

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte OLE K. NILSSEN, pro se

Appeal No. 96-3618
Application 08/004,598¹

ON BRIEF

¹ Application for patent filed January 14, 1993, entitled "Combination Cordless-Cellular Telephone System," which is a continuation-in-part of Application 07/860,234, filed March 27, 1992, now U.S. Patent 5,210,788, issued May 11, 1993, which is a continuation of Application 07/627,189, filed December 13, 1990, now abandoned, which is a continuation-in-part of Application 07/562,897, filed August 6, 1990, now U.S. Patent 5,068,890, issued November 26, 1991, which is a continuation-in-part of Application 07/397,266, filed August 23, 1989, now U.S. Patent 5,070,522, issued December 3, 1991, which is a continuation-in-part of Application 07/136,505, filed December 23, 1987, now U.S. Patent 4,866,757, issued September 12, 1989, which is a continuation of Application 06/921,381, filed October 22, 1986, now abandoned.

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Before URYNOWICZ, BARRETT, and DIXON, Administrative Patent Judges.

BARRETT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the final rejection of claims 1, 5, 7, 9, 15, 27, 28, 30, 43-47, 58-62, and 65-77. Claims 2-4, 6, 8, 10-14, 16-26, 29, 31-42, 48-57, 63, and 64 have been canceled. The amendment received October 21, 1997 (Paper No. 22), has been entered as noted in the Advisory Action (Paper No. 23).

We affirm-in-part.

BACKGROUND

The disclosed invention is directed to various arrangements of cellular cordless telephones.

Claim 46 is reproduced below.

46. An arrangement comprising:

a cordless base-station operable to receive a first incoming wireless telephonic signal as well as to emit a first outgoing wireless telephonic signal; the cordless base station being further characterized by including two transceivers;

a cellular base-station operable to receive a second incoming wireless telephonic signal as well as to emit a second outgoing wireless telephonic signal; and

a portable wireless telephone instrument operable controllably to provide for wireless telephonic

connection with both the cordless base-station and the cellular base-station, thereby to permit effectuation of telephone conversations between the portable wireless telephone instrument and either the cordless base-station or the cellular base-station.

THE PRIOR ART

The examiner relies on the following prior art

references:²

Yorita 1988	4,768,218	August 30,
		(filed April 27,
1987)		
Duffy 1988	4,745,632	May 17,
		(filed December 27,
1985)		
Kinoshita 1988	4,790,000	December 6,
		(filed December 10,
1986)		
Sakanishi et al. (Sakanishi) 3, 1990	4,939,769	July
		(filed July 8,
1988)		
Gillig et al. (Gillig) 1991	4,989,230	January 29,
		(filed September 23,
1988)		
Stoodley et al. (Stoodley) 1992	5,103,474	April 7,

² The Examiner erroneously lists Sato et al., U.S. Patent 5,210,785, issued May 11, 1993, filed February 27, 1989, in the list of references relied on ([Third] Supplemental Examiner's Answer, page 6).

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1990)		(filed May 8,
Emmert et al. (Emmert)	5,151,643	September 29,
1992		(filed March 4,
1991)		
Gilhousen et al. (Gilhousen)	5,257,283	October
26, 1993		(filed August 23,
1991)		
Schellinger et al. (Schellinger)	5,260,988	November 9,
1993		(filed February 6,
1992)		
Bartholomew et al. (Bartholomew)	5,319,634	June 7,
1994		(filed October 7,
1991)		
Hong	5,396,538	March
7, 1995		(filed December 24,
1991)		
Crane et al. (Crane)	5,533,097	July 2,
1996		(filed December 8,
1993)		
Fujii et al. (Fujii)	5,551,060	August 27,
1996		(filed August 28,
1992)		

Except for Crane, Appellant does not challenge that the patents are prior art to the present application.

THE REJECTIONS

We refer to the Examiner's Answer (Paper No. 11) (pages referred to as "EA__"), the [First] Supplemental Examiner's Answer (Paper No. 15) (pages referred to as "SEA__"), the [Second] Supplemental Examiner's Answer (Paper No. 17) (pages referred to as "2dSEA"), and the [Third] Supplemental Examiner's Answer (Paper No. 20) (pages referred to as "3dSEA__") for a statement of the Examiner's rejections. We refer to the Reply Brief (Paper No. 12) (pages referred to as "RBr__"), the Second Reply Brief (Paper No. 16) (pages referred to as "2dRBr__"), the Third Reply Brief (Paper No. 19) (pages referred to as "3dRBr__"), and the Fourth Reply Brief (Paper No. 21) (pages referred to as "4thRBr__") for a statement of Appellant's arguments thereagainst. Since the Examiner entered all new grounds of rejection in the Examiner's Answer, it is not necessary to refer to the Final Rejection (Paper No. 8) or the Appeal Brief (Paper No. 10).

Because of the new grounds of rejection added at various points in the Examiner's Answer, [First] Supplemental Examiner's Answers, and [Second] Supplemental Examiner's Answer, we identify the first time the rejection was made in

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the list of rejections below. Appellant's response is found in the Reply Brief which immediately follows the new ground of rejection. The list of rejections follow the order set forth in the [Third] Supplemental Examiner's Answer.

1. Claims 1, 5, 7, 9, 30, 43-45, 58, 67-72, and 77 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellant regards as his invention (new ground of rejection in 2dSEA).

2. Claim 9 stands rejected under 35 U.S.C. § 102(e) as being anticipated by Hong (new ground of rejection in 2dSEA).

3. Claim 15 stands rejected under 35 U.S.C. § 102(e) as being anticipated by Gillig (new ground of rejection in 2dSEA).

4. Claims 30 and 43-45 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Kinoshita (new ground of rejection in 2dSEA).

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5. Claims 66-68 and 70-77 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Crane (new ground of rejection in 2dSEA).
6. Claims 1, 5, and 46 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gillig and Fujii (new ground of rejection in 2dSEA).
7. Claim 7 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Gillig and Yorita (new ground of rejection in 2dSEA).
8. Claims 27 and 28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gillig and Duffy (new ground of rejection in 2dSEA).
9. Claim 47 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Gillig, Fujii, and Duffy (new ground of rejection in 2dSEA).
10. Claim 58 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Hong and either Kinoshita or Gillig (new ground of rejection in 2dSEA).

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11. Claim 69 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Crane and Hong (new ground of rejection in 2dSEA).

12. Claim 7 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Gillig and Bartholomew (new ground of rejection in EA).

13. Claims 58-60 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gillig and Hong (new ground of rejection in EA).

14. Claim 27 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Gillig, Sakanishi, and Stoodley (new ground of rejection in EA).

15. Claims 30, 46, and 61 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gillig and Yorita (new ground of rejection in EA).

16. Claims 43-45 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gillig and Gilhousen (new ground of rejection in EA).

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17. Claims 1, 5, 66, 67, 71-74, 76, and 77 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gillig and Schellinger (new ground of rejection in SEA).

18. Claim 28 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Gillig, Stoodley³, Sakanishi, and Schellinger (new ground of rejection in SEA).

19. Claim 47 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Gillig, Yorita, and Schellinger (new ground of rejection in SEA).

20. Claims 65, 68, 70, and 75 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gillig, Schellinger, and Emmert (new ground of rejection in SEA).

21. Claim 69 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Gillig, Schellinger, Emmert, and Hong (new ground of rejection in SEA).

³ The Examiner's rejection (SEA17) inadvertently omits mention of Stoodley, which is applied to the rejection of claim 27 from which claim 28 depends.

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22. Claims 1, 5, 7, 9, 15, 27, 28, 30, 43-47, 58, and 65-77 stand rejected under the judicially created doctrine of double patenting over claims 1-12 of Appellant's U.S. Patent 5,623,531 (new ground of rejection in 2dSEA).

The Examiner states that "[t]he rejection[s] of claims 9 and 15 under 35 U.S.C. § 103(a) have been withdrawn" (3dSEA58). Apparently, this statement is a holdover from the [Second] Supplemental Examiner's Answer, which withdrew the previous § 103(a) rejection of claim 9 over Gillig and Hong and the rejection of claim 15 over Gillig and Sakanishi, because no rejection of claims 9 and 15 was contained in the [Second] Supplemental Examiner's Answer.

It is noted that there is no rejection of claim 62.

OPINION

1. Claims 1, 5, 7, 9, 30, 43-45, 58, 67-72, and 77:
35 U.S.C. § 112, second paragraph

The Examiner considers the alternative term "and/or" in claims 1, 7, 9, 30, 58, and 77 to be indefinite (2dSEA26). We disagree. The term "and/or" is broad, not indefinite. For example, in claim 1, which contains the phrase "transmit

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and/or receive," the claim would be infringed by a device which transmits and receives, or by a device which only transmits, or by a device which only receives. Therefore, the alternative limitation is met by prior art which transmits and receives, or by a device which only transmits, or by a device which only receives. This indefiniteness ground of rejection of claims 1, 7, 9, 30, and 77, and their dependent claims 5 and 43-45 is reversed.

The Examiner considers the term "substantially higher" in claim 30 to be a relative term which renders the claim indefinite (2dSEA26). We disagree. Relative claim language does not automatically render a claim indefinite.

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. In this case, one of ordinary skill in the art would have understood that "substantially higher" means the power level allows cellular base stations to transmit signals over a distance of several miles while the power level of cordless base station transmits maybe 100 feet. This indefiniteness ground of rejection of claim 30 and its dependent claims 43-45 is reversed.

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The Examiner considers the terms "under certain circumstances" and "appropriate" in claim 58 to be relative terms which render the claim indefinite (2dSEA27). We disagree. The term "under certain circumstances" qualifies that the charging current is not always supplied to the battery (e.g., when the handset is not in the base station cradle), but that it must be capable of doing so. The term "appropriate" merely qualifies that the control actions must be of the right type to effectuate the claimed telephonic connection. This indefiniteness ground of rejection of claim 58 is reversed.

The Examiner considers the phrase "such manner as" in claim 67 to render the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention (2dSEA27). We disagree. The phrase indicates that the arrangement is operable in the way that follows the phrase. This indefiniteness ground of rejection of claim 67 and its dependent claims 68-72 is reversed.

2. Claim 9: § 102(e) over Hong

Claim 9 is directed to a conventional cordless telephone having contactless power transfer to the handset battery when

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the handset is cradled in the base station. Hong shows a cordless telephone in figure 1 which is connected to a telephone utility company via telephone lines 14. The handset 18 has a built-in battery 38. The handset is adapted to fit into the base unit 12 for charging (col. 4, lines 47-49). Charging is contactless via an induction voltage produced by power transmitter 32 (col. 4, lines 22-25): "A digital power receiver 44 detects and rectifies the induction voltage from the digital power transmitter 32 of the base unit 12 to charge the battery 38" Hong establishes a prima facie case of anticipation of claim 9.

Appellant argues that "[a]ccording to Applicant's specification, as well as in accordance with ordinary usage of the term in the U.S.A., a 'cordless telephone system' inherently includes various key features, such as a 'hand-set' with a dial for dialing telephone numbers" (3dRBr4) and that "Hong neither describes nor suggests a 'cordless telephone system' in the sense expressly defined by Applicant" (3dRBr4). To the extent certain features are inherent in a cordless telephone, they are inherent in the cordless telephone of Hong. When Hong discloses a cordless telephone handset 18 it

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conveys to one of ordinary skill in the art all the features of a conventional cordless telephone handset. Hong is directed to the inductive battery charging feature and it need not describe what is well known in the art and not important to the invention. See Paperless Accounting, Inc. v. Bay Area Rapid Transit System, 804 F.2d 659, 664, 231 USPQ 649, 652 (Fed. Cir. 1986). Thus, Appellant's argument is not persuasive.

Appellant argues that the Examiner improperly equated Hong's element 40 to Appellant's handset. Appellant errs because the Examiner clearly referred to "handset (#18) having a handset transceiver (#40)" (2dSEA28). In any case, however, Appellant should know what constitutes the handset in Hong.

Appellant has failed to rebut the prima facie case of anticipation. Therefore, the rejection of claim 9 is sustained.

3. Claim 15: § 102(e) over Gillig

Claim 15 is directed to the system shown in Appellant's figure 17. However, the terms "first," "second," etc. do not correspond to the description in the specification at page 32.

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We generally adopt the Examiner's reasons, but note that the "telephone instrument" at "a third location" is better read on the telephones known to be attached to the landlines of the telephone company phone system (TELCO) in Gillig, but not expressly shown in figure 1, rather than on the community cordless base station 188 as found by the Examiner (EA31).

In Gillig, the TELCO corresponds to the claimed "public telephone system" (shown as the central telephone exchange CTE in Appellant's figure 17). The cordless base station 180 and antenna 182 in home or office 181 correspond to the claimed "first transceiver and a first antenna" at "a first location" (shown as the dual function base transmitter station DFBSz at location Z in Appellant's figure 17). The cellular base station 190 and antennas 192, 194 correspond to the claimed "second transceiver and a second antenna" at "a second location" (shown as the cellular base station CBSy and cellular antenna CAy in Appellant's figure 17). The TELCO is known to those of ordinary skill in the art (indeed, to an average person) to have other telephones attached to the system than the ones shown in figure 1 of Gillig, which telephones correspond to the claimed "telephone instrument" at

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"a third location" (shown as public telephone PTx at location X in Appellant's figure 17). The cellular cordless telephone 10 corresponds to the claimed "cordless-cellular telephone" at "a fourth location" (shown as the dual function hand-piece DFHPw in Appellant's figure 17). Gillig establishes a prima facie case of anticipation of claim 15.

Appellant argues that the "Examiner has failed to show clearly what element in Gillig's Fig. 1 corresponds to what element of Applicant's claimed invention" (3dRBr4) and argues that the Examiner has failed to make a prima facie showing. This style of argument is totally unpersuasive and is not in compliance with Patent and Trademark Office (PTO) rules. PTO rules require that, in addressing a section 102 rejection, an applicant specify "any specific limitations in the rejected claims which are not described in the prior art relied upon in the rejection." 37 CFR § 1.192(c)(8)(iii) (1997). Appellant does not point out any errors in the rejection.

Appellant has failed to rebut the prima facie case of anticipation. Therefore, the rejection of claim 15 is sustained.

4. Claims 30 and 43-45: § 102(e) over Kinoshita

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Kinoshita discloses a portable radio telephone system which "can be used both for an urban public cellular radio telephone system and for a private radio telephone system which is built inside a local area" (col. 1, lines 46-48). The private radio telephone system attached to the private branch exchange (PBX) in figure 3 corresponds to the claimed "first wireless telephone base-station." The private system has two transceivers (col. 3., lines 65-67): "The radio telephone subscriber circuits are connected to transmission/reception antennas 18, 19 through transceivers (TRX) 16" A base station of a cell of the public cellular system corresponds to the claimed "second wireless telephone base-station." The portable telephone set 20 corresponds to the claimed "portable wireless telephone instrument" and can communicate with the private radio telephone system or the public cellular radio telephone system (e.g., col. 3, line 65, to col. 4, line 7). The power level of the private radio telephone system is kept at a very low intensity so as to not affect the public cellular radio telephone system (col. 2, lines 10-18), and the cellular system uses a high power level to cover a greater geographical

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area, which means the power level of the public cellular system is substantially higher than the power level of the private radio telephone system. Kinoshita establishes a prima facie case of anticipation of claim 30.

Appellant argues that the "Examiner has failed to show, at least with a clarity sufficient to permit a skilled artisan to see and understand, exactly where Kinoshita describes that particular structure" (3dRBr5). We consider the rejection to be sufficiently clear. To the extent that the Examiner has done things like refer to element 16 as the first wireless base station, where the base station might be considered to also include the antennas, this is good enough for anyone reading the action to understand what was intended since there is no single element number that could be used.

Appellant asks where Kinoshita describes "a first wireless telephone base-station," "a second wireless telephone base-station," and "a portable wireless telephone instrument" (3dRBr5). These elements have been addressed supra. Manifestly, Kinoshita does not need to use the same terms as the claim.

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Appellant argues that "Kinoshita does not clearly describe his 'telephone set' as being 'portable' or 'wireless'" (3dRBr6). Figure 3 of Kinoshita clearly shows a person holding a portable or mobile telephone set 20.

Appellant argues that "Kinoshita does not describe his 'telephone set' as being 'operable controllably to provide for wireless telephonic connection with the first and/or the second base-station'" (3dRBr6). The operator in Kinoshita can manually select between the public cellular system and the private radio telephone system or the mode can be done automatically (col. 6, lines 32-61), which satisfies the limitation of "controllably." The term "and/or" is a broad alternative term that is met by either "and" or "or"; Kinoshita clearly discloses the connection with the public cellular "or" the private system.

Appellant has failed to rebut the prima facie case of anticipation. Therefore, the rejection of claim 30 is sustained. Appellant does not argue the separate patentability of dependent claims 43-45; hence, these claims fall with claim 30. Thus, the rejection of claims 43-45 is also sustained.

5. Claims 66-68 and 70-77: § 102(e) over Crane

Claim 66 calls for "an antenna; and a first and a second transceiver, each connected with . . . the antenna," where the first transceiver is for cordless communication and the second transceiver is for cellular communication. Crane discloses an antenna 229 for local-area (i.e., cordless) communications and a separate antenna 231 for wide-area (e.g., cellular) communications (col. 3, lines 61-65). Thus, Crane does not disclose a single antenna connected with both transceivers as we believe the claim must be interpreted. While the use of a common antenna might very well be obvious (e.g., see Gillig, col. 2, lines 58-63), the rejection before us is based on anticipation. The rejection of claim 66 is reversed.

Claim 67 recites "antenna means" and we find that the two antennas 229 and 230 in Crane are equivalent to a single antenna which can transmit two different signals. Crane has a "large-capacity, rechargeable battery 223" (col. 3, line 51), which corresponds to the claimed "battery means." Crane has a cordless telephone handset 105 in communication with a local-area communications system in the briefcase 101 (col. 2, lines 43-45), which correspond to the "cordless portable

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telephone instrument" and the "cordless telephone base station." Crane has a cellular phone unit which plugs into one of the slots 215, 217, 219 for a wide-area communication system (col. 3, lines 29-38), which corresponds to the claimed "cellular telephone instrument." As shown in figure 1, a person can communicate from the cordless handset 105 to the cordless base station in briefcase 101 in the local-area communications system, from the local-area communications system to the cellular phone unit within the briefcase 101, and then to cellular system 115. Crane establishes a prima facie case of anticipation of claim 67.

Appellant argues that the arrangement of claim 67 is not described by Crane (3dRBr8), but Appellant fails to address the teachings of Crane and, so, does not rebut the prima facie case. Appellant does not argue the separate patentability of dependent claims 70-72; hence, these claims fall together with claim 67. The anticipation rejection of claims 67 and 70-72 is sustained.

Claim 68 recites a housing means including a cradle for holding the portable cordless telephone instrument. The briefcase 101 in Crane is a housing and includes a

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compartment 207 for storing the handset 105; this compartment is broadly considered to be a cradle. Appellant merely argues that Crane does not disclose a cradle (3dRBr8), without addressing the teachings of Crane. The rejection of claim 68 is sustained.

Claim 73 is similar to claim 67 and is anticipated for the reasons stated in that analysis. Appellant does not argue the separate patentability of dependent claims 74-76; hence, these claims fall together with claim 73. The anticipation rejection of claims 73-76 is sustained.

Appellant's only argument with respect to claim 77 is that the subject matter of claim 77 is fully disclosed in grandparent Application 07/627,189 ('189 application), filed December 13, 1990, and therefore Crane is inapplicable as a reference against claim 77 (3dRBr9). The Examiner states that the claimed "cordless base station including a cellular telephone instrument" was not disclosed in the '189 application and, so, the claim is not entitled to the earlier date (3dSEA76). Appellant does not rebut the Examiner's statement in his Fourth Reply Brief; hence, the correctness of

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the Examiner's position is taken as admitted. The rejection of claim 77 is sustained.

6. Claims 1, 5, and 46: § 103(a) over Gillig and Fujii

Gillig discloses the limitations of claim 1 except for the limitation of "a second base transceiver functional to provide telephonic connection with a cellular telephone system independent of the first base transceiver." The Examiner finds that Fujii "teaches the use of a base telephone apparatus [referring to figure 5A] . . . in a cordless telephone system for the purpose of increasing the spectrum efficiency in the cordless telephone system" (2dSEA49) and concludes that it would have been obvious "to incorporate the use of a base telephone apparatus includes [sic] the second base transceiver as taught by Fujii, et al in the cordless telephone system of Gilling, et al for the purpose of increasing the spectrum efficiency in the cordless telephone system in order [to] form in one piece an article which has formerly been formed in two pieces and put together" (2SEA50).

We will not sustain this rejection. Figure 5A of Fujii shows an inner base station of a cellular system having a plurality of transceivers and an outer base station having a

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plurality of transceivers. The transceivers of a cellular base station connect with portable cellular telephone sets, they do not connect with other cellular base stations as recited by claim 1 (or, at least, the Examiner has not established this fact). Moreover, we do not find the motivation in Fujii to do what the Examiner proposes. Accordingly, the rejection of claims 1 and 5 is reversed.

Gillig is considered to disclose the limitations of claim 46. The only possible difference is the cordless base station "including two transceivers." One of ordinary skill in the art would have appreciated that the cordless base station 180 in Gillig must have two transceivers: one for transmitting and receiving over the telephone line to the telephone company and one for transmitting and receiving over the wireless channel to the handset. Since claim 46 would have been obvious over Gillig, it would have been obvious over Gillig and Fujii. In any case, however, Appellant does not argue the rejection of claim 46. The rejection of claim 46 is sustained.

7. Claim 7: § 103(a) Gillig and Yorita

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Gillig discloses the limitations of claim 7 except for the "base telephone apparatus connected with at least two separate telephone lines of a telephone utility company, thereby to permit making an outgoing telephone call via one of the two telephone lines while a conversation is being carried-on via the other one of the two telephone lines." The Examiner finds that it was "well known in the art to have multiple line base telephone apparatuses" (2dSEA51) as evidenced by Yorita. The Examiner also states that "[i]t has been held that mere duplication of the essential working parts of a device involves only routine skill in the art" (2dSEA51). We agree that it was well known in the telephone art to have telephone sets, commonly business telephone sets such as those used by receptionists, connected to multiple telephone lines so that the user may switch between calls. Yorita shows a cordless telephone base station connected through N telephone lines to a telephone utility company. Numerous cordless sets are associated with the base station, but this is not precluded by the claim language of claim 7. The prior art teachings would have motivated one of ordinary skill in the art to provide multiple telephone lines to a cordless

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telephone base station for the purpose of allowing the user to handle more than one call. Thus, the Examiner has established a prima facie case of obviousness.

Appellant argues that the Examiner erred in relying on mere duplication of parts (3dRBr11). It is not necessary to rely on this alternative reasoning by the Examiner.

Appellant argues that the "Examiner has utterly failed to provide evidence to the effect that a skilled artisan would have found it obvious to seek to provide two hardwire telephone connections to a single base telephone apparatus" (3dRBr12). This argument ignores and does not deny the Examiner's finding that it was well known in the telephone art to provide multiple lines to a single telephone set. Further, Appellant has failed to address the teachings of Yorita.

The prima facie case has not been rebutted. The rejection of claim 7 is sustained.

8. Claims 27 and 28: § 103(a) over Gillig and Duffy

Claim 27 depends on claim 15 and calls for a "cordless base station for the cordless-cellular telephone." Presumably, this refers to the cordless base station DFBS1 in Appellant's figure 14. The Examiner relies on Duffy. Duffy

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discloses a wireless telephone unit attached to a conventional mobile telephone unit. The mobile telephone unit may be of the cellular type (col. 3, lines 61-66) and is connected to a battery power supply 156, as shown in figure 2; the mobile telephone unit comprises a "cordless base station." Since the mobile telephone unit is cellular, it has a transceiver to communicate with a cellular telephone system, as recited in claim 28; in this respect we disagree with the Examiner's reference to element 210 in Gillig (2dSEA53), because element 210 is part of the cellular cordless telephone, not part of the first receiver as claimed. The wireless telephone unit "may comprise any of the well-known commercially available units which are intended for wireless operation" (col. 3, line 66, to col. 4, line 1). It would have been obvious to combine the cellular cordless telephone of Gillig with a mobile telephone unit as taught in Duffy to obtain the wireless advantages of Duffy (e.g., col. 1, lines 6-21), and because Duffy states that any commercially available telephone unit can be used (col. 3, line 66, to col. 4, line 1) (which would include a cellular cordless set as taught by Gillig), and because Gillig teaches that the cellular cordless

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telephone may be a mobile unit installed in a vehicle (col. 2, line 41). The combination of Gillig and Duffy establishes a prima facie case of obviousness.

Appellant argues that the "Examiner utterly failed to provide an explanation of why it would be obvious for a skilled artisan to seek to make the proposed modifications to Gillig" (3dRBr12). The motivation is set forth in the preceding paragraph.

The prima facie case has not been rebutted. The rejection of claims 27 and 28 is sustained.

9. Claim 47: § 103(a) over Gillig, Fujii, and Duffy

Duffy discloses a wireless telephone unit attached to a conventional mobile telephone unit. As addressed in the rejection of claims 27 and 28 in the preceding section, it would have been obvious to combine the cellular cordless telephone of Gillig with a mobile telephone unit as taught in Duffy: (1) to provide the wireless advantages taught by Duffy (e.g., col. 1, lines 6-21); (2) because Duffy states that any commercially available telephone unit can be used (col. 3, line 66, to col. 4, line 1) (which would include a cellular cordless set as taught by Gillig); and (3) because Gillig

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teaches that the cellular cordless telephone may be a mobile unit installed in a vehicle (col. 2, line 41). The arrangement of Duffy permits communication between the wireless telephone unit and a person in hardwired connection with the public telephone system without a hardwired telephone line. Appellant has not argued the separate patentability of claim 47, but relies on the argued patentability of claim 46 (3dRBr12). The rejection of claim 47 is sustained.

10. Claim 58: § 103(a) over Hong and Kinoshita or Gillig

Kinoshita teaches a portable wireless telephone set 20 which carries out communication between an urban public cellular radio telephone system or a private radio telephone system, but does not teach inductive battery charging. Gillig teaches a portable cellular cordless telephone, but does not teach inductive battery charging. Hong teaches that cordless telephones use a rechargeable battery which is normally recharged by mechanically contacting a voltage output end of a charger with a charging end of the handset (e.g., col. 1, lines 25-39). This is said to have problems because the mechanical contacts may oxidize or become contaminated with alien substances (e.g., col. 1, lines 40-46). Hong provides

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inductive charging between the base unit 12 and the handset 18 (col. 3, line 29, to col. 4, line 27). Hong does not disclose a combined cellular cordless telephone instrument.

The Examiner concludes that it would have been obvious to incorporate the cellular cordless feature of Kinoshita or Gillig in the rechargeable handset of Hong to provide the advantages of a cellular cordless telephone instrument (2dSEA57). Stated differently, it would have been obvious to provide inductive battery charging as taught by Hong in the cellular cordless telephone system of Gillig or Kinoshita to overcome the problem of contamination of mechanical contacts which exist in any mechanical contact charger. In our opinion, the Examiner has established a prima facie case of obviousness.

Appellant argues that the rejection fails to point out where Hong teaches a "portable wireless telephone instrument" as defined on page 47 of the specification (3dRBr13). Hong expressly teaches that the inductive recharging structure is applicable to a charging a portable radio telephone (col. 2, lines 8-11) and radio telephone includes a cordless telephone (col. 1, lines 21-24). In figure 1, the portable handset 18

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is clearly identified. A cordless telephone meets the definition of a "portable wireless telephone instrument."

Appellant argues that the Examiner has failed to provide any explanation why one of ordinary skill in the art would have been motivated to modify Hong and "a skilled artisan would have to see a resulting benefit whose value would clearly outweigh all the obvious drawbacks associated with so modifying Hong, drawbacks such as: increased size, weight, power drain, structural and functional complexities, cost, spectrum requirements, etc." (3dRBr14). One skilled in the art would have been motivated to modify Hong to achieve the benefits of a telephone set that could also operate with a cellular system, which benefits are evident from Gillig or Kinoshita. One skilled in the art would also have been motivated to modify either Gillig or Kinoshita to have inductive recharging to provide more reliable charging as taught in Hong. The fact that the modification may require tradeoffs or have disadvantages evident to one of ordinary skill in the art does not teach away from the modification itself.

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The prima facie case has not been rebutted. The rejection of claim 58 is sustained.

11. Claim 69: § 103(a) over Crane and Hong

Claim 69 adds the limitations that the portable cordless telephone instrument is held in a cradle where it can be recharged by a noncontacting charging means. Hong teaches a contactless recharger for a cordless telephone when the handset is mounted in the cradle. It would have been obvious to add the noncontacting recharger of Hong to any cordless telephone set, such as Crane, to provide more reliable charging. The combination of Crane and Hong establishes a prima facie case of obviousness.

Appellant refers to the arguments presented in connection with claim 68 (3dRBr14). As we noted in the discussion of claim 68, Appellant merely argues that Crane does not disclose a cradle (3dRBr8), without addressing the teachings of Crane. The rejection of claim 68 was sustained.

Appellant argues that "Claim 69 includes a feature by which: 'to permit a person to use the telephone instrument for carrying out telephone conversations with cordless base station as well as with a cellular base station'" (3dRBr14)

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and that this feature is taught by neither Crane nor Hong. The quoted language is actually contained in parent claim 67, which we found to be anticipated by Crane as discussed in section 5.

The prima facie case has not been rebutted. The rejection of claim 69 is sustained.

12. Claim 7: § 103(a) over Gillig and Bartholomew

Gillig discloses the limitations of claim 7 except for the "base telephone apparatus connected with at least two separate telephone lines of a telephone utility company, thereby to permit making an outgoing telephone call via one of the two telephone lines while a conversation is being carried-on via the other one of the two telephone lines." The Examiner finds that it was "well known in the art to have multiple line base telephone apparatuses" (EA8) as evidenced by Bartholomew. We agree that it was well known in the telephone art to have telephone sets, commonly business telephone sets such as those used by receptionists, connected to multiple telephone lines so that the user may switch between calls. Bartholomew, figure 1, shows a multiline phone set 13 having N lines 12. Such prior art teachings would have

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motivated one of ordinary skill in the art to provide multiple telephone lines to a cordless telephone base station for the purpose of allowing the user to handle more than one call. The combination of Gillig and Bartholomew establishes a prima facie case of obviousness.

Appellant argues that Bartholomew does not describe a telephone apparatus permitting two telephone calls, "especially not in combination with, or in the context of, the particular 'cordless telephone system' defined by claim 7" (RBr8). One of ordinary skill in the telephone art would have had sufficient skill to apply multiple lines known in conventional telephone sets to cordless telephone sets.

The prima facie case has not been rebutted. The rejection of claim 7 is sustained.

13. Claims 58-60: § 103(a) over Gillig and Hong

We refer to the discussion in section 10, supra, for a discussion of the prima facie case over the combination of Gillig and Hong.

Appellant argues (RBr8) that the Examiner erred in stating that "it would have been obvious . . . to use the inductive charging technique taught by Hong in the system

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taught by Gillig '230 in order to isolate the hand set from the power source so as to avoid an accidental power surge" (EA9). Appellant argues that there is no general reason to believe that Gillig's cellular cordless telephone is susceptible to power surges (RBr8). We are not sure where the Examiner got the motivation about avoiding power surges; however, Hong provides express motivation to use an inductive charging circuit to overcome the problems of mechanical contacts. The references clearly suggest the combination.

The prima facie case has not been rebutted. The rejection of claims 58-60 is sustained.

14. Claim 27: § 103(a) over Gillig, Sakanishi, and Stoodley

Claim 27 depends from claim 15. In the [Second] Supplemental Examiner's Answer, the Examiner withdrew the rejection of claim 15 under 35 U.S.C. § 103 over Gilling and Sakanishi (2dSEA25) and entered a new ground of rejection under § 102(e) over Gillig; thus, Sakanishi is not required for the rejection. We have sustained the § 102 rejection of claim 15 over Gillig.

Claim 27 recites that "the first transceiver and the first antenna are combined with a first battery and integrated

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into an [sic] portable cordless entity operable to function as a cordless base station for the cordless-cellular telephone." It is noted that claim 27 only requires the base station to be "cordless" in the sense of having no attached power cord, there are no limitations that would require it to be cordless in the sense of having no hardware connection to a telephone line.

Stoodley discloses that a cordless telephone base unit has a power supply and "[t]he power supply may be arranged to draw power from a utility outlet, and may optionally be provided with a battery backup" (col. 7, lines 30-32). Manifestly, with a battery backup, the base unit can be operated without a cord. We agree with the Examiner that it would have been obvious to provide a battery in the base station of Gillig "in order to provide power to the base station in the event of a [sic] electrical outage of the power company" (EA12) and also because a battery would allow the base station to be moved around without the restriction of a cord. We do not find where Appellant traversed this rejection of claim 27. The rejection of claim 27 is sustained.

15. Claims 30, 46, and 61: § 103(a) over Gillig and Yorita

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Gillig teaches a portable cellular cordless telephone. The cordless base station 180 or the community cordless base station 188 correspond to the claimed "first wireless telephone base-station" of claim 30, the "cordless base-station" of claim 46, and the "first wireless base-station" of claim 61. The cellular base station 190 corresponds to the claimed "second wireless telephone base-station" of claim 30, the "cellular base-station" of claim 46, and the "second wireless base-station" of claim 61. The cellular cordless telephone 10 corresponds to the "portable wireless telephone instrument" of claims 30, 46, and 61. Gillig can effectuate connections between the cordless base station, the cellular base station, or both at the same time (col. 3, lines 35-37). The TELCO in Gillig is known to be connected to many other telephone sets, one of which is the "first telephone instrument" of claim 61. Since the cordless connection has a very limited range (maybe 100 feet) and the cellular connection has a much greater range (on the order of miles), it would have been apparent to one of ordinary skill in the art that the cellular base station has a

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power level "substantially higher" than the cordless base station.

The Examiner finds that Gillig does not expressly teach that the cordless base station contains two transceivers. The Examiner finds that the community cordless base station 188 must have multiple transceivers or a multiplexing scheme. The Examiner states that it was "well known in the art to have multiple transceivers within a base station as evidenced by Yorita and therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use multiple transceivers in the base station in order to service more than one party at a given time" (EA13-14). We agree with the Examiner's rationale, which is also unchallenged by Appellant. It is also noted that the cordless base station 180 must have two transceivers: one for transmitting and receiving over the telephone line to the telephone company and one for transmitting and receiving over the wireless channel to the handset. The combination of Gillig and Yorita establishes a prima facie case of obviousness.

Appellant argues with respect to claim 30 that the feature of the second wireless telephone base station having a

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power level "substantially higher than the first power level [of the first base station]" is not described or suggested (RBr9). Obviousness is determined through the eyes of one of ordinary skill in the art. 35 U.S.C. § 103(a). Persons of ordinary skill in the art must be presumed to know something about the art apart from what the references expressly disclose. In re Jacoby, 309 F.2d 513, 516, 135 USPQ 317, 319 (CCPA 1962). One of ordinary skill would have known that a cellular base station transmits at a substantially higher power level than a cordless base station because the cellular transmitted signal must cover a greater distance.

Appellant's arguments (RBr10) do not clearly point out what feature of claim 46 is not taught by the references. It is argued that the "cordless base-station" of claim 46 must be a private base station and cannot reasonably be equated with Gillig's "community cordless base station." We find no such limitation, expressly or impliedly, in claim 46.

Nevertheless, we have noted that the cordless base station 180 in Gillig must have two transceivers and also meets claim 46.

The prima facie case has not been rebutted. The rejection of claims 30, 46, and 61 is sustained.

16. Claims 43-45: § 103(a) over Gillig and Gilhousen

Claims 43-45 recite that the portable wireless telephone instrument emits a third outgoing wireless telephonic signal at a third power level and the first power level (of the cordless base station) is adjusted in response to the third outgoing telephonic signal (claim 43) or the third power level (of the handset) is adjusted in response to information conveyed by either the first outgoing wireless telephonic signal (of the cordless base station, claim 44) or the second outgoing wireless telephonic signal (of the cellular base station, claim 45). The Examiner finds that "[i]t [wa]s well known in the art to adjust both base station transmit levels as well as handset transmit power levels as the signal is determined to be at varying strengths" (EA14), as evidenced by Gilhousen. Gilhousen discloses adjusting the mobile unit transmitter power and the base station transmitter power. Appellant acknowledges, but does not respond to the rejection in the Reply Brief; thus, we presume that Appellant admits the Examiner's finding of what was well known in the art and in the teachings of Gilhousen. The rejection of claims 43-45 is sustained.

17. Claims 1, 5, 66, 67, 71-74, 76, and 77:
§ 103(a) over Gillig and Schellinger

Gillig discloses the limitations of claim 1 except for the limitation of "a second base transceiver functional to provide telephonic connection with a cellular telephone system independent of the first base transceiver." The Examiner relies on Schellinger, figure 1. Figure 1 shows a cellular cordless portable telephone 101 may be in communication with a cordless base station 115 in a home or office, one of several cellular base stations 105, 107 in a cellular telephone system 103, or "a microcellular base station 113, which is a cellular adjunct cell having lower power and limited capabilities but providing public radiotelephone service to distinct areas such as shopping malls, airports, etc." (col. 3, lines 14-17). The Examiner states that the placement of the microcellular base station is arbitrary and concludes that "it would have been obvious . . . to include both the microcellular base station and the cordless base station within the same housing . . . because it would allow the two base stations to share common elements (and space) and reduce the cost and use of materials of the two base stations" (SEA16).

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We disagree with the Examiner's reasoning. The microcellular system is intended to cover a much wider area than the home or office area covered by a cordless system and, moreover, is part of a cellular telephone company service, not a (normally) private cordless system. There is no motivation, express or implied, to combine the two types of systems. "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992), citing In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). However, even if there was motivation for the combination, we do not see how the combination meets the limitation of claim 1 for the second transceiver to communicate with a cellular telephone system, unless the Examiner is relying on some unstated interpretation of the claim. The microcellular system communicates with the TELCO over hardwire telephone lines, not with a cellular telephone system like 103. Therefore, the rejection of claims 1 and 5 is reversed.

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Claim 66 recites a battery operated portable structure having two transceivers. Neither Gillig nor Schellinger discloses a battery operated structure and we do not find where the Examiner addresses this limitation. Claim 66 further recites that the structure effectuates communication between a cellular base station and the structure, and between the structure and a portable cordless telephone instrument. Assuming, arguendo, that the combination of Gillig and Schellinger is proper, the microcellular system would communicate with the TELCO over hardwired telephone lines, not a cellular base station as claimed. For these two reasons, the rejection of claim 66 is reversed.

Claims 67 is are similar to claim 66 and the rejection of claim 67 and its dependent claims 71 and 72 is reversed for the same two reasons.

Claims 73 and 77 recite connect means to effectuate communication between a cordless telephone instrument, the cordless base station, a cellular telephone instrument, and a cellular base station, which is similar to the cellular cordless scheme in claim 66. Assuming, arguendo, that the combination of Gillig and Schellinger is proper, it does not

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suggest the microcellular system communicating with the cellular base station. The rejection of claims 73 and 77, and dependent claims 74 and 76, is reversed.

18. Claim 28: § 103(a) over Gillig, Sakanishi, Stoodley, and Schellinger

Claim 28 requires the "portable entity" corresponding to a cordless base station to have an auxiliary transceiver for communication with a cellular telephone system. As discussed in the preceding section 17, Schellinger does not suggest putting a cellular transceiver in the cordless base station that would communicate with a cellular telephone system. The rejection of claim 28 is therefore reversed.

19. Claim 47: § 103(a) over Gillig, Yorita, and Schellinger

Claim 47 requires the cordless base station to be operable to convey a conversation "without having connection with a hard-wired telephone line." Schellinger does not suggest putting a cellular transceiver in the cordless base station that would communicate with a cellular telephone system and, therefore, does not suggest a non-hardwired

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connection with the TELCO. The rejection of claim 47 is reversed.

20. Claims 65, 68, 70, and 75:
§ 103(a) over Gillig, Schellinger, and Emmert

Claim 65 recites a "structure" corresponding to a cordless base station having a rechargeable battery. The Examiner applies Emmert. Emmert teaches a rechargeable battery in the handset 101, not in the cordless base station as required by the claim. Nevertheless, this limitation is not argued by Appellant.

Claim 65 further recites "a first and second transceiver" "the arrangement being further characterized by being functional, even if not being connected with said at least one hardwired telephone line, to effectuate telephonic connection between a portable cordless telephone instrument and a cellular telephone base station." Schellinger does not suggest putting a cellular transceiver in the cordless base station that would communicate with a cellular telephone system and, therefore, does not suggest a non-hardwired connection with the TELCO. Emmert does not cure this

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deficiency. The rejection of claim 65 and its dependent claims 68 and 70 is reversed.

With respect to the rejection of claim 75, Emmert does not cure the deficiency in the combination of Gillig and Schellinger with respect to claim 73. Therefore, the rejection of claim 75 is reversed.

21. Claim 69: § 103(a) over Gillig,
Schellinger, Emmert, and Hong

Hong is applied to teach contactless battery recharging of a battery in the handset. Hong does not supply the missing teaching of a cellular telephone instrument in the cordless base station to provide communication with a cellular telephone base station in claim 67. Accordingly, the rejection of claim 69 is reversed.

22. Claims 1, 5, 7, 9, 15, 27, 28, 30, 43-47, 58,
and 65-77: judicially created double patenting

The Examiner relies on In re Schneller, 397 F.2d 350, 158 USPQ 210 (CCPA 1968) (so-called Schneller-type double patenting). Schneller is an obviousness-type double patenting case with a special fact situation. Schneller applies to those situations where: (1) the subject matter recited in the

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claims of the application is fully disclosed and covered by a claim in the patent (i.e., there has been no improvement or modification invented after filing and the application claim reads on subject matter which has been protected by a patent claim); and (2) there is no reason why appellant was prevented from presenting the same claims for examination in the issued patent (i.e., there is no justification for extending the protection, such as the existence of a restriction requirement). Obviousness-type double patenting rejections can usually be overcome with a terminal disclaimer.

Appellant only argues that the "Examiner has utterly failed to provide clear prima facie evidence in support of his rejections" (3dRBr15). Merely denying that a prima facie case has been made is a non-helpful and nonpersuasive style of argument because it does not address the merits by pointing out the errors in the Examiner's position. In an obviousness-type double patenting rejection, Appellant is in the best position to distinguish the claims of the application from the claims of the patent. Although we could technically sustain the rejection based on a lack of argument by

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Appellant, in this situation, a cursory review shows that the Examiner mistakenly applied the principle in Schneller.

Patent 5,623,531 (the '531 patent) is said to be a continuation-in-part of Application 181,833, filed January 8, 1994, which is said to be a continuation of the instant application. The '531 patent discloses the subject matter covered by the claims of this application. However, the Examiner errs in stating that the "the patent and the application are claiming common subject matter" (2dSEA60). The claims of the '531 patent are directed to a telephone and auxiliary power distribution system, not to the features of a cordless or cellular cordless telephone. Because the subject matter of the present claims do not fall within the claims of the '531 patent and because the Examiner has not otherwise established that the subject matter of the present claims would have been obvious over the claims of the '531 patent, the rejection of claims 1, 5, 7, 9, 15, 27, 28, 30, 43-47, 58, and 65-77 is reversed.

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CONCLUSION

One or more of the rejections of claims 7, 9, 15, 27, 28, 30, 43-47, 58-61, 67-69, and 73-77 are sustained.

The rejections of claims 1, 5, 62, 65, 66, and 70-72 are reversed.

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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