

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. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TSUNEHIRO MATSUI

Appeal No. 2000-0369
Application No. 08/477,770

ON BRIEF

Before JERRY SMITH, DIXON, and GROSS, **Administrative Patent Judges**.
DIXON, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-6, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

Appellant's invention relates to a system for automatically distributing received documents to alternative memories in a network rather than automatic storage in the memory of a facsimile machine attached to the network. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. A facsimile apparatus connected to at least one personal computer, comprising:

receiving means for receiving, through a public line, a communication procedure signal and a document from a transmitting station;

mail box information storage means for storing first mail box information corresponding to a mail box of said facsimile apparatus and second mail box information corresponding to a mail box of said personal computer;

storage means for storing a document destined for the mail box information storage means; and

control means including

(a) first determining means for determining whether or not a document to be received is destined for the mail box of said facsimile apparatus or said personal computer based on the communication procedure signal received by said receiving means,

(b) second determining means for comparing designation information in the communication procedure signal with the first and second mail box information stored in said mail box

information storage means to determine whether or not the document to be received is the document destined for a mail box of said personal computer,

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(c) receive control means for controlling said receiving means to receive the document when said second determining means determines that the document to be received is the document destined for a mail box of said personal computer,

(d) storage control means for storing the document received by said receiving means into said storage means,

(e) transfer means for transferring the document stored in said storage means to said personal computer via a network, and

(f) erasing means for erasing the document, which is transferred by said transfer means, in said storage means.

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

Silverberg	5,091,790	Feb. 25, 1992
Fuller et al. (Fuller)	5,224,156	Jun. 29, 1993

Claims 1-6 stand rejected under 35 U.S.C. § 103 as being unpatentable over Fuller in view of Silverberg.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellant regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 19, mailed Mar. 17, 1999) for the examiner's reasoning in support of the rejections, and to the appellant's brief (Paper No. 18, filed May 26, 1998) and reply brief (Paper No. 20, filed May 17, 1999) 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 argues that neither Fuller nor Silverberg discloses a first or second determining means nor do the references disclose the use of a communication procedure signal. (See reply brief at pages 1-2.) We agree with appellant. The examiner maintains that the signal from the depression of the asterisk "*" key followed by a mailbox number and the pound key "#" is a communication procedure signal.

(See answer at pages 4-5.) The examiner relies on columns 5-6 of Fuller to teach reception of the mailbox number and storage of the message in the appropriate mailbox.

The examiner then admits that Fuller does not transfer the stored document to a personal computer and relies upon the teachings of Silverberg for this feature.

While we agree with the examiner that Fuller does not transfer the stored document to a personal computer, we find that Fuller does teach that recipients can have a notification at a remote location of receipt of documents and/or have documents

automatically forwarded to another facsimile machine. (See Fuller at columns 7-9, Fig. 4 and 6.) While this is close to a personal computer and at times may even be a personal computer, we find that Fuller stores the document and then determines the appropriate

handling of the document rather than determining prior to reception and storage as recited in the language of independent claim 1. Claim 1 requires:

(a) first determining means for determining whether or not a document to be received is destined for the mail box of said facsimile apparatus or said personal computer based on the communication procedure signal received by said receiving means,

(b) second determining means for comparing designation information in the communication procedure signal with the first and second mail box information stored in said mail box information storage means to determine whether or not the document to be received is the document destined for a mail box of said personal computer. (Emphasis added.)

Therefore, we agree with appellant that Fuller does not teach or suggest the first or second determining means for a document to be received as defined by the language of claim 1. (See reply brief at pages 2-3.) We find that Fuller determines the additional routing of a received document not routing of a to be received document.

Appellant argues that the second determining means does not compare destination information in the communication procedure signal with the first and second mail box information stored in said mail box information storage means to determine whether or not the document to be received is the document destined for a mail box of said personal computer. We agree with appellant. Appellant argues that there is no comparison of the "*" to determine the destination of the document. We agree with appellant. Since the examiner has not provided a teaching of all the elements of the claimed invention as recited in the language of independent claim 1, we will not sustain the

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rejection of claim 1 and its dependent claims 2 and 3. Similarly, we will not sustain the rejection of independent claim 4 and its dependent claims 5 and 6.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-6 under 35 U.S.C. § 103 is reversed.

REVERSED

JERRY SMITH)
Administrative Patent Judge)
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) BOARD OF PATENT
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Administrative Patent Judge) AND
) INTERFERENCES
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