

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 65

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte STANLEY KUGELL and DAVID SILVER

Appeal No. 2003-1924
Application No. 08/554,533

ON BRIEF

Before McQUADE, NASE, and LEVY, Administrative Patent Judges.
NASE, Administrative Patent Judge.

ON REQUEST FOR REHEARING

This is in response to the appellants' request for rehearing¹ of our decision mailed July 7, 2004, wherein we affirmed the examiner's rejection of claims 16, 17, 20, 23, 27, 30, 32 through 39, 42, 45, 49, 52, 54 through 62, 65, 68, 72, 75, and 77 through 81 under 35 U.S.C. § 103(a) as being unpatentable over McLeod in view of Murphy and reversed

¹ Filed August 31, 2004.

the examiner's rejection of claims 16, 17, 37 through 39, and 59 through 62 under 35 U.S.C. § 103(a) as being unpatentable over McLeod in view of Burgess.

We have carefully considered the arguments raised by the appellants in their request for rehearing, however, those arguments do not persuade us that our decision was in error in any respect.

In our affirmance of the rejection of claims 16, 17, 20, 23, 27, 30, 32 through 39, 42, 45, 49, 52, 54 through 62, 65, 68, 72, 75, and 77 through 81 under 35 U.S.C. § 103(a), we (1) determined the scope and content of the applied prior art (i.e., Murphy and McLeod); (2) ascertained the difference between Murphy and claim 16; and (3) concluded that it would have been obvious at the time the invention was made to a person of ordinary skill in the art to have modified Murphy to arrive at the subject matter of claim 16 as suggested and taught by McLeod.

The points that the appellants believe this panel of the Board of Patent Appeals and Interferences to have misapprehended or overlooked in our earlier decision are:

- a. In rejecting the claims as being obvious over Murphy in view of McLeod at page 6 of the Decision, the Board was essentially making a new rejection which overlooked the teachings of the McLeod reference as a whole and therefore was improper.

- b. In rejecting the claims as being obvious over McLeod in view of Murphy at page 7 of the Decision, the Board overlooked the fact that McLeod teaches away from the modification suggested by the Board.
- c. Moreover, in making its obviousness rejections, the Board overlooked the substantial non-obvious advantages obtained by the invention.

We have once again reviewed the teachings of McLeod as a whole and find that McLeod does not teach away from the claimed invention but rather is suggestive of the claimed invention when considered with the teaching of Murphy. It remains our conclusion that it would have been obvious at the time the invention was made to a person of ordinary skill in the art to have modified Murphy's "Example Call Flow" by providing a toll-free 800 access number which does not include a prefix for reaching an operator as suggested and taught by McLeod. In our view, McLeod suggests that an 800 number be provided by a long-distance company in order to provide automated enhanced services that were previously available only through private exchange network systems or local telephone exchanges (column 2, lines 18-23). Murphy's "Example Call Flow" discloses the use of an automated enhanced feature (collect call) and discusses the value of providing such automated services (i.e., the reduction in time spent by human operators) (see Murphy at p. 25). Therefore, it remains our opinion that it would have been obvious to one of ordinary skill in the art to provide an 800 access number for the automated collect call system of Murphy in order to provide such service outside of a local telephone exchange. Likewise, we still consider that it would have been obvious to one of ordinary skill in the art at the

time the invention was made to have modified McLeod's long distance telephone switching system to include an automated collect call service as disclosed in Murphy in order to reduce the time required by human operators. Thus, we continue to find the appellants argument that there is no motivation, suggestion or basis for combining McLeod and Murphy to arrive at the claimed subject matter unpersuasive.

The arguments raised by the appellants are unpersuasive for the reasons which follow.

First, McLeod does not teach away from the claimed subject matter. As to the specific question of "teaching away," our reviewing court in In re Gurley, 27 F.3d 551, 553, 31 USPQ2d 1130, 1131 (Fed. Cir. 1994) stated "a reference will teach away if it suggests that the line of development flowing from the reference's disclosure is unlikely to be productive of the result sought by the applicant." In this case, McLeod does not teach or suggest that automated collect calls (i.e., collect calls without the use of a human operator) would not work. Instead, it is our view that McLeod suggests that an 800 number be provided by a long-distance company in order to provide automated enhanced services that were previously available only through private exchange network systems or local telephone exchanges.

Second, it is our opinion that there is sufficient suggestion, teaching or motivation in the applied prior art to arrive at the subject matter of claim 16 as set forth above without the use of hindsight knowledge derived from the appellants' own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). Motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved. See In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). In addition, the teaching, motivation or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. See WMS Gaming, Inc. v. International Game Tech., 184 F.3d 1339, 1355, 51 USPQ2d 1385, 1397 (Fed. Cir. 1999). In that regard, it must be borne in mind that where two known alternatives are interchangeable for their desired function, an express suggestion of the desirability of the substitution of one for the other is not needed to render such substitution obvious. See In re Fout, 675 F.2d 297, 301, 213 USPQ 532, 536 (CCPA 1982); In re Siebentritt, 372 F.2d 566, 568, 152 USPQ 618, 619 (CCPA 1967).

Lastly, in making our determination of the obviousness of the subject matter of claim 16 from the combined teachings of Murphy and McLeod, this panel of the Board did not

overlook the advantages that may be obtained by the claimed invention. Instead, we believe those advantages, as they relate to the claimed subject matter, are present in the combined teachings of Murphy and McLeod. In addition, we note that attorney argument in a brief cannot take the place of evidence. In re Pearson, 494 F.2d 1399, 1405, 181 USPQ 641, 646 (CCPA 1974).

In light of the foregoing, the appellants' request for rehearing is granted to the extent of reconsidering our decision, but is denied with respect to making any change thereto.

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

REQUEST FOR REHEARING - DENIED

JOHN P. McQUADE
Administrative Patent Judge

JEFFREY V. NASE
Administrative Patent Judge

STUART S. LEVY
Administrative Patent Judge

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