

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte DAVID W. STAUFFER and JOSEPH P. HOFFBECK

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Appeal No. 2006-2679  
Application No. 10/359,882

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ON BRIEF

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Before HAIRSTON, BLANKENSHIP, and MACDONALD, Administrative Patent Judges.  
BLANKENSHIP, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-16, which are all the claims remaining in the application.

We affirm.

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BACKGROUND

The invention relates to a system and method for printing caller ID information associated with a telephone call. Representative claim 1 is reproduced below.

1. A caller ID printing device, comprising:

a controller configured to detect caller ID information from an incoming call;

and a printer configured to automatically print the caller ID information and a message template onto a printed call record immediately after receipt of a first ring signal and without user intervention.

The examiner relies on the following references:

Valenzona et al. (Valenzona)	US 4,747,133	May 24, 1988
Sawaya	US 6,125,170	Sep. 26, 2000
Asano	US 2003/0126016 A1	Jul. 3, 2003 (filed Jul. 26, 2002)

Claims 1-14 stand rejected under 35 U.S.C. § 103 as being unpatentable over Sawaya and Asano.

Claims 15 and 16 stand rejected under 35 U.S.C. § 103 as being unpatentable over Sawaya, Asano, and Valenzona.

We refer to the Final Rejection (mailed Jun. 17, 2005) and the Examiner's Answer (mailed Jan. 11, 2006) for a statement of the examiner's position and to the Brief (filed Oct. 31, 2005) and the Reply Brief (filed Mar. 15, 2005) for appellants' position with respect to the claims which stand rejected.

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OPINION

Based on appellants' remarks in the Brief, we will select claims 1 and 15 as representative in deciding this appeal. See 37 CFR § 41.37(c)(1)(vii).

The examiner finds that Sawaya describes the invention of instant claim 1 except for printing "immediately after receipt of a first ring signal." (Answer at 8.) The examiner refers to Asano's ¶ 46, which teaches that caller ID information is typically sent in telephone networks between the first and the second rings.

We observe that the instant application was filed February 6, 2003 and claims the benefit under 35 U.S.C. § 119(e) for U.S. provisional application 60/384,141, filed May 29, 2002. The Asano application was filed July 26, 2002, but purports to be a continuation-in-part of application number 10/150,769, filed May 17, 2002. Based on this information, Asano may or may not be a reference. The first question would be which, if any, of the instant claims are entitled to the effective filing date of May 29, 2002 by applicants having met all of the statutory requirements of 35 U.S.C. § 119(e) -- e.g., the claims are supported by the provisional application in accordance with the requirements of the first paragraph of § 112. See 35 U.S.C. § 119(e)(1). The second question would be what effect, if any, the Wertheim rule with respect to "secret prior art" might have on the determination of the effective date of the published application. See In re Wertheim, 646 F.2d 527, 537, 209 USPQ 554, 564 (CCPA 1981) ("If...[the USPTO] wishes to utilize against an applicant a part of that patent disclosure found in an application filed earlier than the date of the application which became the patent, it must

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demonstrate that the earlier-filed application contains §§120/112 support for the invention claimed in the reference patent.”). In any event, appellants do not contest the presumption that Asano constitutes prior art.<sup>1</sup>

Instant claim 1 recites that printing occurs “immediately” after receipt of a first ring signal. The adverb is used in a relative, rather than absolute, sense. As noted in appellants’ specification, the caller ID information is normally transferred after the first ring signal, and before the second ring signal. The controller would not possess the caller ID information until a measurable period after the first ring signal.

We disagree with appellants’ assessment (Brief at 7) that Sawaya “fails to disclose the automatic printing of caller ID information. . . .” Aside from the general teachings relating to receiving and printing such information, the reference describes automatically printing known information, such as time and date of a call, onto paper prior to the paper being fed over a graphics pad (e.g., element 410, Fig. 4) to receive handwritten information. The reference further describes printing caller ID information along with message-related indicia such as lines to be filled in with new information. As the examiner points out, the controller may be operative to automatically advance the paper supply upon receipt of each incoming telephone call. Col. 3, l. 35 - col. 4, l. 5.

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<sup>1</sup> Moreover, appellants’ specification (at the bottom of page 2) acknowledges that caller ID information is typically sent over the phone line between the first and second ring signals of an incoming call.

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Considering the reference as a whole, the reference supports the examiner's finding that Sawaya discloses automatically printing caller ID information.

Further, we agree with the examiner that, in view of the artisan's knowledge that caller ID information was normally transmitted between the first and the second ring signal, there was requisite suggestion from the prior art to print the information "immediately" after receipt of a first ring signal and without user intervention, within the meaning of instant claim 1. Once the machine-generated and machine-received information is obtained (e.g., time, date, and caller ID information relating to the call), the information would be ready for printing, and should be. The suggestion to combine may come from the prior art, as filtered through the knowledge of one skilled in the art. Motorola, Inc. v. Interdigital Tech. Corp., 121 F.3d 1461, 1472, 43 USPQ2d 1481, 1489 (Fed. Cir. 1997); see also Cable Elec. Prods., Inc. v. Genmark, Inc., 770 F.2d 1015, 1025, 226 USPQ 881, 886-87 (Fed. Cir. 1985) ("[T]he suggestion to modify the art to produce the claimed invention need not be expressly stated in one or all of the references used to show obviousness. 'Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art.'") (quoting In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881).

We have considered all of appellants' arguments in the Brief but are not persuaded of error in the rejection over Sawaya and Asano. We also find appellants' arguments in the Reply Brief, which are based in the main on allegations of

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advantageous properties over the prior art that are simply not commensurate with the scope of the subject matter that is claimed, to be not persuasive.

With respect to the rejection of claim 15 under 35 U.S.C. § 103 as being unpatentable over Sawaya, Asano, and Valenzona, we note that appellants hold there was no suggestion from the prior art to provide a “writing implement receptacle” with a telephone message printing apparatus as described by Sawaya. We disagree, and refer to the examiner’s rejection. Moreover, for all that the language requires, display 108 (Sawaya Fig. 1) is a writing implement receptacle, in that one could rest a pen, pencil, or stylus lengthwise across the display.

We therefore sustain the rejection of claims 1-14 under 35 U.S.C. § 103 as being unpatentable over Sawaya and Asano and the rejection of claims 15 and 16 under 35 U.S.C. § 103 as being unpatentable over Sawaya, Asano, and Valenzona.

#### CONCLUSION

The rejection of claims 1-16 under 35 U.S.C. § 103 is affirmed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

KENNETH W. HAIRSTON )  
Administrative Patent Judge )  
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 ) BOARD OF PATENT  
HOWARD B. BLANKENSHIP ) APPEALS  
Administrative Patent Judge ) AND  
 ) INTERFERENCES  
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ALLEN R. MACDONALD )  
Administrative Patent Judge )

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