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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 34

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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***Ex parte*** TOMIO NAGAKURA

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Appeal No. 1997-1880
Application No. 08/370,222[1]

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HEARD: DECEMBER 6, 1999

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Before HAIRSTON, BARRETT, and DIXON, **Administrative Patent Judges**.

DIXON, **Administrative Patent Judge**.

## DECISION ON APPEAL

This is a decision on appeal from the Examiner's final rejection of claims 1-4, 8 and 10-12, which are all of the claims pending in this application.

We REVERSE.

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[1] Application for patent filed January 9, 1995. According to appellant, this application is a continuation of serial number 07/835,328, filed February 14, 1992.

## BACKGROUND

The appellant's invention relates to a radio pager and a method of writing information in the ROM of the radio pager. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

> 1 . A method of writing information necessary for communication in a ROM of a radio pager to which a particular type code is assigned by using a ROM writer, comprising the steps of:
>
> (a) storing in said ROM writer a single writing program for each of a plurality of types of radio pagers;
>
> (b) electrically connecting said radio pager and said ROM writer;
>
> (c) confirming the connection of said radio pager and said ROM writer;
>
> (d) sending a type code request signal from said ROM writer to said radio pager via said electrical connection;
>
> (e) sending, in response to said type code request signal, a type code signal representative of said particular type code from said radio pager to said ROM writer via said electrical connection;
>
> (f) causing said ROM writer to identify the type of said radio pager connected thereto on the basis of said type code signal;
>
> (g) causing said ROM writer to initiate said writing program corresponding to said type of said radio pager; and
>
> (h) sending said information from said ROM writer to said ROM of said radio pager to thereby write said information in said ROM.

The prior art references of record relied upon by the Examiner in rejecting the appealed claims are:

| | | |
|---|---|---|
| Webb et al. (Webb) | 4,577,060 | Mar. 18, 1986 |
| Jasinaki | 5,070,329 | Dec. 03, 1991 |

Admitted Prior Art (APA) in specification at figure 1.[2]

Claims 1-4, 8 and 10-12 stand rejected under 35 U.S.C. § 103 as being unpatentable over APA in view of Jasinaki and Webb.

Rather than reiterate the conflicting viewpoints advanced by the Examiner and the appellant regarding the above-noted rejections, we make reference to the Examiner's Answer (Paper No. 28, mailed Oct. 17, 1996) for the Examiner's reasoning in support of the rejections, and to the appellant's brief (Paper No. 27, filed Aug. 7, 1996) for the appellant's arguments thereagainst.

**OPINION**

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the Examiner. As a consequence of our review, we make the determinations which follow.

[2] Although the APA is not listed as being prior art relied upon in the Examiner's Answer, it is nonetheless applied in rejecting the appealed claims.

Appellant argues that “the references commonly fail to teach the claimed features of sending a type code request signal from a ROM writer to a radio pager, and sending, in response to the type code request signal, a type code signal representative of a particular type code from the radio pager to the ROM writer.” (See brief at page 4.) We agree with appellant. While the APA teaches general interaction between the radio pager and the ROM writer, the APA does not teach or suggest the interactive request and response between the two units.

The Examiner relies on Jasinaki to teach that a “stationary local unit can interrogate (send a request to) the pager to receive the pager[']s identity instead of having a user manually input the identity of the pager." (See answer at page 3.) We disagree with the Examiner. We find that Jasinaki merely teaches a system for automatically identifying communication receivers, including acknowledge back capability for delivering messages to the communication receivers on-site. While Jasinaki teaches interactive signaling between two units to identify the receiver, the reference does not explicitly teach that the pager type information is included nor does Jasinaki suggest the claimed interactive signaling with a ROM writer. Furthermore, Jasinaki only teaches this interaction between the on-site communication system and the radio pager, not the claimed interactive signaling with the ROM writer.

The Examiner relies on Webb to teach the transmission of pager type information in an interregional communication network for pagers. (See answer at page 3.) The Examiner has directed attention to columns 8 and 9 of Webb. We note that this portion of Webb pertains to the paging terminal rather than the radio pager and that the pager type information included in figures 4A and 4B also pertain to the paging terminal rather than the radio pager. We agree with appellant that Webb does not teach or suggest the claimed interaction of “sending a type code request signal from said ROM writer to said radio pager via said electrical connection” and “sending, in response to said type code request signal, a type code signal representative of said particular type code from said radio pager to said ROM writer via said electrical connection”, as set forth in claim 1.

Furthermore, appellant argues that there is no suggestion for combining the three teachings to achieve appellant's claimed invention. (See brief at pages 5 and 6.) We agree with appellant. Appellant further argues that if the teachings were combined, the manner in which the combination of the teachings would automatically interrogate the pager would be “entirely different” than the claimed invention. (See brief at pages 5 and 6.) We agree with appellant.

Appellant also argues the claimed invention “obviates the need for correlating the identity of the pager to its type, as well as the need for the additional circuitry

associated with this correlation." (See brief at page 7.) Again, we agree with appellant.

Therefore, we will not sustain the rejection of independent claim 1, nor its dependent claims 2-4, 8 and 12. Similarly, independent claim 10 includes a limitation that the pager type is determined from a message sent by the radio page. Therefore, we will also not sustain the rejection of claim 10 or its dependent claim 11.

**CONCLUSION**

To summarize, the decision of the Examiner to reject claims 1-4, 8 and 10-12 under 35 U.S.C. § 103 is reversed.

REVERSED

| | |
|---|---|
| KENNETH W. HAIRSTON<br>Administrative Patent Judge | ) |
| LEE E. BARRETT<br>Administrative Patent Judge | ) BOARD OF PATENT<br>) APPEALS<br>) AND<br>) INTERFERENCES |
| JOSEPH L. DIXON<br>Administrative Patent Judge | ) |

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