

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID W. STAUFFER and JOSEPH P. HOFFBECK

Appeal 2006-2679
Application 10/359,882
Technology Center 2600

Decided: March 30, 2007

Before KENNETH W. HAIRSTON, HOWARD B. BLANKENSHIP, and
ALLEN R. MACDONALD, *Administrative Patent Judges*.

BLANKENSHIP, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

INTRODUCTION

Appellants' Request for Rehearing (filed Nov. 15, 2006) contends that we erred in our Decision on Appeal entered September 25, 2006, in which we sustained the rejection of claims 1-16.

OPINION

Appellants contend in the Request that we erred in our conclusion that the subject matter as a whole of representative claim 1 was prima facie obvious over Sawaya (U.S. 6,125,170) and Asano (US 2003/0126016 A1).

Appellants argue (Request 2-3) that Sawaya receives time and date information relating to a telephone call from clock and timer circuitry, rather than from a caller ID signal from a telephone line. Appellants' arguments seem to presume that the "caller ID information" of claim 1 requires that time and date information be detected from an incoming call. We disagree with the implicit presumption, as the claim does not specify the caller ID information that is detected. Our reviewing court has repeatedly warned against confining the claims to specific embodiments described in the specification. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1323, 75 USPQ2d 1321, 1334 (Fed. Cir. 2005) (en banc). Moreover, narrower (depending) claim 9 recites that the caller ID information includes one or more of an incoming call time, an incoming call date, a calling party telephone number, and a calling party name.

In any event, Appellants also contend that Sawaya's description of a message system that prints the name and phone number of the caller, as conveyed by caller ID, is not sufficient to enable the requisite telephone interface. Sawaya describes caller ID capabilities (col. 3, ll. 52-59) and printing the information along with a message template (col. 4, ll. 1-5).

While a reference must enable someone to practice the invention in order to anticipate under § 102, a non-enabling reference may qualify as prior art for the purpose of determining obviousness under § 103. *Symbol*

Techs., Inc. v. Opticon, Inc., 935 F.2d 1569, 1578, 19 USPQ2d 1241, 1247 (Fed. Cir. 1991).

Even assuming that enablement is required in this case, we refer to claim 3 of Sawaya, claiming a caller-identification capability, and printing onto a slip additional known information relating to the incoming call, including the telephone number associated with the incoming call. The telephone number associated with an incoming call is caller ID information - see instant claim 9.¹

The reference (Sawaya) is a U.S. patent. A patent shall be presumed valid. 35 U.S.C. § 282. Absent clear evidence adduced by Appellants in support of the allegation of non-enablement, we find the mere allegation to be unpersuasive.

We agree with Appellants' remarks at pages 4 through 6 of the Request to the extent that Sawaya describes some embodiments in which call records are not "automatically" printed. However, we hold to our view that the reference supports the Examiner's finding that Sawaya also describes printing of caller ID information automatically, without user intervention (e.g., col. 3, l. 35 - col. 4, l. 5).

Finally, Appellants' further remarks in the Request allege that Sawaya fails to disclose automatically printing information after a first ring signal. The Examiner agrees; Appellants' remarks are directed to an issue not in controversy. To the extent the remarks might be intended as responsive to the § 103 rejection for obviousness over Sawaya and Asano, we disagree

¹ We also observe that intervening claim 2 of Sawaya claims advancement of a message slip "upon receipt of an incoming telephone call."

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that Sawaya fails to disclose automatically printing caller ID information and are thus not persuaded of error in the rejection.

We therefore hold to our previous conclusion that Appellants have not shown error in the rejection of representative claim 1 over Sawaya and Asano. Appellants' Request does not show that we misapprehended or overlooked anything in making that determination.

CONCLUSION

In summary, we have granted Appellants' request for rehearing to the extent that we have reconsidered our decision sustaining the rejection of claims 1-16, but we decline to modify the decision in any way.

DENIED

tdl/ce

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