

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte DAVID M. MOONEY,  
JAMES B. GLAZIER, DAVID E. WOOD,  
JOSEPH A. KIMLINGER  
and PAUL GOSHGARIAN

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Appeal No. 95-0057  
Application 07/775,114<sup>1</sup>

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ON BRIEF

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Before JERRY SMITH, BARRETT and LEE, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

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<sup>1</sup> Application for patent filed October 11, 1991.

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This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1, 4-12 and 14, which constitute all the claims remaining in the application.

The claimed invention pertains to a cellular telephone system in which the handset is equipped with an integrated circuit card reader for storing information regarding phone call transactions on an integrated circuit card as the phone calls are made.

Representative claim 1 is reproduced as follows:

1. An apparatus for controlling and recording cellular phone call transactions for use in a cellular telephone system, the system containing a remote unit having a radio transceiver, a handset and a logic bus, the apparatus comprising:

(a) remote card reader interface means for writing and reading information to and from an integrated circuit card placed in the remote card reader;

(b) logic bus interface means for connecting a processing means to the logic bus of the transceiver;

(c) processing means connected to the logic bus interface means and remote card reader interface means for processing information observed on the logic bus or read from the card, said information including phone call transaction information; and

(d) the processing means further including means for controlling the remote unit in response to information read from the card and for writing phone call transaction information to an integrated circuit card placed in the remote card reader, the phone call transaction information including at least the phone number and duration for each call processed by on the remote unit.

The examiner relies on the following references:

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Harris	4,776,003	Oct. 04, 1988
D'avello et al. (D'avello)	4,860,336	Aug. 22, 1989
Kemppi	4,868,846	Sep. 19, 1989
Fuwa (Japanese Kokai)	61-244164	Oct. 30, 1986
Iwanami (Japanese Kokai)	62-286360	Dec. 12, 1987

Claims 1, 4 and 5 stand rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of Kemppi, D'avello or Harris in view of Fuwa.<sup>2</sup> Claims 6-11 stand rejected under 35 U.S.C. § 103 as being unpatentable over D'avello in view of Fuwa. Finally, claims 12 and 14 stand rejected under 35 U.S.C. § 103 as being unpatentable over D'avello in view of Fuwa and further in view of Iwanami.

Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs 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

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<sup>2</sup> Our understanding of Fuwa and Iwanami is based on translations provided by the Scientific and Technical Information Center of the U. S. Patent and Trademark Office. These translations were previously provided to appellants by the examiner.

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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 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 collective 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, 6-12 and 14. We reach the opposite conclusion with respect to claim 5. Accordingly, we affirm-in-part.

Appellants have nominally indicated in section VI. of the brief that the claims within each of the three rejections stand together. Nevertheless, the arguments section of the brief proceeds to provide arguments in support of the separate patentability of some of the claims. This procedure is inconsistent with 37 CFR § 1.192 and would be grounds to treat all the claims within each rejection as standing or falling together. However, since the examiner in the answer has

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responded to these separate arguments of appellants, we will not require strict compliance with 37 CFR § 1.192 in order for appellants to have the claims considered separately for patentability. Therefore, to the extent that appellants have properly argued the reasons for independent patentability of specific claims, we will consider such claims individually for patentability. To the extent that appellants have made no separate arguments with respect to some of the claims, such claims will stand or fall with the claims from which they depend. Note In re King, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986); In re Sernaker, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983).

All the claims before us have been rejected under 35 U.S.C. § 103. As a general proposition 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.

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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).

With respect to each of the three rejections, the examiner has pointed out the teachings of the prior art, has pointed out the perceived differences between the prior art and the claimed invention, and has reasonably indicated how and why the prior art would have been modified and/or combined to arrive at the claimed invention. The examiner has, therefore, at least satisfied the burden of presenting a prima facie case of obviousness. The burden is, therefore, upon appellants to come forward with evidence or arguments which persuasively rebut the examiner's prima facie case of obviousness. Appellants have presented several arguments in response to the examiner's rejections. Therefore, we consider obviousness based upon the totality of the evidence and the relative persuasiveness of the arguments.

I. The rejection of claims 1, 4 and 5 based upon Kemppe, D'Avello or Harris in view of Fuwa.

The examiner relies on each of Kemppe, D'Avello and Harris as teaching a remote card reader for use with a cellular telephone. According to the examiner, each of these references

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lacks only a teaching of using a remote card reader which not only reads information from the card but also writes information about the calls back onto the card [answer, pages 5-6]. The examiner cites Fuwa as providing this teaching and explains why it would have been obvious to the artisan to combine the teachings of Fuwa with any of the "primary" references.

Appellants' initial argument is that the Fuwa translation is so confusing that it does not support the examiner's interpretation. Appellants assert that it is not clear in Fuwa whether the data regarding the phone calls is written to the card or written to a central host billing computer [brief, page 9].

The

examiner argues that the translation clearly supports his position that data regarding phone transactions is written onto the card. Although we agree with appellants that the Fuwa translation is not entirely clear on this point, we nevertheless agree with the examiner that the document as a whole would have suggested to the artisan that data was intended to be written onto the card.

First, the very nature of integrated circuit cards, also commonly referred to as smart cards, is that they contain

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processing circuitry and memory right on the card for reading data from the memory, processing the data by circuitry on the card, and writing information back into the memory. Thus, one of the main advantages of an integrated circuit card is that it can both retrieve and store data. The Fuwa translation also indicates that seven categories of data are "input in the IC card." We interpret this phrase to mean that each of the seven categories of data exists on the card at some point. Since some of these categories of data cannot be predetermined in advance, such as date and time of start and end of connection, these categories of data must be placed on the card after calls have been made which means that the integrated circuit card of Fuwa is written onto. We also find Fuwa's concern with the amount of data which can be

stored on the card to be indicative that Fuwa writes data onto the card. If Fuwa were only an identification card as suggested by appellants, there would be no reason to worry about the amount of characters which could be stored on the card because such information would not exceed the information of conventional credit cards. Fuwa's concern about the storage capacity of the card can only be the result of a desire to continually add

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additional data to the data preset on the card. It is the storage of this additional data written onto the card for which Fuwa seeks capacity. Thus, we are of the view that the Fuwa translation considered as a whole suggests that the Fuwa card reader also writes phone call transaction data onto the card.

We also note that the question of obviousness here does not turn simply on whether the preferred embodiment of Fuwa does or does not write onto the integrated circuit card, but rather, whether writing onto the card would have been suggested to the artisan. Despite any ambiguities in the Fuwa translation, the artisan would have appreciated the obviousness of storing the phone call data on the integrated circuit card so that the card owner would have a record of the calls that were made for comparison to subsequent billing invoices. Thus, we find that Fuwa

teaches to the artisan the writing of call transaction data onto the integrated circuit card.

Appellants argue that Kemppe only teaches the reading of information from the card and fails to suggest the accounting functions which requires writing information to the card [brief,

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pages 9-10]. This argument is completely unconvincing since the examiner relies on Fuwa for this teaching. The references cannot be attacked individually when the rejection is based upon a combination of the references.

Appellants argue that there is no basis for combining the teachings of Kemppi with Fuwa because Kemppi suggests no need for accounting and Fuwa discloses no controlled access requirements [brief, page 10]. We do not agree with this argument because Fuwa does suggest that access would be controlled based on whether the card is valid, whether the user is a registered subscriber or whether the card has been lost or stolen. Thus, Fuwa clearly suggests that telephone access and call accounting should be combined in a single integrated circuit card. Fuwa also clearly notes the deficiencies of conventional magnetic-type credit cards, and suggests why an integrated circuit card would be an improvement over such conventional cards. Thus, Fuwa also

provides a basis why any conventional credit card would be replaced with a similar integrated circuit card.

Appellants argue that the "logic bus interface means" of claim 1 must be construed in light of the specification and that

neither of the references discloses this means [brief, page 10]. The examiner responds that the applied references have a logic bus interface means which renders the claims obvious. We note that appellants have not identified a single "corresponding structure" to the logic bus interface means which would not be suggested by the combined teachings of the prior art. We agree with the examiner that any integrated circuit card which reads data, processes data and writes data will inherently have a logic bus interface means between the processor, the memory and the card reader. Appellants have not identified any specific structure which would patentably distinguish their interface means with the interface means of the prior art, and we do not independently find any patentable differences in the apparatus.

Appellants make the same arguments with respect to the rejections on D'Avello and Harris as were made with respect to the rejection using Kempfi. These arguments are not persuasive for the same reasons discussed above. Appellants also argue that the conventional credit card systems of D'Avello and Harris would not be used with the Fuwa integrated circuit card because such use would destroy the standard credit card features of D'Avello and Harris. This argument is not persuasive because Fuwa

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specifically teaches why it would be desirable to replace conventional credit card systems with a similar integrated circuit card system. Thus, the artisan would have appreciated the obviousness of replacing the conventional credit card systems of D'Avello and Harris with similar integrated circuit card systems.

For all the reasons discussed above, each of the alternative rejections of claim 1 is sustained. With respect to the rejections of claim 4, appellants argue that D'Avello requires a host computer to determine the validity of the credit card used to make the call rather than relying on a processing means internal to the remote unit as claimed [brief, page 14]. Since Fuwa suggests that the integrated circuit card determines whether or not it is valid, we find the recitation of claim 4 clearly suggested by Fuwa which is applied in all the rejections of claim 4. Therefore, we also sustain each of the alternative rejections of claim 4.

With respect to the rejections of claim 5, appellants argue that none of the references teach the use of a maintenance card to perform system functions [brief, page 15]. The examiner

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responds that any card which is regularly used by a subscriber is maintained by that subscriber so that the card is a "maintenance card" [answer, page 23]. The examiner also defines system function as any function to do with the telephone such as dialing a number. Appellants respond that the examiner's definitions are improper because they are inconsistent with the definitions presented in their specification [reply brief, page 12]. We agree.

It is clear from the specification that a maintenance card is not a card which is maintained by a subscriber but is a card which maintains the phone system. Thus, the examiner has interpreted language of claim 5 in a manner which is clearly inconsistent with the disclosed invention. Such interpretation is improper. Since the examiner has failed to address the question of why it would have been obvious to use a maintenance card as recited in claim 5, we do not sustain any of the alternative rejections of claim 5 as presented by the examiner.

II. The rejection of claims 6-11 based upon D'Avello in view of Fuwa.

With respect to claim 6, appellants argue that there is no basis for combining the teachings of D'Avello with Fuwa. We considered this argument with respect to the rejection of claim

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1, and we find it unconvincing for the reasons discussed above. With respect to claims 7-11, appellants simply argue that these claims further restrict claim 6 and, therefore, are patentable. These are not considered separate arguments with respect to the dependent claims so that claims 7-11 stand or fall with independent claim 6. Therefore, we sustain the rejection of claims 6-11 as presented by the examiner.

III. The rejection of claims 12 and 14  
based upon D'Avello in view of Fuwa and  
further in view of Iwanami.

Appellants argue that these references are sufficiently different that there is no motivation to combine these references as proposed by the examiner [brief, page 18]. We do not agree with this position for reasons discussed above as well as reasons given by the examiner [see answer, pages 26-27]. Therefore, we sustain the rejection of claims 12 and 14.

In summary, the rejection of claims 1, 4 and 5 based on Kemppe, D'Avello or Harris in view of Fuwa is sustained with respect to claims 1 and 4 but is reversed with respect to claim 5. The rejection of claims 6-11 based on D'Avello in view of Fuwa is sustained. The rejection of claims 12 and 14 based on D'Avello in view of Fuwa and further in view of Iwanami is

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sustained. Accordingly, the decision of the examiner rejecting claims 1, 4-12 and 14 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	)	
	)	
	)	
	)	BOARD OF PATENT
LEE E. BARRETT	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
	)	
JAMESON LEE	)	
Administrative Patent Judge	)	

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Schwegman, Lundberg & Woessner, P.A.  
3500 IDS Center  
80 South Eighth Street  
Minneapolis, MN 55402