

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JOHN D. BYRNE

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Appeal No. 2000-2254  
Application 08/746,746

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ON BRIEF

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Before JERRY SMITH, BARRY and LEVY, 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 1-29, 31-40 and 42-47, which constitute all the claims remaining in the application.

The disclosed invention pertains to a radio telephone which is operable in more than one radio telephone system, such as a cordless telephone system and a cellular telephone system. The radio telephone of the invention automatically monitors

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signals of the two telephone systems and selects which of the two radio telephone systems will be used.

Representative claim 1 is reproduced as follows:

1. A radio telephone operable in more than one radio telephone system, the radio telephone comprising communication means respectively associated with each of the radio telephone systems, monitoring means for monitoring signals of the radio telephone systems, and selection means responsive to said monitoring means for automatically selecting and re-selecting respective said communication means in accordance with the signals of one of the radio telephone systems fulfilling at least one predetermined criterion and, wherein a first one of the communication means includes at least one non-cellular system transceiver and the selection means can automatically select and re-select between the first communication means having the non-cellular system transceiver and a second one of the communication means which includes a cellular transceiver.

The examiner relies on the following references:

D'Amico et al. (D'Amico)	5,159,593	Oct. 27, 1992
Ramsdale et al. (Ramsdale)	5,278,991	Jan. 11, 1994
Alvesalo	5,384,824	Jan. 24, 1995
Gillig et al. (Gillig)	5,463,674	Oct. 31, 1995
Schellinger et al. (Schellinger)	WO 93/16560	Aug. 19, 1993

The following rejections are on appeal before us:

1. Claims 1-6, 9, 11 and 47 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Schellinger in view of Gillig.

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2. Claim 8 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Schellinger in view of Gillig and further in view of Ramsdale.

3. Claim 12 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Schellinger in view of Gillig and further in view of Alvesalo.

4. Claims 7 and 10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Schellinger in view of Gillig and further in view of D'Amico.

5. Claims 13-18, 20-22, 24-29, 32-34, 36-40 and 43-45 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Schellinger in view of D'Amico.

6. Claims 23, 35 and 46 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Schellinger in view of D'Amico and further in view of Alvesalo.

7. Claims 19, 31 and 42 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Schellinger in view of D'Amico and further in view of Ramsdale.

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

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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 for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellant's arguments set forth in the briefs along with the examiner's rationale in support of the rejections 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 have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 1-12, 24-29, 31-35 and 47. We reach the opposite conclusion with respect to claims 13-23, 36-40 and 42-46. Accordingly, we affirm-in-part.

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,

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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 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

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1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered and are deemed to be waived by appellant [see 37 CFR § 1.192(a)].

We consider first the rejection of claims 1-6, 9, 11 and 47 based on the teachings of Schellinger and Gillig. The examiner has indicated how he finds the invention of these claims to be obvious over the collective teachings of Schellinger and Gillig [answer, pages 4-6]. The examiner cites Schellinger as teaching a radio telephone which can communicate with either a cordless base station or a cellular base station. The examiner essentially finds that Schellinger teaches the claimed invention except that Schellinger uses a single cellular transceiver for communicating with both the cordless and cellular base stations rather than two separate transceivers as claimed. The examiner cites Gillig as teaching the use of separate transceivers in a radio telephone for communicating with a cordless base station and a cellular base station and automatically selecting between the two. The examiner finds that it would have been obvious to the artisan to use a separate cordless transceiver in Schellinger as taught by Gillig.

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With respect to claim 1, appellant argues that Schellinger discloses only a single cellular transceiver while Gillig does not disclose a monitoring means for selecting and re-selecting different ones of the transceivers. Thus appellant argues that neither Schellinger nor Gillig teaches a telephone having the claimed monitoring means and the selection means. Appellant also argues that Schellinger teaches away from using two different transceivers as claimed [brief, pages 4-7].

The examiner responds that it would have been obvious to the artisan to replace the single transceiver of Schellinger with two separate transceivers as taught by Gillig. The examiner also responds that the claimed automatic selecting and re-selecting is met by the collective teachings of Schellinger and Gillig [answer, pages 12-14]. Appellant responds that Schellinger discloses only a single communication means so that there can be no selection between communication means and Gillig does not teach re-selecting between communication means [reply brief, pages 1-2].

We will sustain the examiner's rejection of claim 1. Schellinger teaches the desirability of operating a radiotelephone in both a cordless telephone system and a cellular telephone system. Schellinger's radio telephone, however,

communicates with both systems using a cellular transceiver. Schellinger also discloses that such a radio telephone must be able to automatically determine which system it is to operate in [page 3, lines 3-8]. Gillig also teaches the desirability of operating a radio telephone in both a cordless telephone system and a cellular telephone system. The Gillig radio telephone, however, uses a cordless telephone transceiver 110 and a cellular telephone transceiver 120. We agree with the examiner that it would have been obvious to broadly replace the single transceiver of Schellinger with two separate transceivers as taught by Gillig. Even though Schellinger may use a single transceiver to reduce the cost of the device, cost savings do not represent a technological teaching away from the claimed invention. To the contrary, the applied prior art clearly suggests the use of two different transceivers when communicating over cordless telephone systems and cellular telephone systems.

Although appellant argues that Schellinger and Gillig do not teach the automatic monitoring and selection as claimed, we do not agree. In fact, we find that each of the applied references teaches the claimed monitoring and automatic selection and re-selection of the appropriate telephone system [see for example, Schellinger, page 9, lines 16-24 and Gillig, Figure 8].

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Thus, we agree with the examiner that the dual mode systems of Schellinger and Gillig monitor the signals within the telephone systems and automatically switch systems when established predetermined criteria are met as recited in claim 1.

With respect to claim 3, appellant argues that Schellinger does not teach a user indicated preference which is based on signals from the radio telephone system to automatically select one of the telephone systems [brief, pages 7-8]. The examiner responds that Schellinger does teach a user indicated preference for use in the automatic selection [answer, pages 14-15].

We will sustain the examiner's rejection of claim 3. We agree with the examiner that Schellinger teaches this claimed feature [see for example page 11, lines 8-11]. Thus, the incoming signals in Schellinger will result in the selection of one of the telephone systems based on priorities established by the user.

With respect to claim 5, appellant argues that Schellinger does not teach a selection criterion based on access rights of the user [brief, page 8]. The examiner responds that access rights are necessary before the user can access either of the telephone systems [answer, page 15].

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We will sustain the examiner's rejection of claim 5. We agree with the examiner that access rights will inherently determine system selection because a system with no access rights will clearly not be selected by the radio telephone of Schellinger and Gillig over a system with access rights.

Thus, we have sustained the examiner's rejection of claims 1, 3 and 5. Since dependent claims 2, 4, 6, 9 and 11 have not been separately argued by appellant, we also sustain the rejection of these claims.

With respect to independent claim 47, appellant's arguments are essentially the same arguments we considered above with respect to claim 1. Therefore, we sustain the examiner's rejection of claim 47 for the same reasons discussed above with respect to claim 1.

We now consider the rejection of claim 8 based on the teachings of Schellinger, Gillig and Ramsdale. The examiner cites Ramsdale as teaching that it was known to use velocity as a criterion for handoff of a signal [answer, page 6]. Appellant argues that there is no disclosure in the applied prior art of using velocity to automatically select between respective communication means [brief, page 9]. The examiner responds that Ramsdale teaches using velocity as the predetermined criterion

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[answer, pages 16-17]. Appellant responds that the teaching relied on by the examiner does not necessarily relate to the velocity of the user [reply brief, page 2].

We will sustain the examiner's rejection of claim 8. Ramsdale teaches that the velocity of a mobile telephone can be a factor in the quality of the signal in a communication system. Therefore, we find that it would have been obvious to the artisan to broadly select between communication systems based on velocity as recited in claim 8.

We now consider the rejection of claim 12 based on the teachings of Schellinger, Gillig and Alvesalo. The examiner cites Alvesalo as teaching that GSM was a known cellular radio telephone system and that DECT was a known cordless radio telephone system [answer, pages 6-7]. Appellant argues that Alvesalo does not disclose or suggest the features of claim 12 [brief, pages 9-10]. The examiner responds that it would have been obvious for the cellular and cordless telephone systems of Schellinger to be a GSM and a DECT system as taught by Alvesalo so that the system could be used in Europe [answer, pages 17-18].

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We will sustain the examiner's rejection of claim 12. The combination of Schellinger and Gillig teaches switching between a cellular telephone system and a cordless telephone system for reasons discussed above. Alvesalo teaches that GSM is a conventional cellular telephone system in Europe, and DECT is a conventional cordless telephone system in Europe. We agree with the examiner that it would have been obvious to select between a GSM system and a DECT system so that the system could be used in Europe.

We now consider the rejection of claims 7 and 10 based on the teachings of Schellinger, Gillig and D'Amico. The examiner cites D'Amico as teaching that it was known to use a lower bit error rate or frame error rate for selecting the best signal and to monitor for signals during a period of nominal TDMA inactivity of a selected one of the telephone systems [answer, pages 7-8]. Appellant simply argues that there is no disclosure in the applied prior art of the features recited in claims 7 and 10 [brief, page 8-9]. The examiner reiterates that D'Amico teaches the claimed features [answer, pages 16-17].

We will sustain the examiner's rejection of claims 7 and 10. D'Amico teaches that it was broadly known to select signals based on a bit error rate or a frame error rate and to monitor

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signals during a period of nominal TDMA inactivity as asserted by the examiner. Note that D'Amico teaches monitoring time slots to determine channel utilization [column 2, lines 18-20]. Such monitoring of time slots would include monitoring the time slots during a period of nominal TDMA inactivity as claimed. Claims 7 and 10 merely broadly claim using these concepts in a combined radio telephone system. We agree with the examiner that the broad recitation of these conventional features in the radio telephone system of Schellinger and Gillig would have been obvious to the artisan.

We now consider the rejection of claims 13-18, 20-22, 24-29, 32-34, 36-40 and 43-45 based on the teachings of Schellinger and D'Amico. The examiner has indicated how he finds the invention of these claims to be obvious over the collective teachings of Schellinger and D'Amico [answer, pages 8-11]. The examiner cites Schellinger as teaching a radio telephone which can communicate with either a cordless base station or a cellular base station. The examiner essentially finds that Schellinger teaches the claimed invention except that Schellinger does not show the user information signals including the criterion data in the manner claimed. The examiner cites D'Amico as teaching the claimed user information signals. The examiner finds that it

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would have been obvious to the artisan to use the predetermined criteria of D'Amico in the Schellinger radio telephone.

With respect to claim 13, appellant argues that neither Schellinger nor D'Amico discloses or suggests a radio telephone system in which user information is exchanged between the two radio telephone systems [brief, pages 10-11]. The examiner responds that the user information signals are the voice communications between the two radio telephone systems [answer, pages 18-19]. Appellant responds that the voice communications cannot meet the claimed user information signals [reply brief, pages 2-3].

We will not sustain the examiner's rejection of independent claim 13 or of claims 14-23 which depend therefrom. We agree with appellant that the voice communications disclosed by D'Amico do not suggest the claimed user information. The user information of claim 13 is exchanged between the two radio telephone systems. We do not agree with the examiner that the voice communications of Schellinger are exchanged between the two systems. Although the mobile receiver exchanges information with each of the two systems, there is no teaching that user information from one system is exchanged with the other system.

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Since independent claim 36 contains recitations similar to independent claim 13, we do not sustain the examiner's rejection of claim 36 or of claims 37-40 or 42-46 which depend therefrom.

With respect to independent claim 24, appellant argues that Schellinger does not teach selecting and re-selecting telephone systems based on a predetermined criterion and D'Amico relates to a single telephone system [brief, pages 15-16]. The examiner responds that D'Amico teaches that bit error rate and frame error rate are factors to be considered in determining whether a radio telephone signal should be handed off to another channel. The examiner reiterates that it would have been obvious to the artisan to use this information in the radio telephone system of Schellinger [answer, pages 22-23].

We will sustain the examiner's rejection of claim 24. We agree with the examiner that the applied prior art teaches that a radio telephone signal should be selected based on the criterion of bit error rate or frame error rate. The artisan would have found it obvious in the system of Schellinger to select the telephone system which provides the lower bit error rate or frame error rate under certain circumstances.

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Each of the claims which depends from claim 24 recites a feature which was argued and considered above. Therefore, we also sustain the examiner's rejection of claims 25-29 and 31-35 for reasons discussed above.

In summary, we have sustained the examiner's rejection with respect to claims 1-12, 24-29, 31-35 and 47, but we have not sustained the rejection with respect to claims 13-23, 36-40 and 42-46. Therefore, the decision of the examiner rejecting claims 1-29, 31-40 and 42-47 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

JERRY SMITH	)	
Administrative Patent Judge	)	
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LANCE LEONARD BARRY	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
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