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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte EUN-SUN KIM, WI-HYUN YOO,
and SEUNG-CHUL CHOI

Appeal 2010-008193
Application 11/377,288
Technology Center 2600

Before ROBERT E. NAPPI, DEBRA K. STEPHENS and
GEORGIANNA W. BRADEN, *Administrative Patent Judges*.

BRADEN, *Administrative Patent Judge*

DECISION ON APPEAL

This is an appeal¹ under 35 U.S.C. § 134(a) from the Final Rejection of claims 1-3, 5-7, and 9-11.² We have jurisdiction under 35 U.S.C. § 6(b).
We affirm.

STATEMENT OF THE CASE

Appellants' Invention

Appellants' invention relates to a call origination method using a short key in a mobile communication terminal for performing call origination conveniently. (Abstract.)

Exemplary Claim

Claims 1, 7, and 11 are the pending independent claims. Claim 1 is exemplary, and is reproduced below with disputed limitations in italics:

1. A call origination method using a short key in a mobile communication terminal, the method comprising:

receiving a short key setup menu;

receiving at least one number corresponding to a short key implemented in the short key setup menu;

receiving at least one phone number of a phone book corresponding to the received number;

setting the number as the short key;

originating a call to a phone number corresponding to the number, when the number set as the short key is input; and

¹ The Real Party in Interest is Samsung Electronics, Co., Ltd.

² Claims 4 and 8 were cancelled and are not on appeal.

if the phone number corresponding to the short key input does not exist, originating a call to a phone number previously registered in an address of the phone book corresponding to the number.

Examiner's Rejections

1. Claims 1-3, 5-7, and 9-11 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. (Ans. 3.)
2. Claims 1, 2, 6, 7, 9, and 11 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Lim (US 2002/0169007). (Ans. 3.)
3. Claims 3, 5, and 10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Lim in view of Frederiksen (US 6,185,295). (Ans. 5.)

ISSUE 1

§ 112, Second Paragraph, Rejection of Claims: 1-3, 5-7, and 9-11

Appellants contend that independent claim 1 is definite and claim element “the number” in line 13 of independent claim 1 has support in line 4 of independent claim 1. (App. Br. 10.)

Issue 1: Has the Examiner erred in concluding that claims 1-3, 5-7, and 9-11 are indefinite under § 112, second paragraph? In particular, the issue turns on whether an ordinarily skilled artisan, having read Appellants' Specification, would be apprised of the scope of the following claim limitation recited in independent claim 1:

“originating a call to a phone number previously registered in an address of the phone book corresponding to the number.”

ANALYSIS

The test for definiteness under 35 U.S.C. § 112, second paragraph, is whether “those skilled in the art would understand what is claimed when the claim is read in light of the specification.” *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986).³ If the language of the claim is such that a person of ordinary skill in the art could not interpret the metes and bounds of the claims so as to understand how to avoid infringement, a rejection of the claim under 35 U.S.C. § 112, second paragraph is deemed appropriate. *Morton Int’l, Inc. v. Cardinal Chemical Co.*, 5 F.3d 1464, 1470 (Fed. Cir. 1993). We note that it is the Appellants’ burden to precisely define the invention, not the USPTO’s. *In re Morris*, 127 F.3d 1048, 1056 (Fed. Cir. 1997).

We review the Examiner’s rejections in light of Appellants’ arguments that the Examiner has erred. Appellants submit that “the number” in line 13 of independent claim 1 has support in line 4 of independent claim 1. (App. Br. 10.) However, the Examiner finds that the claim element “the number” in line 13 of claim 1 lacks sufficient antecedent

³ “The legal standard for definiteness is whether a claim reasonably apprises those of skill in the art of its scope.” *In re Warmerdam*, 33 F.3d 1354, 1361 (Fed. Cir. 1994) (citing *Amgen Inc. v. Chugai Pharmaceutical Co. Ltd.*, 927 F.2d 1200, 1217 (Fed. Cir.1991)). The “inquiry therefore is merely to determine whether the claims do, in fact, set out and circumscribe a particular area with a reasonable degree of precision and particularity.” *In re Moore*, 439 F.2d 1232, 1235 (CCPA 1971).

basis and is, therefore, indefinite. (Ans. 3.) We agree with the Examiner. Although, line 4 of claim 1 recites “receiving at least one number corresponding to a short key implemented in the short key setup menu,” there is no indication in the language of claim 1 whether “the number” recited at line 13 is (i) one *of the at least one* phone number corresponding to a short key, (ii) one *of the at least one* phone number, (iii) the number set as the short key, (iv) a phone number corresponding to the number, (v) a phone number previously registered in an address of the phone book, or (v) a number of an address in a phone book.

The Appellants further contend that

“the number” in line 13 of independent claim 1 refers to the number on the key pad of the mobile terminal set as the short key of a phone number. If the phone number does not exist when a call is originated to the phone number corresponding to the short key, a call is made to the phone number previously registered as the phone number corresponding to the number on the key pad of the mobile terminal set as the short key of said phone number (paragraphs [0015] - [0025]).

(App. Br. 10.)

We are unpersuaded by Appellants’ contention, because (a) the language of the claims as currently written, does not reflect the language of Appellants’ argument, and (b) as shown below, Appellants’ Specification discloses multiple interpretations for the term “the number”:

[W]hen the user presses a short key, that is a number key, the controller 100 shown [in Figure 1,] determines if a phone number corresponding to the short key exists, or if a phone number exists in an address corresponding to the number previously set in the phone book.

(Spec. [0015], emphasis added.)

[W]hen the short key setup menu is received from the user, the display unit 110 displays the arrangement screen of number keys in the key input unit 130. Accordingly, when the user sets a short key, the display unit 110 displays whether the short key has been set so that existence or absence of a phone number previously set in a number to be set by the user can be determined.

(Spec. [0016], emphasis added.)

[I]f the user presses a number key, when there exist both the phone number of a short key corresponding to the number of the number key and a phone number corresponding to an address of the phone book, the display unit 110 displays all of the existing phone numbers. If the display unit 110 receives the short key setup menu from the user and displays the arrangement screen of the number keys, when a number key of a number which a short key has been set is received from the user, the display unit 110 displays both the phone number set as the short key and various information.

(Spec. [0016], emphasis added.)

The phone book database sequentially stores phone numbers input by the user. Accordingly, when the order of the phone numbers stored in the phone book database is not randomly set by the user, addresses are set and stored according to an input order. The short key database receives the short key setup menu from the user, receives a number of a number key to be designated as the short key, and stores short keys set separately from the order of the phone book.

(Spec. [0017], emphasis added.)

The key input unit 130 is used when the user inputs both various data stored in the mobile communication terminal and signals

used for performing various functions in the mobile communication terminal. For example, the key input unit 130 according to an exemplary embodiment of the present invention is used when the numbers of the number keys of the key input unit 130 are set as short keys by the user and phone numbers are received so as to correspond to the numbers of the number keys.

(Spec. [0018], emphasis added.)

Consequently, we find that an ordinarily skilled artisan, having read Appellants' Specification, would not have been apprised of the scope of independent claim 1. Further, we decline to engage in speculative assumptions concerning the meaning of Appellants' claim language. *See In re Steele*, 305 F.2d 859, 862-863 (CCPA 1962). Thus, Appellants have not persuaded us the Examiner erred in concluding that independent claim 1 is indefinite under 35 U.S.C. §112, second paragraph.

Appellants have not presented any substantially different arguments for independent claims 7 and 11, which require the same disputed claim limitation as claim 1. Accordingly, we sustain the rejection of independent claims 7 and 11 under 35 U.S.C. § 112, second paragraph. Similarly, Appellants have not presented any substantive arguments with respect to dependent claims 2-3, 5-6, and 9-10, and thus, these claims fall with their respective independent claims. *See* 37 C.F.R. § 41.37(c)(1)(vii) (stating that "the failure of Appellant to separately argue claims which Appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately"). Therefore, we sustain the rejection of claims 1-3, 5-7, and 9-11 under 35 U.S.C. § 112, second paragraph.

ISSUE 2

§ 102(b) Rejection of Claims 1, 2, 6, 7, 9, and 11

As a consequence of our analysis regarding the indefiniteness of claims 1-3, 5-7, and 9-11 discussed *supra*, we *pro forma* reverse the Examiner's rejections of claims 1, 2, 6, 7, 9, and 11 under 35 U.S.C. § 102(b). The subject matter encompassed by these claims must be reasonably understood without resort to speculation. Presently, speculation and conjecture must be utilized inasmuch as the cited claims do not adequately reflect what the disclosed invention is. *In re Steele*, 305 F.2d 859, 862 (CCPA 1962) (a prior art rejection cannot be sustained if the hypothetical person of ordinary skill in the art would have to make speculative assumptions concerning the meaning of claim language); *see also In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970). It should be understood, however, that our decision in this regard is based solely on the indefiniteness of the claimed subject matter, and does not reflect on the adequacy of the prior art evidence applied in support of the rejections.

ISSUE 3

§ 103(a) Rejection of Claims 3, 5, and 10

For the reasons discussed above, we *pro forma* reverse the Examiner's rejections of claims 3, 5, and 10 under 35 U.S.C. § 103(a).

DECISION

The Examiner's decision to reject claims 1-3, 5-7, and 9-11 under 35 U.S.C. § 112, second paragraph is affirmed. The Examiner's decision to reject claims 1, 2, 6, 7, 9, and 11 under 35 U.S.C. § 102(b) is *pro forma*

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reversed on the basis that these claims are indefinite. The Examiner's decision to reject claims 3, 5, and 10 under 35 U.S.C. § 103(a) is *pro forma* reversed on the basis that these claims are indefinite. Since we have affirmed at least one ground of rejection with respect to each claim on appeal, the Examiner's decision is affirmed. *See* 37 C.F.R. § 41.50(a)(1).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

msc