

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANTHONY P. PALETT
and GIL SPEAR

Appeal No. 97-2876
Application 08/335,008¹

ON BRIEF

Before THOMAS, TORCZON and CARMICHAEL, Administrative Patent Judges.

THOMAS, Administrative Patent Judge.

¹ Application for patent filed November 7, 1994. According to the appellants, this application is a continuation of Application 08/012,382, filed February 2, 1993, now abandoned.

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DECISION ON APPEAL

Appellants have appealed to the Board from the examiner's final rejection of claims 43 to 48 and 50 to 57, which constitute all the claims remaining in the application.

Representative claim 43 is reproduced below:

43. A rear-view mirror mounted telephone system adapted for use with a vehicle equipped with a mobile telecommunications transceiver, a source of electrical power, and wiring to carry power to the telephone system and to interconnect the telephone system with the telecommunications transceiver, the rear-view mirror mounted telephone system comprising:

a main housing having upper, lower, left and right edges and a mirrored surface, the housing being adjustably mounted within the vehicle, enabling the mirrored surface to properly function as a rear-view mirror; and

a plurality of telephone controls located on the housing, at least certain of the controls being integral to the housing, the controls including

a microphone,

a speaker, and

means to dial a telephone number, the controls enabling an operator to place and receive telephone calls through the telecommunications transceiver, and to carry

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on a telephone conversation in a hand's free manner once a call is in progress.

The following references are relied on by the examiner:

Meyerle et al. (Meyerle) 1977	4,056,696	Nov. 01,
Spear et al. (Spear)	4,706,273	Nov. 10, 1987
Schofield et al. (Schofield) 1990	4,930,742	June 05,
Marui	5,239,586	Aug. 24, 1993 (filed Nov. 20, 1991)
Takagi, et al. (Takagi) 1989 ² (Japanese Kokai)	03-85949	Apr. 11,
Wu 1992 ² (Chinese patent)	179989	Mar. 01,
Kudo et al. (Kudo) 1992 ² (Japanese Kokai)	04-290044	Oct. 14,

As expressed in some manner in both examiner's answers, it appears that the examiner has rejected certain claims under both the enablement and written description portions of 35 U.S.C.

² Our understanding of this reference is based upon a translation provided by the Scientific and Technical Information Center of the Patent and Trademark Office. A copy of the translation is enclosed with this decision.

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§ 112. As expressed in the supplemental examiner's answer, this rejection is limited to claims 44 to 48 and 52 to 55.

All claims on appeal, claims 43 to 48 and 50 to 57 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner presents the collective teachings of Meyerle in view of Schofield as to claims 43, 50 to 52 and 54, as the basic combination of references. To this basic combination the examiner adds Takagi as to claims 44 to 48, adds Kudo as to claim 53, adds Spear as to claim 55, adds Wu as to claim 56 and Marui as to claim 57.

Rather than repeat the positions of the appellants and the examiner, reference is made to the various briefs and answers for the respective details thereof.

OPINION

Turning first to the rejection of the claims under 35 U.S.C.

§ 112, to the extent the rejection is based upon the enablement provision of this statutory provision, we reverse the rejection. Appellants' reply brief correctly reflects that enablement is determined from the artisan's perspective and cites various cases, which we see no need to repeat here,

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which set forth that the standard must be such as to enable the artisan to make and use the claimed invention without undue experimentation. Our study of the written description portion of the disclosure, the attached drawings and the claims on appeal lead us to conclude that the examiner has not expressed any rationale to convince us that it would have required the artisan undue experimentation to have made and used the presently claimed invention. Essentially, all of the features recited in the pending claims on appeal are shown in the drawing figures.

The focus of the examiner's rejection of the claims under 35 U.S.C. § 112 appears to be the written description portion according to the examiner's reasoning as best expressed in the supplemental answer, where the assertion is made that the specification as filed as a whole indicated that the inventors did not have possession of the presently claimed invention.

Initially, we note that the examiner's earlier reasoning for lack of "support" for the claimed invention of claims implicitly referred to the written description requirement of 35 U.S.C.

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§ 112, first paragraph. In re Higbee, 527 F.2d 1405, 1406, 188 USPQ 488, 489 (CCPA 1976).

The test to be applied under the written description portion of 35 U.S.C. § 112, first paragraph, is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventors had possession at that time of later claimed subject matter. Vas-Cath Inc. v. Mahurkar, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117, reh'g. denied (Fed. Cir. July 8, 1991) and reh'g, en banc denied (Fed. Cir. July 29, 1991).

The manner in which the specification as filed meets the written description requirement is not material. The requirement may be met by either an express or an implicit disclosure. In re Wertheim, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976). An invention claimed need not be described in ipsis verbis in order to satisfy the written description requirement of 35 U.S.C.

§ 112, first paragraph. In re Lukach, 442 F.2d 967, 969, 169 USPQ 795, 796 (CCPA 1971). The question is not whether an added word was the word used in the specification as filed, but whether there is support in the specification for the

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employment of the word in the claims, that is, whether the concept is present in the original disclosure. See In re Anderson, 471 F.2d 1237, 1244, 176 USPQ 331, 336 (CCPA 1973).

There appears to be no basic dispute between appellants and the examiner that at least two embodiments have been disclosed. The first embodiment is essentially shown in the early figures and relates to a telephone system separately mounted with a vehicle's rear-view mirror. The second embodiment begins in Fig. 24 and shows a telephone system which is integral with the rear-view mirror. On the basis of the drawings presented with the application as filed, the examiner asserts that there is no embodiment which shows a telephone system partially integral and partially separable with the rear-view mirror. This position of the examiner focuses the issue upon the problem of mixing embodiments in later than filing date claimed subject matter.

We reverse this rejection essentially because we are in agreement with the positions first advocated by appellants in the principal Brief on appeal. We make reference to the summary of the invention at page 5, lines 11 through 18:

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In one embodiment of the invention mirror assembly the telephone is removably mounted on the mirror by mounting means including a holster secured to the top of the mirror and defining a socket for receipt of the mobile telephone.

In further embodiments of the invention mirror assembly at least one of the components of the telephone is built into the casing of the mirror. (Emphasis added).

Even more telling, however, are the statements made in the specification at page 18, lines 10 to 17:

Although the invention has been illustrated and described in connection with a portable telephone which is removably mounted on the mirror, the invention is also applicable to an arrangement in which some or all of the components of the telephone are built into the mirror as a permanent part of the mirror assembly. Several arrangements in which the telephone is built into the mirror are shown respectively in Figures 24, 25 and 26. (Emphasis added).

To these portions of the specification as filed we add the original filed claims 16, 17, 23, 27 to 29 and 31 to 35.

These portions at pages 5 and 18 of the written description as filed, as well as the originally filed claims just identified, provide an ample basis within 35 U.S.C. § 112, first paragraph, for appellants to have later claimed the

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subject matter of the present claims on appeal set forth and focused upon in present claims 43 to 48 and 50 to 57 under the written description portion of this statutory provision. We are in general agreement with appellants' observation at the bottom of page 2 of the second reply brief, filed on December 30, 1996 where appellants indicate that they believe that the examiner is placing all emphasis on the drawings while ignoring the above specified language in the specification. Although as asserted by the

examiner at the bottom of page 2 and the top of page 3 of the supplemental answer, there is no embodiment which "shows" the telephone system being partially integral and partially separable with the rear-view mirror, the specification language as quoted clearly indicates that this was contemplated by the appellants and therefore was in their possession at the original filing date of the present application. This conclusion is buttressed by consideration of the originally filed claims identified earlier. This decision is believed to be consistent with the above noted case law which indicates that there is no strict ipsis verbis

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requirement to satisfy the written description requirement since clearly the concept of a mixed, or perhaps third, embodiment of the claimed invention was clearly contemplated by the inventors as originally filed. In view of the foregoing, the decision of the examiner rejecting the claims 44 to 48 and 52 to 58 under the written description portion of 35 U.S.C. § 112 is reversed.

Turning to the rejection of claims 43, 50 to 52 and 54 under 35 U.S.C. § 103 in light of the collective teachings of Meyerle in view of Schofield, we reverse this rejection. On the one hand, Meyerle teaches a telephone station set in representative Fig. 1 of this reference mounted on a sun visor 10 for use in an automobile to which various controls are shown to be attached and associated with the telephone set. A modified version of Fig. 1 and Fig. 7 shows that such controls are mounted on a control unit module box 49.

On the other hand, Schofield teaches primarily an adapter for removably mounting an interior rear-view mirror assembly, which is not explicitly disclosed in Schofield per se. Figure 19 of this reference shows a microphone sensor 186 mounted within a microphone housing 180 which forms a part of the

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adaptor 150 to which the channel mount 50 is attached for this mirror assembly to be further attached to ball 62 of the mirror assembly shown in more detail in Figs 11 and 12. Thus, this figure shows a microphone such as for a cellular phone as indicated at col. 3, lines 42 through 62. This embodiment is further described at col. 9, lines 42 through 51 as having "a housing 180 integral with and positioned below the adaptor body for a microphone for a cellular phone, dictation system or the like and its controlling circuitry and wiring." Similar language is found at col. 11, lines 53 through 58.

Claim 43, the only independent claim on appeal, requires in its preamble a rear-view mirror mounted telephone system, where the body of the claim recites the existence of a main housing having a mirrored surface which functions as a rear-view mirror.

The body of this claim further requires a plurality of telephone controls located on this housing. As best construed in light of the above noted teachings and the examiner's reasoning, it appears that the artisan would have found it

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obvious to have mounted a telephone system as in Meyerle on the base support structure or housing adaptor 150/180 of Schofield's Fig. 19 and not on the mirror assembly housing per se, again which assembly is not shown in specifics in this reference.

Therefore, we find ourselves in a general agreement with the appellants' assertion at page 6 of the reply brief filed on June 6, 1996:

Of the claims on appeal, only one (claim 43) is drafted in independent form. It includes the limitation of a main housing having a mirror surface, and a plurality of telephone controls located on the housing ... There is no hint or suggestion of this configuration in the prior art. The Examiner's reliance on Schofield as a primary reference which teaches such a feature for use in combination, fails in that Schofield et al teach only the incorporation of a microphone within a support base to which a rearview mirror is attached. Only Appellant discloses and claims "a plurality of telephone controls located on the housing, at least certain of the controls being integral to the housing," a limitation which is enabled by the specification yet nowhere to be found in the prior art.

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As to the rejection of independent claim 43, the weight of the evidence provided from the collective teachings of Meyerle and Schofield does not support the examiner's conclusion of obviousness of the subject matter of this claim on appeal. Further, the disadvantage noted by the examiner in the discussion between pages 15 and 16 of the answer that the physical position of such a critical device as an automobile rear-view mirror that may be moved when a phone placed on it is used further argues against obviousness of the subject matter of claim 43, at least to the extent asserted to have been obvious based upon the collective teachings of Meyerle and Schofield alone. Schofield teaches that only a phone's microphone is a part of the bracket for a rear view mirror assembly. Therefore, since we do not sustain the rejection of independent claim 43, the respective rejections of the dependent claims must also be reversed.

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Since we have reversed the rejection of certain claims under the first paragraph of 35 U.S.C. § 112, and we have also reversed the rejection of all the claims on appeal under 35 U.S.C. § 103, the decision of the examiner is reversed.

REVERSED

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JAMES D. THOMAS)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
RICHARD TORCZON)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
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