

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RAJASEKHAR AYALA

Appeal No. 95-3807
Application 08/088,696¹

ON BRIEF

Before HAIRSTON, KRASS and FLEMING, *Administrative Patent Judges*.

FLEMING, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 6 through 8, all of the claims present in the application. Claims 1 through 5 have been canceled.

The invention is directed to a system for selectively retrieving communications from a plurality of Customer Premises Equipment (CPE) devices placed at different geographic locations and having corresponding communication addresses.

¹ Application for patent filed July 8, 1993.

The independent claim 6 is reproduced as follows:

6. A system for a subscribing party to retrieve communications from calling parties at a predetermined plurality of Customer Premises Equipment (CPE) devices, each of said subscribing party CPE devices placed at a different geographic location and having a corresponding communication address, the system comprising:

a central office switch (COS) in electrical communication with said calling parties and said plurality of subscribing party CPE devices, said COS adapted to identify communications which are directed to said subscribing party, place the communications on queue and generate corresponding paging signals in a predetermined sequence for receipt by said subscribing party CPE devices at their corresponding communication addresses; and

identification means in electrical communication with said COS for receiving a subscriber specific log-in number at a selected subscribing party CPE device, identifying the corresponding communication on queue and routing the communication to the subscriber at said selected CPE device.

The Examiner does not rely on any references.

The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to teach how to make and use the claimed invention and as failing to provide an adequate written description of the invention. Claims 6 through 8 stand rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

Rather than reiterate the arguments of Appellant and the Examiner, reference is made to the briefs² and answers³ for the respective details thereof.

OPINION

We will not sustain the rejection of claims 6 through 8 under 35 U.S.C. § 112, first paragraph.

"The function of the description requirement [of the first paragraph of 35 U.S.C. 112] is to ensure that the inventor had possession, as of the filing date of the application relied on, of the specific subject matter later claimed by him." *In re Wertheim*, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976). "It is not necessary that the application describe the claim limitations exactly, . . . but only so clearly that persons of ordinary skill in the art will recognize from the disclosure that appellants invented processes including those limitations." *In re Wertheim, supra citing In re Smythe*, 480 F.2d 1376, 1382, 178 USPQ 279, 284 (CCPA 1973).

² Appellant filed an appeal brief on February 3, 1995. We will refer to this appeal brief as simply the brief. Appellant filed a reply appeal brief on April 7, 1995. We will refer to this reply appeal brief as simply the reply brief. The Examiner responded with a supplemental Examiner's answer and thereby entered and considered the reply brief. Appellant filed a supplemental reply appeal brief on May 15, 1995. We will refer to this supplemental reply appeal brief as simply the supplemental reply brief. The Examiner responded with a letter, mailed June 1, 1995, stating that the supplemental reply brief has been entered and considered but not further response by the Examiner is deemed necessary.

³ The Examiner responded to the brief with an Examiner's answer, mailed March 10, 1995. We will refer to the Examiner's answer as simply the answer. The Examiner responded to the reply brief with a supplemental Examiner's answer, mailed April 18, 1995.

Furthermore, the Federal Circuit points out that "[i]t is not necessary that the claimed subject matter be described identically, but the disclosure originally filed must convey to those skilled in the art that applicant had invented the subject matter later claimed." *In re Wilder*, 736 F.2d 1516, 1520, 222 USPQ 369, 372 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 1209 (1985), *citing In re Kaslow*, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983).

The Examiner argues on page 3 of the answer that the specification does not support the claim limitation "generating corresponding paging signals in a predetermined sequence" as recited in Appellant's claims 6 and 8. The Examiner argues in the answer and the supplemental answer that this limitation is new matter and thereby the claims fail to satisfy the requirements of 35 U.S.C. § 112, first paragraph.

We note that the claim limitation is setting forth the routing function of the communication to the CPE devices. Originally filed claims 1 through 3 set forth a switching means for routing the communications to the CPE devices wherein the switch means is provisioned with Automatic Call Distribution architecture (ACD) and wherein the ACD is adapted to perform the routing functions in a predetermined sequence. Furthermore, on page 7,

line 20, through page 8, line 6, and page 9, lines 1-32, of the original specification, Appellant discloses that the ACD routing functions are performed by electronically paging. Because the originally filed claims are part of the disclosure, we find that the disclosure, as originally filed, would have conveyed to those skilled in the art that Appellant had possession of the subject matter later claimed.

The Examiner also objected to the specification under 35 U.S.C. § 112, first paragraph, for failing to provide an enabling disclosure. Claims 6 through 8 stand rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification. On page 3 of the answer, the Examiner argues that the specification fails to teach how to generate corresponding paging signals in a predetermined sequence such that one of ordinary skill in the art would be able to make and use the invention.

In order to comply with the enablement provision of 35 U.S.C. § 112, first paragraph, the disclosure must adequately describe the claimed invention so that the artisan could practice it without undue experimentation. *In re Scarbrough*, 500 F.2d 560, 566, 182 USPQ 298, 303 (CCPA 1974); *In re Brandstadter*, 484 F.2d 1395, 1404, 179 USPQ 286, 293 (CCPA 1973); and *In re Gay*, 309 F.2d 769, 774, 135 USPQ 311, 316 (CCPA 1962). If the Examiner had a reasonable basis for questioning the sufficiency of the disclosure, the burden shifted to the

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Appellant to come forward with evidence to rebut this challenge. *In re Doyle*, 482 F.2d 1385, 1392, 179 USPQ 227, 232 (CCPA 1973), *cert. denied*, 416 U.S. 935 (1974); *In re Brown*, 477 F.2d 946, 950, 177 USPQ 691, 694 (CCPA 1973); and *In re Ghiron*, 442 F.2d 985, 992, 169 USPQ 723, 728 (CCPA 1971). However, the burden was initially upon the Examiner to establish a reasonable basis for questioning the adequacy of the disclosure. *In re Strahilevitz*, 668 F.2d 1229, 212 USPQ 561 (CCPA 1982); *In re Angstadt*, 537 F.2d 498, 504, 190 USPQ 214, 219 (CCPA 1976); and *In re Armbruster*, 512 F.2d 676, 677-78, 185 USPQ 152, 153 (CCPA 1975).

On page 7, line 20, through page 8, line 6, and page 9, lines 1-32, of the specification, Appellant discloses a switch for routing communications to a plurality of CPE devices by using electronic paging. Furthermore, we note that it is well within the abilities of one of ordinary skill in the art to design the switch to page each of a plurality of CPE devices in a predetermined sequence such as a sequence in the order of the communication addresses of the CPE devices. Thus, we find that Appellant's disclosure meets the requirements of 35 U.S.C. § 112, first paragraph, and the Examiner has not established a reasonable basis for questioning the sufficiency of the disclosure. Therefore, we will not sustain the Examiner's rejection of the claims under 35 U.S.C. § 112, first paragraph, for failing to provide an enabling disclosure.

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We have not sustained the rejection of claims 6 through 8 under 35 U.S.C. § 112, first paragraph. Accordingly, the Examiner's decision is reversed.

REVERSED

KENNETH HAIRSTON)
Administrative Patent Judge)
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) BOARD OF PATENT
ERROL A. KRASS) APPEALS AND
Administrative Patent Judge) INTERFERENCES
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MICHAEL R. FLEMING)
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