

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. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM G. PARSONS
and ROBERT W. PIEPHO

Appeal No. 2001-2050
Application No. 08/997,085

ON BRIEF

Before HAIRSTON, FLEMING, and DIXON, Administrative Patent Judges.
HAIRSTON, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 through 32.

The disclosed invention relates to a method and apparatus for processing an on-hold call between a hold initiating party and a holding party. Under the control of the holding party, a pre-recorded hold termination message may be selected and delivered to the hold initiating party.

Claim 1 is illustrative of the claimed invention, and it reads as follows:

1. A method for processing an on-hold call between a hold initiating party and a holding party, comprising the steps of:

receiving at a network node a hold termination signal from the holding party;

receiving at a network node a selection identifier from the holding party; and

delivering a pre-recorded hold termination message from the network node to the hold initiating party in response to the hold termination signal, the pre-recorded hold termination message being identified by the selection identifier.

The references relied on by the examiner are:

Nishikawa et al. (Nishikawa)	5,095,504	Mar. 10, 1992
Inaba	5,099,508	Mar. 24, 1992
Wolff et al. (Wolff)	5,327,486	July 5, 1994
Nepustil	5,930,339	July 27, 1999 (filed Nov. 5, 1996)

Claims 1 through 5, 7, 9, 11 through 14, 16, 19 through 22, 24 and 27 through 32 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Nepustil in view of Wolff.

Claims 8, 10, 17, 18, 25 and 26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Nepustil in view of Wolff and Inaba.

Claims 6, 15 and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Nepustil in view of Wolff and Nishikawa.

Reference is made to the briefs (paper numbers 16 and 18) and the supplemental answer (paper number 21) for the respective positions of the appellants and the examiner.

OPINION

We have carefully considered the entire record before us, and we will reverse the obviousness rejection of claims 1 through 32.

The examiner acknowledges (supplemental answer, page 3) that “**Nepustil** differs from the claimed invention in that the holding party records a message at the network node instead of selecting a pre-recorded message at the network node for delivering to the hold initiating party.”

According to the examiner (supplemental answer, page 4):

Wolff discloses a method wherein a called party can select either a new message or a message among several pre-recorded messages stored at a network node (PTM) for delivering to a calling party, wherein the step of selecting a pre-recorded message would read on selecting a ‘selection identifier’ (see **Wolff, Fig. 1, col. 5, lines 57-60**), and wherein it would have been obvious to one of ordinary skill in the art that a telephone could be used in place of the palm-top computer for performing such simple selection operation (see **Wolff, col. 7, lines 26-28**). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify and combine the above teachings of **Nepustil** and **Wolff** for providing a hold termination method as claimed, for allowing a holding party to quickly and conveniently leaving a frequently used message (see **Wolff, col. 6, lines 41-45**) to a hold initiating party so that the holding party could be better-spent doing other things.

Appellants argue (brief, page 8) that:

Wolff’s disclosure runs contrary to the claimed subject matter on this appeal. Each of the independent claims state that a network node receives a hold termination signal from a holding party. The claims further state that, in response to the hold termination signal, the network node transmits a message to a hold initiating party. Wolff, in contrast, does not disclose any hold termination signal being received from a holding party (Wolff’s calling party). Wolff also fails to disclose transmitting a pre-recorded message to a hold initiating party (Wolff’s called party) in response to a hold termination signal. Additionally, Wolff does not disclose a selection identifier

being received from a holding party or a pre-recorded message being transmitted in response.

Thus, as described above, both Nepustil and Wolff fail to teach or suggest two elements of the claimed invention: 1) delivering to a hold initiating party a pre-recorded message in response to the hold termination signal and 2) receiving a selection identifier and delivering a pre-recorded message in response to the selection identifier. Because the cited references fail to teach or suggest all elements of the pending claims, the rejections to claims 1-32 must be reversed.

We agree with appellants' argument that the holding party accesses a pre-recorded message and sends it to the hold-initiating party in the claims on appeal, whereas the hold initiating party (i.e., the end user) in Wolff accesses a pre-recorded message and sends it to the holding party (i.e., the calling party) (column 4, lines 5 and 6; column 5, lines 57 through 60). Since Nepustil is not concerned with sending pre-recorded messages, and Wolff has a hold-initiating party that performs the pre-recorded message accessing function performed by the holding party in the claims on appeal, we likewise agree with the appellants' argument that the obviousness rejection of claims 1 through 5, 7, 9, 11 through 14, 16, 19 through 22, 24 and 27 through 32 must be reversed.

The obviousness rejection of claims 6, 8, 10, 15, 17, 18, 23, 25 and 26 is reversed because the teachings of Inaba and Nishikawa do not cure the noted shortcomings in the teachings of Nepustil and Wolff.

DECISION

Appeal No. 2001-2050
Application No. 08/997,085

The decision of the examiner rejecting claims 1 through 32 under 35 U.S.C. § 103(a) is reversed.

REVERSED

KENNETH W. HAIRSTON)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
MICHAEL R. FLEMING)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
JOSEPH L. DIXON)	
Administrative Patent Judge)	

KWH/lp

Appeal No. 2001-2050
Application No. 08/997,085

KENYON & KENYON
1500 K STREET , N.W. SUITE 700
WASHINGTON, DC 20005