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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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GUIDO BERTOCCI

Appeal No. 1998-1393
Application No. 08/498,306¹

HEARD: November 2, 1999

Before THOMAS, FLEMING, and BARRY, Administrative Patent Judges.
BARRY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the final rejection of claims 4 and 11. The appellant filed an amendment after final rejection on May 2, 1997, which was entered. We affirm.

¹ The application was filed on July 5, 1995.

BACKGROUND

The invention at issue in this appeal relates to telephony. Cordless telephones comprise two units: a base unit and a handset unit. The invention incorporates features into its handset unit that were previously available only at a base unit. Specifically, a call screening feature allows a user at the handset unit to listen to a message received over telephone lines as it is being recorded by a telephone answering device within the base unit. In addition, a caller-identification (-ID) feature informs the user at the handset unit of the identity of a calling party before the associated call is answered.

Claim 4, which is representative for our purposes, follows:

4. A cordless telephone system comprising:
a base unit for connecting to a telephone line and for receiving a ring signal over said line, said base unit including a telephone answering device for responding to an incoming ring signal detected on said line by going from an on-hook state to an off-hook state on said line, a caller-ID device for identifying a caller-ID signal detected on said line, memory means for storing a telephone number for comparing with said caller-ID signal and a voice message associated with said telephone number, and

said base unit further including a first radio frequency transmitter for transmitting a first plurality of information codes and a first radio frequency receiver for receiving a second plurality of information codes;

a handset unit with a second radio frequency transmitter and a second radio frequency receiver for respectively transmitting the second plurality of information codes to the first receiver and receiving the first plurality of information codes from the first transmitter in the base unit, said handset unit including loudspeaking means for generating an audible acoustic signal upon receipt of both a first and a second one from said first plurality of information codes, said first one from said first plurality of information codes being indicative of a coincidence between said stored telephone number and said caller-ID signal, and said second one from said first plurality of information codes being provided by said base unit for audibly reproducing an incoming message being recorded in said telephone answering device; and

control means in said handset unit for activating said loudspeaking means in response to receipt of said first one from said first plurality of information codes for generating at the handset unit said voice message associated with said telephone number and in response to receipt of said second one from said plurality of information codes for audibly reproducing at the handset unit said incoming message being recorded in the telephone answering device, said control means further including means for deactivating said loudspeaking means in response to receipt of a third one from said first plurality of information codes, said third one from said first plurality of information codes being provided by said base unit upon said telephone answering device returning to an on-hook state.

The references relied on in rejecting the claims follow:

Fujioka	4,894,861	Jan. 16, 1990
Patsiokas et al. (Patsiokas)	5,063,588	Nov. 5, 1991
Hasegawa	5,253,287	Oct. 12, 1993.

Claims 4 and 11 stand rejected under 35 U.S.C. § 103 as obvious over Hasegawa in view of Fujioka and Patsiokas. Rather than repeat the arguments of the appellant or examiner in toto, we refer the reader to the brief and answer for the respective details thereof.

OPINION

In reaching our decision in this appeal, we considered the subject matter on appeal and the rejection and evidence advanced by the examiner. Furthermore, we duly considered the arguments of the appellant and examiner. After considering the totality of the record, we are not persuaded that the examiner erred in rejecting claims 4 and 11. Accordingly, we affirm. Our opinion addresses the grouping and obviousness of the claims.

Grouping of the Claims

37 C.F.R. § 1.192(c)(7), as amended at 60 Fed. Reg. 14518 (Mar. 17, 1995), was controlling when the appeal brief was filed. Section 1.192(c)(7) stated as follows.

For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together and, in the argument under paragraph (c)(8) of this section, appellant explains why the claims of the group are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable.

In addition, claims that are not argued separately stand or fall together. In re Kaslow, 707 F.2d 1366, 1376, 217 USPQ 1089, 1096 (Fed. Cir. 1983).

The appellant states that claims 4 and 11 stand or fall together for the appeal. (Appeal Br. at 3.) Conversely, the appellant omits a statement that claims 4 and 11 do not stand or fall together and reasons why the claims are separately patentable. Therefore, we consider the claims to stand or

fall together, with claim 4 as the representative claim of the group. Next, we address the obviousness of the claims.

Obviousness of the Claims

We begin our consideration of the obviousness of the claims by finding that the references represent the level of ordinary skill in the art. See In re GPAC Inc., 57 F.3d 1573, 1579, 35 USPQ2d 1116, 1121 (Fed. Cir. 1995) (finding that the Board of Patent Appeals and Interference did not err in concluding that the level of ordinary skill in the art was best determined by the references of record); In re Oelrich, 579 F.2d 86, 91, 198 USPQ 210, 214 (CCPA 1978) ("[T]he PTO usually must evaluate ... the level of ordinary skill solely on the cold words of the literature."). Of course, every patent application and reference relies on the knowledge of persons skilled in the art to complement its disclosure. In re Bode, 550 F.2d 656, 660, 193 USPQ 12, 16 (CCPA 1977). Such persons must be presumed to know something about the art apart from what the references teach. In re Jacoby, 309 F.2d 513, 516, 135 USPQ 317, 319 (CCPA 1962). The appellant make two

arguments regarding the obviousness of claims 4 and 11. We address these seriatim.

First, the appellant argues, "one skilled in the art would not look to Fujioka to achieve the automatic screening operation in a cordless telephone handset unit as applicants [sic] have disclosed and claimed." (Appeal Br. at 4.) The examiner replies, "Fujioka teaches that it is known in the telephony art (including wireless telephony) to provide voice notification when a particular caller id matches a list stored in memory at the telephone." (Examiner's Answer at 8.) We agree with the examiner.

The appellant errs in determining the scope of the prior art. A reference is analogous art if it is within the field of an inventor's endeavor or is reasonably pertinent to the particular problem with which the inventor was involved. In re Oetiker, 977 F.2d 1443, 1447, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992); In re Clay, 966 F.2d 656, 658-59, 23 USPQ2d 1058, 1060 (Fed. Cir. 1992). Furthermore, a reference is reasonably pertinent if, because of the matter with which it deals, it

logically would have commended itself to the inventor's attention in considering his problem. If the reference's disclosure has the same purpose as the claimed invention, the reference relates to the same problem, and that fact supports use of that reference in a rejection. An inventor may have been motivated to consider the reference when making his invention. Clay, 966 F.2d at 659, 23 USPQ2d at 1061.

Here, a problem with which the appellant are involved is the "caller-ID feature," (Spec. at 2), which informs a user "of the identity of a pre-identified calling party before the call is answered." (Id.) Similarly, the problem that Fujioka solves relates to "telephone networks ... [that] offer an originating number notifying service" Col. 1, ll. 15-17. The reference "enables the terminating subscriber of a c[all] from a registered originating party to judge the originating party from an audible indication" Id. at ll. 37-40. Accordingly, both the claimed invention and Fujioka address the problem of caller-identification. Therefore, the reference reasonably pertains to the particular problem with which the appellant was involved and is analogous art.

Second, the appellant summarizes the remainder of his arguments as follows.

There is ... no disclosure or suggestion provided in any of these cited references, of a voice message being stored in memory in a base unit of a cordless telephone and then being transmitted to a handset unit, also in the cordless telephone, where the voice message is generated in a loudspeaker in the handset unit. (Appeal Br. at 5.)

The examiner replies, "Since the cited references disclose that it is known in the art to forward caller identification information (whether visual or audible), the combination of Hasegawa, Fujioka, and Patsiokas renders the present invention obvious" (Examiner's Answer at 8-9.) We agree with the examiner.

The appellant errs in considering the references individually. "Non-obviousness cannot be established by attacking references individually where the rejection is based upon the teachings of a combination of references." In re Merck & Co., 800 F.2d 1091, 1097, 231 USPQ 375, 380 (Fed. Cir. 1986) (citing In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981)). In determining obviousness, furthermore,

references are read not in isolation but for what they fairly teach in combination with the prior art as a whole. Id. at 1097, 231 USPQ at 380.

Here, the rejection is based on the combination of Hasegawa, Patsiokas, and Fujioka. The appellant admits that Hasegawa "describes a cordless telephone system" (Appeal Br. at 3.) As is conventional, the system of the reference includes a base unit 1 and a handset unit 4. Fig. 1. The appellant further admits that Hasegawa's system "includes an answering system for automatically answering an incoming call from another terminal through a telephone line." (Appeal Br. at 3.) Moreover a, call monitoring feature of the reference allows a user at a handset unit to listen to a message received over telephone line 2 as it is being recorded by an automatic recording circuit 14 within the base unit. Col. 6, ll. 33-36, 62-66.

Patsiokas teaches a caller-ID feature that, the appellant admits, "provides called subscribers with the identity of calling subscribers." (Appeal Br. at 4.) When a caller 106

wants to speak with a subscriber 106', the caller 106 transmits a call request 112 to a central station. The call request includes data identifying the caller, i.e., caller-ID data. The central station transfers the caller-ID data to the subscriber. The reference permits a "called subscriber [to] decide whether to answer a call received during a meeting, interview, conference or the like, or during periods when the called party would rather not be interrupted." Col. 1, ll. 32-36. In short, Patsiokas teaches the desirability of providing caller-ID data to the portable units of a communications system.

The combined teachings of Hasegawa and Patsiokas (collectively Hasegawa-Patsiokas) would have suggested providing Patsiokas's caller-ID data to Hasegawa's handset. The motivation to do so would have been to permits a user to decide whether to answer a call.

The appellant also admits, "Fujioka teaches the pre-registering of subscribers' telephone numbers so that when any one of the registered subscribers' number coincides with the

originating subscriber's number, the termination subscriber can know the originating party from the audible indication before answering the call." (Appeal Br. at 4.) The appellant further admits, "Fujioka employs a caller-ID device for use in identifying a caller for audibly announcing that caller via a speaker" (Id.) Specifically, the reference provides a voice message containing "ID information such as the originating subscriber's name." Col. 4, ll. 38-39.

Fujioka teaches that the caller-ID feature generally "can be used to eliminate the necessity of answering unwanted harassing calls or frequent sales calls" Col. 6, ll. 7-9. The reference's use of the voice message to provide caller-ID information specifically, enables a user to identify a caller when the user is away from his telephone. Col. 1, ll. 25-29.

The combined teachings of Hasegawa-Patsiokas and Fujioka would have suggested providing Fujioka's caller-ID voice message to Hasegawa's handset. The motivation to do so would have been to permit a called subscriber to decide whether to

answer a call when he is too far from the handset to read a visual indication of caller-ID data.

In summary, the combined teachings of the references would have suggested storing a voice message in memory in a base unit of a cordless telephone and then transmitting the message to a handset unit, also in the cordless telephone, where the voice message is generated in a loudspeaker in the handset unit. For the foregoing reasons, the examiner has established a prima facie case of obviousness. Therefore, we affirm the rejection of claims 4 and 11.

We end our consideration of the obviousness of the claims by noting that the aforementioned affirmance is based only on the arguments made in the brief. Arguments not raised in the brief are not before us, are not at issue, and are thus considered waived.

CONCLUSION

To summarize, the examiner's rejection of claims 4 and 11 under 35 U.S.C. § 103 is affirmed.

No period for taking subsequent action concerning this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

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