

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

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEVEN F. GILLIG and GLENN E. PEDERSON

Appeal No. 1998-1491
Application No. 08/654,502

ON BRIEF

Before BARRETT, RUGGIERO, and BARRY, Administrative Patent Judges.

BARRY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the rejection of claims 30-57. We reverse.

BACKGROUND

The invention at issue in this appeal relates to cordless and cellular telephones. Cordless telephones typically are used to place and receive telephone calls throughout a house. Such cordless telephones are connected to a user's telephone

landline. Because of their limited range, however, cordless telephones are not suitable for use in vehicles.

Vehicular communications are typically achieved by means of radio telephone systems, the most prevalent being cellular telephone systems. A cellular telephone allows a user to place and receive telephone calls throughout a large, metropolitan area. A cellular telephone call, however, can cost as much as seven times a cordless telephone call.

The inventive cellular cordless telephone can be used to place and receive both cellular telephone calls and cordless telephone calls. Claim 46, which is representative for our purposes, follows:

46. A radiotelephone comprising first and second communication circuits, each communication circuit providing speech communication according to first and second communication protocols, respectively, the second communication circuit configured as a plug-in accessory which couples via a connector to the first communication circuit.

The references relied on in rejecting the claims follow:

Martiny et al. 26, 1978 (Martiny)	4,131,851	Dec.
Dinkins	4,659,878	Apr. 21, 1987
Bhagat et al. (Bhagat)	4,747,122	May 24, 1988
Kinoshita 6, 1988	4,790,000	Dec. (filed Dec. 10, 1986)
Sasaki et al. 1991	5,040,204	Aug. 13, (filed Oct. 2, 1987)
Nonami 1991	5,054,052	Oct. 1, (filed July 6, 1989)
Hofmann ¹ A1	German Offenlegungsschrift DE 3444989	June 12, 1986.

Claims 30-57 stand rejected under 35 U.S.C. § 103 as obvious over Dinkins in view of Martiny, Bhagat, Sasaki, or Nonami. Claims 30-57 also stand rejected under 35 U.S.C. § 103 as obvious over Kinoshita in view of Martiny, Bhagat, Sasaki, or Nonami. Claims 30-57 further stand rejected under

¹ A copy of the translation prepared by the U.S. Patent and Trademark Office is attached. We will refer to the translation by page number in this opinion.

35 U.S.C. § 103 as obvious over Hofmann in view of Martiny, Bhagat, Sasaki, or Nonami. Rather than repeat the arguments of the appellants or examiner in toto, we refer the reader to the brief and answer for the respective details thereof.

OPINION

In reaching our decision in this appeal, we considered the subject matter on appeal and the rejection advanced by the examiner. Furthermore, we duly considered the arguments and evidence of the appellants and examiner. After considering the totality of the record, we are persuaded that the examiner erred in rejecting claims 30-57. Accordingly, we reverse.

We begin by noting the following principles from In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993).

In rejecting claims under 35 U.S.C. Section 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. In re Oetiker, 977

F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).... "A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." In re Bell, 991 F.2d 781, 782, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) (quoting In re Rinehart, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976)). If the examiner fails to establish a prima facie case, the rejection is improper and will be overturned. In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

Furthermore, "[o]bviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor." Para-Ordnance Mfg. v. SGS Importers Int'l, 73 F.3d 1985, 1087, 37 USPQ2d 1237, 1239 (citing W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1450, 1551, 1553, 220 USPQ 303, 311, 312-13 (Fed. Cir. 1983)). "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 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992) (citing In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984)). "It is impermissible to use the claimed invention as an instruction manual or 'template' to piece

together the teachings of the prior art so that the claimed invention is rendered obvious." Id. at 1266, 23 USPQ2d at 1784, (citing In re Gorman, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991)).

Turning to the claims, we note that claims 30-38 each specify in pertinent part the following limitations:

- a first communication circuit contained in a first housing and configured for two-way speech communication according to a first communication protocol; and
- a second communication circuit contained in a second housing and configured for two-way speech communication according to a second communication protocol

Similarly, claims 39-45 each specify in pertinent part the following limitations:

- a first housing containing a first communication circuit configured for two-way communication of speech information according to a first communication protocol; and
- a second housing containing a second communication circuit configured for two-way communication of speech information according to a second communication protocol

Also similarly, claims 46-50 each specify in pertinent part the following limitations:

first and second communication circuits, each communication circuit providing speech communication according to first and second communication protocols, respectively, the second communication circuit configured as a plug-in accessory which couples via a connector to the first communication circuit.

Further similarly, claims 51-57 each specify in pertinent part the following limitations:

a first communication circuit contained in a first housing ... operable according to a first communication protocol for two-way communication of speech information with a first remote transceiver;

a second communication circuit contained in a second housing ... operable according to a second communication protocol for two-way communication of speech information with a second remote transceiver

Accordingly, claims 30-57 each require separate two-way communication circuits contained in separate housings. With this requirement in mind, we address the rejections relying on Dinkins, Kinoshita, and Hofmann as the primary reference.

Rejections Relying on Dinkins

Although Dinkins teaches first and second communications circuits that provide two-way communication, the examiner admits that the primary reference "does not disclose that each of the communication circuit having [sic] a separate housings." (Examiner's Answer at 3.) To the contrary, Figures 3 and 4 of Dinkins show all the communications circuitry of mobile subscriber unit 20 as contained in the same housing. Faced with this defect, the examiner makes the following allegation.

[I]t would have been obvious ... to incorporate the well known and patriarchal use of each of the communication circuit having a separate housings in the communication device of **Dinkins** in order to make the communication circuits separable. It has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179.

(Id. at 4-5.)

The appellants reply, "While the Examiner has cited references that show separate communication circuits in separate housings, the prior art lacks any motivation to combine Dinkins with such references." (Appeal Br. at 5.) We first address the rejection over Dinkins in view of Martiny.

Rejection over Dinkins in view of Martiny

The examiner fails to show that Martiny remedies the defect of Dinkins. Although the secondary reference teaches separate r-f and a-f units, the units are not contained in separate housings. To the contrary, the units are contained "in one and the same case" Col. 1, ll. 31-32.

Because Dinkins and Martiny integrate their circuits into the same housing, we are not persuaded that teachings from the prior art would appear to have suggested the claimed limitations of separate two-way communication circuits contained in separate housings. The examiner impermissibly relies on the appellants' teachings or suggestions. He fails to establish a prima facie case of obviousness. Therefore, we reverse the rejection of claims 30-57 over Dinkins in view of Martiny. We next address the rejections over Dinkins in view of Bhagat, Dinkins in view of Sasaki, or Dinkins in view of Nonami.

Rejections over Dinkins in view of Bhagat, Sasaki, or Nonami

Although Bhagat, Sasaki, or Nonami each teach separate communication circuits contained in separate housings, the examiner fails to identify a sufficient suggestion to combine any of the secondary references with Dinkins. "[T]he question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination.'" In re Beattie, 974 F.2d 1309, 1311-12, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992) (quoting Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984)).

Here, the teachings of Dinkins reveal that the circuitry of its mobile subscriber unit operates as an integral unit to relay data between a fixed cellular base station 10 and a remote handset 30. Col. 3, l. 66 - col. 5. l. 40. Rather than providing a line of reasoning to explain why combining Bhagat's, Sasaki's, or Nonami's teaching of using separate housings for separate circuits with Dinkins' integral unit would have been desirable, the examiner merely concludes, "it would have been obvious ... to incorporate the well known and patriarchal use of ... the communication circuit having a

separate housings in the communication device of **Dinkins** ... to make the communication circuits separable." (Examiner's Answer at 4-5.) Rather than being persuasive, such a conclusion is circular.

The examiner also attempts to circumvent the requirement to show desirability by relying on Nerwin as a per se rule of obviousness. (Id. at 5.) Such "reliance on per se rules of obviousness is legally incorrect and must cease. Any such administrative convenience is simply inconsistent with section 103" In re Ochiai, 71 F.3d 1565, 1570, 37 USPQ2d 1127, 1132 (Fed. Cir. 1995).

Because the circuitry of Dinkins' mobile subscriber unit operates as an integral unit, we are not persuaded that the prior art would have suggested the desirability, and thus the obviousness, of combining either Bhagat, Sasaki, or Nonami teaching of using separate housings with either Dinkins' teaching of a mobile subscriber unit.² The examiner's

²Although Bhagat, Sasaki, and Nonami each teach separate
(continued...)

conclusions impermissibly rely on the appellants' teachings or suggestions to piece together the teachings of the prior art. He fails to establish a prima facie case of obviousness. Therefore, we reverse the rejections of claims 30-57 over Dinkins in view of Bhagat, Dinkins in view of Sasaki, or Dinkins in view of Nonami. Next, we address the rejections relying on Kinoshita as the primary reference.

Rejections Relying on Kinoshita

Although Kinoshita teaches first and second communications circuits that provide two-way communication, col. 1, ll. 39-41 ("a radio frequency circuit of the private radio frequency channels in addition to the radio frequency of the urban cellular radio telephone"), the examiner admits that the primary reference "does not disclose that each of the communication

²(...continued)
communication circuits contained in separate housings, the communication provided by the circuits is not two-way. To the contrary, it is a one-way paging signal. Accordingly, we are also not persuaded that teachings from any of these references alone would appear to have suggested the claimed limitations of separate two-way communication circuits contained in separate housings.

circuit having [sic] a separate housings." (Examiner's Answer at 6.) To the contrary, Figures 3, 5 and 8 of Kinoshita show all the communications circuitry of a portable telephone set 20 as

contained in the same housing. Faced with this defect, the examiner makes the following allegation.

[I]t would have been obvious ... to incorporate the well known and patriarchal use of each of the communication circuit having a separate housings in the communication device of **Kinoshita** in order to make the communication circuits separable. It has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179.

(Id. at 6-7.)

The appellants reply, "Kinoshita lacks ... any suggestion to provide first and second housings." (Appeal Br. at 7.) We first address the rejection over Kinoshita in view of Martiny.

Rejection over Kinoshita in view of Martiny

The examiner fails to show that Martiny remedies the defect of Kinoshita. Because Kinoshita and Martiny integrate their circuits into the same housing, we are not persuaded that teachings from the prior art would appear to have suggested the claimed limitations of separate two-way communication circuits contained in separate housings. The

examiner impermissibly relies on the appellants' teachings or suggestions. He fails to establish a prima facie case of obviousness. Therefore, we reverse the rejection of claims 30-57 over Kinoshita in view of Martiny. We next address the rejections over Kinoshita in view of Bhagat, Kinoshita in view of Sasaki, or Kinoshita in view of Nonami.

Rejections over Kinoshita in view of Bhagat, Sasaki, or Nonami

Although Bhagat, Sasaki, or Nonami each teach separate communication circuits contained in separate housings, the examiner fails to identify a sufficient suggestion to combine any of the secondary references with Kinoshita.

Here, the teachings of Kinoshita reveal that the circuitry of its portable telephone set operates as an integral unit to transmit and receive data in a private radio telephone system and in a public cellular radio telephone system. Col. 5, l. 48 - col. 6, l. 16. As explained in addressing the rejections relying on Dinkins as the primary reference, the examiner's conclusion that "it would have been obvious ... to incorporate ... the communication circuit

having a separate housings in the communication device of **Kinoshita** ... to make the communication circuits separable," (Examiner's Answer at 6-7), is circular. Also as explained in addressing the rejections relying on Dinkins as the primary reference, his reliance on Nerwin as a per se rule of obviousness, (id. at 7), is legally incorrect.

Because the circuitry of Kinoshita's portable telephone set operates as an integral unit, we are not persuaded that the prior art would have suggested the desirability, and thus the obviousness, of combining either Bhagat, Sasaki, or Nonami teaching of using separate housings with Kinoshita' teaching of a portable telephone set. The examiner's conclusions impermissibly rely on the appellants' teachings or suggestions to piece together the teachings of the prior art. He fails to establish a prima facie case of obviousness. Therefore, we reverse the rejections of claims 30-57 over Kinoshita in view of Bhagat, Kinoshita in view of Sasaki, or Kinoshita in view of Nonami. Next, we address the rejections relying on Hofmann as the primary reference.

Rejections Relying on Hofmann

Although Hofmann teaches first and second communications circuits that provide two-way communication, Translation, p. 2 ("two radio sub-systems"), the examiner admits that the primary reference "does not disclose that each of the communication circuit having [sic] a separate housings." (Examiner's Answer at 8.) To the contrary, "[t]he basic concept of the invention is to combine two sub-systems? [sic] in the automatic telephone system." Translation, p. 2. Faced with this defect, the examiner makes the following allegation.

[I]t would have been obvious ... to incorporate the well known and patriarchal use of each of the communication circuit having a separate housings in the communication device of **Hofmann** in order to make the communication circuits separable. It has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179.

(Examiner's Answer at 8-9.)

The appellants reply, "Hofmann lacks any motivation to separate any components of the radio device among first and

second housings." (Appeal Br. at 8.) We first address the rejection over Hofmann in view of Martiny.

Rejection over Hofmann in view of Martiny

The examiner fails to show that Martiny remedies the defect of Hofmann. Because Hofmann and Martiny integrate their circuits into the same housing, we are not persuaded that teachings from the prior art would appear to have suggested the claimed limitations of separate two-way communication circuits contained in separate housings. The examiner has impermissibly relied on the appellants' teachings or suggestions. He has not established a prima facie case of obviousness. Therefore, we reverse the rejection of claims 30-57 over Hofmann in view of Martiny. We next, and last, address the rejections over Hofmann in view of Bhagat, Hofmann in view of Sasaki, or Hofmann in view of Nonami.

Rejections over Hofmann in view of Bhagat, Sasaki, or Nonami

Although Bhagat, Sasaki, or Nonami each teach separate communication circuits contained in separate housings, the

examiner fails to identify a sufficient suggestion to combine any of the secondary references with Hofmann.

The teachings of Hofmann reveal that the circuitry of its automatic telephone system operates as an integral unit to transmit and receive data in a VHF range and a UHF range. Translation, pp. 1-3. As explained in addressing the rejections relying on Dinkins as the primary reference, the examiner's conclusion that "it would have been obvious ... to incorporate ... the communication circuit having a separate housings in the communication device of **Hofmann** ... to make the communication circuits separable," Examiner's Answer at 8), is circular. Also as explained in addressing the rejections relying on Dinkins as the primary reference, his reliance on Nerwin as a per se rule of obviousness, (id. at 8-9), is legally incorrect.

Because the circuitry of Hofmann' automatic telephone system operates as an integral unit, we are not persuaded that the prior art would have suggested the desirability, and thus the obviousness, of combining either Bhagat, Sasaki, or Nonami

teaching of using separate housings with Hofmann' teaching of an automatic telephone system. The examiner's conclusions impermissibly rely on the appellants' teachings or suggestions to piece together the teachings of the prior art. He fails to establish a prima facie case of obviousness. Therefore, we reverse the rejections of claims 30-57 over Hofmann in view of Bhagat, Hofmann in view of Sasaki, or Hofmann in view of Nonami.

CONCLUSION

In summary, the rejection of claims 30-57 under 35 U.S.C. § 103 as obvious over Dinkins in view of Martiny, Bhagat, Sasaki, or Nonami. The rejection of claims 30-57 under 35 U.S.C. § 103 as obvious over Kinoshita in view of Martiny, Bhagat, Sasaki, or Nonami is also reversed. Furthermore, the rejection of claims 30-57 under 35 U.S.C. § 103 as obvious over Hofmann in view of Martiny, Bhagat, Sasaki, or Nonami is reversed.

REVERSED

LEE E. BARRETT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
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Appeal No. 1998-1491
Application No. 08/654,502

Page 22

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