

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN KENNETH GALLANT

Appeal 2007-1575
Application 10/101,199¹
Technology Center 2600

Decided: December 21, 2007

*Before ANITA PELLMAN GROSS, JAY P. LUCAS, and MARC S. HOFF
Administrative Patent Judges.*

LUCAS, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF CASE

Appellant appeals from a final rejection of claims 1 to 13 under authority of 35 U.S.C. § 134. The Board of Patent Appeals and Interferences (BPAI) has jurisdiction under 35 U.S.C. § 6(b).

¹ Application filed March 18, 2002. Appellant claims the benefit under 35 U.S.C. § 119 of a plurality of provisional applications filed March 20, 2001. The real party in interest is MCI, Inc.

Appellant's invention relates to the feature of "call screening" in telephone services, in which an incoming call is reviewed before it is passed on to the recipient. According to the invention, under certain circumstances the call may be forwarded to a chosen alternative mechanical or human recipient. In the words of the Appellant:

Claim 1 recites in a communications system, a method for processing a request from an originating party to establish communications with a destination party, comprising receiving a request from the originating party to establish communications with the destination party (e.g., 402, Fig. 4; pg. 18, para. 0071); determining if the request is permissible based upon applying at least one criterion to at least one aspect of the request (e.g., 414-422, Fig. 4; pg. 19, para. 0076, to pg. 20, para. 0080), the determining if the request is permissible includes identifying a type of address with which the originating party or the destination party is associated (e.g., 508, Fig. 5; 608, Fig. 6; pg. 23, para. 0091-0094; pg. 26, para. 0107, to pg. 27, para. 0109). By way of example, the determining may include identifying whether the address is an IP address, a uniform resource locator, a universal resource identifier, a public telephone number, a private telephone number, etc. (see, for example, pg. 4, para. 0014). The method further comprises determining if a forwarding-on-screening feature is associated with the destination party (e.g., 428, Fig. 4; pg. 21, para. 0084); and responding to the request with forwarding information if the request is not permissible and a forwarding-on-screening feature is associated with the destination party (e.g., 432, Fig. 4; pg. 21, para. 0086).

Brief, pages 2-3

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Claim 1 is exemplary:

1. In a communications system, a method for processing a request from an originating party to establish communications with a destination party, comprising:

receiving a request from the originating party to establish communications with the destination party;

determining if the request is permissible based upon applying at least one criterion to at least one aspect of the request, the determining if the request is permissible includes identifying a type of address with which the originating party or the destination party is associated;

determining if a forwarding-on-screening feature is associated with the destination party; and

responding to the request with forwarding information if the request is not permissible and a forwarding-on-screening feature is associated with the destination party.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Chow	US 6,587,683 B1	Jul. 1, 2003
		(filed Dec. 13, 1999)
Yau	US 6,741,688 B1	May 25, 2004
		(filed Oct. 28, 1999)

Rejections:

R1: Claims 1 to 10 stand rejected under 35 U.S.C. § 103(a) for being obvious over Chow in view of Yau.

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R2: Claims 11 to 13 stand rejected under 35 U.S.C. § 102(e) for being anticipated by Yau.

Appellant contends that the claimed subject matter is not anticipated by Yau (Brief, page 6), or rendered obvious by Chow in combination with Yau (Brief, page 12), for reasons to be discussed more fully below. The Examiner contends that each of the claims is properly rejected.

Rather than repeat the arguments of Appellant or the Examiner, we make reference to the Brief and the Answer for their respective details. Only those arguments actually made by Appellant have been considered in this decision. Arguments which Appellant could have made but chose not to make in the Brief have not been considered and are deemed to be waived.

See 37 C.F.R. § 41.37(c)(1)(vii) (2004).²

We affirm the rejections.

ISSUE

The issues are whether Appellant has shown that the Examiner erred in rejecting claims 11 to 13 under 35 U.S.C. § 102(e) and claims 1 to 10 under 35 U.S.C. § 103(a). Further, the primary issue for the § 102 rejection

² Appellant has not presented any substantive arguments directed separately to the patentability of the dependent claims or related claims in each group, except as will be noted in this opinion. In the absence of a separate argument with respect to those claims, they stand or fall with the representative independent claim. *See In re Young*, 927 F.2d 588, 590 (Fed. Cir. 1991).

turns on whether the Yau reference teaches the limitation of identifying a type of address with which the originating or destination party is associated, when that limitation is broadly, but fairly, interpreted. The § 103 rejection issue turns on whether Yau teaches that limitation and also whether the two references are properly combinable.

FINDINGS OF FACT

The record supports the following findings of fact (FF) by a preponderance of the evidence.

1. Appellant has invented a technique for screening and forwarding a communication (e.g. phone call) from an originating party to a destination party. As a feature of this method and system, the invention will screen the phone call and forward it based on applying a criterion to one aspect of the request to complete the phone call including identifying the type of address associated with either party. (Claim 1; spec. ¶ [0013],[0014]). Address types, in accordance with the specification, may include IP addresses, URLs, public or private telephone numbers, or any forms of character strings in a computing system. (Specification, ¶ [0014]).

PRINCIPLES OF LAW

Appellant has the burden on appeal to the Board to demonstrate error in the Examiner's position. See *In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006)

"To reject claims in an application under section 103, an examiner must show an unrebutted *prima facie* case of obviousness. . . . On appeal to the Board, an applicant can overcome a rejection by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness." [citations removed] *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998).

Both anticipation under 35 U.S.C. § 102 and obviousness under § 103 are two-step inquiries in which the first step is a proper construction of the claims and the second step requires a comparison of the properly construed claims to the prior art. *Medichem S.A. v. Rolabo S.L.*, 353 F.3d 928, 933 (Fed. Cir. 2003).

"Shortly after the creation of this court, Judge Rich wrote that '[t]he descriptive part of the specification aids in ascertaining the scope and meaning of the claims inasmuch as the words of the claims must be based on the description. The specification is, thus, the primary basis for construing the claims.' *Standard Oil Co. v. Am. Cyanamid Co.*, 774 F.2d 448, 452 (Fed. Cir. 1985). On numerous occasions since then, we have reaffirmed that point..." *Phillips v. AWH Corp.*, 415 F.3d 1303, 1315 (Fed. Cir. 2005).

It is axiomatic that anticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim. See *In re King*, 801 F.2d 1324, 1326 (Fed. Cir. 1986) and *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458 (Fed. Cir. 1984).

Our reviewing court states in *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989) that "claims must be interpreted as broadly as their terms reasonably allow." Our reviewing court further states that "the words of a claim 'are generally given their ordinary and customary meaning.'" *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (en banc) (internal citations omitted). The "ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application." *Id.* at 1313.

References within the statutory terms of 35 U.S.C. § 103 qualify as prior art for an obviousness determination only when analogous to the claimed invention. *In re Clay*, 966 F.2d 656, 658 (Fed. Cir. 1992). Two separate tests define the scope of analogous prior art: (1) whether the art is from the same field of endeavor, regardless of the problem addressed and, (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved. *In re Deminski*, 796 F.2d 436, 442 (Fed. Cir. 1986); see also *In re Wood*, 599 F.2d 1032, 1036 (CCPA 1979) and *In re*

Bigio, 381 F.3d 1320, 1325 (Fed. Cir. 2004). Furthermore, “there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness’ . . . [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int'l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

ANALYSIS

From our review of the administrative record, we find that the Examiner has presented prima facie cases for the rejections of Appellant’s claims under 35 U.S.C. §§ 102 and 103. The prima facie cases are presented on pages 3 to 8 of the Examiner’s Answer. In opposition, Appellant presents a number of arguments which we will consider forthwith.

Rejection under 35 U.S.C. § 102(e)

The first argument alleges that Yau “in no way discloses or suggests performing a screening operation to determine whether to permit a call to the destination party from the originating party, where the screening operation includes identifying a type of address with which the originating party or destination party is associated, as required by claim 11.” (Br. 6, middle).

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Appellant concedes that Yau screens telephone numbers (Br. 7, bottom), but distinguishes that activity from the claimed identification of a “type of address.” Appellant further explains (Br. 8, bottom),

“By way of example, Appellant’s screening system may receive an address and determine whether the address is an IP address, a E.164-type telephone number, a private number, etc. Contrary to the Examiner’s allegation, one skilled in the art would readily appreciate that receiving a telephone number is in no way equivalent to identifying a type of address with which an originating or destination party is associated.”

Key to reviewing this rejection is understanding the proper interpretation of the claims. (See *Medichem S.A. v. Rolabo S.L* cited above). The clause in question, with respect to claim 1 and claim 11, reads, “...identifying a type of address with which the originating party or the destination party is associated.” During examination, a claim may be interpreted in a broad but reasonable manner, not inconsistent with the Specification. (See *In re Zletz* and *Phillips v. AWH Corp* cited above.). Although the Appellant would have us read “type of address” as only referring to the class of communications that the code belongs to, (e.g., URL, phone number, IP address) it is clear from the Specification that phone numbers are a type of address. Yau teaches looking for certain types of addresses (e.g., so-called 800 or 900 type phone numbers, among others). (See Yau, col. 4, l. 19+). It seems perfectly consistent with the wording of the claim to interpret the phrase in question to mean, for example, determining if the request to establish a phone call is to, or from, an 800

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number. Under that interpretation, we find Yau teaches “identifying a type of address with which the originating party or destination party is associated.”

Regarding claim 12, Appellant argues that Yau does not disclose or suggest routing the phone call to an alternative number when the type of address has been identified and the destination party does not permit the call. Examiner has pointed to column 4, lines 36 to 43, which describes a received call, once identified as an 800 number call, being “rerouted” or “forwarded to another number.” (*Id.*, col. 4, l. 39). We do not find error in the Examiner rejecting the cited claim over this teaching.

With respect to claim 13, the Appellant presents an argument similar to that presented concerning claim 11. As Yau teaches identifying the address as being a phone number, we do not find error in the Examiner’s rejection.

Rejection under 35 U.S.C. § 103(a)

Appellant first argues the proper joining of the references in the rejection. As both Yau and Chow present inventions in the same field of endeavor, we find that an artisan would look to both teachings in seeking a solution to a problem involving screening, call forwarding, and telephony in general. (*See KSR*, cited above).

Appellant’s arguments with respect to claims 1, 2, and 4 to 10 (Br.13, top, 19, bottom) echo the arguments against the rejection of Claim 11

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discussed above. For the reasons stated, we find the teachings in Yau supportive of the claimed limitation concerning “identifying a type of address.”

With respect to claim 3, we find that Chow teaches determining from the Caller ID the “address, building number, company affiliation, etc.” of the calling party (Chow, col. 5, l. 50+). As the claim limitation concerns the originating party’s location, we do not find error in the Examiner’s rejection of this claim.

CONCLUSION OF LAW

Based on the findings of facts and analysis above, we conclude that the Examiner did not err in rejecting claims 1 to 13.

DECISION

The Examiner's rejection of claims 1 to 13 is Affirmed.

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

AFFIRMED

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VERIZON
PATENT MANAGEMENT GROUP
1515 N. COURTHOUSE ROAD
SUITE 500
ARLINGTON VA 22201-2909