

# EXHIBIT 9



UNITED STATES DEPARTMENT OF COMMERCE  
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08/459,376 06/02/95 PAULICK

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EXAMINER

26W2/0831

PHAM, C

ART UNIT

PAPER NUMBER

11

MOTOROLA INC  
INTELLECTUAL PROPERTY DEPARTMENT KDK  
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2611

DATE MAILED:  
08/31/95

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

This application has been examined  Responsive to communication filed on \_\_\_\_\_  This action is made final.

A shortened statutory period for response to this action is set to expire 03 month(s), \_\_\_\_\_ days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- Notice of References Cited by Examiner, PTO-892.
- Notice of Draftsman's Patent Drawing Review, PTO-948.
- Notice of Art Cited by Applicant, PTO-1449.
- Notice of Informal Patent Application, PTO-152.
- Information on How to Effect Drawing Changes, PTO-1474.
- \_\_\_\_\_

Part II SUMMARY OF ACTION

1.  Claims 1-4, 6-17 AND 19-26 are pending in the application.

Of the above, claims \_\_\_\_\_ are withdrawn from consideration.

2.  Claims 5 AND 18 have been cancelled.

3.  Claims \_\_\_\_\_ are allowed.

4.  Claims 1-4, 6-10, 12, 15-17, 19-22 AND 24 are rejected.

5.  Claims 11, 13, 14, 23, 25 AND 26 are objected to.

6.  Claims \_\_\_\_\_ are subject to restriction or election requirement.

7.  This application has been filed with Informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8.  Formal drawings are required in response to this Office action.

9.  The corrected or substitute drawings have been received on \_\_\_\_\_. Under 37 C.F.R. 1.84 these drawings are  acceptable;  not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).

10.  The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_, has (have) been  approved by the examiner;  disapproved by the examiner (see explanation).

11.  The proposed drawing correction, filed \_\_\_\_\_, has been  approved;  disapproved (see explanation).

12.  Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has  been received  not been received  been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_.

13.  Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14.  Other

EXAMINER'S ACTION

PTOL-326 (Rev. 2/93)

987FH090

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**Part III DETAILED ACTION**

1. The preliminary amendment filed on 6-2-95 has been fully considered and made of record. By this amendment, claims 1-4, 6-17 and 19-26 are pending in the application and claims 5 and 8 have been canceled.

***Claim Rejections - 35 USC § 112***

2. Claims 1-4, 6, 15-17 and 19 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.

- Claim 1, lines 7-8, it is not clear whether or not the recited "at least a portion" is the same as the portion recited at line 6.

- Claim 15, lines 6-7, it is also not clear whether or not the recited "at least a portion" is the same as the portion recited at line 5.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless --  
(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

4. Claims 20-22 are rejected under 35 U.S.C. § 102(e) as being anticipated by Yokoyama (5,392,461).

- Consider claims 20 and 22, Yokoyama shows in figure 1 a radio device having receiver circuitry disposed in a housing (shielding case 33), an antenna (31) coupled to the receiver circuitry and attached to the outside surface of the housing, a substantially planar cover (the back side of housing 32) attached to the outside surface of the shielding case for concealing the antenna between the cover and the outside surface of the shielding case.

- As to claim 21, the back side of the housing (32) of Yokoyama is considered an escutcheon.

**Claim Rejections - 35 USC § 103**

5. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject

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matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

6. Claim 24 is rejected under 35 U.S.C. § 103 as being unpatentable over Yokoyama.

- Yokoyama discloses a radio device as discussed above. Although Yokoyama does not specify the type of antenna used in its antenna section (31), it is known in the art that loop antenna are also widely used. therefore, it would have been obvious to those ordinarily skilled in the art to use a loop antenna in the antenna section (31) of the device.

7. Claims 7-10 and 12 are rejected under 35 U.S.C. § 103 as being unpatentable over Yokoyama in view of Metroka et al (5,117,449).

- Consider claims 7 and 10, Yokoyama discloses a radio device as discussed above. Yokoyama, however, fails to show the radio device including pager circuitry and a pager antenna. Nevertheless, it is known in the art to incorporate pager

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circuitry in a radio device, as shown by Metroka (see figure 1, element 105), such that the user of the radio can use the pager to screen incoming calls (col. 1, lines 14-59). Therefore, it would have been obvious to those of ordinary skill in the art to implement the radio device of Yokoyama with a pager as taught by Metroka for the above noted purpose to improve its use. Such implementation could have been done by providing the pager circuitry inside the shielding case (33) and a pager antenna in an antenna section structured similar to the antenna section (31) of the radio device.

- As to claim 8, the back side of the housing (32) is considered an escutcheon.

- As to claim 9, the shielding case (33) also acts as a shield.

- As to claim 12, the antenna pager when implementing the radio device of Yokoyama as taught by Metroka could also take the form of a loop antenna.

#### ***Allowable Subject Matter***

8. Claims 11, 13, 14, 23, 25 and 26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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9. Claims 1-4, 6, 15-17 and 19 would be allowable if rewritten or amended to overcome the rejection under 35 U.S.C. 112.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chi Pham whose telephone number is (703) 305-4378. The examiner can normally be reached on Monday-Friday from 9:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Eisenzopf, can be reached on (703) 305-4711. The fax phone number for this Group is (703) 305-9508.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4700.

CHP

CHP

August 29, 1995

*Chi H. Pham*

CHI H. PHAM  
PRIMARY EXAMINER  
GROUP 2600