

The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.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. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RONALD R. FOSTER and RAYMOND WU

Appeal No. 2004-0547
Application No. 09/536,894

ON BRIEF

Before FLEMING, LEVY, and NAPPI, **Administrative Patent Judges.**

NAPPI, **Administrative Patent Judge.**

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1 through 9, 13 and 14.

The invention relates to a remote video telephone system that makes use of a base video unit and remote video units. A user of the system can communicate with the base video unit through a standard telephone connection (see page 4 of appellants' specification). The base unit also communicates with the remote video units (see page 5 of appellants' specification). Through the base unit a user can select which of the remote video units to communicate with (see page 7 of appellants' specification).

Claim 1 is representative of the invention:

1. A video phone system comprising:

a base video unit having a video display screen, a microphone, and a speaker;

at least two remote video units that selectively provide audio and video signals to said base video unit;

a multiplexer associated with said base video unit, said multiplexer unit capable of being controlled by a caller for selecting a selected one of said audio and video signals from said at least two remote units or said base video unit, such that upon a selection input from said caller, said selected one of said audio and video signals is automatically routed through said base video unit to said caller without the need for human intervention; and

a first circuit for allowing the base video unit and the selected one of said remote video units to electronically communicate with a standard external telephone line, said first circuit adapted for routing said selected one of said audio and video signals out through said standard external telephone line, further wherein the base video unit and the remote video unit both include a communication means for allowing the base video unit and the remote video unit to electronically communicate with one another.

References

Mun et al. (Mun)	6,094,213	July 25, 2000 (filed April, 13, 1998)
Gerszberg et al. (Gerszberg)	6,020,916	Feb. 1, 2000 (filed Dec. 31, 1997)
Ratner	5,684,826	Nov. 4, 1997
Yamadera et al. (Yamadera)	5,444,477	August 22, 1995
Lazik	5,237,602	August 17, 1993

Rejections at Issue

Claims 1 through 3, 5, 9, 13 and 14 stand rejected under 35 U.S.C. § 103 as being unpatentable over Yamadera in view of Lazik. Claims 4 and 6 stand rejected under 35 U.S.C. § 103 as being unpatentable over Yamadera in view of Lazik and Mun. Claim 7 stands rejected under 35 U.S.C. § 103 as being unpatentable over Yamadera in view of Lazik and Gerszberg. Claim 8 stands rejected under 35 U.S.C. § 103 as being unpatentable over Yamadera in view of Lazik and Ratner.

Opinion

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the brief¹ along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

With full consideration being given to the subject matter on appeal, the examiner's rejections and the arguments of appellants and examiner, for the reasons stated *infra*, we reverse the examiner's rejection of claims 1 through 9, 13 and 14 under 35 U.S.C. § 103.

Appellants argue, on page 8 of the brief, that there is no incentive or suggestion to combine Yamadera in view of Lazik. On page 7 of the brief, appellants assert that

¹ This decision is based upon the Appeal Brief received August 14, 2003.

“[t]he secretary terminal 101 of the Yamadera patent is intended to be manipulated **only by an actual human secretary**. See Col. 5, lines 36-61. However, in the claimed invention, a human intervenor (sic) at the base video unit is not required to route the call to the remote video unit.” (emphasis original). Further, on page 8 of the brief appellants assert that the Lazik involves a remotely accessible audio phone system which “[u]pon connection to the master unit 10, the remote caller can enter a satellite unit ID and be ‘patched through’ ... to one or more of the satellite units.”

The examiner responds to these arguments on pages 11 and 12 of the answer. On page 11 of the answer, the examiner recognizes that Yamadera teaches manual transfer of a video call from a secretary terminal to one or more executive terminal. However, the examiner cites *In re Venner* 120 USPQ 192, 1994 (CCPA 1958), stating, “it is well settled that it is not ‘invention’ to broadly provide a mechanical or automatic means to replace manual activity which has accomplished the same result.” Further, on page 12 of the answer the examiner states:

Lazik is relied upon to teach the feature of allowing a remote caller to select one of a plurality of remote communication units for establishing communication through a master unit without human intervention so that the remote caller is capable of selecting a particular remote communication unit for establishing a communication by entering a code, thereby makes it more user friendly in permitting local system control from a remote calling location (Col. 3, lines 54 and col. 5 line 37 through col. 7 line 16)... Thus, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Yamadera in providing automatic means for replacing manual activity, as per teaching of Lazik, in order to allow the remote caller to select one of a plurality of remote communication units connected with a maser unit without human intervention, thereby making it more user friendly.

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We disagree with the examiner's analysis. Independent claims 1 and 14 contain limitations of "said selected one of said audio and video signals is automatically routed through said base video unit to said caller without the need for human intervention." We concur with both the appellants and the examiner that Yamadera does not teach this limitation. However, we find that this limitation is not broadly providing automatic means to replace a manual activity accomplished the same result. Yamadera teaches that the function of the secretary is to transfer the incoming calls to the person the calling party intended to contact (see column 1, lines 25-34, see also col. 5, lines 36-42). We find that the secretary performs this function by operating the secretary terminal (see column 5, lines 56-60). We find the secretary terminal is used to inform the executive terminal user of an incoming call (see column 5, line 56), and to set up communications amongst the executive terminal users (see column 6, lines 53 –62). Thus, we do not find that the claim limitation of "signals is automatically routed through said base video unit to said caller without the need for human intervention" is an automatic means to replace manual activity such as discussed in *In re Venner*, as the automated step claimed does not accomplish the same result as the manual step in Yamadera.

Further, we find that there is no express or implicit motivation to combine the teachings of Yamadera and Lazik. It is the burden of the examiner to establish why one having ordinary skill in the art would have been led to the claimed invention by the express teachings or suggestions found in the prior art, or by the implication contained in such teachings or suggestions. *In re Sernaker* 702 F.2d 989, 995, 217 USPQ 1, 6

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(Fed. Cir. 1983). “The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved.” *In re Huston* 308 F.3d 1267, 1278, 64 USPQ2d 1801, 1810 (Fed. Cir. 2002, citing *In re Kotzab* 217 F.3d 1365, 1370, 55 USPQ 1313, 1317 (Fed. Cir. 200)). We find that Yamadera, teaching that the secretary terminal is manually operated, does not provide motivation to automate the routing of the signals without human intervention. Further, we do not find that the nature of the problem to be solved in Yamadera provides motivation to automatically route signals through the base video unit to said caller without the need for human intervention. Yamadera is concerned with solving the problem of simultaneously transferring documents at high-speed and video conferencing (see column 1, lines 35-60). Similarly, we find no suggestion in Lazik to automatically route signals through a base video unit to said caller without the need for human intervention, in a video phone system such as Yamadera. Nor do we find that the nature of the problem to be solved in Lazik, to allow a caller on a telephone to check on the condition of a person who may be physically unable to answer the phone (see Lazik column 3, lines 26-33) provides motivation to combine the teachings. Thus, we do not find motivation to combine the teachings, either expressly, implicitly or from the nature of the problem to be solved. Accordingly, we will not sustain the examiner’s rejection of claims 1 through 3, 5, 9, 13 and 14 under 35 U.S.C. § 103 as being unpatentable over Yamadera in view of Lazik.

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Claims 4 and 6 through 8 all ultimately depend upon claim 1 and necessarily contain the same limitations addressed above with respect to claim 1. The examiner's rejections of claims 4 and 6 through 8, rely upon the teachings of Yamadera in view of Lazik in combination with Mun or Gerszberg, or Ratner. The examiner has not shown, nor do we find that Mun, Gerszberg, or Ratner teach or suggest automatically routing signals through the base video unit to said caller without the need for human intervention. Thus, for the reasons stated *supra* concerning the rejection of claim 1, we will not sustain the examiner's rejections of claims 4, 6 through 8 under 35 U.S.C. § 103.

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Accordingly, we reverse the examiner's rejection of claims 1 through 9, 13 and 14 under
35 U.S.C. § 103.

REVERSED

MICHAEL R. FLEMING)	
Administrative Patent Judge)	
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STUART S. LEVY)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
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ROBERT NAPPI)	
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