

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 55

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte MICHAEL L. LUBIN, SETON P. KASMIR, KATHRYN A. KUBASAK,  
GREGORY A. HEIN, SURENDRA B. MANDAVA, CHANCHAI POONPOL, SHAHIN  
HEDAYAT, and DONALD W. BURTIS

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Appeal No. 1999-2028  
Application No. 08/769,036

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ON BRIEF

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

GROSS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 67 through 69, 71, 73 through 82, 88 through 93, and 95. Claims 70 and 94 have been indicated as being allowable.<sup>1</sup>

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<sup>1</sup> The examiner states under the heading "Status of Claims" that claims 83, 84, 86, and 87 are allowed, but then includes claims 83, 84, and 87 in the statement and discussion of the rejection. We assume from the prosecution history that claims 83, 84, 86, and 87 contain allowable subject matter, that claims 83, 84, and 87 were inadvertently included in the rejection, and that none of claims 83, 84, 86, and 87 are before us on appeal.

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Appellants' invention relates to a telephone handset that includes circuitry that transceives both analog cellular signals and also cellular digital packet data (CDPD) signals. Claim 67 is illustrative of the claimed invention, and it reads as follows:

67. A telephone handset that communicates with analog cellular signals and with cellular digital packet data (CDPD) signals over frequency channels, comprising:

analog cellular signal circuitry that transceives analog cellular signals;

CDPD signal circuitry that transceives CDPD signals; and

a control processor, coupled to the discriminating circuit, that controls the analog cellular signal circuitry and the CDPD signal circuitry such that the CDPD signals are transceived over the same frequency channels as the analog cellular signals.

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Braitberg et al. (Braitberg)	5,479,479	Dec.
26, 1995		

Claims 67 through 69, 71, 73 through 84, 87 through 93, and 95 stand rejected under 35 U.S.C. § 103 as being unpatentable over Braitberg.

Reference is made to the Examiner's Answer (Paper No. 51, mailed April 14, 1998) for the examiner's complete reasoning

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in support of the rejection, and to appellants' Brief (Paper No. 49, filed February 26, 1998) and Reply Brief<sup>2</sup> (Paper No. 52, filed June 15, 1998) for appellants' arguments thereagainst.

OPINION

As a preliminary matter, we note that appellants indicate on pages 4-5 that the claims are not to stand or fall together. Appellants list claims 67, 76, 78 through 82, 88, 90, 92, and 94 together as Group I, claims 68, 73, and 93 together as Group II, and claims 69, 71, 74, 75, 77, 89, 91, and 95, respectively, as Groups III through X, but does not argue claim 77 separately. We will treat the claims substantially according to appellants' groupings<sup>3</sup>, with claim 77 grouped with claim 67, from which it depends, and with claims 67, 68, 69, 71, 74, 75, 89, 91, and 95 as representative of Groups I through IX, respectively.

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<sup>2</sup> Regarding the issue raised in the Reply Brief concerning the examiner's references to willful false statements and fraud, the examiner is reminded of the proper language to be used in rejecting claims, as set forth in MPEP § 707.07(d).

<sup>3</sup> Although appellants include claim 94 as part of Group I, we will not treat claim 94 as it has been indicated as containing allowable subject matter and is, therefore, not before us on appeal.

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We have carefully considered the claims, the applied prior art reference, and the respective positions articulated by appellants and the examiner. As a consequence of our review, we will affirm the obviousness rejection of claims 67, 68, 71, 73 through 82, 88, 90 through 93, and 95 and reverse the obviousness rejection of claims 69 and 89.

Regarding Group I, appellants assert (Brief, page 6) that Braitberg does not mention CDPD nor paging. Also, appellants contend (Brief, page 11) that "nothing in Braitberg ... permits handling of both analog cellular signals and CDPD signals." As pointed out by the examiner (Answer, page 10), paging is not recited in the claims, and, therefore, cannot be relied upon as evidence of non-obviousness. Further, as the examiner combines appellants' admissions as to the prior art with Braitberg for the limitations concerning CDPD, appellants' argument that Braitberg does not mention CDPD fails to address the rejection.

Appellants argue (Brief, page 7) that their disclosure of "the difficulty of integrating the features of AMPS voice transmission with applications such as data transmission, electronic mail, duplex paging, etc. ... teaches strongly away

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from any suggestion that it would be appropriate to combine CDPD as disclosed, with Braitberg." We disagree.

We concede that appellants disclose that AMPS voice transmission and data transmission are difficult to integrate. However, Braitberg states (column 12, lines 22-34) that the phone may be a conventional AMPS type phone, but that it "must be modified to provide a data path for digital data through connector 48." Braitberg continues that "it will be assumed that cellular phone 10 contains circuitry to packetize and depacketize digital data transmitted and received by the cellular phone." Further, Braitberg indicates (column 12, lines 58-61) that cellular phone 10 receives RF signals and "decides internally whether the RF signals contain voiceband or data/control information." Thus, Braitberg integrates AMPS voice transmission with data transmission in a single telephone handset, though Braitberg does not specify CDPD as the type of data signals.

Appellants admit (specification, page 9, lines 1-6) that CDPD was "developed to overcome some of the undesirable effects of transmitting raw digital data over the AMPS system," and (specification, page 12, lines 27-28) that "CDPD

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has been adopted as a national standard by the cellular industry." In light of these admissions, it would have been obvious to the skilled artisan to modify the handset of Braitberg to accommodate CDPD type packet data signals to conform with the national standard for such data transmission. The level of the skilled artisan should not be underestimated. See In re Sovish, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985). Accordingly, we will affirm the rejection of claim 67, and of the claims grouped therewith, claims 76 through 82, 88, 90, and 92.

As to the second group of claims, appellants argue (Brief, page 12) that Braitberg fails to show the analog cellular signal circuitry and the CDPD signal circuitry operatively coupled to a single, common radio frequency transceiver, as recited in claim 68. However, as indicated above, Braitberg discloses (column 12, lines 58-61) that RF signals are received by the telephone via an RF air-link and telephone 10 discriminates between voice and data information. In other words, both types of signals are received by the same RF air-link. Further, Braitberg discloses (column 11, lines 20-35) that the invention allows the cellular phone "to

transceive information using an external antenna," by coupling the cellular phone to the external antenna. Thus, Braitberg must operatively couple the signal circuitry to a common RF antenna. Therefore, we will sustain the rejection of claim 68 and of claims 73 and 93, grouped therewith.

Regarding claim 69, appellants contend (Brief, page 12) that nothing in Braitberg suggests a user control for selecting modes. We agree. Braitberg indicates that the mode is determined inside the telephone handset. Braitberg does not contemplate giving the user any control of the modes. Further, the inclusion of a user input is more than "broadly providing a manual activity to replace mechanical or automatic means which has accomplished the same result," as argued by the examiner (Answer, page 7). Accordingly, we cannot sustain the rejection of claim 69.

For claim 71, appellants argue (Brief, page 12) that the prior art does not show "at least portions of the analog cellular signal circuitry and the CDPD signal circuitry [being] included in a single application specific integrated circuit." However, it would have been obvious to include at least a portion of each signal circuitry in a single

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integrated circuit to minimize the circuitry required.

Therefore, we will sustain the rejection of claim 71.

As to claims 74 and 75, the examiner (Answer, page 8) takes Official Notice that "switch over circuitry for compensating for multipath conditions and diversity receiving antenna are all well known ... in cellular telephone [sic] and it would have been obvious to incorporate such well known elements in the cellular telephone of **Braitberg, et al** in order to improve reception and transmission of the cellular telephone." Appellants merely assert (Brief, page 12) that Braitberg fails to disclose both the switch over circuitry and the diversity receiving antenna. However, the rejection is based on 35 U.S.C. § 103, and appellants do not challenge the specific Official Notice nor the rationale for obviousness for claims 74 and 75. Arguments that could have been made but were not presented in the Brief are considered waived. See 37 CFR § 1.192(a). Therefore, we will affirm the rejection of claims 74 and 75.

We note that appellants (Brief, pages 13-14) attack generally the examiner's taking of official notice, arguing that the examiner has failed to state the date on which his

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official notice was taken. Appellants do not point to the specific Official Notice taken for claims 74 and 75. We assume that the examiner's Official Notice that elements were well-known and common are as of the effective filing date of the present application. Thus, we do not consider this general attack as particularly pointing out deficiencies in the examiner's rejection as required by 37 CFR § 1.192(c)(7).

Claim 89 recites a "control processor ... for maintaining operation only in the CDPD mode until receiving an indication of analog cellular operation." Appellants argue (Brief, page 13) that this limitation is not shown by the references. We agree that Braitberg does not disclose such a control processor. Further, as the examiner has not addressed this limitation, the examiner has failed to establish a prima facie case of obviousness. Consequently, we must reverse the rejection of claim 89.

For the limitation of claim 91, the examiner asserts (Answer, page 9) that it would have been obvious to use two processors instead of one for parallel processing of the analog and CDPD signal circuitries. Appellants merely state that the claim limitation "is not shown by the prior art."

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Appellants fail to address the rationale for obviousness. Again, arguments that could have been made but were not presented in the Brief are considered waived. See 37 CFR § 1.192(a). Therefore, we will affirm the rejection of claim 91.

Last, appellants (Brief, page 13) paraphrase the entirety of claim 95 and contend that it "is not shown by the references." Appellants do not specifically point out any deficiencies in the rejection as required by 37 CFR § 1.192(c)(7). Accordingly, we will sustain the rejection of claim 95.

In summary, we have sustained the rejection of claims 67, 68, 71, 73 through 82, 88, 90 through 93, and 95 and have not sustained the rejection of claims 69 and 89 based on Braitberg. Therefore, the decision of the examiner rejecting claims 67 through 69, 71, 73 through 82, 88 through 93, and 95 is affirmed-in-part.

We make the following new ground of rejection under 37 CFR § 1.196(b). Claims 67 through 69, 71, 73 through 82, and 88 through 93 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. In claim 67, line 7, the

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phrase "the discriminating circuit" lacks antecedent basis. Accordingly, claim 67 and the claims which depend therefrom, claims 68, 69, 71, 73 through 82, and 88 through 93, are vague and indefinite.

#### CONCLUSION

The decision of the examiner rejecting claims 67 through 69, 71, 73 through 82, 88 through 93, and 95 under 35 U.S.C. § 103 is affirmed as to claims 67, 68, 71, 73 through 82, 88, 90 through 93, and 95 and reversed as to claims 69 and 89. A new ground of rejection of claims 67 through 69, 71, 73 through 82, and 88 through 93 under 35 U.S.C. § 112, second paragraph, has been added pursuant to provisions of 37 CFR § 1.196(b).

In addition to affirming the examiner's rejection of one or more claims, this decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides, "A new ground of rejection shall not be considered final for purposes of judicial review."

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Regarding any affirmed rejection, 37 CFR § 1.197(b) provides:

(b) Appellants may file a single request for rehearing within two months from the date of the original decision . . . .

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

Should the appellants elect to prosecute further before the Primary Examiner pursuant to 37 CFR § 1.196(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere

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incident to the limited prosecution, the affirmed rejection is overcome.

If the appellants elect prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for reconsideration thereof.

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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  
37 CFR § 1.196(b)

JERRY SMITH	)	
Administrative Patent Judge	)	
	)	
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	)	
	)	BOARD OF PATENT
MICHAEL R. FLEMING	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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ANITA PELLMAN GROSS	)	
Administrative Patent Judge	)	

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