

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. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BEVERLY RIMMER BRITT and JOHN EDWARD ETCHELLS

Appeal No. 2001-0654
Application 08/910,315

ON BRIEF

Before JERRY SMITH, FLEMING, and DIXON, Administrative Patent Judges.

FLEMING, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1 through 8, all the claims pending in the present application.

The invention relates to cellular phones. In particular, the invention relates to a cellular phone which transmits the current location of the phone using a global positioning system

and personal identity information unique to the person using the phone. See page 2, of Appellants' specification. In particular, the personal data which is transmitted is not only the identity of the person, but also may be a substantial amount of personal data such as medical information. See page 4 of Appellants' specification.

Representative claim 1 present in the application is reproduced as follows:

1. A transmitter for communication over a cellular system, comprising:

a data storage device electronically storing predefined personal identity information unique to the person using said transmitter for communication to a receiving station over the cellular system, the predefined personal identity information being exclusive of any transmitter identifying number and exclusive of the transmitter's location;

a position-finding receiver for determining a current geographic location of the transmitter;

a signal processing element for providing a signal that includes said predefined personal identity information unique to the person using said transmitter and said current location;

a transmission element receiving said signal from said signal processing element and, in response thereto, transmitting a cellular signal that includes said predefined identity information unique to the person using said transmitter and said current location; and

a manually operable actuator for establishing communication with a receiving party over the cellular system and initiating transmission of said cellular signal thereto.

REFERENCES

The references relied on by the Examiner are as follows:

Hillis	5,303,297	Apr. 12, 1994
Wizgall et al. (Wizgall)	5,630,209	May 13, 1997
Emery et al. (Emery)	5,727,057	Mar. 10, 1998
		(filed Dec. 27, 1994)

Rejections At Issue

Claims 1, 2 and 4 through 8 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hillis in view of Emery.

Claim 3 stands rejected under 35 U.S.C. § 103 as being unpatentable over Hillis in view of Emery and Wizgall.

Rather than repeat the arguments of Appellants or Examiner, we make reference to the brief and answer for the respected details thereof.

OPINION

With full consideration being given to the subject matter on appeal, the Examiner's rejections and the arguments of Appellants and the Examiner, for the reasons stated *infra*, we reverse the Examiner's rejection of claims 1 through 8 under 35 U.S.C. § 103.

Appellants point out that Appellants' apparatus claim 1 and method claim 8 recite the storage of predefined personal identity information unique to the person using the transmitter and exclusive of any transmitter identifying number and exclusive of

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the transmitter's location. Appellants argue that this limitation is not shown in the Examiner's proposed combination of references.

As pointed out by our reviewing court, we must first determine the scope of the claim. "[T]he name of the game is the claim." *In re Hiniker Co.*, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). As our reviewing court further states that "the terms used in the claims bear a "heavy presumption" that they means what they say and have the ordinary meaning that would be attributed to those words by persons skilled in the relevant art." *Texas Digital Systems, Inc. v. Telegenix, Inc.*, _____ F.3d _____, 2002 WL 31307212 *3 (Fed. Cir. (Oct. 16, 2002.)).

We note that independent claim 1 recites "[a] transmitter for communication over a cellular system, comprising: a data storage device electronically storing predefined personal identity information unique to the person using said transmitter for communication to a receiving station over the cellular system, the predefined personal identity information being exclusive of any transmitter identifying number and exclusive of the transmitter's location; . . . a signal processing element for

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providing a signal that includes said predefined personal identity information unique to the person using said transmitter and . . . a transmission element receiving said signal from said signal processing element and, in response thereto, transmitting a cellular signal that includes said predefined identity information unique to the person using said transmitter".

Appellants' only other independent claim 8 recites "[a] method for communicating information over a cellular system via a transmitter, comprising: storing predefined personal identity information unique to the person using said transmitter for communication to a receiving station over the cellular system, the predefined personal identity information being exclusive of any transmitter identifying number and exclusive of the transmitter's location; . . . providing a signal that includes said predefined personal identity information unique to the person using said transmitter . . . establishing communication with a receiving party over the cellular system and initiating transmission of said signal thereto that includes said predefined personal identity information and said current location."

In regards to claims 1 and 8, the Examiner agrees that Hillis does not teach personal identity information being exclusive of any identifying number associated with the

transmitter. See page 3 of the Examiner's answer. However, the Examiner argues that Emery teaches personal identity information in column 2, lines 16 through 49, and column 7, lines 25 through 33. See page 3 of the Examiner's answer.

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a *prima facie* case of obviousness. **In re Oetiker**, 977 F.2d 1443, 1445, 24 USPQ 1443, 1444 (Fed. Cir. 1992). **See also In re Piasecki**, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The Examiner can satisfy this burden by showing that some objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art suggests the claimed subject matter. **In re Fine**, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir.. 1988). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the Appellants. **Oetiker**, 977 F.2d 1445, 24 USPQ at 1444. **See also Piasecki**, 745 F.2d at 1472, 223 USPQ at 788.

An obviousness analysis commences with a review and consideration of all the pertinent evidence and arguments. "[I]n reviewing the [Examiner's decision on appeal, the Board must necessarily weigh all of the evidence and arguments." **In re**

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Oetiker, 977 F.2d at 1445, 24 USPQ2d at 1444. “[T]he Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency’s conclusion.” **In re Lee**, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002). With these principles in mind, we commence review of the pertinent evidence and arguments of Appellants and Examiner.

We fail to find that Emery teaches predefined personal identity information unique to the person using a transmitter and exclusive of any identifying number and exclusive of the transmitter location. The Examiner has directed us to column 2, lines 16 through 49. Upon our review of this portion of the specification, we find that Emery is teaching location ID and telephone ID. We fail to find any teaching directed to personal identity information as required by Appellants’ claims 1 and 8. Furthermore, we fail to find support for the Examiner’s position in column 7, lines 25 through 33. Emery does not teach personal identity information but instead teaches location ID and transmitter ID. Upon our review of the entire disclosure of

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Emery, we fail to find any support for the Examiner's assertion that Emery teaches personal identity information as required by claims 1 through 8.

The Examiner has further rejected claim 3 under 35 U.S.C. § 103 as being obvious over Hillis in view of Emery and further in view of Wizgall. The Examiner relies on Wizgall for the teaching of a detachable mass memory card. See page 5 of the Examiner's answer. We note that the Examiner for this rejection also relies on Emery for the teaching of personal identity information unique to a person using the transmitter and exclusive of any transmitter identifying number and exclusive of the transmitter's location as required by claim 3 due to its dependence on claim 1. We therefore will not sustain the rejection of claim 3 for the same reasons as above.

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In view of the foregoing, we will not sustain the Examiner's rejection of claims 1 through 8 under 35 U.S.C. § 103.

REVERSED

JERRY SMITH)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
MICHAEL R. FLEMING)	
Administrative Patent Judge)	APPEALS AND
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)	INTERFERENCES
)	
JOSEPH L. DIXON)	
Administrative Patent Judge)	

MRF:pgg

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S H Dworetsky
AT & T Corp.
P.O. Box 4110
Middletown, NJ 07748-4801