

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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 JOHN M. VERBIL, MARTIN R. MARKS, R. ERIC PFLUM,
WILLIAM C. CATELLIER, and ROBERTO YSLAS

Appeal No. 2006-3280
Application No. 09/874,152

ON BRIEF

Before JERRY SMITH, HOMERE, and LUCAS, **Administrative Patent Judges.**

HOMERE, **Administrative Patent Judge.**

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the final rejection of claims 1, 4 through 10, 21 through 28, all of which are pending in this application. Claims 2 and 3 have been canceled by Appellants.

We reverse.

Invention

Appellants' invention relates generally to a method and apparatus for queuing calls placed by a caller to a subscriber line having a Call Forward on Busy Line functionality within an Advanced Intelligent Network (AIN) telecommunication system. When the subscriber line is busy, the Call Forward On Busy Line functionality comprised therein reroutes all calls in destination to the subscriber line to a local switch servicing said subscriber line. The local switch, in turn, forwards the subscriber calls to an intelligent peripheral within the AIN system, which then queues the forwarded calls in available queue slots. The intelligent peripheral subsequently places a busy check on the subscriber line. If the subscriber line is no longer busy, the local switch then forwards the busy check back to the intelligent peripheral, which drops the busy check and connects a queued subscriber call with the busy check call.

Claim 1 is representative of the claimed invention and is reproduced as follows:

1. A method of queuing calls to a subscriber of queuing services accessed through a subscriber line, the method comprising:

provisioning Call Forward on Busy Line on the subscriber line to permit detecting a call to the subscriber line at a local switch connected to the subscriber line;

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if the subscriber line is busy, forwarding the call to an intelligent peripheral within an Advanced Intelligent Network (AIN) telecommunications system;

queuing the call to the subscriber in the intelligent peripheral;

determining that the subscriber line is not busy by dialing the subscriber line from the intelligent peripheral; and

if a call is queued in the intelligent peripheral and the subscriber line is determined to be not busy, connecting the call to the subscriber with the subscriber line.

References

The Examiner relies on the following references:

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|-------------------------------|-----------|--|
| Andrews et al. (Andrews) | 5,271,058 | Dec. 14, 1993 |
| Weisser, Jr. et al. (Weisser) | 5,600,710 | Feb. 4, 1997 |
| Watts | 5,668,861 | Sep. 16, 1997 (filed Dec. 23, 1993) |
| Marks et al. (Marks) | 5,844,896 | Dec. 1, 1998 (filed Feb. 26, 1997) |
| Knoerle et al. (Knoerle) | 6,597,780 | Jul. 22, 2003 (filed Dec. 16, 1999) |

Rejections at Issue

A. Claims 1, 4 through 10, 21 through 28 stand rejected under 35 U.S.C. § 103 as being unpatentable over the combination of Weisser, Knoerle and Watts.

B. Claims 11 through 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over the combination of Weisser and Knoerle.

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C. Claims 10 and 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over the combination of Weisser, Knoerle, Watts and Andrews.¹

D. Claims 1, 11, 21 and 28 stand rejected under double patenting as being unpatentable over claim 1 of Marks.

Rather than reiterate the arguments of Appellants and the Examiner, the opinion refers to respective details in the Briefs² and the Examiner's Answer.³ Only those arguments actually made by Appellants have been considered in this decision. Arguments that Appellants could have made but chose not to make in the Briefs have not been taken into consideration. See 37 CFR 41.37(c)(1)(vii)(eff. Sept. 13, 2004).

OPINION

In reaching our decision in this appeal, we have carefully considered the subject matter on appeal, the Examiner's rejections, the arguments in support of the rejections and the

1 We note that the Examiner previously rejected claim 10 under 35 U.S.C. § 103 as being unpatentable over the combination of Weisser, Knoerle and Watts, and rejected claim 20 over the combination of Weisser and Knoerle alone. The present rejection of those claims appears to contradict the Examiner's earlier position with regard to the teachings of Weisser and Knoerle. We will only consider the Examiner's rejection of claims 10 and 20 under 35 U.S.C. § 103 as being unpatentable over the combination of Weisser and Knoerle.

2 Appellants filed an Appeal Brief on Jan. 05, 2006. Appellants filed a Reply Brief on May 26, 2006.

3 The Examiner mailed an Examiner's Answer on March 24, 2006. The Examiner mailed a communication on Aug. 07, 2006 indicating that the Reply Brief had

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evidence of obviousness relied upon by the Examiner as support for the rejections. We have, likewise, reviewed and taken into consideration Appellants' arguments set forth in the Briefs along with the Examiner's rationale in support of the rejections and arguments in the rebuttal set forth in the Examiner's Answer. After full consideration of the record before us, we do not agree with the Examiner that claims 1, 4 through 10, 21 through 28 are properly rejected under 35 U.S.C. § 103 as being unpatentable over the combination of Weisser, Knoerle and Watts. We also do not agree with the Examiner that claims 11 through 20 are properly rejected under 35 U.S.C. § 103 as being unpatentable over the combination of Weisser and Knoerle. Additionally, we do not agree with the Examiner that claims 1, 11, 21 and 28 are properly rejected under double patenting as being unpatentable over claim 1 of Marks. Accordingly, we reverse the Examiner's rejections of claims 1, 4 through 28 for the reasons set forth **infra**.

I. Under 35 U.S.C. § 103, is the Rejection of Claims 1, 4 through 10, 21 through 28 as being unpatentable over combination of Weisser, Knoerle and Watts Proper?

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a **prima facie** case of

been entered and considered.

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obviousness. **In re Oetiker**, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). **See also In re Piasecki**, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The Examiner can satisfy this burden by showing that some objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art suggests the claimed subject matter. **In re Fine**, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the Appellants. **Oetiker**, 977 F.2d at 1445, 24 USPQ2d at 1444. **See also Piasecki**, 745 F.2d at 1472, 223 USPQ at 788. Thus, the examiner must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the examiner's conclusion. However, a suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art, as the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. **In re Kahn**, 441 F.3d 977, 987-88, 78 USPQ2d 1329, 1336 (Fed. Cir.

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2006) citing **In re Kotzab**, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000). See also **In re Thrift**, 298 F.3d 1357, 1363, 63 USPQ2d 2002, 2008 (Fed. Cir. 2002).

An obviousness analysis commences with a review and consideration of all the pertinent evidence and arguments. "In reviewing the [E]xaminer's decision on appeal, the Board must necessarily weigh all of the evidence and argument." **Oetiker**, 977 F.2d at 1445, 24 USPQ2d at 1444. "[T]he Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion." **In re Lee**, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

With respect to representative claim 1, Appellants argue in the Briefs that neither Weisser nor Knoerle nor Watts teaches dialing the subscriber line from the intelligent peripheral of the AIN telecommunications system to determine whether the subscriber line is no longer busy.

Particularly, at page 7 of the Appeal Brief,⁴ Appellants state the following:

None of the references cited by the Examiner disclose an intelligent peripheral placing calls on behalf of queued calls to determine if a called subscriber is busy.

⁴ We note that Appellants reiterate these same arguments at page 2 of the Reply Brief.

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In order for us to decide the question of obviousness, "[t]he first inquiry must be into exactly what the claims define." **In re Wilder**, 429 F.2d 447, 450, 166 USPQ 545, 548 (CCPA 1970). "Analysis begins with a key legal question-- what is the invention claimed?"...Claim interpretation...will normally control the remainder of the decisional process." **Panduit Corp. v. Dennison Mfg.**, 810 F.2d 1561, 1567-68, 1 USPQ2d 1593, 1597 (Fed. Cir. 1987).

We note that representative claim 1 reads in part as follows:

[D]etermining that the subscriber line is not busy by dialing the subscriber line from the intelligent peripheral.

We note at page 13, lines 10 through 13, Appellants' specification states the following:

Intelligent peripheral 42 places a busy check call to subscriber line 116. The busy check call is dropped if the busy check call is forwarded back to the intelligent peripheral 42 from local switch 30.

Thus, the claim does require dialing the subscriber line from the intelligent peripheral of the AIN telecommunications system to determine whether the subscriber line is no longer busy.

Now, the question before us is what Weisser, Knoerle and Watts would have taught to one of ordinary skill in the art? To answer this question, we find the following facts:

1. At column 9, lines 2 through 26, Weisser states the following:

Initially, a call is initiated as shown in block 100. It is then determined whether the line for the called number is busy (block 110, FIG. 2). If the called number is not busy, the telephone network, using the AIN, connects the call to the called line (block 120, FIG. 2). If the called party is busy, the system determines if the called number subscriber is an "Advertise-on-Busy" subscriber (block 130, FIG. 2). If the called party is not an "Advertise-on-Busy" subscriber, then the telephone system initiates a busy signal to the calling party indicating that the called line is busy or occupied (block 140, FIG. 2). On the other hand, if it is determined by the telephone system that the called line, which is busy, is an "Advertise-on-Busy" subscriber, then the call is queued in a service control point 26 and then temporarily connected by a voice circuit to a chosen service node 39. The service node then plays a recorded message selected by the service control point to the caller while waiting to provide a connection to the called line (blocks 150 and 160, FIG. 2). The queue established in this service control point 26 establishes the order that calls placed on hold will be connected to the called line. The service control point 26 also stores indicia related to the message to be played in the service node 39 for any given call. These recorded messages can be chosen, selected, and created by the "Advertise-on-Busy" subscriber.

2. Further, at column 3, line 66 through column 4, line 7, Watts states the following:

If the called telecommunications device 18 disconnects, intelligent peripheral 40 initiates a call to the calling telecommunications device 12 which is

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notified of the disconnect by playing an announcement such as "Your Notification Hold call has been disconnected. If you wish to re-initiate the call, please press one now". The calling party either confirms the announcement whereupon the call is re-initiated by the intelligent peripheral, or the calling party simply disconnects.

With the above discussion in mind, we find that Weisser teaches a method for re-routing a call to an AIN system when a subscriber line for which the call was intended is busy. Weisser discloses playing a recorded message to a calling party while waiting on hold to be connected to the subscriber line. Next, we find that Knoerle teaches a system for providing a continuous tone to a caller being re-routed from a service node to a central office (see abstract). Additionally, we find that Watts teaches a system wherein an intelligent peripheral initiates a call to a calling party when said party's call was dropped while waiting on hold to be connected with the called party.

It is our view that one of ordinary skill in the art would have duly recognized that the combined teaching of Weisser, Knoerle and Watts does not amount to the invention as set forth in representative claim 1. Particularly, the ordinarily skilled artisan would have readily been apprised of the fact that the teachings of the combined references amount to, at best, a method that allows a calling party to be connected to a called party when the latter's line is available for communication, and in the

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event that the calling party is dropped while waiting on hold, an intelligent peripheral would place a call to the calling party. The ordinarily skilled artisan would have readily recognized that the combined references merely disclose a mechanism for allowing the intelligent peripheral to call the calling party upon being disconnected from the AIN. In other words, the ordinarily skilled artisan would have found that the Weisser-Knoerle-Watts combination is limited to queuing calls to the subscriber line in an AIN system; connecting each of these calls to the subscriber line as it becomes available; and dialing the calling party from the intelligent peripheral if the calling party was dropped while waiting on hold. The ordinarily skilled would have found, however, that the cited combination does not amount to dialing the subscriber line (called party) from the intelligent peripheral to determine whether said party is still busy or available for communication with the next calling party waiting in line.

In consequence, we find error in the examiner's stated position, which concludes that the combination of Weisser, Knoerle and Watts teaches the claimed limitation of dialing the subscriber line from the intelligent peripheral of the AIN telecommunications system to determine whether the subscriber line is no longer busy.

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It is therefore our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to the ordinarily skilled artisan the invention as set forth in claims 1, 4 through 10, and 21 through 28. Accordingly, we will not sustain the Examiner's obviousness rejection of claims 1, 4 through 10, and 21 through 28.

II. Under 35 U.S.C. § 103, Is the Rejection of Claims 11 through 20 as being unpatentable over the combination of Weisser and Knoerle Proper?

With respect to 11 through 20, Appellants argue in the Briefs that neither Weisser nor Knoerle teaches dialing the subscriber line from the intelligent peripheral of the AIN telecommunications system to determine whether the subscriber line is no longer busy. We have already addressed this argument in the discussion of representative claim 1 above, and we agree with Appellants.

It is therefore our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to the ordinarily skilled artisan the invention as set forth in claims 11 through

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20. Accordingly, we will not sustain the Examiner's obviousness rejection of claims 11 through 20.

II. Under the Judicially Created Doctrine of Obviousness-type Double Patenting, Is the Rejection of Claims 1, 11, 21 and 28 as being unpatentable over Claim 1 of Marks Proper?

With regard to claims 1, 11, 21 and 28, the Examiner takes the position that cited claims are broader than claim 1 of Marks, and they are therefore not patentably distinct from the cited claim. In response, Appellants argue that the cited claims are patentably distinct from claim 1 of Marks. Particularly, the cited claims in the present application require an intelligent peripheral that places a call to a subscriber line to determine if the subscriber line is busy. Appellants submit that the cited limitation is not disclosed in claim 1 of Marks, which requires that such a call be made to the subscriber line only after it has already been determined that the subscriber line is not busy. We agree with Appellants.

It is therefore our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to the ordinarily skilled artisan the invention as set forth in claims 1, 11, 21 and 28. Accordingly, we will not sustain the Examiner's obviousness double patenting rejection of claims 1, 11, 21 and 28.

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CONCLUSION

In view of the foregoing discussion, we have not sustained the Examiner's decision rejecting claims 1, 4 through 28 under 35 U.S.C. § 103. Therefore, we reverse.

REVERSED

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| JERRY SMITH |) | |
| Administrative Patent Judge |) | |
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| |) | BOARD OF PATENT |
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