

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board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 LILLA BOROCZKY,
AGNES Y. NGAI and EDWARD F. WESTERMANN

Appeal No. 2002-1946
Application 08/988,080

ON BRIEF

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

DECISION ON APPEAL

Appellants have appealed to the Board from the examiner's final rejection of claims 1, 3-11, 15-26 and 33. Representative claim 1 is reproduced below:

1. A method for providing directory assistance information via a packet switch network including the Internet, comprising the steps of:

providing an Internet site with a directory assistance service that provides directory assistance information including telephone numbers;

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receiving a user request for directory assistance;

processing the user request and selectively providing directory assistance information of a called party;

receiving a request to initiate a call completion service to be performed within a telecommunications system based on a telephone number of said called party;

instructing a calling party to terminate a connection to the packet switched network to make a line available for incoming calls if the calling party wishes to receive said all on said same line as said connection to the packet switched network;

communicating to the telecommunications system to make a first outbound call leg to the called party number and a second outbound leg to the calling party; and

communicating to the telecommunications system that if both call legs are initiated successfully, to couple the two legs to complete a call between the called party and the calling party.

The following references are relied on by the examiner:

Rondeau	5,850,433	Dec. 15, 1998 (filing date May 1, 1996)
Low et al. (Low)(PCT)	WO 97/22210	June 19, 1997

Claims 1, 3-11, 15-26 and 33 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner relies upon Rondeau in view of Low.

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

OPINION

We reverse.

As expressed at the bottom of page 3 of the principal brief on appeal and in accordance with the arguments in this brief, appellants focus upon a feature common to each independent claim on appeal of instructing a calling party to terminate a connection to the packet switched network (or Internet) to make a line available for incoming calls if the calling party wishes to receive said call on said same line as said connection to the packet switched network (Internet).

Assuming for the sake of argument that Rondeau and Low are properly combinable within 35 U.S.C. § 103, we agree with appellants' basic urging that the noted feature would not have been taught or suggested within 35 U.S.C. § 103 to the artisan.

In Rondeau, for example, terminal server 26, database server 28, telephone server 30 and LAN 32 suggest the use of a packet switch network or Internet system to the extent recited in the claims on appeal. However, the link from the terminal 18 to the database server 28, once established, appears to be never lost or disconnected in any manner once data is retrieved by the database server for access by the terminal user, for subsequent access-

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ability to the telephone server 30 to the telephone 22 of the called party. There appears to be no teaching or suggestion then of the calling party terminating a line connection on line 20 to its own server 26.

In addition to the Abstract in Low, the more pertinent figures in this reference, as argued by the examiner, include Figures 14-16C and the discussion beginning at page 43, line 16 through page 50, line 27. In the context of the operability of the overall system in Figure 14, the discussion in the paragraph bridging pages 44 and 45, as noted and quoted by appellants in the brief, teaches that should the terminal in this figure be connected to a non-ISDN line or an ordinary telephone line, user A's terminal 53, once it obtains a telephone number of user B from user B's phone page off of the Internet, user A's terminal 53 "automatically suspend[s] its Internet session ... and then terminate[s] its ... connection to thereby free up the telephone line." See page 45, lines 3-6.

Appellants' arguments with respect to this portion of Low relied upon by the examiner at page 5 of the principal brief on appeal is well taken. Although the teaching is clear that Low's terminal 53 automatically suspends the calling party's Internet

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connection, the reader may only infer that there is also an automatic termination of the line itself, although the reader may also infer that from the automatic suspension operation, the user would be called upon to perform a manual termination at will. Because the language corresponding in each independent claim on appeal requires that the methodology exists for "instructing" the calling party to do the actual termination, we would be speculating as to the artisan's interpretation of the noted teaching. In any event, since it is clear to us that the noted portion of Low does not teach and also does not clearly suggest that the calling party actually perform the termination operation, we cannot sustain the rejection of the claims on appeal.

The applicability of Figure 14 and the noted teaching at the top of page 45 is problematic to the extent that there is no teaching in Low in the subsequent clause of the claims on appeal of the telecommunication system making a first outbound call leg to the called party and then a second outbound leg call to the calling party. However, the discussion of the three embodiments in Figure 16A-16C make clear that in Figure 16A gateway 90, and in Figure 16B, gateway 90 and switch 94, and in Figure 16C,

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gateway 90 and switch 95 perform the separate calling functions of initiating two outbound calls to directly connect user A and user B. This is clear from the discussion at the bottom of page 48 and the top of page 50.

Although the examiner's reliance upon Figures 16A through 16C ends with the discussion at page 50, line 10, the next succeeding paragraph at lines 12-23 make clear that in the circumstance in accordance with the embodiments in these three figures where only one telephone line may exist, the discussion in this paragraph makes reference to the previous discussion with respect to Figure 14 regarding the various approaches including the termination of the Internet session just discussed earlier in this opinion as an option to provide a solution to the problem presented when only a single telephone line is usable. However, it is clear from this overall discussion, when put in proper context with respect to Figure 14, that there is no additional teaching or suggestion here as to the embodiments in Figure 16 to obviate our consideration earlier with respect to failure of Low to actually instruct a calling party to terminate the connection as required by all claims on appeal.

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We are therefore unpersuaded by the examiner's reasoning principally at page 11 of the answer that the noted teachings "explicitly imply" that user A would manually terminate its Internet connection in order to call the user B when there is only one telephone line available to user A. The various call setup request approaches associated with the embodiments in Figure 16 do not change the automatic nature of the suspension and speculative manner of termination of the phone line associated with Figure 14. As emphasized at pages 2 and 3 of the reply brief, it appears to us as well that it is user A's terminal 53 and not the user himself that automatically suspends as noted at these portions of the reply brief. The speculative nature of the manner in which the actual termination occurs as discussed earlier in our opinion is noted again by the question posed by appellants that why should the calling party be instructed to perform manual termination of the actual line when the terminal 53 itself performs an automatic suspension of the connection anyway?

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In view of the foregoing, we conclude that the noted argued feature common to all claims on appeal would not necessarily have been obvious to the artisan within 35 U.S.C. § 103. As such, the decision of the examiner rejecting all claims on appeal under 35 U.S.C. § 103 is reversed.

REVERSED

James D. Thomas)	
Administrative Patent Judge)	
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Michael R. Fleming)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
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Joseph L. Dixon)	
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