

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID MCELVANEY

Appeal No. 2001-1944
Application No. 08/734,857

ON BRIEF

Before THOMAS, DIXON and GROSS, Administrative Patent Judges.

THOMAS, Administrative Patent Judge.

DECISION ON APPEAL

Appellant has appealed to the Board from the examiner's final rejection of claims 1 through 7.

Representative claim 1 is reproduced below:

1. A digital network telephony device comprising:

a telephone handset comprising a microphone and a speaker, said microphone being connected to at least two microphone wires and said speaker being connected to at least two speaker wires;

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a computer system comprising a computer sound card having an input jack and an output jack and means for receiving and transmitting digital audio signals, means for compressing and decompressing said audio signals, means for transmitting compressed audio signals to a digital network, means for receiving compressed audio signals from said digital network; and

means for connecting the microphone wires to the input jack and for connecting the speaker wires to the output jack.

The following reference is relied on by the examiner:

Schindler et al. (Schindler) 5,675,390 Oct. 07, 1997
(filed Jul. 17, 1995)

Claims 1 through 7 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner relies upon Schindler alone.

Rather than repeat the positions of the appellant and the examiner, reference is made to the brief and the answer for the respective details thereof.

OPINION

Since we have concluded that the examiner has failed to establish a prima facie case of obviousness within 35 U.S.C. § 103, we reverse.

As appellant's disclosed invention in the Summary of the Invention at pages one and two of the brief made clear, it was

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well known in the art to utilize a separate microphone and speaker connected to the sound card of a PC for purposes of implementing internet telephony. As expressed at the top of page two of the principal brief on appeal, "the invention differs in that a telephone handset is used and is connected only to the system's sound card."

Schindler's Fig. 1 shows a home entertainment system 110 which is based upon personal computer 118 in the figure. The system utilizes plural remote control devices 124, 126. These are shown in Figs. 9 and 10 respectively. Fig. 3 shows the input/output to a personal computer 118 in Fig. 1, and the input/outputs consist of two sound cards 320, 321 as well as an RF input/output element 324. The sound card 320 in Fig. 3 is shown in more detail in Fig. 6 and, as noted by the examiner in the answer, includes a microphone input 620 and speaker line output 618. The input/output connections themselves from Fig. 3 are shown in Fig. 7 and the sound card is also shown there with the same speaker line output 618 and the microphone input 620 as a part of the sound card. Figs. 6 and 7 are discussed at column 12 of Schindler.

Of Figs. 9A-9C, Fig. 9C illustrates and column 13, line 45 begins a discussion of a cordless telephone as depicted. This is one variation of remote control input 124, shown in Fig. 1. The discussion at column 14 beginning at line 15 indicates that this unit interconnects with the personal computer 118 by the use of RF circuitry 324 in Fig. 3 and a similar discussion was introduced at the initial portion of column 9 as well. The keyboard embodiment in Fig. 10 is also discussed at the bottom of column 13 and intercommunicates with the personal computer 118 in Fig. 1 by the use of RF element 1040 in Fig. 10 by means of the RF input/output portion 324 in the Fig. 3 showing of the personal computer 118. Part of the remote control 124 from Fig. 9C is shown in Fig. 12 to emphasize that it communicates with the personal computer by means of the radio frequency capability. Note the discussion beginning at column 16, line 11.

Column 17, lines 26 through 41, noted by the examiner in the answer, emphasizes that the implementation of the telephone capability in these earlier figures of Schindler focuses upon portable phones and speakerphones, the latter of which characterization is consistent with appellant's assessment of the prior

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art in the specification as filed. As emphasized here, both speaker phone and cordless telephone approaches in the early figures of Schindler all use the interconnectability of these remote devices 124, 126 with the personal computer 118 by the use of RF element 324 in Fig. 3 and not by the use of the sound card 320 as is required by the claims on appeal.

The discussion of Fig. 14 beginning at the bottom column 18 of Schindler indicates a Windows-based environment for imaging various functionalities by the use of icons shown initially in Fig. 14A. What has not been recognized by both appellant and the examiner is the icon showing of a conventional telephone to the right center of this figure. The information services icon 1412 is shown in Fig. 14B and the information services menu in Fig. 14D includes the ability for voice messages and interconnections. The discussion at the middle of column 19 at lines 32 through 36 indicates the information services menu includes the capability of a telephony function, but it is noted that it is tied to the modem for voice messages. Thus, again, there is no teaching

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or suggestion of the use of the sound card within the PC 118 in Figs. 1 and 3 for telephony purposes.

The speakerphone and cordless telephone approaches discussed at column 17, lines 26 through 42 are based upon interconnectabilities utilizing the modem only and do not appear to teach or suggest the use of the PC 118 and its sound card 320 to implement this telephone functionality.

Figs. 15 and 16 of this reference are two different versions of the video conferencing system. The Fig. 15 system utilizes the ability to have microphone and speaker inputs connected to the public telephone network PSTN generally shown as element 1510 in Fig. 15. Again, this approach does not utilize the sound card 320 of personal computer 118 in Figs. 1 and 3.

Finally, the alternative video conferencing approach unit Fig. 16 is that portion of Schindler most relied upon by the examiner as the basis for the telephone handset capability. The discussion of this figure begins at the bottom half of column 20. The dashed item 1622 in Fig. 16 is stated at column 20, lines 52 through 57 as indicating a voice capability as an optional advanced feature.

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When the entirety of Schindler's disclosure is considered in conjunction with labeled element 1622 depicting a dashed rectangular block stating "PHONE VOICE I/O" fulfilling a very brief discussion in the noted portions of column 20, we are constrained to conclude, like appellant and the substance of the affidavit from Mr. Bogley (submitted as an attachment to paper no. 9 received on March 15, 1999) that Schindler does not teach or suggest the use of the claimed telephone handset. Consistent with our earlier noted discussion with respect to the speaker-phone and portable telephone approaches in the earlier figures of Schindler, it appears to us that the depiction of the outgoing arrowhead from element 1622 feeding directly the modem is consistent with the prior approaches. Thus, to the extent that a phone is suggested as part of element 1622, that is, a conventional telephone handset, it is fed directly into the modem 322 and not into the sound card 320. Correspondingly, however, any received audio in any form would appear to enter from a public telephone line 1612 through the modem 322 to the bus 312 and outputted correspondingly to the sound card 320 to the phone

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according to the depiction of the arrowhead to the element 1622. The manner in which appellant argues and the manner in which the affidavit of Mr. Bogley conveys to us that Schindler's system appears to work is straightforward according to the showings in Fig. 16.

The examiner indicates at the bottom of page 7 of the answer that "Schindler teaches in Figure 16 that two way communication is performed using element 1622 (voice capability), sound card and a modem. One output goes to modem 322 for transmission and one input goes to sound card 320 for reception." The examiner goes on to indicate that "[t]his teaching supports the conclusion that element 1622 could be interpreted as a telephone handset which is used to provide voice communications that is separate from a video conference."

Although we agree with these general assessments of the examiner as to these teachings and showings, the claimed invention requires that both the microphone of the telephone handset input be to the sound card and the output from the sound card feed the speaker of the handset. By the examiner's own admission, even if we consider the designation of element 1622 in Fig. 16 as indicating a conventional telephone handset, it is not

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connected in the manner required by the claims on appeal.
Appellant's remarks at the bottom of page 4 of the Reply brief are consistent with this understanding as well as the substance of paragraphs 5, 6 and 7 of the affidavit of Mr. Bogley.

Thus, if we were to consider the teachings and suggestions of Schindler and any inferences that the artisan would have reasonably derived therefrom in a light most favorably to the examiner, the subject matter of the claimed invention still would not have been met. The weight of the evidence before us in the form of Schindler as well as the affidavit of Mr. Bogley leads us to conclude that it would not have been obvious for the artisan to have connected a telephone handset in the manner claimed to the sound card of a personal computer.

In order for us to sustain the examiner's rejection under 35 U.S.C. § 103, we would need to resort to speculation or unfounded assumptions to supply deficiencies in the factual basis of the rejections. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968), reh'g denied, 390 U.S. 1000 (1968). This we decline to do. Here,

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simply put, more evidence is needed to convince us of the obviousness of the subject matter of the claims on appeal than for the examiner to rely upon Schindler and the examiner's own arguments.

Our reviewing court has made it clear in In re Lee, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002), and In re Zurko, 111 F.3d 887, 42 USPQ2d 1476 (Fed. Cir. 1997) that rejections must be supported by substantial evidence in the administrative record and that where the record is lacking in evidence, this Board cannot and should not resort to unsupported speculation. As indicated in Lee, 277 F.3d at 1343-44, 61 USPQ2d at 1433-34, the examiner's finding of whether there is a teaching, motivation or suggestion to combine the teachings of the applied references must not be resolved based on "subjective belief and unknown authority," but must be "based on objective evidence of record."

In view of the foregoing, since we are constrained to reverse the rejection of independent claims 1 and 7 on appeal, we must also reverse the rejection of dependent claims 2 through 6.

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Therefore, the decision of the examiner rejecting claims 1 through 7 under 35 U.S.C. § 103 is reversed.

REVERSED

JAMES D. THOMAS)	
Administrative Patent Judge)	
)	
)	
JOSEPH L. DIXON)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
ANITA PELLMAN GROSS)	
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