

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEROME P. DREXLER

Appeal 2007-2951
Application 09/974,222¹
Technology Center 2100

Decided: February 27, 2008

Before LANCE LEONARD BARRY, HOWARD B. BLANKENSHIP, and
JEAN R. HOMERE, *Administrative Patent Judges*.

HOMERE, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134 from the Examiner's final rejection of claims 1 through 29. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

¹ Filed on October 09, 2001. Honeywell International Inc. is the real party in interest.

The Invention

Appellant invented a method for transferring data from an electronic mail (e-mail) message to a relational database. (Spec. 1.) As depicted in Figures 1 and 2, upon receiving an incoming e-mail message (10), a database import utility program (40) examines the received message to determine whether it meets certain predefined selection criteria (50). If it does, the utility program (40) concludes that the e-mail is in a predefined format, and parses it into a plurality of data strings (44). (Spec. 6.) Subsequently, a string association block (64) associates the parsed data strings with corresponding fields in the database (80). The relationships between the parsed data strings and associated database fields are subsequently stored (68). (Spec. 4-7.)

An understanding of the invention can be derived from exemplary claims 1, 3, and 11, which read as follows:

1. A method of recording data to a database that has a number of database locations, the method comprising the steps of:

receiving an electronic mail message, the electronic mail message including a set of data elements;

selecting a first subset of the data elements;

saving the first subset of data elements to a first location of the database;

selecting a second subset of the data elements; and

saving the second subset of data elements to a second location of the database.

3. The method of claim 2, wherein the step of determining whether an electronic mail message is in a predefined format includes the steps of:

counting the number of times a predetermined delimiter character appears in the electronic mail message; and

comparing the number of times that the predetermined delimiter character appears in the electronic mail message to an expected number.

11. A method of recording data to a database that has a number of database fields, the method comprising the steps of:

parsing an electronic mail message into a number of parsed data strings;

providing a correspondence between selected parsed data strings and a database field in the database; and

saving each of the selected parsed data strings to the corresponding database field in the database.

The Examiner relied upon the following prior art to reject the claims on appeal:

Payne	US 6,092,090	Jul. 18, 2000
Barnishan	US 6,654,950B1	Nov. 25, 2003

The Examiner rejected the claims on appeal as follows:

- A. Claims 1, 2, and 10 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Payne.
- B. Claims 3 through 9 and 11 through 29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Payne and Barnishan.

FINDINGS OF FACT

The following findings of fact (FF) are supported by a preponderance of the evidence.

Payne

1. Payne discloses a method and system for indexing electronic documents to effectively manage the documents in a paperless office environment. (Abstract.) Incoming documents are received in the form of hardcopy (periodicals and correspondence that are scanned), facsimile, or email. (Col. 2, ll. 47-48.) Upon receiving the document, a module (210) determines the type or format of the document (i.e. an e-mail, a fax, or other). The received electronic document is parsed to extract therefrom key attributes that are stored as text based records in one or more pre-engineered database to separately index the associated documents. (Col. 2, ll. 50-55, col. 5, ll. 50-55.) The actual image of the document is separately stored in an image database server (40). (Col. 5, ll. 56-59.)

2. Upon receiving a facsimile document, it is parsed to separate the address information from the actual text of the document. In other words, the addressee of the fax inputs into the database select data about the received fax including the subject, author, date, etc. The system subsequently indexes the received facsimile document by creating an index card entry for the fax in one or more databases. (Col. 3, ll. 55-65.) Each of the databases includes a series of indices that separately delineate key attributes for a particular category of documents. (Col. 4, l. 66- col. 5, l. 8.)

3. A single image file is also created for the fax. The image file is stored in a database file server (image server 40) that includes a plurality of

file entries representing pointers to the address location for each of the documents stored therein. (Col. 4, ll. 1-3.)

4. Payne indicates that the disclosed system handles e-mail and facsimile documents in a similar fashion. Upon receiving an e-mail, the system parses the e-mail address from the associated text. It then stores the text of the e-mail in a text based file. Finally, it stores and indexes the address entries of the e-mail in a separate database. (Col. 6, ll. 10-22.)

5. As depicted in Figure 5, Payne discloses a resident database that classifies various document types. The resident database uses a form structure (510) to allow a user to input data in the database for each document type. (Col. 7, ll. 16-27.)

6. As shown in Figure 6, the form (610) includes several fields specific to the data associated with the document type being indexed. These fields allow documents to be formatted in accordance with the user-input data in the form structure. (Col. 8, ll. 1-26.)

Barnishan

7. Barnishan discloses a method and system for translating a dialect in a legacy program into another target dialect. (Abstract.)

8. As shown in Figures 12A, 12B, upon loading the code of the legacy dialect (220) into a database, a re-host program (210) pre-formats and parses the code into branches and sub-branches of a tree as determined by delimiters and separators used in the dialect. The parsed code is stored in the database in a tree structure. (Col. 10, ll. 26-40.)

9. As shown in Figures 15A, 15B each branch or sub-branch of the formatted dialect code is compared with previously created statements in

a translation model (404) for the target dialect. Upon matching each line in the formatted dialect code with a corresponding line in the translation model (404), the translated dialect code is stored in a text box. (Col. 10, ll. 46-61.)

10. Barnishan discloses post processing activities, such as adding the number of lines, delimiters, and any other features of the target dialect. (Col. 10, l. 66 - col. 11, l. 3.)

PRINCIPLES OF LAW

1. ANTICIPATION

“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).

In rejecting claims under 35 U.S.C. § 102, “a single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation.” *Perricone v. Medicis Pharmaceutical Corp.*, 432 F.3d 1368, 1375-76 (Fed. Cir. 2005) (citing *Minn. Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1565 (Fed. Cir. 1992)). “Anticipation of a patent claim requires a finding that the claim at issue ‘reads on’ a prior art reference.” *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1346 (Fed. Cir. 1999) (“In other words, if granting patent protection on the disputed claim would allow the patentee to exclude the public from practicing the prior art, then that claim is anticipated, regardless of whether it also covers subject matter not in the prior art.”) (internal citations omitted).

2. OBVIOUSNESS

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) (“On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.”) (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 127 S. Ct. at 1734 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”)

“The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Leapfrog Enter., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007) (quoting *KSR Int'l v. Teleflex, Inc.*, 127 S. Ct. 1727, 1739 (2007)).

Discussing the obviousness of claimed combinations of elements of prior art, *KSR* explains:

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, §103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill. *Sakraida* [*v. AG Pro, Inc.*, 425 U.S. 273 (1976)] and *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57 (1969)] are illustrative—a court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions.

KSR, 127 S. Ct. at 1740. Where the claimed subject matter cannot be fairly characterized as involving the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for the improvement, a holding of obviousness can be based on a showing that there was “an apparent reason to combine the known elements in the fashion claimed.” *KSR*, 127 S. Ct. at 1740-41. Such a showing requires “some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, 127 S. Ct. at 1741 (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

The reasoning given as support for the conclusion of obviousness can be based on interrelated teachings of multiple patents, the effects of demands known to the design community or present in the marketplace, and the background knowledge possessed by a person having ordinary skill in the art. *KSR*, 127 S. Ct. at 1740-41. See also *Dystar Textilfarben GmbH v. C.H. Patrick Co.*, 464 F.3d 1356, 1368 (Fed. Cir. 2007) which states:

[A]n implicit motivation to combine exists not only when a suggestion may be gleaned from the prior art as a whole, but when the “improvement” is technology-independent and the combination of references results in a product or process that is more desirable, for example because it is stronger, cheaper, cleaner, faster, lighter, smaller, more durable, or more efficient. Because the desire to enhance commercial opportunities by improving a product or process is universal—and even common-sensical—we have held that there exists in these situations a motivation to combine prior art references even absent any hint of suggestion in the references themselves. In such situations, the proper question is whether the ordinary artisan possesses knowledge and skills rendering him *capable* of combining the prior art references.

Leapfrog, 485 F.3d at 1162 (holding it “obvious to combine the Bevan device with the SSR to update it using modern electronic components in order to gain the commonly understood benefits of such adaptation, such as decreased size, increased reliability, simplified operation, and reduced cost”).

Also, a reference may suggest a solution to a problem it was not designed to solve and thus does not discuss. As stated in *KSR*:

Common sense teaches . . . that familiar items may have obvious uses beyond their primary purposes, and in many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle. . . . A person of ordinary skill is also a person of ordinary creativity, not an automaton.

KSR, 127 S. Ct. at 1742.

The prior art relied on to prove obviousness must be analogous art. As explained in *Kahn*,

the “analogous-art” test . . . has long been part of the primary *Graham analysis* articulated by the Supreme Court. *See Dann [v. Johnston]*, 425 U.S. [219,] 227-29 . . . [1976], *Graham*,

383 U.S. at 35. . . The analogous-art test requires that the Board show that a reference is either in the field of the applicant's endeavor or is reasonably pertinent to the problem with which the inventor was concerned in order to rely on that reference as a basis for rejection. *In re Oetiker*, 977 F.2d [at] 1447 . . . References are selected as being reasonably pertinent to the problem based on the judgment of a person having ordinary skill in the art. *Id.* (“[I]t is necessary to consider ‘the reality of the circumstances,’—in other words, common sense—in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor.” (quoting *In re Wood*, 599 F.2d 1032, 1036 (C.C.P.A. 1979)).

Kahn, 441 F.3d at 986-87. *See also In re Clay*, 966 F.2d 656, 659 (Fed. Cir. 1992) (“[a] reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem.”).

In view of *KSR*'s holding that “*any* need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed,” 127 S. Ct. at 1742 (emphasis added), it is clear that the second part of the analogous-art test as stated in *Clay, supra*, must be expanded to require a determination of whether the reference, even though it may be in a different field from that of the inventor's endeavor, is one which, because of the matter with which it deals, logically would have commended itself to an artisan's (not necessarily the inventor's) attention in considering *any* need or problem known in the field of endeavor. Furthermore, although under *KSR* it is not always necessary to identify a known need or problem as a motivation for modifying or combining the prior art, it is nevertheless

always necessary that the prior art relied on to prove obviousness be analogous. *See KSR*, 127 S. Ct. at 1740 (“The Court [in *United States v. Adams*, 383 U.S. 39, 40 (1966)] recognized that when a patent claims a structure already known in the prior art that is altered by the mere substitution of one element for another *known in the field*, the combination must do more than yield a predictable result.”) (emphasis added). *See also Sakraida*, 425 U.S. at 280 (“Our independent examination of that evidence persuades us of its sufficiency to support the District Court's finding ‘as a fact that each and all of the component parts of this patent . . . were old and well-known throughout the dairy industry long prior to the date of the filing of the application for the Gribble patent.’”).

ANALYSIS

A. 35 U.S.C § 102(b) REJECTION

Claims 1, 2, and 10

Independent claim 1 recites in relevant part saving a first subset and a second subset of an electronic mail message respectively in a first location and a second location of a database. (App. Br., Claims Appendix.) Appellant argues that Payne does not teach an electronic mail message that includes set of data elements (excluding the address lines (From...To), and the subject line of the e-mail) that are stored in different locations of the database. Therefore, Appellant argues that Payne does not anticipate independent claim 1. (App. Br. 14.)²

² This decision relies and refers to the Appeal Brief filed on Sep. 29, 2005. We have not considered the substitute Brief filed on Feb 02, 2006 since it

In response, the Examiner avers that Payne's address lines are subsets of the electronic mail message that are stored separately in one or more databases. Therefore, the Examiner concludes that Payne anticipates independent claim 1. (Ans. 14.)

Thus, the precise issue before us turns on whether Payne's address lines qualify as subsets of the e-mail message that are stored in separate locations of a database. We answer this inquiry in the affirmative.

We begin by considering the scope and meaning of "email message" which must be given its broadest reasonable interpretation consistent with Appellant's disclosure, as explained in *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997):

[T]he PTO applies to the verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant's specification.

Id. at 1054. *See also In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989) (stating that claims must be interpreted as broadly as their terms reasonably allow.)

Appellant's Specification states the following:

The email message 10 may be of various types and formats. A typical *email message 10 may include information such as the address of the sender, the address of the recipient, and message text.* Such an email message 10 could also include an attachment, such as a file or program or header lines such as the subject line, a CC line, a BCC line, etc. (Emphasis Added.)

(Spec. 4-5.)

was refused entry by the Examiner, and Appellants failed to timely petition the Examiner's refusal to enter the brief.

Our reviewing court further states, “[t]he ‘ordinary meaning’ of a claim term is its meaning to the ordinary artisan after reading the entire patent.” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1321 (Fed. Cir. 2005).

Upon reviewing Appellant’s Specification, we find that “email message” can be reasonably construed to include information such as the addresses of the sender and recipient of the email.

As set forth in the Finding of Fact (FF) section above, Payne discloses parsing a received email into its address entries and the text of the email. (FF 4.) Payne further discloses storing and indexing the address entries in one or more databases. (FF 1-4.) Additionally, Payne discloses storing the text of the email in a separate image database. (*Id.*) We find that one of ordinary skill would readily recognize from Payne’s disclosure that, consistently with Appellant’s Specification, the disclosed address entries and text are integral subsets of the email message that are stored in different locations. Particularly, the ordinarily skilled artisan would aptly appreciate that Payne’s address entries are stored and indexed as separate records in a database. It follows that Appellant has not shown that the Examiner erred in finding that Payne anticipates independent claim 1.

Regarding claim 2, Appellant argues that the Examiner’s rejection lacks specificity, and that Payne does not teach determining whether the email is in a predefined format. (App. Br. 15-16.) In response, the Examiner explains that Payne teaches the predefined formats by providing particular forms to input data in order to create documents of corresponding types. (Ans. 16-17.) We agree with the Examiner.

Payne discloses a mechanism for identifying various types of documents. Particularly, Payne provides certain forms that include various fields into which a user inputs data pertaining to each incoming email document to thereby classify said document in the database according to its type. (FF 5-6.) The ordinarily skilled artisan would readily recognize that the choice of a previously structured form as an aid to index an incoming email document in the database is indicative of the type, as well as the predefined format of said document. The rationale behind this conclusion is that the number of fields in the input forms for a particular database dictate the number of strings and corresponding delimiters in the parsed document that are needed to be filled in that database. Further, we note that Payne's disclosure of whether an incoming document is a fax or an email (see Figure 3) suggests that a determination is made of whether an email meets certain predefined format before it can be identified as such. We are therefore satisfied that the Examiner did make a sufficient prima facie case of anticipation, which Appellant failed to successfully rebut. Thus, Appellant has failed to show that the Examiner erred in finding that Payne anticipates dependent claim 2.

Appellant did not provide separate arguments with respect to the rejection of dependent claim 10. Therefore, we select independent claim 1 as being representative of the cited claim. Consequently, claim 10 falls together with representative claim 1. 37 C.F.R. § 41.37(c)(1)(vii).

B. 35 U.S.C. § 103(a) REJECTIONS

Claims 3 through 9

Appellant argues that the Examiner's rejection of claims 3 through 9 lacks specificity, and therefore it fails to establish a prima facie case of obviousness. (App. Br. 16.) Further, Appellant argues that neither Payne nor Barnishan teaches the limitations of claims 3 and 4. (App. Br. 16-17.) However, beyond these mere allegations, Appellant has not even attempted to show any deficiencies in the portions of Payne and Barnishan upon which the Examiner relied to reject the cited claims. Such allegations are insufficient to rebut the Examiner's prima facie case of obviousness. A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim. *See* 37 C.F.R. § 41.37(c)(1)(vii). Further, as explained by the Examiner at pages 17 and 18 of the Answer, we note that the fields in Payne's input forms for entering attributes of a document are indicative of an equal number of delimiters and strings contained in the parsed document. Additionally, Barnishan explicitly discloses using delimiters to parse a dialect into data strings, and subsequently comparing the strings in the dialect to previously generated strings by a translation model in a second dialect, and finally adding the number of delimiters in a translated dialect. (FF. 9-10.) Therefore, the ordinarily skilled artisan would have readily recognized that Payne's email, taken in combination with Barnishan's dialect translation model, would have *predictably* resulted in counting delimiters in an email document and comparing them with previously computer delimiters

generated by the translation model.³ On this record, we are therefore satisfied that the Examiner did make a sufficient prima facie case of obviousness, which Appellant failed to successfully rebut. It follows that Appellant has failed to show that the Examiner erred in finding that the combination of Payne and Barnishan renders claims 3 and 4 unpatentable.

Appellant did not provide separate arguments with respect to the rejection of dependent claims 5 through 9. Therefore, we select dependent claim 3 as being representative of the cited claims. Consequently, claims 5 through 9 fall together with representative claim 3. 37 C.F.R. § 41.37(c)(1)(vii).

Claims 11 through 29

Independent claim 11 recites in relevant part parsing a message into a number of data strings that are saved into corresponding database fields. (App. Br., Claims Appendix.) Appellant argues that the combination of Payne and Barnishan does not teach the cited limitation. (App. Br. 17.) Further, Appellant argues that the proffered combination is improper since Payne and Barnishan are non-analogous prior art. Particularly, Appellant argues that Payne indexes an entire document including an email; and even though Barnishan teaches parsing a legacy code into a tree structure, it has nothing to do with an email message. (App. Br. 18-19.)

³ The Supreme Court has held that in analyzing the obviousness of combining elements, a court need not find specific teachings, but rather may consider "the background knowledge possessed by a person having ordinary skill in the art" and "the inferences and creative steps that a person of ordinary skill in the art would employ." *See KSR Int'l*, at 1740-41. To be nonobvious, an improvement must be "more than the predictable use of prior art elements according to their established functions." *Id.* at 1740.

In response, the Examiner asserts that Payne's disclosure of custom forms with a predetermined number of fields for inputting data strings of a parsed document to be indexed in a database teaches the claimed limitation. (Ans. 19.) Further, the Examiner submits that both Payne and Barnishan are directed to processing text files. Therefore, they are analogous.

We agree with the Examiner.

As discussed above, Payne's teaching of forms with predefined fields are indicative of the number of parsed strings for the email document that will be indexed in the database. Further, Payne discloses storing the email address lines in at least one database record, which by definition spans at least two fields. Therefore, the ordinarily skilled artisan would readily recognize that each instance (intersection between the row and a field) in the database record stores one of the parsed strings (address lines) therein. Additionally, as discussed above, Barnishan explicitly discloses parsing a text into strings that are subsequently stored in a database in a tree structure (FF 8.) The ordinarily skilled artisan would have readily recognized that Payne's email, taken in combination with Barnishan's text parsing scheme, would have *predictably* resulted in parsing an email into data strings that are stored in corresponding fields in a database.

Appellant's argument that the cited references are not analogous is not persuasive. Both references, as noted by the Examiner, reasonably pertain to the problem of parsing a textual document for storage in a database. The ordinarily skilled artisan would have recognized that the references disclose known elements that perform known functions to produce a predictable

result.⁴ We further note that Payne teaches all the limitations of independent claim 11. As discussed above, Payne teaches parsing the email document into data strings that are stored as a database record spanning a plurality fields. It follows that Appellant failed to show that the Examiner erred in concluding that the combined teachings of Payne and Barnishan renders claim 11 unpatentable.

Appellant did not provide separate arguments with respect to the rejection of dependent claims 12 through 15. Therefore, we select dependent claim 11 as being representative of the cited claims. Consequently, claims 12 through 15 fall together with representative claim 11. 37 C.F.R. § 41.37(c)(1)(vii).

Regarding the rejection of claims 16 through 29, Appellant substantially repeats the same arguments proffered for independent claims 1 and 11 above. In other instances, Appellant merely alleges that the combination of Payne and Barnishan does not teach the limitations of certain claims. (App. Br. 20-21.) We have addressed these arguments and allegations in great detail in our earlier discussion above. We find these arguments unpersuasive. Similarly, we find these allegations unsupported by the facts in the record before us. Consequently, it is our view that Appellant has failed to show that the Examiner erred in rejecting claims 16 through 29 over the combination of Payne and Barnishan.

SUMMARY

Appellant has not shown that the Examiner failed to establish that:
A. Claims 1, 2, and 10 are anticipated by Payne under 35 U.S.C. § 102(b).

⁴ *Id.*

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B. Claims 3 through 9 and 11 through 29 are unpatentable over the combination of Payne and Barnishan under 35 U.S.C. § 103(a).

DECISION

We affirm the Examiner's decision rejecting claims 1 through 29.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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