

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. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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**Ex parte** VINCENT C. JACKSON

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Appeal No. 1999-2213  
Application No. 08/641,956

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ON BRIEF

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Before THOMAS, DIXON, and BARRY, **Administrative Patent Judges**.  
DIXON, **Administrative Patent Judge**.

**DECISION ON APPEAL**

This is a decision on appeal from the examiner's final rejection of claims 1-18, which are all of the claims pending in this application.

We REVERSE.

## BACKGROUND

Appellant's invention relates to a method and apparatus for a portable digital entertainment system. The system utilizes a centralized store of music and/or games which are selectable by users and downloaded to the portable units for use at a time desired by the user. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. A dedicated cellular system for distribution of digital music and video games by microwave transmission, comprising:  
  
a microwave cellular tower capable of transmitting and receiving a plurality of digital music and video games transmissions,  
  
a storage unit of user selectable music and video games connected to said microwave cellular tower,  
  
a selection processor for managing exchange of user selectable music and video games between said storage unit and said microwave cellular tower, and  
  
a plurality of dedicated user portable digital cellular devices exchanging digital music and video games transmissions with said microwave cellular tower in response to user selection of said user selectable music and video games.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Bradbury	5,442,512	Aug. 15, 1995
Norman et al (Norman)	5,702,302	Dec. 30, 1997
		(Filed Feb. 15, 1996)

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Claims 1-18 stand rejected under 35 U.S.C. § 103 as being unpatentable over Bradbury and in view of Norman.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellant regarding the above-noted rejection, we make reference to the examiner's answer (Paper No. 13, mailed Mar. 2, 1999) for the examiner's reasoning in support of the rejection, and to appellant's brief (Paper No. 12, filed Dec. 4, 1998) for the appellant's arguments thereagainst.

### **OPINION**

In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by appellant and the examiner. As a consequence of our review, we make the determinations which follow.

Appellant traverses the examiner rejection and specifically the examiner's reliance upon the use of the computer disclosed by Bradbury to access the Internet via a wireless modem. (See brief at page 4.) Appellant argues that the claimed invention is a dedicated cellular network that does not use a modem to translate analog signals to digital signals and that the system includes a plurality of dedicated portable cellular

stereos or portable cellular gaming units.<sup>1</sup> (See brief at page 4.) We agree with appellant.

Appellant argues that there is no motivation to combine the teachings of the cellular-based gaming of Norman with the portable laptop of Bradbury. (See brief at page 5.) We agree with appellant. In our view, we find that the examiner has not provided a convincing line of reasoning to combine the cellular communication between plural display units and the control unit with the portable computer of Bradbury. The examiner relies on the teachings of Bradbury in combination with the portable computer being connected to the Internet for a majority of the teachings in the rejection. (See answer at page 5.) We agree with the examiner that in the context postulated by the examiner, games, music and any other data/information would be readily available over the Internet. But, we question what the motivation of the skilled artisan would have been to use a portable computer in a dedicated music and/or game system. While the examiner has identified the correspondence of various parts of the postulated system to

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<sup>1</sup> Here we note that appellant argues the stereo and gaming units in the alternative, but the language of independent claims 1 and 14 “exchanging digital and video games” implying that each portable unit has both capabilities. We do not find a disclosed embodiment having both functionalities. We further note that independent claim 14 uses both “and” and “or” in the claim with respect to the exchange and retrieval of the stored data.

the claimed invention, the examiner has not addressed the claimed invention, as a whole. Whereas, the claim requires

a selection processor for managing exchange of user selectable music and video games between said storage unit and said microwave cellular tower, and

a plurality of dedicated user portable digital cellular devices exchanging digital music and video games transmissions with said microwave cellular tower in response to user selection of said user selectable music and video games.

The “selection unit” argued by the examiner actually is a “selection processor” for managing the exchange of selectable data which would be more than a mere router at an Internet Service Provider (ISP).

Appellant argues that Bradbury is silent as to use of the Internet and does not provide a motivation for its use as the examiner maintains. (See brief at page 4.) We agree with appellant. From our review of Bradbury, Bradbury is concerned with the integration of the disclosed functional units into a portable work station. (Bradbury at columns 3-4.) Bradbury discloses that the data interface 66 is connected to the cellular phone and the modem to permit facsimile and data transmission. (Bradbury at column 5, lines 2-4.) Therefore, Bradbury does not expressly suggest the use of an ISP as advanced by the examiner. While we do not dispute the interaction of the units in the examiner’s proposed use of the portable computer of Bradbury, we do not find an express or even an implied teaching or suggestion in Bradbury alone for the examiner’s combination with an ISP.

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Appellant further argues that there is no motivation to combine the teachings of [Bradbury and Norman. (See brief at page 5.) We agree with appellant that the examiner has not shown a convincing line of reasoning to further miniaturize the system Bradbury to the size and capability of the portable units of Norman as the examiner suggests.

“The Patent Office has the initial duty of supplying the factual basis for its rejection. It may not, because it may doubt that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis.” *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 174 (CCPA 1967). Therefore, we find that the examiner has not established a *prima facie* case of obviousness, and we will not sustain the rejection of independent claim 1 and its dependent claims 2-13.

Independent claim 14 contains similar limitation as claim 1; therefore, we will not sustain the rejection of claim 14 and its dependent claims 15-18.

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**CONCLUSION**

To summarize, the decision of the examiner to reject claims 1-18 under 35 U.S.C. § 103 is reversed.

REVERSED

JAMES D. THOMAS  
Administrative Patent Judge

JOSEPH L. DIXON  
Administrative Patent Judge

LANCE LEONARD BARRY  
Administrative Patent Judge

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JLD:pgg  
Jackie Lee Duke

Appeal No. 1999-2213  
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One West Loop South  
Suite 100  
Houston, TX 77027-9009