

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

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Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JAY S. WALKER,  
THOMAS M. SPARICO,  
and JAMES A. JORASCH

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Appeal No. 2000-1362  
Application 08/914,165<sup>1</sup>

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ON BRIEF

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Before THOMAS, KRASS, and BARRETT, Administrative Patent Judges.  
BARRETT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the final rejection of claims 82, 86, and 87.

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<sup>1</sup> Application for patent filed August 19, 1997, entitled "Method and Apparatus for the Secure Storage of Audio Signals."

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We reverse.

BACKGROUND

The invention relates to a process for recording an audio communication in a secure manner.

Claim 82 is reproduced below.

82. A process for recording audio communications, comprising:

establishing an audio connection with a calling party;

receiving an audio communication over the audio connection from the calling party;

encrypting the audio communication to provide an encrypted audio communication;

storing the encrypted audio communication; and

providing to the calling party a code for decrypting the encrypted audio communication.

The examiner relies on the following references:

Olson et al. (Olson)	5,136,648	August 4, 1992
Bieselin et al. (Bieselin)	5,559,875	September 24, 1996

Bieselin discloses method and apparatus for recording and retrieval of audio conferences.

Olson relates to a message storage security system for a voice message (VM) system. A VM system maintains a system directory (customer data base) of all user "mailboxes." Every subscriber (user) has his own directory which contains

information about messages in their "mailbox" (col. 3, lines 45-47). It is important that a user get his and only his messages. The integrity of stored message security is vulnerable if the VM system should fail in the process of updating pointers on the disk which identify a particular user's message, in which case another user B's directory may point to a message that in reality belongs to user A (col. 1, lines 22-34, 60-65). Olson discloses encryption for a particular message for a designated user where the encoding key is stored in the designated user's message directory (col. 1, lines 47-57; figure 3A; col. 4, lines 15-35). When the user enters a mailbox number and password number, the VM system attaches the key to the channel and the encrypted message is retrieved from disk and played through the channel using the key (figure 3B; col. 4, lines 36-45). If any disk errors occur or the system retrieves an incorrect message, the encrypted message will not be decrypted by the other mailbox and there will no be any playing of unauthorized voice messages to a non-designated user (col. 4, lines 46-51).

Claims 82, 86, and 87 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bieselin and Olson.

We refer to the first Office action (Paper No. 4), the final rejection (Paper No. 8) (pages referred to as "FR\_\_") and the examiner's answer (Paper No. 16) for a statement of the examiner's rejection, and to the brief (Paper No. 15) (pages

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referred to as "Br\_\_") and reply brief (Paper No. 17) (pages referred to as "RBr\_\_") for a statement of appellants' arguments thereagainst.

#### OPINION

##### Grouping of claims

The examiner states that appellants' arguments why the claims are separately patentable do not comply with the Manual of Patenting Examining Procedure § 1206(7) because appellants merely state differences in what the claims cover (EA2-3).

Appellants argue that the brief identifies specific limitations in the rejected claim which are not present in any other group of claims, provides an argument that such limitations are not described in the prior art relied on in the rejection, and provides an explanation of how such limitations render the claimed subject matter unobvious over the prior art (RBr2). Accordingly, it is argued, these reasons fully explain why the different groups are separately patentable (RBr2).

We agree with appellants that the brief fully complies with the requirements of 37 CFR § 1.192(c)(8) to argue the separate patentability of the claims. The examiner's statement is clearly erroneous. Nevertheless, although the examiner states that the claims are not separately argued, which would normally justify considering only the broadest claim, the rejection addresses all of the claims. Therefore, the case need not be remanded.

Claim 82

The examiner finds that Bieselin does not disclose the steps of "encrypting" and "storing the encrypted audio communication" (EA3; EA5 ¶ 1). Although not mentioned by the examiner, Bieselin also does not perform the step in claim 82 of "providing to the calling party a code for decrypting the encrypted audio communication." The examiner finds that Olson discloses a device that encrypts audio messages and stores them in encrypted form and that Olson discloses sending a cryptographic key to a user directory associated with the message (Paper No. 4, pp. 6-7; EA4). The examiner concludes that it would have been obvious "to combine the encryption properties of Olson with the recording properties of Bieselin in order to create an apparatus for securely storing audio signals, because the types of persons for whom the systems are designed would benefit from this feature in that they would not want their messages to be available to all users of a system" (Paper No. 4, p. 7; EA4).

Appellants argue that Olson provides a code allowing access to the encrypted voice by the called party, but not the calling party (Br6-7). Thus, it is argued that Olson does not disclose or make obvious the step of "providing to the calling party a code for decrypting the encrypted audio communication."

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The examiner admits that Olson does not teach providing a code to a calling party, but reasons that Bieselin discloses a calling party and (EA6 ¶ 3):

In the invention of Bieselin, all parties that participate in the recorded communication may later access it. When the Olson reference is combined with the Bieselin reference, the result is an encrypted communication among a plurality of parties. In order for the invention of Bieselin to function as intended, a decrypt code would have to be given to all participants.

That is, the examiner considers the calling party limitation to be "inherent in the combination of references" (EA7 ¶ 5; see also EA8 ¶ 8). Stated differently (EA8 ¶ 6):

In Bieselin, the calling party may access the recorded communication. If encryption is included in Bieselin, but provision of a decryption code to the calling party is not, then that invention cannot function as originally intended by Bieselin, because in Bieselin the calling party is supposed to be able to later access the recorded audio data. It is clearly within the realm of knowledge of the person of ordinary skill in cryptography and telecommunications that provision of a decryption code to the calling party will solve this problem.

The motivation is further explained as follows (EA9 ¶ 9):

The person of ordinary skill in teleconferencing and cryptography would recognize the need for security in any communication system over which critical data will be transported, including communication systems used by the groups of persons for with [sic] Bieselin is specifically intended. Therefore, motivation to include cryptography in Bieselin exists in the body of knowledge of the person of ordinary skill.

Appellants argue (Br8) that the fact that Bieselin discloses a system having a calling party does not make obvious the limitation in claim 82 of "providing to the calling party a code

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for decrypting the encrypted audio communication." It is argued that neither Bieselin nor Olson address reducing the vulnerability of digitally recorded audio information to tampering while allowing a calling party access to the information (Br8).

The examiner states that sufficient motivation has been provided to modify Bieselin to include this feature (EA8 ¶ 7).

The examiner's rejection, as we understand it, is based on the following logic: (1) one of ordinary skill in the art would have recognized the need for "security" in Bieselin; (2) Olson shows encrypting a stored audio message as a type of security; (3) the combination of Olson and Bieselin would suggest encrypting the recorded audio communications of Bieselin to provide security; and (4) if the audio communications were encrypted in Bieselin, it would be necessary to supply the code to calling parties in order for them to be able access the communications.

The examiner's reasoning is not persuasive. Assuming one skilled in the art would have recognized the need for "security," the only "security" teachings in the combination are found in Olson. Olson is directed to a voice mailbox system (VMS) where a called party's messages are encrypted for the purpose of preventing the playing of unauthorized voice messages to a non-designated user in case of a system malfunction. A calling

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party has no ability to retrieve the encrypted message once it is stored in the called persons mailbox. Olson's encryption is transparent to the VMS called party because the code is automatically stored in the called party's mailbox directory after a message is encrypted (figure 3A) and is automatically retrieved when a message is to be played (figure 3B); i.e., the code is not actually provided to the called party to be used in decrypting the encrypted message, but is a background part of the VMS. Olson's "security" does not suggest encoding a calling person's audio information or stored audio communications in general. Bieselin is not a VMS and does not suggest the cross connection problem faced by Olson. Thus, the teachings of Olson are not directly applicable to overcoming a problem in Bieselin. If Olson was combined with Bieselin to provide security, what would be most straightforwardly suggested to one in the art would be somehow (it is not clear how) adding a VMS with encoding. We disagree with the examiner's conclusion that "[w]hen the Olson reference is combined with the Bieselin reference, the result is an encrypted communication among a plurality of parties" (EA6 ¶ 3). There is no teaching or suggestion in Olson of encrypting the audio communications of parties to a call, nor are we aware of any common knowledge in the art to make this modification; this teaching is found only in appellants' disclosure. Thus, the examiner's rejection is based on a faulty conclusion.

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The examiner relies on the knowledge of one of ordinary skill in the art to supply missing limitations and as motivation to modify the combination of Bieselin and Olson. However, it appears here that the asserted knowledge of those in the art, which is supposed to fill in the gaps in the rejection, is nothing more than a guise for hindsight based on appellants' disclosure. Neither Bieselin nor Olson address reducing the vulnerability of digitally recorded audio information to tampering while allowing a calling party access to the information. Yet the examiner somehow finds this result inherent in the final result based on knowledge of those in the art. As we noted, the examiner erred in concluding that the combination of Olson and Bieselin suggests encrypting an audio communication of a calling party, as opposed to encrypting a voice mailbox as taught by Olson. Thus, the examiner also errs in concluding that the only difference is whether it would have been obvious to provide the parties with the code to access the encrypted information. The examiner glosses over the actual differences by overgeneralizing the teachings of Olson and relying on vague references to knowledge in the art. It is impossible to tell exactly what specific facts about the knowledge the art the examiner is finding so that we can perform a meaningful review. We are not aware of any general knowledge in the art that supports the examiner's conclusion of obviousness. In any case,

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the case law requires that all material facts be documented on the record rather than by conclusions about "basic knowledge." See In re Lee, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002). Lastly, the examiner's reasoning that providing encryption would have "inherently" suggested the need to provide a code to the calling party appears to be the very model of hindsight because it starts with a modification and then works backward to arrive at the claimed subject matter.

For the reasons stated above, we conclude that the examiner has failed to establish a prima facie case of obviousness with respect to claim 82. The rejection of claim 82 is reversed.

Claims 86 and 87

Claim 86 is directed to encrypting audio communications between at least two parties and recite, in part, "generating at least two access codes, any of which can be used to obtain access to the encrypted audio recording; transmitting the key to the at least two parties; and transmitting the at least two access codes respectively to the at least two parties such that each party receives a unique access code." Claim 87 has similar limitations which omit the word "and." Claim 86 additionally recites "embedding a time stamp in the encrypted audio recording."

Appellants argue that, as with claim 82, the references cited by the examiner do not disclose or suggest transmitting a

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decrypt key as recited by claims 86 and 87 (Br11 & Br12). The examiner applies the same basic reasoning as with claim 82 (EA10): "[T]he person of ordinary skill in the art would [have] be[en] motivated to provide a decrypt key to all parties authorized to access the communication, in order to allow the invention of Bieselín to function as originally intended."

The examiner's rationale is not persuasive for the reasons discussed in connection with claim 82. The examiner has failed to establish a prima facie case of obviousness with respect to the limitation of transmitting the decrypt key to the two parties to the audio communication, as recited in claims 86 and 87. The rejection of claims 86 and 87 is reversed.

Although we have reversed the rejection of claim 86, we further note that the examiner has provided no factual evidence to support the obviousness of "embedding a time stamp in the encrypted audio recording." The examiner takes Official Notice that authentication was well known in the art of encryption and that time stamps were well known forms of authentication (EA4). This is simply not the kind of fact that is susceptible to taking of Official Notice. However, even if true, the examiner has not addressed the specific limitation of embedding the time stamp in the encrypted audio recording. If the examiner's position is that embedding a time stamp in an encrypted audio recording was well known in the art, then it should be no problem for the

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examiner to produce a reference. Because the examiner has also failed to establish the obviousness of embedding a time stamp in the encrypted audio recording, the rejection of claim 86 is reversed for this additional reason.

In addition, both claims 86 and 87 also recite generating access codes and transmitting them to the two parties. Although appellants argue the limitations only with respect to claim 87, the arguments apply also to claim 86. The examiner finds that Bieselin features an access code controller that generates access codes and transmits them to the parties "as implicitly disclosed in figure 6A and column 7 par. 6 of the specification . . . [which] disclose the use of a password, or access code, to access the system" (EA4).

There is clearly a difference between the system "generating" and transmitting access codes to the parties, as claimed, and receiving access codes (passwords or user IDs) as taught by Bieselin. The examiner's rejection fails to address the particular language of the claims. For this additional reason, the rejection of claims 86 and 87 is reversed.

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CONCLUSION

The rejection of claims 82, 86, and 87 is reversed.

REVERSED

JAMES D. THOMAS	)	
Administrative Patent Judge	)	
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	)	BOARD OF PATENT
ERROL A. KRASS	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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