

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte SVEN J. LANTTO  
and MATS O. STILLE

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Appeal No. 1998-0644  
Application 08/637,588

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ON BRIEF

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Before THOMAS, JERRY SMITH and HECKER, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 22-26, which constitute all the claims remaining in the application.

The invention pertains to a method for handling a request for a new call from a mobile station which is

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currently in an active call state. More particularly, the invention is directed to reducing the amount of communications required between the mobile station and the central network.

Representative claim 22 is reproduced as follows:

22. A signalling method for a radiocommunication system having a mobile station and a network comprising the steps of:

establishing an active call between said mobile station and said network;

transmitting a signal from said mobile station to said network requesting that a new call be established;

detecting, in said network, said established active call;

interpreting, in said network, said signal as a request to place on hold said active call; and

establishing said new call.

The examiner relies on the following references:

Barnes et al. (Barnes)	4,829,554	May 9, 1989
Pugh et al. (Pugh)	5,414,754	May 9, 1995
		(filed July 9, 1992)

Claim 24 stands rejected under 35 U.S.C. § 112, second paragraph, for failing to particularly point out and distinctly claim the invention. Claims 22 and 23 stand rejected under 35 U.S.C. § 102(b) as being anticipated by the disclosure of Barnes. Claims 24-26 stand rejected under 35

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U.S.C. § 103. As evidence of obviousness the examiner offers Pugh in view of Barnes.

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

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner, the arguments in support of the rejections and the evidence of anticipation and obviousness relied upon by the examiner as support for the prior art rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the brief 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 claim 24 particularly points out the invention in a manner which complies with 35 U.S.C. § 112. We are also of the view that the disclosure of Barnes fully meets the invention as set forth in claims 22 and 23. Finally, we are of the view that the collective evidence relied upon and the

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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 24 and 25. We reach the opposite conclusion with respect to claim 26. Accordingly, we affirm-in-part.

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We consider first the rejection of claim 24 under the second paragraph of 35 U.S.C. § 112. The examiner's rejection indicates that, in the examiner's view, claim 24 does not correspond in scope to what appellants regard as their invention [answer, pages 3-4]. Appellants respond that claim 24 sets forth exactly what they consider to be their invention and that claim 24 unambiguously informs those skilled in the art what is being claimed [brief, pages 4-5].

The general rule is that a claim must set out and circumscribe a particular area with a reasonable degree of precision and particularity when read in light of the disclosure as it would be by the artisan. In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971). Acceptability of the claim language depends on whether one of ordinary skill in the art would understand what is claimed in light of the specification. Seattle Box Co., v. Industrial Crating & Packing, Inc., 731 F.2d 818, 826, 221 USPQ 568, 574 (Fed. Cir. 1984).

We agree with appellants that the artisan having considered the specification of this application would have no difficulty ascertaining the scope of the invention recited in

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claim 24. The examiner has not identified why the scope of the invention recited in claim 24 would not be understood by the artisan. Instead, the examiner simply disagrees with appellants that claim 24 is consistent in scope with their invention. It is an applicants' right to define what the invention is, and the scope of that invention can be claimed as broadly as the prior art allows. We find that the metes and bounds of the invention recited in claim 24 would be clear to the artisan when considered in light of the specification. Therefore, the rejection of claim 24 under the second paragraph of 35 U.S.C. § 112 is not sustained.

We now consider the rejection of claims 22 and 23 under 35 U.S.C. § 102(b) as being anticipated by the disclosure of Barnes. Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.); cert. dismissed, 468 U.S. 1228 (1984); W.L. Gore and Associates, Inc. v. Garlock, Inc., 721

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F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

The examiner quotes several portions of Barnes in support of his position that Barnes fully meets the claimed invention [answer, pages 4-7]. Appellants argue that Barnes does not teach or suggest the step of interpreting a new call signal in the network as a request to place the active call on hold [brief, page 5]. We have carefully considered the record in this case, and we agree with the examiner that Barnes anticipates the invention as set forth in claims 22 and 23.

The starting point for any analysis of anticipation has to be a consideration of the scope of the claimed invention. A key feature of the examiner's rejection is the examiner's interpretation that to place a call on hold broadly means that a telephone connection is maintained. The examiner points to the request for a conference call in Barnes as meeting the recitations of claims 22 and 23. When an ongoing call by a mobile unit is taking place in Barnes, and the user desires to add an additional instrument, Barnes discloses that the connection between the original two parties is maintained while the call is placed to the telephone instrument to be

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added [column 28, line 64 to column 29, line 30]. Based upon the examiner's broad interpretation of the claims, Barnes teaches that the signal requesting that an instrument be added acts as a request to maintain the original call or to place the original call on "hold" within the broad meaning of that term.

Although appellants argue that Barnes does not teach the step of interpreting a new call signal as a request to place the active call on hold, they never address the examiner's position that maintaining a call connection between the original parties broadly meets the language of placing a call on hold. We agree with the examiner that if his broadest interpretation of the claim is acceptable, then the scope of claim 22 is met by the request to add an additional instrument as disclosed by Barnes. We find merit in the examiner's claim interpretation which has essentially gone unchallenged by appellants. Therefore, we sustain the examiner's rejection of claim 22 under 35 U.S.C.

§ 102.

With respect to claim 23, appellants argue that they cannot find any teaching in Barnes for a call reference value

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which identifies the new call but does not identify the active call [brief, page 7]. When the request for a new call occurs in Barnes, the user must transmit the new telephone number to the network. We interpret this new telephone number as being the claimed call reference value. Since this value identifies the new call but does not identify the active call, the recitation of claim 23 is fully met. Therefore, we also sustain the rejection of claim 23 under 35 U.S.C. § 102.

We now consider the rejection of claims 24-26 under 35 U.S.C. § 103 as unpatentable over the teachings of Pugh in view of Barnes. In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art

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as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden 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 Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Passaic, 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). Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could

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have made but chose not to make in the brief have not been considered [see 37 CFR § 1.192(a)].

The examiner's rejection takes the position that Pugh teaches all the features of these claims except for the step of transmitting a single signal which requests a new call without sending a request to put the active call on hold. The examiner cites Barnes as teaching this feature and asserts the obviousness of automatically placing an active call on hold when a request for a new call is received [answer, pages 7-10].

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With respect to claim 24, appellants' only argument is that Barnes does not teach a "single signal transmitted from a mobile station to a network requesting the network to setup a new call, which signal does not include a request to put the active call on hold, in response to which the network **does** place the active call on hold" [brief, pages 7-8]. In view of the examiner's broad interpretation of placing a call on hold and our discussion above with respect to claim 22, we agree with the examiner that the request to add an additional instrument in Barnes has the effect of also placing the active call on hold without a separate request to do so. Since appellants' argument is not persuasive of error in the rejection of claim 24, we sustain the examiner's rejection of claim 24 under 35 U.S.C.

§ 103. Since claim 25 has the same recitation as claim 23, we also sustain the rejection of claim 25 for the reasons discussed above.

With respect to claim 26, appellants argue that "there is absolutely no disclosure in Pugh et al of receiving a request for transmitting DTMF tones and in response thereto

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deciding to transmit DTMF tones to equipment associated with an active call rather than equipment associated with a call on hold" [brief, page 9]. We agree with appellants.

The examiner has never specifically addressed the limitations of claim 26. Claim 26 is different from the other claims in that the method operates when a mobile unit has both an active call and a call on hold at the same time. The claimed method requires that DTMF tones be sent to the party associated with the active call rather than the party associated with the call on hold. We can find nothing in the applied references nor anything identified by the examiner which teaches or suggests this operation. Therefore, the examiner has failed to establish a prima facie case of obviousness. Accordingly, we do not sustain the examiner's rejection of claim 26 under 35 U.S.C.

§ 103.

In summary, we have sustained the rejections of claims 22-25 based on prior art. We have not sustained the rejection of claim 26 nor the rejection of claim 24 under 35 U.S.C. § 112, second paragraph. Therefore, the decision of the examiner rejecting claims 22-26 is affirmed-in-part.

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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

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JAMES D. THOMAS	)	
Administrative Patent Judge	)	
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	)	
	)	BOARD OF PATENT
JERRY SMITH	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
	)	
STUART N. HECKER	)	
Administrative Patent Judge	)	

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