

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte FIDEL GARCIA PEDRAJA, ALFREDO REDONDO IGLESIAS,  
and JOSE LUIS GOMEZ SOLERA

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Appeal No. 1998-2708  
Application No. 08/459,361

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ON BRIEF

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Before THOMAS, FLEMING, and HECKER, Administrative Patent Judges.

HECKER, Administrative Patent Judge.

***DECISION ON APPEAL***

This is a decision on appeal from the final rejection of claims 1 through 5, all claims pending in this application.

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The invention relates to a communications system featuring a wireless terminal station (WTS) which enables a rural subscriber to communicate with a base station (BS) by either a standard telephone (T) or a cordless telephone (WT), using only one telephone number. In particular, referring to Figure 2, a wireless terminal station (WTS) is inhibited or enabled by a control means (EDC) depending on whether or not a cordless telephone (WT) is being used, which cordless telephone (WT) can also communicate directly with the base station (BS). The base station (BS) in turn is connected to a base station controller (BSC) which connects to a local exchange (LE).

Representative independent claim 1 is reproduced as follows:

1. Communications system, comprising: a number of base stations (BS) connected to a local exchange (LE) and a number of wireless terminal stations (WTS) that communicate, by radio, with at least one of the base stations (BS) in order to provide telephone services to telephone sets (T) connected by subscriber lines (LS) to the wireless terminals stations (WTS), wherein said wireless terminal stations (WTS) are inhibited or enabled by control means (EDC) depending on whether or not a cordless telephone (WT) is being used which, in an alternative manner to that of the wireless terminal stations (WTS), also communicates directly with the base stations (BS).

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The Examiner relies on the following references:

Morais	4,528,656	Jul. 9, 1985
Gillig et al. (Gillig)	5,463,674	Oct. 31, 1995
		(filed Jul. 15, 1994)

Claims 1 through 5 stand rejected under 35 U.S.C. § 103 as being unpatentable over Gillig in view of Morais.<sup>1</sup>

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the brief, reply brief and answer for the respective details thereof.

#### **OPINION**

After a careful review of the evidence before us, we will not sustain the rejection of claims 1 through 5 under 35 U.S.C. § 103.

The Examiner has failed to set forth a *prima facie* case. It is the burden of the Examiner to establish why one having ordinary skill in the art would have been led to the claimed

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<sup>1</sup> Claim 2 had been rejected under 35 U.S.C. § 112, second paragraph. However, an amendment received Sept. 26, 1997 and acknowledged by the Examiner on Oct. 15, 1997, overcame this rejection.

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invention by the reasonable teachings or suggestions found in the prior art, or by a reasonable inference to the artisan contained in such teachings or suggestions. ***In re Sernaker***, 702 F.2d 989, 995, 217 USPQ 1, 6 (Fed. Cir. 1983).

"Additionally, when determining obviousness, the claimed invention should be considered as a whole; there is no legally recognizable 'heart' of the invention." ***Para-Ordnance Mfg. v. SGS Importers Int'l, Inc.***, 73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995) (***citing W. L. Gore & Assocs., Inc. v. Garlock, Inc.***, 721 F.2d 1540, 1548, 220 USPQ 303, 309 (Fed. Cir. 1983), ***cert. denied***, 469 U.S. 851 (1984)).

The Examiner reasons that Gillig discloses the claimed invention except that Gillig is connected to land lines rather than to a radio communications system. The Examiner notes that Morais discloses a radio communications system with a number of base stations connected to a local exchange and a number of wireless terminal stations that communicate, by radio, with at least one base station, and telephone sets connected by subscriber lines to the wireless terminal stations (final rejection-page 3). The Examiner states:

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In a system such as this, one would be motivated to include a control means for enabling/inhibiting the wireless terminal station, as taught by Gillig, in order to minimize communications costs. Therefore, in order to minimize communications costs, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to use an apparatus with an alternate communications means and a control means for enabling/inhibiting the wireless terminal station as taught by Gillig, in the typical radio communications system of Morais. [Final rejection-page 3.]

Appellants argue that neither Gillig nor Morais teaches or suggests the claimed wireless terminal station (WTS) (brief-page 12). The Examiner responds that the wireless terminal station (WTS) is taught at 10 in Figure 1 of Gillig, and the first sentence of the abstract and Figure 1 in Morais (answer-page 4).

We agree with Appellants as to Gillig. Element 10 in Figure 1 of Gillig clearly does not have "telephone sets (T) connected by subscriber lines (LS) to the wireless terminal<sup>2</sup> stations (WTS)" as recited in independent claims 1 and 3. On the other hand, Morais clearly discloses such wireless terminal stations (WTS) in Figure 1 as 14, 16 and 18.

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<sup>2</sup> "[T]erminals" here in claim 1 should be "terminal".

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Appellants further argue that neither Gillig nor Morais teaches or suggests wireless terminal stations (WTS) which are inhibited or enabled by a control means (EDC) depending on whether or not a cordless telephone (WT) is being used (brief-pages 13 and 14), regarding claim 1. The Examiner responds that Gillig "discloses an 'audio switch [which] selects between audio signals of audio circuitry in the cordless transceiver and audio circuitry in the cellular transceiver under control of select signals.'" (reference characters omitted)." (Answer-page 4.)

We agree with Appellants. Gillig's audio switch selection is unrelated to inhibiting or enabling a wireless terminal station (WTS). In a broad sense, Gillig's switch could be considered to be the control means (EDC). Additionally, when the audio circuitry is disconnected from the cordless transceiver it would inhibit the cordless transceiver. Concurrently, when the audio circuitry is connected to the cellular transceiver, it would enable the cellular transceiver. However, element 10 of Gillig is not a wireless terminal station (WTS) as claimed since it is not connected to subscriber lines (LS) as claimed.

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Considering the wireless terminal stations (WTS) of Morais, we find no hint that it would be desirable to enable or inhibit any of them and use a cordless telephone in an alternative manner as recited in claim 1. It remains unclear as to exactly what the Examiner intends to modify in Morais. If the Examiner is indicating that one of Morais's remote stations (WTS), 14, 16, or 18, be replaced by element 10 of Gillig, we find this would not meet the requirements of claim 1 for the alternative communication by subscriber lines. If the Examiner is indicating that telephone sets (T) be replaced by element 10 of Gillig, we find this would also not meet the requirements of claim 1 for the alternative communication by subscriber lines. The broad use of Gillig's teachings (discussed supra) to modify Morais in the manner claimed can only be found in Appellants' disclosure. As argued by Appellants, hindsight reconstruction is not permitted (brief-page 24).

With respect to independent claim 3, Appellants argue that Gillig's cordless base station 180 cannot be considered as the claimed repeater as suggested by the Examiner (brief-page 32). We agree. If base station 180 were considered to

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be the claimed radio transceiver (RT), we are left without base stations (BS) which are also required by claim 3. Additionally, we find nothing to enable the suggested repeater when a cordless telephone is used. Also, as noted supra with respect to claim 1, we find element 10 of Gillig is not a WTS, and there is no reason, other than hindsight, to contemplate using cordless telephones in Morais.

The Federal Circuit states that "[t]he 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). "Obviousness 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 at 1087, 37 USPQ2d at 1239, **citing W. L. Gore & Assocs., Inc. v. Garlock, Inc.**, 721 F.2d at 1551, 1553, 220 USPQ at 311, 312-13.

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Since there is no evidence in the record that the prior art suggested the desirability of inhibiting or enabling a wireless terminal station (WTS) or radio transceiver (RT) as claimed, we will not sustain the Examiner's rejection of independent claims 1 and 3.

The remaining claims on appeal also contain the above limitations discussed in regard to claims 1 and 3 and thereby, we will not sustain the rejection as to these claims.

We have not sustained the rejection of claims 1 through 5 under 35 U.S.C. § 103. Accordingly, the Examiner's decision is reversed.

**REVERSED**

JAMES D. THOMAS	)	
Administrative Patent Judge	)	
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	)	
	)	
MICHAEL R. FLEMING	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
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	)	
STUART N. HECKER	)	
Administrative Patent Judge	)	

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