

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 26<sup>1</sup>

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte GARY J. GRIMES

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Appeal No. 1998-2191  
Application No. 08/284,708

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ON BRIEF

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Before THOMAS, GROSS, and BLANKENSHIP, Administrative Patent Judges.

BLANKENSHIP, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-17, which are all the claims in the application.

We reverse.

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<sup>1</sup> We note apparent discrepancies in paper numbering in the instant file wrapper. We follow the convention of recent papers and deem this to be Paper No. 26.

BACKGROUND

The invention is directed to a telephone billing management method for cellular telephones. Claim 1 is reproduced below.

1. A telephone billing management method for a cellular telephone system having at least one provider with a real-time node computer and a plurality of user phone terminals with display units, said method comprising the steps of:

preprogramming the provider's real-time node computer to download cumulative current billing period information and transmit via cellular radio telecommunication channels said information to at least one of the user phone terminals during a two-way call signalling set-up period initiated by a user when beginning a current call; and

downloading and transmitting from the provider's real-time node computer said cumulative current billing period information to the user phone terminal during said two-way call set-up period via the cellular radio telecommunications channels, the user phone terminal being capable of displaying said current billing period information on the display unit.

The examiner relies on the following references:

Hattori et al. (Hattori)	5,109,401	Apr. 28, 1992
Ortiz et al. (Ortiz)	5,361,297	Nov. 1, 1994 (filed Jul. 28, 1992)

Claims 1-17 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hattori and Ortiz.

We refer to the Final Rejection (mailed Feb. 21, 1996), the Examiner's Answer (mailed Oct. 29, 1996), and the Supplemental Examiner's Answer (mailed May 9, 1997) for a statement of the examiner's position. We refer to the Brief (filed Aug. 13, 1996) and

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the Reply Brief (filed Dec. 30, 1996) for appellant's position with respect to the claims which stand rejected.

### OPINION

The rejection of instant claim 1 is set forth on pages 4 and 5 of the Answer. Hattori is relied upon as disclosing a base station linked to a mobile station 300. Hattori discloses, as pointed out at column 5, line 59 to column 6, line 17, that the mobile unit receives signals from the base station over the established speech communication link. The received information includes charge rate information. The call charge is calculated in the mobile unit by multiplying the time of the call by the charge rate information.

Contrary to the examiner's finding, however, the section does not disclose that the mobile unit "obtains the air time from the base station unit." Rather, CPU 331 (Fig. 2) of radio unit 300, which is part of mobile telephone apparatus 100 (Fig. 1), measures speech communication time, and uses the received charge rate information to calculate the call charge. According to column 5, lines 13 through 23 of Hattori, the user enters a dollar value for the allowable call charge.

In any event, the examiner concludes that "[i]t would have been obvious to one of ordinary skill in the art to perform the calculation step in the base unit because the base unit controls the charge rate and it recognizes the amount of the air time when in direct communication with the mobile unit whenever a two-way call is attempted." (Answer, page

5.) However, even if it would have been obvious to “perform the calculation step in the base unit,” it is unclear how that may speak to the requirements of claim 1. The claim recites that information is transmitted to the user phone terminal “during said two-way call set-up period.” Even if the call charge is thought to be a species of “cumulative current billing period information,” the “information” is not known during the two-way call set-up period -- before the call takes place.

With respect to instant claim 1, the rejection appears to rely on Ortiz only for teaching a display system, even though Hattori is recognized as disclosing display unit 450.

“[S]ystems for displaying current billing period information to a user has [sic; have] been well known in the art.” (*Id.*) The rejection then refers to column 14, lines 7-17 of Ortiz.

Column 14 of Ortiz refers to an embodiment shown in Figure 6 of the reference. Ortiz at column 12, line 64 et seq. describes an “autonomous pay telephone arrangement” 11 that may be retrofitted to a “standard” mobile telephone arrangement. Column 13, line 44 through column 14, line 29 reveals that billing rates for phone services, including “precharges, tariffs, mark-ups and the like as well as accounting information” are stored in memory 31 by means of computer access port 25, for programming by an external computer, or by means of hand-set 21 and LED display 17. Information on phone charges is accumulated until a reset operation is performed. While the system permits pricing of calls on a real-time basis, it is clear that the information is calculated and maintained at the user’s location, rather than transmitted from “the provider’s real-time node computer,” as

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required by instant claim 1. The Ortiz system is designed to estimate what the periodic bill from the service provider is expected to be, so that the owner of the system will know, to a reasonable degree, what the service provider's actual charge will be for a cumulative billing period. "The owner or user does not have to wait until the call is completed or until the bill comes in a month later to find out how much the cost of the call was." Ortiz, column 15, lines 21-24.

Thus, although Ortiz at column 14 discloses display of "current billing period information," and additionally calculation and storage of an approximation of actual "current billing period information," the information is calculated and maintained at the user's location. In this regard we note that Hattori, in the "third embodiment" described at column 7, line 27 through column 8, line 12, discloses calculating and storing both a "call charge" and an "accumulated call charge." The "accumulated call charge" is within the ambit of the claim 1 language of "cumulative current billing period information." However, as in Ortiz, the calculation and storage of the information is an approximation of what the provider's actual charges will be, and the calculation and storage is performed locally, by the user's apparatus.

In light of the examiner's findings and the references which have been applied in the rejection, we agree with appellant, as set forth on pages 5 and 6 of the Brief, that an essential part of instant claim 1 is not disclosed or suggested in the evidence before us. There is no disclosure or suggestion of downloading and transmitting cumulative current

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billing period information from the provider's real-time node computer to the user phone terminal during the two-way call set-up period. While in hindsight the reasons for modifying the prior art may appear obvious -- the reasons alleged by the examiner at pages 5 and 9 of the Answer -- the reasons do not arise from the prior art as represented by the disclosures of Hattori and Ortiz.

The obviousness inquiry requires the decision maker to return to the time the invention was made. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1050, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988). In view of the ubiquitous cell phones, and cell phone networks, of which we have current knowledge, it is tempting to view appellant's contribution to the art from today's perspective. In the instant rejection, however, the Hattori and Ortiz references comprise the only evidence we have of what the artisan knew at the time of invention. We agree with appellant that the references fail to establish the obviousness of the subject matter as a whole of instant claim 1. Further, the rejection of the other independent claim on appeal (claim 17) fails to establish the obviousness of the subject matter. (See Answer, page 6.)

The allocation of burdens requires that the USPTO produce the factual basis for its rejection of an application under 35 U.S.C. § § 102 and 103. In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984) (citing In re Warner, 379 F.2d 1011, 1016, 154 USPQ 173, 177 (CCPA 1967)). The one who bears the initial burden of presenting a prima facie case of unpatentability is the examiner. In re Oetiker, 977 F.2d

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1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). That burden has not been met in the instant case. Accordingly, we do not sustain the rejection of claims 1-17 under 35 U.S.C. § 103 as being unpatentable over Hattori and Ortiz.

CONCLUSION

The rejection of claims 1-17 is reversed.

REVERSED

JAMES D. THOMAS	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
ANITA PELLMAN GROSS	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
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	)	
HOWARD B. BLANKENSHIP	)	
Administrative Patent Judge	)	

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S H DWORETSKY  
AT&T BELL LABORATORIES  
600 MOUNTAIN AVE  
PO BOX 636  
MURRAY HILL , NJ 07974-0636