

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. 11

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

Ex parte WALTER L. DAVIS

---

Appeal No. 1997-0606  
Application No. 08/169,048

---

ON BRIEF

---

Before JERRY SMITH, FLEMING and LALL, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-29, which constitute all the claims in the application.

The disclosed invention pertains to a combination paging system and telephone system. More particularly, the invention relates to the routing of paging messages intended for a portable transceiver which can be located outside of a home calling area. The portable transceiver continually informs

the system whenever the portable transceiver enters a new calling area. The system compares the location of the home calling area with the area last entered by the transceiver, and messages for the transceiver are routed to the calling area of the transceiver whenever it has left the home calling area.

Representative claim 1 is reproduced as follows:

1. In a combination paging system and telephone system, a method for communicating comprising the steps of:

(a) transmitting paging signals having a location identifier associated with a geographic location of the paging system transmitting same;

(b) receiving location update signals indicating the geographic location of a transceiver transmitting its location identifier from another geographic location;

(c) decoding the location identifier incorporated in the location update signals and storing the location identifier identifying the geographic location of the transceiver transmitting same;

(d) receiving paging message;

(e) routing the paging messages addressed to the transceiver located in the other geographic location in response to the location identifier associated with the transceiver; and

(f) transmitting the paging messages addressed to the transceiver located in the geographic location of the paging system.

Appeal No. 1997-0606  
Application No. 08/169,048

The examiner relies on the following references:

Frost	4,178,476	Dec. 11, 1979
Eastmond et al. (Eastmond)	5,153,903	Oct. 06, 1992
Wohl et al. (Wohl)	5,247,700	Sep. 21, 1993
Rappaport et al. (Rappaport)	5,451,839	Sep. 19, 1995

(filed Jan. 12, 1993)

The following rejections were set forth as new grounds of rejection in the examiner's answer:

1. Claims 6 and 18 were rejected under 35 U.S.C. § 102(b) as being anticipated by the disclosure of Frost.

2. Claims 9, 10, 16 and 17 were rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of Frost in view of Eastmond.

3. Claims 7, 11 and 19-28 were rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of Frost in view of Wohl.

4. Claim 29 was rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of Frost in view of Wohl and further in view of Rappaport.

Appellant was apprised of these new grounds of rejection and given a period of two months in which to file a reply [answer, pages 5-9 and 12]. No response to these new grounds

Appeal No. 1997-0606  
Application No. 08/169,048

of rejection has been received. Accordingly, this appeal is dismissed with respect to all such claims subject to the new grounds of rejection [37 CFR § 1.193 as of the date of the examiner's answer]. Therefore, this appeal is dismissed with respect to claims 6, 7, 9-11 and 16-29. The merits of the new grounds of rejection against these claims have not been considered in rendering this decision.

Claims 1-5, 8 and 12-15 remain on appeal before us. These claims stand rejected under 35 U.S.C. § 102(b) as being anticipated by the disclosure of Frost<sup>1</sup>.

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

#### OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of anticipation relied upon by the examiner as

---

<sup>1</sup> The final rejection of claim 3 was only made under 35 U.S.C. § 103 based on the teachings of Frost, Beeson and Heffernan. Therefore, this rejection under 35 U.S.C. § 102 was a new ground of rejection against claim 3 although not designated as such.

Appeal No. 1997-0606  
Application No. 08/169,048

support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellant's arguments set forth in the brief along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the disclosure of Frost does fully meet the invention as set forth in claims 1, 2, 4, 5, 8 and 12-15. We reach the opposite conclusion with respect to claim 3. Accordingly, we affirm-in-part.

Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.); cert. dismissed, 468 U.S. 1228 (1984); W.L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

Appeal No. 1997-0606  
Application No. 08/169,048

With respect to independent claim 1, the examiner indicates how he reads the claim on the disclosure of Frost [answer, pages 4-5]. Appellant broadly asserts that Frost does not anticipate the claimed invention because Frost does not teach or suggest steps (a)-(c) and (e) of claim 1 [brief, page 10]. Appellant does not address these steps specifically, but rather, he argues that the Frost disclosure of suspending pager service prior to traveling and reinstating the service after arrival at a destination is different from the claimed invention [*id.*, pages 10-11]. The examiner responds that the differences between Frost and the disclosed invention are not relevant to the claimed invention, and that the steps of claim 1 are each performed in Frost [answer, pages 10-11].

We agree with the conclusion of the examiner. In our view, each of the steps as broadly recited in claim 1 is disclosed by Frost. The paging signals in Frost are transmitted with location identifiers associated therewith [see Figure 7, for example]. The Frost system receives information regarding the new location of the pager. The claim does not preclude user intervention in carrying out this

Appeal No. 1997-0606  
Application No. 08/169,048

step. The Frost system identifies (decodes) the new location of the pager and routes messages addressed to that pager to the new location. Since the examiner would appear to have properly read claim 1 on the disclosure of Frost, and since appellant has not offered a convincing argument in rebuttal, we sustain the examiner's rejection of claim 1. Since claims 2, 4 and 5 are not separately argued, we also sustain the rejection with respect to these claims.

Although appellant nominally argues the rejection of independent claims 8 and 13 separately, the arguments presented are exactly the same arguments we considered above with respect to claim 1. Since the argued limitations of claims 8 and 13 are similar to the recitations of claim 1, we sustain the rejection of these claims for the same reasons discussed above with respect to claim 1.

Although claims 12, 14 and 15 are nominally argued separately, appellant makes the same argument with respect to each of these claims. Specifically, appellant argues that in Frost the geographic area is identified by the user placed telephone call so that there is no need to determine the geographic location [brief, pages 13-14, 16 and 17]. This

Appeal No. 1997-0606  
Application No. 08/169,048

argument is not persuasive because the home station in Frost must determine the geographic location of the pager based on the remote station which reports the new location to the home station. We agree with the examiner that the invention as set forth in these claims is fully met by the disclosure of Frost.

We now consider the rejection with respect to claim 3. As noted above, claim 3 was rejected in the final rejection under 35 U.S.C. § 103 based on the teachings of Frost, Beeson and Heffernan. Appellant's brief responds to this rejection. The examiner's answer has changed the rejection of claim 3 set forth in the final rejection to a rejection under 35 U.S.C. § 102 as anticipated by the disclosure of Frost.

In the final rejection, the examiner indicated that Frost did not fully disclose the limitations recited in claim 3 [second final rejection, pages 5-6], however, the examiner cited Heffernan for teaching the different data rates of claim 3. The examiner has not shown in the answer, however, where this feature of claim 3 suddenly appeared in the disclosure of Frost. Thus, the examiner has never supported the present rejection of claim 3 based on Frost alone. Therefore, the examiner has failed to establish a prima facie case of

Appeal No. 1997-0606  
Application No. 08/169,048

anticipation. Accordingly, we do not sustain the anticipation rejection of claim 3 on this record. In summary, we have dismissed this appeal with respect to claims 6, 7, 9-11 and 16-29. The rejection of claims 1-5, 8 and 12-15 as anticipated by Frost is sustained with respect to claims 1, 2, 4, 5, 8 and 12-15, but is not sustained with respect to claim 3. Accordingly the decision of the examiner rejecting claims 1-5, 8 and 12-15 is affirmed-in-part.

Appeal No. 1997-0606  
Application No. 08/169,048

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

JERRY SMITH	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
MICHAEL R. FLEMING	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
PARSHOTAM S. LALL	)	
Administrative Patent Judge	)	

js/jg

Appeal No. 1997-0606  
Application No. 08/169,048

MOTOROLA, INC.  
PATENT DEPT.  
1500 GATEWAY BOULEVARD  
BOYNTON BEACH, FL 33426-8292