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. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PER TOMAS ANDREASON

Appeal No. 2002-1531
Application No. 08/828,548

ON BRIEF

Before DIXON, GROSS, and SAADAT, **Administrative Patent Judges**.

DIXON, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-21, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

Appellant's invention relates to a connection of a computer to a telephone exchange. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

> 1. Method for using a computer as a telephone comprising the steps of:
>
> connecting the computer to a telephone exchange via a computer network, such that the computer is capable of receiving telephone calls over a direct telephone connection between the computer and a calling party;
>
> registering, in the exchange, the computer as a telephone;
>
> allocating, by the exchange, a unique telephone number that is to be associated with the computer;
>
> setting up, via the computer network, a traffic channel between the telephone exchange and the computer, for sending and receiving speech signals;
>
> generating data packets containing telephony by applying, in the exchange, a signal structure, suitable for telephony, to speech signals intended for the computer; and
>
> sending the data packets containing telephony to the computer over said traffic channel wherein telephony comprises speech signals transmitted between a user of the computer and the calling party in real time.

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

Henley et al. (Henley)	5,526,353	Jun. 11, 1996
Iwami et al. (Iwami)	5,604,737	Feb. 18, 1997
White et al. (White)	6,014,379	Jan. 11, 2000 (filed Nov. 9, 1996)

Claims 1-8, 11-17 and 20 stand rejected under 35 U.S.C. § 103 as being anticipated by White. Claims 9 and 18 stand rejected under 35 U.S.C. § 103 as being unpatentable over White in view of Henley. Claims 10, 19, and 21 stand rejected under 35 U.S.C. § 103 as being unpatentable over White in view of Iwami.

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. 24, mailed Apr. 25, 2001) for the examiner's complete reasoning in support of the rejections, and to appellant's brief (Paper No. 23, filed Jan. 25, 2001) and reply brief (Paper No. 25, filed Jun. 5, 2001) for 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.

35 U.S.C. § 102

To the extent that the rejection may be based on the principles of inherency - since White does not expressly describe that which is claimed -- we note that our reviewing court has set out clear standards for a showing of inherency, which have not

been attained in the instant case. To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." **In re Robertson**, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted).

We are persuaded by appellant that the Section 102 rejection of each claim on appeal is in error. We thus do not sustain the rejection of claims 1-8, 11-17, and 20 under 35 U.S.C. § 102 as being anticipated by White. The examiner maintains that White teaches the recited steps are carried out in or by the telephone exchange. (See answer at pages 3-10.) Appellants maintain that White does not teach or suggest the recited steps are carried out by the exchange. (See brief at pages 5-7, and reply at pages 2-4.) We agree with appellant that the examiner has not established where White teaches registering the computer as a telephone in the exchange. The examiner maintains that White teaches registering at column 11, but we agree with appellant that this portion of White teaches the use of an outside database and translation is performed by an Internet gateway router. Clearly White does not teach or fairly suggest the claimed registering step. Additionally, the examiner maintains that White teaches the translation of voice to packets and vice versa, but appellant argues that the Internet gateway router performs this function and that the router is not part of the exchange. Therefore, White does not teach the claimed “generating data packets containing

telephony by applying, in the exchange, a signal structure, suitable for telephony, to speech signals intended for the computer." Since the examiner has not established a ***prima facie*** case of anticipation, we cannot sustain the examiner's rejection of independent claim 1 and its dependent claims 2-8. Similarly, we do find that the examiner has not established a ***prima facie*** case of anticipation for independent claims 11 and 20, we cannot sustain the examiner's rejection of independent claims 11 and 20 and dependent claims 12-17.

35 U.S.C. § 103

In determining novelty, the first inquiry must be into exactly what the claims define. **In re Wilder**, 429 F.2d 447, 450, 166 USPQ 545, 548 (CCPA 1970). Similarly, a Section 103 analysis begins with a key legal question -- what is the invention claimed? **Panduit Corp. v. Dennison Mfg. Co.**, 810 F.2d 1561, 1567, 1 USPQ2d 1593, 1597 (Fed. Cir. 1987).

"Deficiencies of the cited references cannot be remedied by the Board's general conclusions about what is 'basic knowledge' or 'common sense.'" **In re Zurko**, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). Furthermore, "the Board's findings must extend to all material facts and must be documented on the record, lest the 'haze of so-called expertise' acquire insulation from accountability." **In re Lee**, 277 F.3d 1338, 1345, 61 USPQ2d 1430, 1435 (Fed. Cir. 2002). Here, we find the Examiner's arguments to be supported merely by the Examiner's own expertise instead

of the evidence of record and the teachings of prior art which are required in order to establish a ***prima facie*** case of obviousness. The examiner relies upon the same deficient teachings in White which Henley and Iwami do not remedy. Accordingly, we do not sustain the 35 U.S.C. § 103 rejection of independent claims 19 and 21 and dependent claims 9, 10, and 18 over White and Henley or White and Iwami.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-8, 11-17 and 20 under 35 U.S.C. § 102 is reversed, and the decision of the examiner to reject claims 9, 10, 18, 19, and 21 under 35 U.S.C. § 103 is reversed.

REVERSED

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

JD/RWK

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