

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 32

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN D. BYRNE

Appeal No. 1999-1109
Application No. 08/359,904

ON BRIEF

Before RUGGIERO, LALL, and GROSS, Administrative Patent Judges.
LALL, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the Examiner's final rejection¹ of claims 1-15 and 17-21.

¹ On the latest final rejection, Paper No. 25, the Examiner objects to claims 7 and 10. Also, in the Examiner's answer, Paper No. 28, the Examiner withdraws the 103 rejection as to claims 7, 10, 16 and 20, see page 3. However, we note that only claim 16 is free from any kind of rejection either under 35 U.S.C. § 112 first or second paragraph or under 35 U.S.C. § 103. Therefore, for one reason or another all these claims are on appeal, except for claim 16 which is indicated to be allowable.

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The disclosed invention is related to a radio telephone that can be used in at least two radio telephone systems. The telephone switches between the two radio telephone systems based upon the velocity of the telephone. Thus, if a user is moving relatively slowly, such as when walking or standing still at home or in an office, the telephone will be used with a first system, such as a cordless based station. However, if a user is moving relatively fast, such as in a car, the telephone will switch to a second system, such as a system having a cellular or satellite based station. A further understanding of the invention can be obtained by the following claim.

1. A radio telephone operative in at least two radio telephone systems, the radio telephone comprising communication means respectively associated with each of the radio telephone systems, at least one of the radio telephone systems being a cellular system and at least one of the radio telephone systems being a non-cellular system, sensing means for sensing the velocity of movement of the radio telephone, and selection means responsive to the sensing means for selecting one of respective said communication means for the said telephone systems in dependence, wholly or partially, on the sensed velocity.

The Examiner relies on the following references:

Benveniste	5,345,499	Sep. 6, 1994
		(filed Mar. 23, 1992)

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Gudmundson et al. (Gudmundson)	5,392,453	Feb. 21, 1995 (filed July 19, 1992)
Shiotsuki et al. (Shiotsuki)	5,436,956	July 25, 1995 (filed July 19, 1993)
Ivanov et al. (Ivanov)	5,513,380	Apr. 30, 1996 (filed Feb. 14, 1994 ²)
Tanaka Japanese Patent	61-245639	Oct. 31, 1986
Kojima Japanese Patent	1-73925	Mar. 20, 1989
Ramsdale et al. (Ramsdale) United Kingdom Patent Application	2,242,805	Oct. 9, 1991
Chia International Appl.	WO 92/12602	July 23, 1992
Yamada United Kingdom Patent	2,252,699	Aug. 12, 1992
Schellinger et al. (Schellinger) International Appl.	WO 93/16548	Aug. 19, 1993
Mende, W., "On the Hand-Over Rate in Future Cellular Systems", IEEE, pgs. 358-362, (1988) (Mende)		

² The filing date of the instant application predates the filing date of this reference. However, this reference is not critical to the rejections on appeal as it is only used in the alternative.

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Claims 17-20 stand rejected under 35 U.S.C. § 112 first paragraph for lack of written description. Claims 2-10 and 17-20 stand rejected under 35 U.S.C. § 112, second paragraph. Claims 11-13, 15 and 21 stand rejected under 35 U.S.C. § 102 as anticipated by Gudmundson. Claims 11-13 and 21 stand rejected under 35 U.S.C. § 102 as anticipated by Chia. Claims 1, 2, 8 and 9 stand rejected under 35 U.S.C. § 103 as being unpatentable over Chia in view of Schellinger. Claims 3-5 and 14 stand rejected over 35 U.S.C. § 103 over Chia, Schellinger and Shiotsuki. Claims 17-19 stand rejected under 35 U.S.C. § 103 over Chia in view of Tanaka and Benveniste or Ivanov or Kojima or Ramsdale or Yamada or Mende.

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Rather than repeat the arguments of Appellant and the Examiner, we make reference to the briefs³ and the answer for their respective details thereof.

OPINION

We have considered the rejections advanced by the Examiner and the supporting arguments. We have, likewise, reviewed the Appellant's arguments set forth in the briefs.

We affirm.

At the outset, we note that there are a number of grounds of rejection in this case. We will consider each ground of rejection separately.

³ The principal brief was filed as Paper No. 20 on September 2, 1997. The Examiner mailed out the last final rejection as Paper No. 25 on February 19, 1998, after the principal brief and a prior Examiner's answer, Paper No. 21, a prior reply brief, Paper No. 22, and a second prior reply brief, Paper No. 24. Appellant filed a supplemental appeal brief, Paper No. 26, in which he referred to the principal appeal brief, Paper No. 20, and merely supplemented the arguments given in that brief by this supplemental brief. The Examiner mailed out the last Examiner's answer, Paper No. 28, which forms the basis of our decision. Appellant filed the last reply brief, Paper No. 29, in response to the Examiner's answer. The Examiner noted entry of this last reply brief, see Paper No. 30, without any further response.

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35 U.S.C. § 112, first paragraph, written description

On page 4 of the Examiner's answer, the Examiner rejects claims 17-20 under this ground of rejection as the claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. Specifically, the Examiner asserts, *id.*

at 4, that "[a]lthough it does adequately mention that other device can be use (sic) to measure 'user velocity,' nothing about 'absolute velocity,' and it does not state anywhere it has no regard to relative velocity of the telephone relative to the base station." Appellant argues, brief (Paper No. 20) at page 5, that "[f]or example, page 5, lines 8-11 of the Application describe use of a car speedometer. A car speedometer senses absolute velocity without regard to relative velocity of the telephone relative to the base station."

The written description requirement serves "to ensure that the inventor had possession, as of the filing date of the

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application relied on, of the specific subject matter later claimed by him;

how the specification accomplishes this is not material." In re Wertheim, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976). In order to meet the written description requirement, the appellants do not have to utilize any particular form of disclosure to describe the subject matter claimed, but "the description must clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed." In re Gosteli, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989). Put another way, "the applicant must ... convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention." Vasilkov-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). Finally, "[p]recisely how close the original description must come to comply with the description requirement of section 112 must be determined on a case-by-case basis." Eiselstein v. Frank, 52 F.3d 1035, 1039, 34 USPQ2d 1467, 1470 (Fed. Cir. 1995)

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(quoting Vasilkov-Cath, 935 F.2d at 1561, 19 USPQ2d at 1116).

We have reviewed the specification at page 5 and we agree with Appellant that a mention is made of a car speedometer as well as an inertial navigation unit as examples of the types of device which can be used to measure the velocity. However, the specification leaves the possibility that the velocity can be of any type of velocity and not necessarily restricted to absolute velocity which is shown by the examples. Thus, the specification states at page 5 that "[t]he network may then either command the terminal to change to the macro-cellular system or advise the terminal of its detected velocity, enabling the terminal to make the decision about system change over." We note that this statement does not restrict itself to the absolute velocity which is to be used in this determination of the terminal change over. Therefore, we agree with the Examiner that the specification lacks the support of the written description which would enable an artisan to appreciate that the inventor had possession of the invention regarding restricting the system to the absolute velocity. Therefore, we sustain the rejection of claims 17-20 under 35 U.S.C. § 112, first paragraph for lack of written description.

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Rejection under 35 U.S.C. § 112, second paragraph

The Examiner rejects claims 2-10 and 17-20 under this ground of rejection on page 5 of the Examiner's answer. With respect to claim 17, the Examiner contends, *id.*, that "Claim 17 is confusing since terms '*absolute velocity*' and '*relative velocity*' are undefined in the specification." Appellant at page 6 of the principal brief argues that "[t]he specification describes various ways to sense velocity of the telephone including use of a car speedometer, inertial navigation unit, GPS satellite navigation system, etc. Clearly, these do not measure or sense relative velocity of the telephone relative to the base station. They are used to sense non-relative or absolute velocity."

Regarding claim 2, the Examiner asserts, answer at page 5, that "[c]laim 2 is confusing since both of the telephone systems are cellular, while the parent claim state (sic) one must be a non-cellular." Appellant argues, principal brief at page 6, that "claim 2 includes three telephone systems; one non-cellular and two cellular."

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The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). In making this determination, the definiteness of the language employed in the claims must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. id.

The Examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. § 112, second paragraph, is whether the claims meet the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available. Some latitude in the manner of expression and the aptness of terms is permitted even though the claim language is not as precise as the Examiner might desire. If the scope of the invention sought to be patented cannot be determined from the language of the claims with a reasonable degree of certainty, a rejection of the claims under 35 U.S.C. § 112, second paragraph, is appropriate.

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With respect to claim 17, we are of the opinion that the absolute velocity terms and the relative velocity terms are not clearly defined in the specification as we have explained above regarding the written description requirement. Thus, we agree with the Examiner that claim 17 and dependent claims 18-20 are indefinite under 35 U.S.C. § 112, second paragraph. Regarding claim 2, however, we agree with Appellant that claim 1, the parent claim of claim 2, is not restricted to only two telephone systems. Appellant is correct in arguing that claim 2 contains three telephone systems and it is not in conflict with the language of claim 1. Therefore, we do not sustain the rejection of claim 2 and its dependent claims 3-10 under 35 U.S.C. § 112, second paragraph.

Rejections under 35 U.S.C. § 102

There are two sets of rejections under this ground of rejection using two different references. Before we discuss any

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rejection we cite below the well established law for this ground of rejection.

A prior art reference anticipates the subject of a claim when the reference discloses every feature of the claimed invention, either explicitly or inherently, See Hazani v. Int'l Trade Comm'n, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed. Cir. 1997) and RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984).

We now consider each of the references separately.

Gudmundson

Examiner rejects claims 11-13, 15 and 21 as anticipated by Gudmundson. The Examiner, at pages 5 and 6 of the answer, explains in detail the rejection of these claims. In particular, the Examiner, inter alia, makes reference to figure 5 of Gudmundson. Appellant argues, brief at page 8, "Gudmundson et al. only relates to use of a radio telephone in a single type of radio telephone system; such as a TDMA system or a CDMA system. The single radio telephone system is divided up in different cell layers"

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Further, with respect to claim 11, Appellant argues, brief at page 9, that this claim "calls for two distinct radio telephone systems; a micro-cellular telephone system and a macro-cellular telephone system. However, Gudmundson et al. merely discloses different size cells in a single radio telephone system." We disagree. In our view, claim 11 does not recite any different types of telephone systems, it merely asks for a micro cellular telephone system and a macro cellular telephone system; and Gudmunson clearly shows a telephone system which utilizes both a macro cellular system and a micro cellular system, as the Examiner has pointed out in his Examiner's answer.

Regarding claims 12 and 21, brief at pages 9 and 10, Appellant makes the same argument that these claims recite two different radio telephone systems having different types of base stations. However, for the same reason as for claim 11, we uphold the rejection of these claims as explained by the Examiner at pages 5 and 6 of the Examiner's answer. Therefore, we sustain the anticipation rejection of claims 11-13, 15 and 21 by Gudmundson.

Chia

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The Examiner rejects claims 11-13, and 21 as anticipated by Chia on page 7 of the Examiner's answer. Particularly, the Examiner makes reference to pages 8 and 13 and Figure 1 of Chia. Appellant again argues, brief at pages 10-12, that claims 11, 12 and 21 call for two distinct radio telephone systems and handover occurs when the velocity of the telephone exceeds a threshold velocity. However, we find that in each of these claims

there is a macro cellular telephone system and a micro cellular telephone system, and depending upon the threshold velocity, a handover occurs among one type of cellular system or across the two different types of cellular systems involving the micro and macro cells. We agree with the Examiner that Chia shows such a system in Figure 1 and describes it in more detail on pages 8 and 13 of the disclosure. Chia, for example, states that its system is arranged to determine, from a look-up table of stored templates of conditions for handover, whether a handover between base stations and between macro and microcells is appropriate, see abstract. The look-up table is based on the velocity of the telephone unit. Therefore, we agree with the Examiner that Chia anticipates claims 11-13 and 21.

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Rejections under 35 U.S.C. § 103

There are three rejections under this ground of rejection. We first go over the guidelines of a rejection under 35 U.S.C. § 103.

In our analysis, we are guided by the general proposition that 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. 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). We are further guided by the precedent of our reviewing court that the limitations from the disclosure are not to be imported into the claims. In re Lundberg, 244 F.2d 543, 113 USPQ 530 (CCPA 1957);

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In re Queener, 796 F.2d 461, 230 USPQ 438 (Fed. Cir. 1986). We also note that the arguments not made separately for any individual claim or claims are considered waived. See 37 CFR § 1.192(a) and (c). In re Baxter Travenol Labs., 952 F.2d 388, 391, 21 USPQ2d 1281, 1285 (Fed. Cir. 1991) ("It is not the function of this court to examine the claims in greater detail than argued by an appellant, looking for nonobviousness distinctions over the prior art."); In re Wiechert, 370 F.2d 927, 936, 152 USPQ 247, 254 (CCPA 1967) ("This court has uniformly followed the sound rule that an issue raised below which is not argued in that court, even if it has been properly brought here by reason of appeal is regarded as abandoned and will not be considered. It is our function as a court to decide disputed issues, not to create them.").

We now consider each of the three rejections under different combinations of references individually.

Chia and Schellinger

The Examiner rejects claims 1, 2, 8 and 9 under this combination at page 8 of the Examiner's answer. According to the Examiner, Schellinger teaches the use of the selection of a radio system under certain conditions, which is a non-cellular

system; and it would have been obvious to incorporate the use of one of the radio telephone systems being a non-cellular system in Chia. Appellant argues, brief at page 13, that "Claim 1 calls for a radio telephone with respective communication means associated with two radio telephone systems." Appellant further argues, id., that "there is no disclosure or suggestion in either Chia or Schellinger of a non-cellular system. There is no disclosure or suggestion in either Chia or Schellinger of a radio telephone operative in two radio telephone systems; one cellular and one non-cellular." We disagree with Appellant's position. To the extent claimed, as we discussed before, Chia shows two telephone systems, one having macrocells in it and the other having microcells. Schellinger, however, teaches the use of a cellular system and a non-cellular system in Figure 2, see also Figures 5 and 6-2. In our view, an artisan having a knowledge of the communications involving mobile telephone systems would have found it obvious to combine Chia with Schellinger's teachings of using a cellular and non-cellular system in the communication systems shown by Chia.

With respect to claim 9, Appellant argues, brief at page 14, that "[h]owever, as noted on page 7, lines 10-12 of Chia,

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'rate or change' of signal strength is not used by the speed estimator. Instead, the speed estimator in Chia uses an averaged signal."

We disagree with Appellant's position. On pages 8 and 9 of Chia, it is described that the changing of the template is proportional to the velocity of the mobile unit. Therefore, the velocity is being used as determinative of the template selection which is related to the signal strength. As we discussed before, to the extent claimed, the velocity recited in the claim is not limited to the absolute velocity, contrary to the position argued by Appellant.

Therefore, we sustain the obviousness rejection of claims 1, 2, 8 and 9 over Chia in view of Schellinger.

Chia, Schellinger and Shiotsuki

The Examiner rejects claims 3-5 and 14 over this combination. According to the Examiner, answer at page 9, Chia in view of Schellinger et al. discloses all the subject matter claimed except for the velocity of movement being determined by sensing the rate at which the radio telephone moves across cell boundaries. The Examiner contends, id. at 10, that "it would have been obvious ... to incorporate the velocity of movement is

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(sic) determined by sensing the rate at which the radio telephone moves across cell boundaries, as taught by **Shiotsuki, et al** in the radio telephone and method of **Chia** in view of **Schellinger, et al** in order to effectively control the time interval of issuing handoff request." Appellant argues, brief at page 15, that "[t]here is no velocity sensing means in Shiotsuki [sic, Shiotsuki] et al. Shiotsuki [sic, Shiotsuki] et al. merely uses a level crossing rate to delay a handoff. There is no disclosure or suggestion in Shiotsuki [sic, Shiotsuki] al. of using a level crossing rate to sense velocity that is subsequently used to select between two radio telephone systems." We disagree with Appellant's position. Figure 4 of Shiotsuki shows that a high rate of level crossing would give rise to a short time interval of handoff requested signals, which would correspond to the mobile station moving at a faster speed, because in a fast moving speed, the handoff has to be given at a fast rate as the contact with the base stations has to be made from one region to the next. See column 5 lines, 36-48. Therefore, we sustain the obviousness rejection of claims 3-5 and 14 over Chia, Schellinger and Shiotsuki.

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Chia, Tanaka and Benveniste, or Ivanov or Kojima or
Ramsdale or Yamada or Mende

Examiner rejects claims 17-19 under this combination at pages 10-12 of the Examiner's answer. Examiner asserts, id. at 10, that "Tanaka teaches the well known use, and the Examiner takes also official notice as such, of means for sensing absolute velocity of the telephone without regard to relative velocity of the telephone relative to the base station in a radio station for the purpose of operating a radio telephone base on the radio telephone speed." The Examiner further states, id. at 10-11, "it would have been obvious ... to incorporate the well know (sic) use of means for sensing absolute velocity of the telephone without regard to relative velocity of the telephone relative to the base station in the radio telephone of **Chia** in order to operate a radio telephone base on the radio telephone speed." Appellant argues, brief at page 18, that "Tanaka does not indicate if the 'traveling speed' is absolute velocity or relative velocity. Furthermore, even if Tanaka and Chia were combined, they would only suggest adding reception of position registration information, based upon a time interval calculated with speed estimator 64, to the

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telephone in Chia." However, we are persuaded by the Examiner's argument that Tanaka teaches the use of calculating the use of distance and time of crossing by a mobile unit to calculate the absolute velocity of the mobile unit, see pages 3, 5, and 7 of the English translation of Tanaka (a copy of the English translation is enclosed with this decision). Therefore, we agree with the Examiner that it would have been obvious to use the teachings of Tanaka regarding the calculation of the absolute velocity of the mobile unit and to use absolute velocity to change the handover from one type of cell to another type of cell in Chia.

Regarding claims 18 and 19, the Examiner asserts, answer at page 11, that "the use of velocity of movement is determined by sensing the rate at which the radio telephone moves across cell boundaries in a radio telephone system, is well known, as evidence (sic) by **Benveniste** or **Ivanov, et al** or **Kojima** or **Ramsdale, et al.** or **Yamada** or **Mende** and the Examiner takes Official Notice as such, for the purpose of effectively controlling the time interval of issuing handoff request."

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Regarding claims 18 and 19, Appellant makes only conclusory statements that Chia and Tanaka do not show the recited limitations of these claims (brief at page 18). Such statements do not constitute proper arguments based on substantial line of reasoning or factual evidence. Moreover, we have already discussed the limitations recited in claims 18 and 19.

Therefore, we sustain the obviousness rejection of claims 17-19 over Chia, Tanaka and Benveniste or Kojima or Ramsdale or Yamada or Mende.

However, we reverse the obviousness rejection of claims 17-19 over Chia, Tanaka and Ivanov, as Ivanov is not prior art against these claims, as noted at pages 2 and 3 of this decision.

In summary, we have sustained the rejection of claims 17-20, under 35 U.S.C. § 112, first paragraph, written description; the rejection of claims 17-20, but not of claims 2-10, under 35 U.S.C. § 112, second paragraph; claims 11-13, 15, and 21 under 35 U.S.C. § 102 as anticipated by Gudmundson; claims 11-13 and 21 as anticipated by Chia; rejection under 35 U.S.C. § 103 of claims 1, 2, 8 and 9 over Chia and Schellinger; claims 3-5 and 14 over Chia, Schellinger and Shiotsuki; and claims 17-19

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over Chia, Tanaka and Benveniste or Ivanov or Kojima or Ramsdale
or Yamada or Mende.

Accordingly, the decision of the Examiner rejecting claims
1-15 and 17-21 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

JOSEPH F. RUGGIERO)	
Administrative Patent Judge)	
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PARSHOTAM S. LALL)	APPEALS
Administrative Patent Judge)	AND
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ANITA PELLMAN GROSS)	
Administrative Patent Judge)	

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