

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LOUIS W. SCHORNACK, CARL T. HEITSCHL, NURI G. ANTER,
NEIL BENEDITZ and JAY KINDER

Appeal No. 97-2762
Application No. 08/309,845¹

ON BRIEF

Before HAIRSTON, FLEMING, and HECKER, Administrative Patent Judges.

HAIRSTON, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 12 through 61. In an Amendment After Final (paper number 11), all of the claims were amended.

¹ Application for patent filed September 20, 1994.

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The disclosed invention relates to a method and apparatus for alternately coupling a land-line, telephonic communication device (e.g., a telephone) between a land-line link and a radio link.

Claims 12 and 52 are illustrative of the claimed invention, and they read as follows:

12. In an apparatus for alternately coupling a land-line, telephonic communication device between a land-line link and a radio link, comprising a land-line link having land-line telephone wiring that connects a land-line, telephonic communication device to the land-line's central station; a radio link that connects a land-line, telephonic communication device to a base station of the radio link; first means for coupling a land-line, telephonic communication device to said land-line link; second means for coupling the land-line, telephonic communication device to a radio link; and switching means for switching connection of a land-line, telephonic communication device between the land-line link and the radio link, the improvement comprising;

said second means for coupling the land-line, telephonic communication device to a radio link comprising a portion of said land-line telephone wiring of said land-line link, whereby a land-line, telephonic communication device is capable of placing or receiving a telephone call over the radio link by utilizing a portion of the land-line link, and alternatively placing or receiving a telephone call over the land-line link.

52. A method of coupling a land-line, telephonic communication device to a radio system, by utilizing land-line, interior-premises, telephone wiring located at a premises where the land-line telephonic communication device is to be used, comprising:

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(a) connecting at least one land-line, telephonic communication device to at least a portion of the land-line, interior-premises, telephone wiring located at the premises where the land-line, telephonic communication device is to be used for making a call over the radio system;

(b) coupling said at least a portion of the land-line, interior-premises, telephone wiring located at the premises to a radio transceiver which is part of a radio system; and

(c) said step (b) comprising coupling said at least a portion of the land-line, interior-premises, telephone wiring located at the premises to a radio interface that is coupled to said radio transceiver.

The reference relied on by the examiner is:

Shitara et al. (Shitara) 4,833,702 May
23, 1989

Claims 12 through 17, 20, 22, 29 through 34, 37 and 46 through 57 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Shitara.

Claims 18, 19, 21, 23 through 28, 35, 36, 38 through 45 and 58 through 61 stand rejected under 35 U.S.C. § 103 as being unpatentable over Shitara.

Reference is made to the briefs and the answers for the respective positions of the appellants and the examiner.

OPINION

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We have carefully considered the entire record before us, and we will sustain the rejections as to claims 29 through 45 and 47 through 61, and we will reverse the rejections as to claims 12 through 28 and 46.

The examiner's analysis of the teachings of Shitara is as follows (Answer, page 4):

Consider claims 12-17, 20, 22, 29-34, 37, 46-57. Shitara et al. disclose in figure 1 an apparatus (5) for alternately coupling a landline telephone (7) to either a landline link or a radio link comprising first means (6) for coupling the landline telephone to a landline link to the central station (8) of a telephone network; second means (i.e. the wiring coupling the landline telephone to the PBX 5) for coupling the landline telephone to a radio link via the radio transceiver units (2); switching means (in the PBX 5) for switching a connection between the landline link and the radio link. As is clear from the figure, if the landline telephone places a call to a radiotelephone (1), then the connection to the radio network is via a part of the landline (i.e. via the wiring coupling the phone 7 to the PBX 5) before the actual radio link commences and, alternatively, if the landline telephone places or receives a call over the landline link (i.e. via the PSTN), a portion of this landline link is utilized (i.e. the same interior premises telephone wiring coupling the landline telephone to the PBX).

Appellants argue (Brief, page 6) that:

The language used in the claims, as delimited by the specification, is directed to alternately connecting a land-type phone to one of a switched, land-line telephone network or to a radio system, such as the

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switched cellular system having many base stations for handing off. Thus, claim 12 recites, "In an apparatus for alternately coupling a land-line, telephonic communication device between a land-line link and a radio link". Since the claims are not read in a vacuum, but in light of the specification, the radio link is like the land-line link in that both are separate and distinct telephone systems. (Emphasis added).

Insofar as claim 12 is concerned, we agree with appellants' argument. The claim 12 apparatus for alternately coupling a land-line, telephonic communication device between a land-line link and a radio link comprises a wired link that connects a land-line, telephonic communication device and the land-line's central station, and a radio link that connects a land-line, telephonic communication device to a base station. Inasmuch as the radio link that connects the land-line, telephonic device to the base station differs from the wired link that connects the land-line, telephonic device and the land-line's central station, we agree with appellants that claim 12 is directed to "separate and distinct telephone systems" (Brief, page 6). Shibata discloses a single telephone system (Figure 1) in which a telephone 7 has a wired link to a central station 8, and a radio link to a plurality of telephones 1-1 through 1-m. Although a radio link exists

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between the telephone 7 and the plurality of telephones 1-1 and 1-m, the radio link does not connect the telephone 7 to the access units (i.e., base stations) 2-1 through 2-l as required by claim 12. The examiner recognizes this by stating (Answer, page 4) "if the landline telephone places a call to a radiotelephone (1), then the connection to the radio network is via a part of the landline (i.e. via the wiring coupling the phone 7 to the PBX 5) before the actual radio link commences." (Emphasis added).

Based upon the foregoing, the 35 U.S.C. § 102(b) rejection of claim 12 is reversed because Shibata discloses a wired link as opposed to a "radio link that connects a landline, telephonic communication device to a base station of the radio link." As a result of the reversal of the 35 U.S.C. § 102(b) rejection of claim 12, the 35 U.S.C. § 102(b) rejection of dependent claims 13 through 17, 20 and 22, and the 35 U.S.C. § 103 rejection of dependent claims 18, 19, 21 and 23 through 28 are likewise reversed.

If the claimed "second means" corresponds to "the wiring coupling the landline telephone to the PBX 5" (Answer, page 4), then we agree with appellants' argument (Reply Brief, page

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2) that it cannot also correspond to a "cellular-transceiver interface means" (claim 46). Accordingly, the 35 U.S.C. § 102(b) rejection of claim 46 is reversed.

Turning to the 35 U.S.C. § 102(b) rejection of claims 29 through 34, 37 and 47 through 57, appellants' argument (Brief, page 7) that "the definition set forth in the specification for the terms 'land-line link' and 'radio link' clearly mean an entire system, such as the switched land-line system or the switched cellular system" is not commensurate in scope with the apparatus and method set forth in these claims. Other than claim 12, and the claims that depend therefrom, none of the claims on appeal recites a radio link from the land-line, telephonic communication device to a base station. For example, claim 29 and the claims that depend therefrom broadly recite a "second means for coupling a land-line, telephonic communication device to a radio link," claim 47 and the claims that depend therefrom broadly recite a "means for coupling said plurality of land-line, telephonic communication devices to said at least one radio transceiver," and claim 52 and the claims that depend therefrom broadly recite "coupling said at least a portion of the land-line, interior-premises, telephone

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wiring located at the premises to a radio transceiver which is part of a radio system." Since appellants has not argued that the claims should be interpreted with the sixth paragraph of 35 U.S.C. § 112 in mind, we will apply a broadest reasonable interpretation to these claims. In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997).

We agree with appellants' argument (Brief, page 7) that "[t]he claims cannot be read in a vacuum and divorced from the specification, but must be construed in light of the specification." On the other hand, it is improper to narrow the scope of the claims by implicitly reading into the claims limitations from the specification which have no express basis in the claims. In other words, appellants are not permitted to engage "in a *post hoc* attempt to redefine the claimed invention by impermissibly incorporating language appearing in the specification into the claims." In re Paulsen, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994). Thus, the "second means" in claim 29, the "means for coupling" in claim 47, and the "coupling" step of claim 52 all read on "the wiring coupling the landline telephone [7] to the PBX 5 . . .

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for coupling the landline telephone to a radio link via the radio transceiver units (2)" (Answer, page 4).

Appellants' arguments (Brief, pages 11 and 12) that the wires 4 of Shitara are only used to connect the telephone 7 to the radio-linked telephones 1-1 through 1-m are correct. As indicated by the examiner (Answer, page 4), however, the wiring coupling the telephone 7 to the PBX is used to connect the telephone 7 to both the central station 8 and to the radio telephones.

Inasmuch as the examiner has responded (Answer, pages 7 through 11) to all of appellants' arguments concerning claims 29 through 34, 37 and 47 through 57, we see no need to repeat that which is clearly explained by the examiner. Thus, the 35 U.S.C. § 102(b) rejection of claims 29 through 34, 37 and 47 through 57 is sustained.

Turning lastly to the obviousness rejection of claims 35, 36, 38 through 45 and 58 through 61, we are in agreement with the examiner's reasoning for the rejection (Answer, pages 5 and 6), and the examiner's response (Answer, pages 6 through 11) to appellants' arguments (Brief, pages 14 through 16; Reply Brief, pages 1 through 3). With respect to the "hook-

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flash means" of claims 35, 36 and 38, and the "call-waiting means" of claims 40, 41, 44 and 58 through 61, for example, we agree with the examiner (Answer, page 10) that:

However, the call waiting feature claimed by the appellant is used by an ordinary landline telephone. With this conventional call waiting feature, it does not matter whether the user of the landline telephone is communicating via a land-line link with another landline telephone or via landline and radio links for communicating with a radio phone (e.g. a cellular phone). The call waiting feature of the landline telephone will still operate the same in either situation. For example, if the user is communicating on his landline telephone with another landline telephone and the user receives a "call waiting tone" indicative of a call being received from a cellular phone caller calling the user, the user need only actuate the "hook-flash" button on his landline phone to alternately couple his phone to either the landline phone or the cellular phone. This would then couple the user's phone to either the landline network servicing the other landline phone or the radio network servicing the cellular phone.

Appellants have not presented an argument to rebut the examiner's reasoning concerning the "hook-flash means" and the "call-waiting means."

Appellants argue (Brief, pages 15 and 16) the non-obviousness of a "plurality" of land-line, telephonic communications-devices connected to a portion of the interior, premises-located telephone wiring (claim 39). We are of the

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opinion that it would have been manifestly obvious to one of ordinary skill in the art to connect a plurality of telephones 7 to the PBX in Shitara.

In summary, the 35 U.S.C. § 103 rejection of claims 35, 36, 38 through 45 and 58 through 61 is sustained.

DECISION

The decision of the examiner is affirmed as to claims 29 through 45 and 47 through 61, and is reversed as to claims 12 through 28 and 46.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED-IN-PART

KENNETH W. HAIRSTON)	
Administrative Patent Judge)	
)	
)	
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)	BOARD OF PATENT
MICHAEL R. FLEMING)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES

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APJ FLEMING

APJ HECKER

DECISION: AFFIRMED-IN-PART
Send Reference(s): Yes No
or Translation (s)
Panel Change: Yes No
Index Sheet-2901 Rejection(s): _____

Prepared: September 27, 1999

Draft Final

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OB/HD GAU

PALM / ACTS 2 / BOOK
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