 CFR § 1.192(a)].

With respect to independent claims 1 and 8, the examiner finds that Suomi teaches the claimed invention except that Suomi uses an RS232 interface rather than a PCMCIA slot as claimed. The examiner cites Gradeler as teaching that a PCMCIA slot is a standard connection for small computers. The examiner finds that it would have been obvious to the artisan to replace the RS232 interface in Suomi with a PCMCIA slot as taught by Gradeler in order to provide an interface that allows for connection to most small computers [answer, pages 3-4].

Appellants make the same arguments with respect to claims 1 and 8. Specifically, appellants argue that even if it would have been obvious to the artisan to replace the RS232 connection of Suomi with a PCMCIA connection as urged by the examiner, the invention of claims 1 and 8 does not result because the claims call for the radio receiver to be received within the PCMCIA slot. Appellants argue that the artisan would not be motivated to change the partitioning of Gradeler such that the PC Card includes only a radio instead of the combination of radio and modem. Appellants also argue that the examiner's proposed modification of the prior art selectively uses teachings of the references based on appellants' own disclosure [brief, pages 5-6].

The examiner responds that the central question is whether the claimed phrase "allowing the radio transceiver to be received within a PCMCIA slot" should be interpreted to mean that the transceiver is housed within a PCMCIA slot. The examiner notes that appellants' own disclosure in Figure 2 shows the transceiver located outside of the notebook computer. The examiner finds, therefore, that the quoted phrase does not require that the transceiver be located within the housing, but only that the transceiver signals can be received within a PCMCIA slot, that is, merely that the transceiver can interface to a PCMCIA slot [answer, pages 5-6].

We agree with the position of the examiner as set forth in the answer. The examiner simply proposes to replace the RS232 interface of Suomi with a PCMCIA slot. Appellants essentially admit that this substitution would present little difficulty if the artisan were motivated to use a PCMCIA connection in Suomi [brief, page 5]. As noted above, appellants' position on this substitution is that the radio transceiver would not be received within the PCMCIA slot.

We agree with the examiner that the artisan would have been motivated to replace the RS232 connection of Suomi with a PCMCIA slot connection so that the transceiver of Suomi could

Appeal No. 2000-1593
Application 08/724,459

interface with conventional small computers which are equipped with PCMCIA slots. Once this obvious modification to Suomi has been made, the question remains whether the radio transceiver of Suomi would then be received within a PCMCIA slot as claimed. The examiner provides a cogent argument as to why the language of claims 1 and 8 should be considered to be met by this proposed modification. In our view, the examiner has at least established a prima facie case of the obviousness of claims 1 and 8. Appellants have presented no persuasive rebuttal arguments responsive to this claim interpretation by the examiner explaining why the examiner's analysis is flawed. Without such persuasive arguments, we agree with the examiner that the rejection of claims 1 and 8 should be sustained.

Although claims 2-4 were rejected based on the additional teachings of Robinson, appellants have not separately argued the rejection of claims 2-4. In fact, appellants indicate that for purposes of this appeal, claims 2-4 stand or fall with independent claim 1 [brief, page 4]. Since appellants have presented no arguments with respect to claims 2-4, we also sustain the rejection of these claims for the same reasons discussed above.

Appeal No. 2000-1593
Application 08/724,459

With respect to dependent claims 6 and 7, appellants note what these claims recite and simply assert that the applied prior art does not teach or suggest these features. These broad assertions do not constitute an explanation of why the rejection is inappropriate. The examiner has addressed the obviousness of these limitations in the rejection [answer, page 4]. Since appellants have not responded to the reasons for the rejection as set forth by the examiner, we also sustain the rejection of claims 6 and 7.

In summary, we have sustained each of the examiner's rejections of the claims on appeal. Therefore, the decision of the examiner rejecting claims 1-4 and 6-8 is affirmed.

Appeal No. 2000-1593
Application 08/724,459

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

AFFIRMED

JERRY SMITH)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
ANITA PELLMAN GROSS)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
HOWARD B. BLANKENSHIP)	
Administrative Patent Judge)	

Appeal No. 2000-1593
Application 08/724,459

BURNS, DOANE, SWECKER & MATHIS LLP
POST OFFICE BOX 1404
ALEXANDRIA, VA 22313-1404

JS:caw