

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JASON ADELMAN, TODD JOSEPH WONGKEE,
PAUL MICHAEL BRENNAN, LLOYD MALCOLM FLORENCE
and RICHARD A. WEISS

Appeal No. 2005-0418
Application No. 10/124,248

ON BRIEF

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

Decision On Appeal

This is a decision on appeal from the final rejection of claims 2, 4-12, 17-20, 22-24, 26-35, and 38-47.

The invention pertains to the processing of non-text messages, which may include voice messages, video messages (with an audio component) and facsimile messages. In particular, the

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invention is concerned with handling non-text messages in a text-based environment, such as e-mail. An envelope is created for the non-text message portion, and a non-text search engine searches the content of the non-text message for pre-defined characteristics. If found within the non-text message, the text equivalent of these pre-defined characteristics are inserted into a slot within a uniquely identified field within the message envelope, together with pointers to the location within the non-text message of the matching content.

Representative independent claim 5 is reproduced as follows:

5. A method for operating on a non-text message, comprising:

searching said message for one or more signal samples having pre-defined characteristics by comparing said one or more signal samples with said pre-defined characteristics; and

upon finding one or more signal samples having said pre-defined characteristics, storing one or more pointers pointing to said found signal samples in said message.

The examiner relies on the following reference:

Klein	5,479,411	Dec. 26, 1995
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Claims 2, 4-12, 17-20, 22-24, 26-35, and 38-47 stand rejected under 35 U.S.C. § 102(e) as anticipated by Klein.

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

OPINION

A rejection for anticipation under section 102 requires that the four corners of a single prior art document describe every element of the claimed invention, either expressly or inherently, such that a person of ordinary skill in the art could practice the invention without undue experimentation. In re Paulsen, 30 F.3d 1475, 1478-79, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994).

It is the examiner's position that Klein discloses searching a message for one or more signal samples having pre-defined characteristics by comparing the one or more signals with the pre-defined characteristics, and that upon finding one or more signal samples having the pre-defined characteristics, storing one or more pointers pointing to the found signal samples in the message. The examiner points to Figures 1 and 4, and to column 1, lines 30-67, column 2, lines 1-54, column 3, lines 46-67, column 5, lines 1-37, and to column 6, lines 1-23, of Klein as support for his position.

We find that the examiner has failed to establish a case of prima facie anticipation with regard to the instant claimed subject matter.

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At the outset, we note that rather than point to specific portions of the reference for support of each and every one of the claimed steps/elements, the examiner identifies practically the whole disclosure of the Klein reference and essentially says "it's in there."

As both appellants and the examiner seem to agree, the instant invention is directed to converting a non-text message, such as speech or image, to a text message. Klein, on the other hand, is directed to the reverse, i.e., converting electronic mail text into voice/fax messages.

The main point of contention between appellants and the examiner is that while Klein's disclosure deals with this text-to-voice/fax conversion, Klein does indicate that "[c]onversion of integrated voice-and-fax messages into e-mail messages is likewise envisioned" (abstract); "[a]lternatively, the transformation of the message from one media to another may be done in the reverse direction" (column 2, lines 3-5); and "the process may be reversed, whereby received integrated voice-and-fax messages are convened into e-mail messages for delivery" (column 6, lines 35-38).

The examiner concludes that Klein therefore discloses the instant invention, while appellants contend that Klein only

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discloses an enabling disclosure for conversion from text to voice-and-fax, and not for the reverse. It is appellants' position that Klein is not enabling for a voice-and-fax to text conversion and that the recitation that such is possible is merely an invitation to try to search a non-text message for signal samples having predefined characteristics, without any disclosure as to how to accomplish such a function.

We are in agreement with appellants. The instant claimed invention sets forth a specific method/apparatus for operating on a non-text message, wherein the non-text message is searched for signal samples having pre-defined characteristics, via comparison of the samples with the pre-defined characteristics, and, when signals having those pre-defined characteristics are found, storing pointers pointing to the found signal samples in the message.

The only embodiment described in detail in Klein is one in which e-mail messages (i.e., text) are converted into voice-and-fax messages. Thus, Klein operates on text messages, rather than non-text messages. While Klein clearly implies that the conversion may be performed in the reverse direction, there is no specific disclosure in Klein as to just how to perform the reverse conversion.

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Looking into the similarities between the instant claimed invention and the method/apparatus of Klein for operating on a text-based message, Klein does search a message (a text message) to see if an integrated voice-and-fax delivery is indicated. If it is so indicated, a computer parses the message to separate it into segments classified by type. An e-mail message has a predefined header followed by a sequence of lines of ASCII characters. Other types of segment lines are defined as whitespace, prose, and non-prose (column 5, lines 4-10). Each line of the message is classified into one of these four types and the four types are identified by different means, e.g. the header is identified by "sentinels predefined for this particular e-mail system" (column 5, lines 12-13). Further, a computer inserts into a voice message, at places that were occupied in the e-mail message by the non-prose segments, voice pointers to the appropriate fax segments (see column 6, lines 1-5).

Thus, it would appear that Klein discloses many of the same words of the instant claim, e.g., "pointer," "predefined." But, the examiner has not shown where Klein is performing the claimed steps or shows the claimed apparatus. The examiner has not specifically shown how the "predefined header" of Klein equates to searching a message for a signal having "pre-defined

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characteristics" by comparing a signal sample with the predefined characteristics, as claimed, and the examiner has not specifically shown the storing of pointers pointing to found samples in the message upon finding signal samples having the pre-defined characteristics, as claimed.

The examiner attempts to find a "pointer," as claimed, by identifying a voice pointer pointing to a voice segment in Klein. The examiner also points to Klein's Figure 4 for support for a prose (non-text) section pointing to a voice segment. However, the instant claims, e.g., claim 5, requires that the pointer must point to signal samples in the message which have pre-defined characteristics. The examiner's explanation, at page 15 of the answer, fails to take into account this modifying claim language.

Again, while Klein does indicate that his disclosed process may be reversed to receive integrated voice-and-fax messages and convert them to e-mail, or text, messages, the reference does not specifically teach how to perform this function, and clearly does not teach how to perform this function in the manner of the instant claimed invention.

Accordingly, we will not sustain the rejection of claims 2, 4-12, 17-20, 22-24, 26-35, and 38-47 under 35 U.S.C. § 102(e).

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It may very well be that with Klein's disclosure of the ability to reverse his preferred process to make it a voice-and-fax to text conversion, together with the disclosure of predefined headers and pointers, the skilled artisan would have found it obvious to operate on a non-text message by searching the message for signal samples having pre-defined characteristics and comparing these signal samples with the pre-defined characteristics and then, upon finding such signal samples with those pre-defined characteristics, storing pointers pointing to the found signal samples in the message. However, the examiner has advanced no reasoning as to obviousness within 35 U.S.C. § 103, and we will not speculate.

But, as to anticipation under 35 U.S.C. § 102(e), the examiner has failed to specifically point out how each and every claimed step/element is found in Klein. Therefore, we cannot sustain this rejection.

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The examiner's decision is reversed.

REVERSED

KENNETH W. HAIRSTON)	
Administrative Patent Judge)	
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ERROL A. KRASS)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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LEE E. BARRETT)	
Administrative Patent Judge)	

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