

The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PRADEEP K. BANSAL, LEE BEGEJA,
ANIL DASS CHATURVEDI, CARROLL W. CRESWELL
and JOHN A. ROTONDA

Appeal No. 2002-1755
Application No. 09/173,286

ON BRIEF

Before KRASS, BARRETT and BARRY, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-18.

The invention is directed to a method of delivering an audio or multimedia greeting containing messages from a group of contributing users.

Appeal No. 2002-1755
Application No. 09/173,286

Representative independent claim 1 is reproduced as follows:

1. A method for creating a message from a plurality of users over a network, comprising the steps of:

receiving from an originating user information for a recipient, at least one contributing user, and a first sub-message;

contacting said at least one contributing user;

receiving a second sub-message from said at least one contributing user; and

composing said message using said first and second sub-messages;

wherein a universe of contributing users to which the message can be directed is restricted according to the information for at least one contributing user provided by the originating user.

The examiner relies on the following references:

Nakatsu et al. (Nakatsu)	5,787,151	Jul. 28, 1998
Hibbeler	6,067,348	May 23, 2000
		(filed Aug. 4, 1998)

Shaw, "Microsoft Office 6 in 1", (Microsoft Office) Que Corporation, (1994), pp. 512-539, 565-574.

Claims 1, 2, 8, 9 and 17 stand rejected under 35 U.S.C. § 102(b) as being in public use or on sale more than one year prior to applicants' invention, as evidenced by Microsoft Office.

Claims 3-7, 10-16 and 18 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner offers Microsoft

Appeal No. 2002-1755
Application No. 09/173,286

Office and Nakatsu with regard to claims 3, 4 and 6, adding Hibbeler with regard to claims 5 and 7. Claims 10 and 13 are rejected under Nakatsu alone, with Microsoft Office added with regard to claims 11 and 12. With regard to claims 14-16, the examiner cites Nakatsu and Hibbeler and with regard to claim 18, the examiner cites Microsoft Office and Nakatsu.

Reference is made to the briefs and answer for the respective positions of appellants and the examiner.

OPINION

With regard to the rejection based on 35 U.S.C. § 102(b), while the examiner asserts that the rejection is based on the "public use or on sale" clause of that statutory section, the examiner has not indicated any specific public use or sale of the claimed invention to which he refers.

Since the examiner cites a reference to Microsoft Office in the rejection under 35 U.S.C. § 102(b), we will presume that the rejection is based on the "described in a printed publication" portion of 35 U.S.C. § 102(b).

Under 35 U.S.C. § 102(b), a reference must disclose, explicitly or implicitly, every limitation of the claimed invention. Glaxo Inc. v. Novopharm Ltd., 52 F.3d 1043, 1047, 34 USPQ2d 1565, 1567 (Fed. Cir.), cert. denied, 516 U.S. 988 (1995).

Appeal No. 2002-1755
Application No. 09/173,286

The examiner applies Figure 7.3, at page 539 of Microsoft Office, to claim 1 as follows: An e-mail message is shown wherein the message is addressed to a recipient and forwarded to another user with an original message. This, the examiner says, is the claimed "receiving from an originating user information for a recipient, at least one contributing user, and a first sub-message."

The examiner identifies the "Message marked as forwarded" and "Send" as the claimed "contacting said at least one contributing user."

The examiner contends that the mail forwarding system of Microsoft Office, whereby a second message can be received, is equivalent to the claimed "receiving a second sub-message from at least one contributing user."

Since Microsoft Office discloses the combining of sub-messages into a single message, by "Your comments" and "Original message," the examiner says that this is the claimed "composing said message using said first and second sub-messages."

The examiner points to the "Reply" button and the "Reply All" button of Microsoft Office, the activation of which creates a new message from a received message, the new message sent back to the recipient, or sent to all the contributing e-mail users,

Appeal No. 2002-1755
Application No. 09/173,286

as the claimed "wherein a universe of contributing users to which the message can be directed is restricted according to the information for at least one contributing user provided by the originating user."

We would agree with the examiner's analysis but for the claimed limitation of the universe of contributing users to which a message can be directed "is restricted" according to the information for at least one contributing user provided by the originating user. There is nothing in Microsoft Office which restricts any recipient from forwarding a message to other recipients who may not be on the originating user's list, or universe, of contributing users to which the message can be directed.

In elucidating on his position, at page 22 of the answer, the examiner explains that in Figure 7.1 (page 538) of the reference, a mail application comprising an original message from Elizabeth Watkins is shown. The message is sent, via "reply all," to two recipients, Jennifer Flynn and Rhonda Kuntz. The examiner interprets the recipients, Flynn and Kuntz, as the claimed "universe" of contributing users originally identified. The examiner further contends that this "universe" of contributing users is restricted to the people listed, viz.,

Appeal No. 2002-1755
Application No. 09/173,286

Flynn and Kuntz, and provided by the originating user Watkins.

We disagree. One cannot reasonably contend that Flynn and Kuntz constitute a "universe" of contributing users wherein the universe of contributing users to which the message can be directed is restricted according to the information for at least one contributing user provided by the originating user. This is because, while the originating user Watkins may have provided the information for at least one contributing user, either Flynn or Kuntz, either one of Flynn or Kuntz could very easily forward the message originating from Watkins to persons outside this "universe" comprising Flynn and Kuntz. Since either one of Flynn or Kuntz may forward this message to another party, outside the "universe" of Flynn and Kuntz which the originating user Watkins may have created, it cannot be said that the "universe of contributing users to which the message can be directed is restricted" by any information provided by the originating user Watkins.

Accordingly, since we find that Microsoft Office does not disclose each and every claimed limitation, we will not sustain the rejection of claims 1, 2, 8, 9 and 17 under 35 U.S.C. § 102(b) over Microsoft Office.

Appeal No. 2002-1755
Application No. 09/173,286

Claims 3, 4 and 6 stand rejected under 35 U.S.C. § 103 over Microsoft Office in view of Nakatsu. The examiner applies Microsoft Office in the same manner as it was applied to claims 1, 2, 8, 9 and 17. The examiner notes that whereas claim 3 calls for a message from the group comprising an audio message, a text message and a multimedia message and whereas claim 4 calls for the message to be delivered over a voice network, Microsoft Office does not disclose this. The examiner turns to Nakatsu for this teaching.

However, to whatever extent Nakatsu may disclose the types of messages urged by the examiner, it clearly does not provide for the deficiency of Microsoft Office, viz., the universe of contributing users to which the message can be directed being "restricted."

Accordingly, we will not sustain the rejection of claims 3, 4 and 6 under 35 U.S.C. § 103 over Microsoft Office in view of Nakatsu.

Similarly, the rejection of claims 5 and 7, dependent on claims 4 and 6, respectively, are rejected over Microsoft Office, Nakatsu and Hibbeler. Hibbeler is relied on by the examiner for its teaching of telephony transmission over the internet, but

Appeal No. 2002-1755
Application No. 09/173,286

Hibbeler does not provide for the deficiency of Microsoft Office noted supra.

Accordingly, we will not sustain the rejection of claims 5 and 7 under 35 U.S.C. § 103 over Microsoft Office, Nakatsu and Hibbeler.

Independent claims 10 and 13 are each rejected under 35 U.S.C. § 103 as obvious over Nakatsu, alone.

The examiner's position is that Nakatsu shows a processor 62 and a computer readable memory 66 connected to the voice card processor 62. The examiner urges that Nakatsu teaches a "prompts and greetings" module (elements 62 and 80) within a voice card processor and compares this teaching to the claimed "a greeting module within said computer readable memory." The claimed speech recognition processor is seen by the examiner in Nakatsu as item 60 in Figure 2. The examiner further contends that Nakatsu suggests a publicly accessible data network by its teaching of a public switched telephone network (PSTN), which transmits data, and is connected to the processor. The examiner says the suggestion of a publicly accessible data network provides the advantage of a greater number of users accessing Nakatsu's greeting message service (Figure 1, item 10), and compares this to the claimed "an interface to a publicly accessible data

Appeal No. 2002-1755
Application No. 09/173,286

network connected to said processor." The claimed "voice response unit" is said to be disclosed in Nakatsu as item 84 of Figure 3.

With regard to claim 13, the examiner points to Nakatsu's audio interface device connected to a switch, and to a T1 line leading to a PSTN, disclosed at column 3, lines 59-62, and items 22, 62 in Figure 2. The examiner also points to column 2, lines 10-14, for the audio adjunct connected to a network; and to column 2, lines 13-14, for a service control point. Nakatsu is also used by the examiner to teach a database connected to a toll switching office, at column 2, lines 46-50. Finally, the examiner contends that Nakatsu suggests an audio interface device connected to a second data network by its teaching of an audio interface connected to telephone lines and a LAN (Figure 1 and Figure 2, items 62, 56, 58 and 30. It is the examiner's position that the teaching of a voice unit connected to voice analog data lines and T1 lines suggests an advantage of simultaneous integration of communication lines for handling various data.

For their part, appellants argue that Nakatsu is not directed to a publicly accessible "data" network because the reference is directed to a PSTN, arguing that a "data" network is suggestive of a packet-based computer network and not telephone

Appeal No. 2002-1755
Application No. 09/173,286

networks such as the PSTN. Moreover, appellants contend that Nakatsu does not disclose or suggest the claimed audio adjunct connected to a second "data" network.

We agree with the examiner that the term "data" network is broad enough to cover telephone line "data." We also agree with the examiner that appellants' argument re a "data network" being suggestive of a packet-based computer network is not convincing because claims 10 and 13 do not require a "packet-based computer network." Further, Nakatsu's voice card connected to a PSTN and a LAN is clearly suggestive of an audio adjunct connected to a second "data" network and appellants have not convinced us otherwise.

Accordingly, the rejection of claims 10 and 13 under 35 U.S.C. § 103 is sustained.

Claims 11 and 12 add to claim 10 the limitation of the computer readable memory comprising a sequential greeting module, a parallel greeting module and a multimedia module.

The examiner relies on Microsoft Office for this limitation and asserts that it would have been obvious to combine this reference with Nakatsu to arrive at the claimed subject matter.

Appellants argue that the claimed "parallel greeting module" is not disclosed by Microsoft Office because the claimed parallel

Appeal No. 2002-1755
Application No. 09/173,286

greeting module avoids the duplication and multiple distribution intrinsic to the multiple-party forwarding process by providing a central interface through which each contributor may interact independently of the other contributors. Appellants also point out that their parallel greeting module provides a single storage point for the message so that only one copy of each contribution need be stored.

The examiner dismisses appellants' arguments as trying to read limitations from the specification into the claims. While the specific arguments of appellants are, indeed, absent from the claims, we agree with appellants that since the term "parallel greeting module" is not a commonly understood term, one must look to the specification to understand its meaning and definition. When the specification is referenced, one finds that this term is described at page 14, where parallel annotation is described as entailing a system receiving greeting inputs from the contributors who connect to the system at any time before a pre-determined time limit expires. The system composes a greeting from the contributor inputs and delivers the greeting to the recipient. When parallel annotation is selected, the system contacts each contributor and prompts the contributors to connect to the system and provide a greeting input. As further explained

Appeal No. 2002-1755
Application No. 09/173,286

at page 15 of the specification, the system waits a predetermined amount of time for each contributor to submit a message. Thus, this description provided by the specification must be read into the claims in the sense of the meaning to be ascribed to the term "parallel greeting module." As such, it is apparent that neither Microsoft Office nor Nakatsu discloses or suggests such a parallel greeting module, as claimed.

Accordingly, we will not sustain the rejection of claims 11 and 12 under 35 U.S.C. § 103 over Nakatsu and Microsoft Office.

With regard to claims 14-16, bringing in the limitation of the data network using a transmission control protocol/Internet protocol, the examiner employs the combination of Nakatsu and Hibbeler to reject these claims. In particular, the examiner recognized that Nakatsu lacked the teaching of a TCP/IP based network and relied on Hibbeler for its teaching of a telephony transmission over the Internet, concluding that it would have been obvious to make the combination "because of Hibbeler's taught advantage of Internet transmission (using TCP/IP), providing a familiar network protocol to the network system of Nakatsu" (answer-page 18).

Appellants argue that there is insufficient motivation to combine Hibbeler with Nakatsu because Hibbeler is solely

Appeal No. 2002-1755
Application No. 09/173,286

concerned with transmitting a pre-recorded message to a recipient, which is unrelated to creating a message from a plurality of users over a network. Moreover, appellants argue, the references do not disclose a general purpose computer connected to the data network. While the examiner points to Nakatsu for this feature, appellants contend that the cited portion relates to transferring files from a workstation connected to the LAN 30 to the IOP unit 64 and that LAN 30 is a propriety local area network and does not constitute a data network as defined in light of the specification.

We have reviewed the arguments of appellants and the examiner and we conclude that the examiner has set forth a reasonable case which is not overcome by appellants' arguments. Since Nakatsu is directed to telephone networks and communication via a LAN, and Hibbeler teaches communication via telephone and, in an alternative embodiment, transmission of messages in a digital format over the Internet (column 6, lines 38-40), the artisan would have understood that, with an Internet card, an Internet service provider would be applicable to the Nakatsu system.

Accordingly, we will sustain the rejection of claims 14-16 under 35 U.S.C. § 103 over Nakatsu and Hibbeler.

Appeal No. 2002-1755
Application No. 09/173,286

Finally, with regard to claim 18, we will not sustain the rejection of this claim under 35 U.S.C. § 103 because the claim depends from claim 17 which includes the restricted universe of contributing users discussed supra with regard to claim 1. Since Microsoft Office lacks a teaching or suggestion of this feature and Hibbeler's disclosure does nothing to remedy this deficiency in Microsoft Office, we will not sustain the rejection of claim 18.

CONCLUSION

We have sustained the rejection of claims 10 and 13-16 under 35 U.S.C. § 103, but we have not sustained the rejection of claims 1-9, 11, 12, 17 and 18 under 35 U.S.C. § 103.

Accordingly, the examiner's decision is affirmed-in-part.

Appeal No. 2002-1755
Application No. 09/173,286

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

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Administrative Patent Judge)	
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LEE E. BARRETT)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
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Appeal No. 2002-1755
Application No. 09/173,286

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