

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. 67

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID E. MURRAY

Appeal No. 2002-2112
Application No. 08/949,534

ON BRIEF

Before THOMAS, HAIRSTON, and BARRETT, Administrative Patent Judges.
HAIRSTON, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1, 3 through 7, 9 through 13 and 15 through 21.

The disclosed invention relates to an apparatus for providing audio, modem and facsimile processing capabilities to a computer system.

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

1. An apparatus for providing audio and modem and fax processing capabilities to a computer system having an I/O bus, the modem and fax capabilities used with a telecommunication link, said apparatus comprising:

an option card, comprising:

means for interfacing with said I/O bus for transferring data;

a digital signal processor on said option card coupled to said interfacing means for performing a plurality of audio processing functions for the computer system;

a daughter board connector connected to said digital signal processor; and

a daughter board connectable to the telecommunications link and removably connected through said daughter board connector to said digital signal processor on said option card, said daughter board having circuitry which when combined with said digital signal processor loaded with modem and fax software adds modem and fax functions to said computer system.

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The references relied on by the examiner are:

Davis et al. (Davis)	4,991,169	Feb. 5, 1991
O'Connell	5,331,111	July 19, 1994 (filed Oct. 27, 1992)
McLaughlin et al. (McLaughlin)	5,687,222	Nov. 11, 1997 (effective filing date July 26, 1994 ¹)
Ninomiya et al. (Ninomiya)	6,088,620	July 11, 2000 (filed Sept. 20, 1996 ²)

Claims 1, 3 through 7, 9 through 13 and 15 through 21 stand rejected under the second paragraph of 35 U.S.C. § 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellant regards as the invention.

Claims 1, 3 through 7, 9 through 13 and 15 through 21 stand rejected under the first paragraph of 35 U.S.C. § 112 for lack of enablement.

Claims 1, 3 through 7, 9 through 13 and 15 through 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over O'Connell in view of Davis.

¹ Appellant has not made an issue of the fact that this date is after the original application filing date of July 19, 1993.

² We note again that appellant has not made an issue of the fact that this date is after the original application filing date.

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Claims 1, 3 through 7, 9 through 13 and 15 through 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the admitted prior art³ in view of Davis.

Claims 1, 3 through 7, 9 through 13 and 15 through 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ninomiya in view of McLaughlin.

Reference is made to the briefs (paper numbers 62 and 64) and the answer (paper number 63) for the respective positions of the appellant and the examiner.

OPINION

For substantially all of the reasons expressed by the appellant⁴, and for the additional reasons set forth infra, we will reverse all of the rejections of record.

Turning first as we must to the indefiniteness rejection, the examiner is of the opinion (answer, page 6) that the claimed

³ We agree with appellant's argument (brief, page 24) that he has limited his admission of prior art to Figure 1. No amount of discussion of Figure 2 will convert the subject matter disclosed therein into admitted prior art (answer, pages 8 and 9).

⁴ We disagree with appellant's statement (brief, page 18) that "[a] technique cannot be both non-enabled yet obvious." We are not aware of any Office policy or case law that prohibits both a lack of enablement rejection and an obviousness rejection of the same claims.

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invention should be limited to the daughterboard, as opposed to the now claimed combination of the daughterboard and a sound card. Inasmuch as appellant's disclosed and claimed invention is expressly directed to the combination of a sound card and a daughterboard, we disagree with the examiner's premise that appellant must claim that which the examiner deems to be appellant's invention. In other words, appellant has the right to claim that which he regards as his invention⁵. With respect to the examiner's insistence (answer, pages 6 and 7) that the appellant recite more functions of the components, and how they "functionally coact with each other such that meaningful results can be achieved," we find that this demand by the examiner is equally without merit since appellant has the right to claim his invention in as broad terms as the disclosure and the prior art will allow without reciting all of the functional coaction between the components as requested by the examiner. Thus, the indefiniteness rejection of all of the claims on appeal is reversed because "[i]n light of Appellant's Specification, one of ordinary skill in the art would understand that a daughter board, such as one containing

⁵ Being mindful of the written description portion of the first paragraph of 35 U.S.C. § 112.

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a CODEC and DAA, and a DSP⁶ of a sound card loaded with modem and fax software in combination provide modem and fax software functions to a computer system" (brief, page 19).

Turning next to the lack of enablement rejection, the examiner is of the opinion (answer, pages 5 and 6) that it would take undue experimentation to "convert or program an audio DSP which is made and programmed for processing audio signals to additionally [sic, additionally] process fax and modem." In the absence of a convincing line of reasoning by the examiner for not accepting the disclosed explanation (specification, page 12) of how the DSP is further programmed to perform the additional functions of a fax and modem via software stored in RAM 72 (Figure 2), we agree with appellant's arguments (brief, page 11) that the "disclosure is presumptively accurate," and that "[t]he Examiner has not shown a

⁶ According to appellant, a coder-decoder (CODEC) performs analog to digital (A/D) and digital to analog (D/A) conversion (specification, page 2), a data access arrangement (DAA) "electrically isolates the modem from the phone line to control emissions of electro-magnetic interference/radio frequency interference (EMI/RFI) [,] . . . isolates the received [signal] from the transmitted analog signals, and develops a digital ring signal to inform the computer system to answer" (specification, page 2), and a digital signal processor (DSP) performs the named function. Several manufacturers and model numbers of DSPs for specialized functions are disclosed by appellant (specification, pages 11 and 14), and discussed in the Edward Newman Rule 312 declaration of record (paragraphs 9 and 10).

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sufficient reason to doubt the truth or accuracy of Appellant's Specification." We additionally agree with the appellant's argument (brief, page 13) that:

Paragraph 9 of the Declaration indicates that one of ordinary skill in the art would have known of modules to implement a fax/modem with a DSP, citing a specific DSP and a specific source for such modules. Paragraph 10 of the Declaration then indicates that one of ordinary skill in the art would have known of modules to implement a sound card with a DSP, again citing a specific DSP and source for such modules. However, no suggestion is made in the Declaration that it was known to implement a sound card with both capabilities, as in Appellants' [sic, Appellant's] claimed subject matter. "Given the teachings of the specification" and based on all of the above, the Newman Declaration states that one skilled in the art would be able to make and use the invention as claimed without undue experimentation.

In light of the disclosure, the declaration, the prior art of record that uses DSPs⁷ and the lack of a definitive and convincing reason for questioning the enablement of the disclosure, we find that the burden of coming forward with evidence of enablement never passed to appellant. For this reason, the lack of enablement rejection of all of the claims on appeal is reversed.

Turning to the obviousness rejection of all of the claims on appeal based upon the teachings of O'Connell and Davis, the examiner indicates (answer, page 7) that O'Connell discloses an I/O

⁷ See the discussion of Davis (answer, page 8).

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bus 12, a DSP 18, a daughterboard 25 and a daughterboard connector (i.e., "the circuit in O'Connell which connects the DSP card to the A/D interface 25"). According to the examiner (answer, page 7), "O'Connell discloses in lines 16-22 of column 5 that the optional A/D interface 25 (CODEC of the instant invention) is for importing sound from other sources such that DSP 18 which is designed for processing signals from MIDI 21 can also be used to process sounds." The examiner admits (answer, page 8) that "O'Connell does not state that the DSP is capable of functioning as modem and fax via the A/D interface 25." Based upon Davis' teaching "that a dsp can be programmed to function as modem (see abstract) and fax (col. 18 line 31)," the examiner contends (answer, page 8) that it would have been obvious to one of ordinary skill in the art "to program the dsp of O'Connell to function as modem and fax."

Appellant argues (brief, pages 22 and 23) that the A/D interface 25 in O'Connell does not correspond to either the claimed daughterboard for providing fax and modem functions or the claimed coder-decoder, and that "[e]ven if Davis teaches a DSP to function as a modem, Davis and O'Connell in combination fail to teach or suggest a DSP on a sound card connected to a daughter board for providing fax/modem functions."

We agree with appellant's arguments that the A/D interface 25 in O'Connell is incapable of performing both coder-decoder functions, and it does not include daughterboard circuitry that functions in concert with a DSP to provide fax and modem functions. Thus, even if the DSP in O'Connell is reprogrammed to handle fax and modem functions as taught by Davis, the applied reference would still neither teach nor would have suggested to the skilled artisan a daughterboard with fax and modem circuitry that will operate with the reprogrammed DSP to provide fax and modem functions as claimed. In short, the obviousness rejection of all of the claims on appeal based upon the teachings of O'Connell and Davis is reversed.

In the obviousness rejection of all of the claims on appeal based upon the admitted prior art and Davis, we agree with the examiner (answer, page 8) that Figure 1 of the disclosed drawing is admitted prior art, but we disagree with the examiner (answer, pages 8 and 9) that Figure 2 is admitted prior art⁸. In light of this glaring error, the obviousness rejection of all of the claims on appeal based upon the examiner's proposed modification of

⁸ It appears that the examiner has mistakenly labeled Figure 3 of the drawing as admitted prior art along with Figure 2 of the drawing (answer, page 9).

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appellant's own disclosure⁹ (i.e., Figure 2¹⁰ and supposedly Figure 3) with the teachings of Davis is reversed.

Turning lastly to the obviousness rejection of all of the claims on appeal based upon the "host CPU 11, buses, memories, controller 14, modem CODEC 152, sound CODEC 153 and DSP 151 for processing sound, modem and fax" teachings of Ninomiya, and the programming of a DSP to function as a "sound card, modem and fax" teachings of McLaughlin (answer, page 9), we agree with the appellant (brief, pages 25 and 26) that:

Ninomiya does not teach or suggest that the DSP 151 is loaded with "modem and fax software." Further, Ninomiya does not teach or suggest that the modem CODEC 153 [sic, 152] is part of a daughter board connected to the DSP 151. Finally, as recognized by the Examiner, Ninomiya fails to recite a DAA. Even if McLaughlin can be used to show inherency of a DAA, which Appellant does not admit, Ninomiya thus fails to teach or suggest all of Appellant's claimed elements.

In summary, the obviousness rejection of all of the claims on appeal based upon the teachings of Ninomiya and McLaughlin is

⁹ An obviousness rejection can not be established via the use of impermissible hindsight.

¹⁰ If by chance Figure 1 was the intended figure, we agree with the appellant's argument (brief, page 24) that "Figure 1 and Davis in combination fail to teach or suggest a daughter board, such as one containing a DAA and CODEC, connected to a DSP of a sound card, where a memory coupled to the DSP is loaded with fax/modem software and sound card software."

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reversed based upon the appellant's argument, and the fact that the references have filing dates after the July 19, 1993 filing date of the subject application.

DECISION

As indicated supra, all of the rejections of record are reversed. Accordingly, the decision of the examiner is reversed.

REVERSED

JAMES D. THOMAS)	
Administrative Patent Judge)	
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)	
)	
)	BOARD OF PATENT
KENNETH W. HAIRSTON)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
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LEE E. BARRETT)	
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