

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 HEIKKI ALANEN,
KIMMO LAAKKONEN and JOUNI HALME

Appeal No. 2001-0815
Application No. 08/803,947

ON BRIEF

Before THOMAS, FLEMING and RUGGIERO, **Administrative Patent Judges**.

FLEMING, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1, 4, 5 and 8 through 23, all the claims present in the application. Claims 2, 3, 6 and 7 have been cancelled.

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The invention relates to a compact radio handset. See page 1 of Appellants' specification. Appellants point out that the problem in the prior art is that the handset can only be used for making or answering a call when the cover is in its extended position. Appellants point out that the prior art handsets operate in such a manner that the action of closing the sleeve terminates a call, regardless of whether it is an incoming or outgoing call. See page 2 of Appellants' specification. Appellants point out that one desired option for a radio telephone is that moving the extended portion from the closed position serves to answer an incoming call. Often, extending the phone will be an automatic or reflex response, and it is this action which automatically answers a call that the user may rather have left unanswered. Appellants' invention corrects this problem by providing a means by which an additional operation performed by the user in a predetermined delay period can cancel the function initiated by the movement of the extending portion. See page 3 of Appellants' specification.

Independent claim 1, present in the application, is reproduced as follows:

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1. A radio handset comprising a housing having user input means and a processor operable to perform a predetermined function of placing the handset in the off-hook condition in response to user input of a predefined actuation signal, wherein the processor is operable to delay performance of the predetermined function for a period during which user generation of a predefined cancellation signal cancels performance of the predetermined function, the housing comprising a key pad including a plurality of keys mounted on a main body and an extending portion mounted for movement between a first position at which the handset is in the on-hook condition and in which a group of the plurality of keys are concealed and a second position at which the handset is in the off-hook condition and in which the group of the plurality of keys are exposed, and wherein the processor is operable to perform the predetermined function in response to movement of the extending portion toward the second position.

References

The references relied on by the Examiner are as follows:

Furuno	5,724,667	Mar. 3, 1998 (effectively filed Nov. 18, 1994)
Martensson (European Patent Application)	0 414 365 A2	Feb. 27, 1991

Rejections at Issue

Claims 13, 22 and 23 stand rejected under 35 U.S.C. § 102 as being anticipated by Furuno. Claims 1, 4, 5, 8 through

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12 and 14 through 21 stand rejected under 35 U.S.C. § 103 as being unpatentable over Martensson in view of Furuno.

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

OPINION

With full consideration being given 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 13, 22 and 23 under 35 U.S.C. § 102 and claims 1, 4, 5, 8 through 12 and 14 through 21 under 35 U.S.C. § 103.

We first will address the rejection of claims 13, 22 and 23 under 35 U.S.C. § 102 as being anticipated by Furuno. Appellants argue that the claims are directed to a processor operable to perform a predetermined function of placing the handset in the off-hook condition in response to user input of a predefined actuation signal, wherein the processor is operable to delay performance of the predetermined function for a period

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during which user generation of a predefined cancellation signal cancels performance of the predetermined function. See pages 5 and 6 of the Brief. Appellants argue that Furuno fails to teach user generation of a predefined cancellation signal during the delay. Nor does Furuno teach cancelling performance of the off-hook position in response to the cancellation signal during the delay period. See page 7 of the Brief.

The Examiner responds to the above Appellants' argument by stating that Furuno discloses a time delay before placing the telephone in an off-hook state. The Examiner states that those skilled in the art would have appreciated that the user in Furuno can cancel the automatic off-hook operation if he closes the lid element 105 before a predetermined time lapse. The Examiner points to Furuno, column 5, lines 37-52; column 6, lines 33-38; column 7, line 47 - column 8, line 4; and column 8, lines 53-58. See page 6 of the Examiner's Answer.

It is axiomatic that anticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim. **See *In re King***, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986) and ***Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.***, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984).

We note that claim 13 requires

a processor operable to perform a predetermined function of placing the handset in the off-hook condition in response to user input of a predefined actuation signal, wherein the processor is operable to delay performance of the predetermined function for a period during which the user generation of a predefined cancellation signal cancels performance of the predetermined function. . . .

Also, we note that claim 22 recites similar language.

Furthermore, we note that claim 23 recites

a first user input operable to place the handset in an off hook condition so as to answer the receiving incoming call, and

a second user input operable to cancel the placing of the handset in the off hook condition, and

a processor comprising:

call answering means configured to initiate placing of the handset in the off hook condition in response to user actuation of the first user input means,

call answering delay means responsive to activation of the call answer means and configured to delay the call answering means for a predetermined period of time, and

call cancellation means configured to cancel answering of the incoming call in response to user actuation of the second user input during the predetermined delay period, and

subsequently to continue to deal with the incoming call as if untreated by the user.

Therefore, the scope of the claims before us requires a processor operable to delay performances of the predetermined function for a period during which the user generation of predefined cancellation signal cancels performance of the predetermined function.

Turning to Furuno, we fail to find that Furuno teaches this limitation. We note that Furuno teaches two separate embodiments. The first embodiment is shown in Figure 4 in which taking out the earphone 27 causes detection switch 67 to switch. The controller 95 performs the function of placing the handset in the off-hook position after a time interval after the detection switch 67 is switched. See column 5, lines 29-52. When the earphone cord 29 is placed back on the reel after the conversation is over, detection switch 68 is closed and the controller 95 switches the telephone to the on-hook state. See column 6, lines 33-38.

In a second embodiment, Appellants show in Figure 9 that a lid element 105 providing an area of notch 26 in the earphone containing portion 28 is present. The lid element 105 is configured to push a detection switch 108. When the lid element 105 is open, the telephone is switched to the off-hook

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state after a time interval corresponding to the first embodiment. When the conversation is over and the user returns the earphone 27 and the lid element 105 is closed, switch 108 again is actuated thereby placing the telephone in the off-hook state. See column 7, line 37, to column 8, line 4.

We find nothing in the disclosure of Furuno that supports the Examiner's position that closing the lid element 105 before the predetermined period lapses will cancel the on-hook state such that the call never is answered in the first place. Instead, what we find one of ordinary skill in the art upon reading this disclosure would have been taught is that upon actuating the lid or opening the lid, the call is going to be answered after the passing of the delay and that simply pushing the earphone back in and closing the lid places it on the off-hook position. This would not cancel the first on-hook state but instead would provide two cycled states, one an on-hook state and then an off-hook state, thereby hanging up on the caller and thereby answering the call and then hanging up. We fail to find that Furuno would teach Appellants' claimed invention of cancelling the off-hook state. In particular, we fail to

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find that Furuno teaches a user generation of a predefined cancellation signal during the delay period to cancel the performance of the off-hook position in response to the cancellation signal during the delay period as claimed by Appellants' claims. Therefore, we will not sustain the Examiner's rejection.

We now turn to the rejection of claims 1, 4, 5, 8 through 12 and 14 through 21 as being rejected under 35 U.S.C. § 103 as being unpatentable over Martensson in view of Furuno. Appellants argue that Martensson discloses a conventional compact portable telephone in which the movement of the extended portion from the first position to the second position automatically produces an off-hook condition. Appellants further argue that Furuno is concerned with a time delay to accommodate withdrawal of an earphone 27 at the time a telephone call is being initiated. Appellants argue that it is unclear how Furuno and Martensson can be combined to produce the Appellants' claimed invention.

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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 at 1445, 24 USPQ at 1444. **See also Piasecki**, 745 F.2d at 1472, 223 USPQ at 788.

The factual inquiry whether to combine references under 35 U.S.C. § 103 must "be based on objective evidence of record." **In re Lee**, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). This "showing must be clear and particular." **In re Dembiczak**, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). "In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select

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the references and combine them to render the claimed invention obvious." *Lee*, 277 F.3d at 1343, 61 USPQ2d at 1434 **quoting In re Fritch**, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). **See also Dembiczak**, 175 F.3d at 999, 50 USPQ2d at 1617 **quoting In re Rouffet**, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998). "[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 or deemed to support the agency's conclusion." *Lee*, 277 F.3d at 1344, 61 USPQ2d at 1434. With these principles in mind, we commence review of the pertinent evidence and arguments of Appellants and Examiner.

Upon a careful review, we fail to find that the Examiner has provided the requisite findings or reasons in Martensson or Furuno to modify these disclosures to obtain the Appellants' claimed invention. We note that Appellants' claim 1 recites a

processor operable to perform a predetermined function of placing the handset in the off-hook condition in response to user input of a predefined actuation signal, wherein the processor is operable to delay performance of

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the predetermined function for a period during which user generation of a predefined cancellation signal cancels performance of the predetermined function. . . .

Similarly, we note that the only other independent claim 12 also recites

a processor operable to perform a predetermined function of placing the handset in the off-hook condition in response to an incoming call and movement of the extending portion toward the second position, wherein the processor is operable to delay performance of the predetermined function for a period during which generation of a predefined cancellation signal cancels performance of the predetermined function. . . .

As we have pointed out above, Furuno fails to teach this limitation. Furthermore, we fail to find that Furuno suggests such a limitation because Furuno is only concerned in allowing the user time to place the earphone in his ear which is the sole purpose of the delay. Furthermore, upon reading Martensson, we fail to find that that reference suggests or teaches such a limitation. Therefore, we will not sustain the Examiner's rejection.

In view of the foregoing, we have not sustained the rejection of claims 13, 22 and 23 under 35 U.S.C. § 102 nor have

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we sustained the rejection of claims 1, 4, 5, 8 through 12 and 14
through 21 under 35 U.S.C. § 103.

REVERSED

JAMES D. THOMAS)	
Administrative Patent Judge)	
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)	
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)	BOARD OF PATENT
MICHAEL R. FLEMING)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JOSEPH F. RUGGIERO)	
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