

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CATHERINE R. MARSHALL

Appeal No. 96-0712
Application No. 08/015,756¹

ON BRIEF

Before HAIRSTON, KRASS, and TORCZON, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1 through 13, all of the claims pending in the application.

¹ Application for patent filed February 10, 1993.

The invention is directed to a facsimile reception system wherein a LAN server permits a group of users to share a single modem residing at that server.

Representative independent claim 1 is reproduced as follows:

1. A method for transmitting a facsimile document from a facsimile store-and-forward service computer to a networked computer system and storing the received facsimile documents in a file that is associated with an intended recipient of the facsimile document, wherein the facsimile store-and-forward service computer is of the type that receives and stores facsimile documents for multiple users and the networked computer system is of the type that includes one or more linked computers, one of which is designated as a central server computer, the method comprising the steps of:

i) transmitting a first code from a first facsimile-compatible modem coupled to the central server computer to a second facsimile-compatible modem coupled to the facsimile store-and-forward service computer, wherein the first code indicates to the facsimile store-and-forward service computer a particular user of the networked computer system who is the intended recipient of the facsimile document;

ii) transmitting a second code from the first facsimile-compatible modem to the second facsimile-compatible modem that causes the facsimile store-and-forward service computer to transmit any facsimile documents that have been received for the particular user from the facsimile store-and-forward service computer to the central server computer;

iii) receiving the facsimile documents at the central server computer that have been transmitted from the facsimile store-and-forward service computer; and

iv) opening at the networked computer system a file that is associated with the particular user of the networked computer system, the file being a secured file, and storing the received facsimile documents in the file associated with the particular user.

The examiner relies on the following references:

Herbst 1990	4,941,170	Jul. 10,
Chen 18, 1992	5,090,049	Feb.
Gordon et al. [Gordon] 1994	5,291,302	Mar. 1,

(filed Oct. 2, 1992)

Claims 1 through 13 stand rejected under 35 U.S.C. 103. As evidence of obviousness, the examiner cites Gordon with regard to claims 1 through 10. The examiner cites Herbst in view of Chen with regard to claims 12 and 13.

Rather than reiterate the arguments of appellant and the examiner, reference is made to the brief and answer² for the respective positions of appellant and the examiner.

OPINION

We affirm.

At the outset, we note that although claim 11 is not included in the statement of the rejection, we assume that the examiner meant to include the claim in the rejection of claims 1 through 10 under 35 U.S.C. 103 over Gordon since the examiner

² When we refer to the "answer," we refer to the answer of June 8, 1999 (Paper No. 15), issued in response to our remand of September 16, 1997 (Paper No. 14).

sets forth reasons for the rejection of claim 11 at the bottom of page 10 of the answer. Apparently, appellant acquiesces in this assumption since appellant had the opportunity to file a reply brief responsive to the answer but chose not to do so.

Turning first to the rejection of claim 1 under 35 U.S.C. 103 over Gordon, the examiner has very clearly and reasonably set forth the grounds of rejection and the rationale therefor at pages 4 through 7. The examiner sets forth the application of Gordon to instant claim 1, identifying corresponding elements and indicating where there are differences. The examiner then sets forth reasons as to why the claimed subject matter as a whole would have been obvious, within the meaning of 35 U.S.C. 103, despite those differences. Accordingly, in our view, the examiner has established a prima facie case of obviousness along the guidelines set forth in Graham v. John Deere Co., 383 U.S. 1 (1966).

In attempting to overcome this prima facie case, appellant has made a variety of arguments. First, at page 3 of the brief, appellant questions the examiner's refusal to enter an amendment which would have made it explicit in the claims that the stored fax messages are delivered directly to the

individual computers on the networked computer system and not through additional modems. The argument is irrelevant to the instant claimed subject matter before us. An examiner's refusal of entry of an amendment is a matter petitionable to the Commissioner of Patents and Trademarks. The examiner's decision to refuse such entry is not appealable under 37 CFR 1.191. Thus, we deal with the actual claims, of record, before us and such claims do not include the proposed amendment.

Appellant argues that Gordon requires a modem for each terminal and, in addition to extra telephone lines, Gordon's system requires "a more complicated method for secure delivery of facsimile messages." It is not seen how such an argument relates to the instant invention, *as claimed*. We find nothing in instant claim 1, for example, that precludes a modem for each terminal and a "complicated method for secure delivery."

At the top of page 4 of the brief, appellant contends that the examiner has not cited any reference "which teaches or suggests this direct and secure delivery of a fax message through a LAN." We find nothing in instant claim 1 which requires a LAN. The claim only recites a "networked computer

system" and Gordon clearly is dealing with a networked computer system.

Next, appellant takes issue with the examiner's references to the claimed steps by saying that "...some of them are well known in the art" and "some of" the steps are taught. More specifically, appellant states, at the bottom of page 4 of the brief, that "the Examiner's unsupported statement that '...some of [the claimed steps] are well known in the art.' is inadequate to reject Applicants' specific claims."

While, of course, it is true that an analysis of the claims is not to be done piecemeal and that all claims are made up of a series of elements or steps which may, per se, be well known, it is our view that the examiner's rejection of claim 1 and the rationale therefor, at pages 4-7 of the answer is a well-reasoned analysis with no piecemeal reconstruction of the claim. Therefore, notwithstanding the examiner's comments about "...some of [the claimed steps]," the examiner has set forth a reasonable basis for rejecting the claims. We also note that while appellant has criticized the examiner's "unsupported statement," it does not appear that appellant has

ever alleged that the examiner's assertions in this regard are wrong.

Accordingly, since the examiner has, in our view, established a prima facie case of obviousness with regard to the subject matter of independent claim 1, and claims 2 through 11 fall therewith, in accordance with appellant's grouping of the claims at page 3 of the brief, we will sustain the rejection of claims 1 through 11 under 35 U.S.C. 103.

We now turn to the rejection of claims 12 and 13 under 35 U.S.C. 103 over Herbst and Chen. Again, we have reviewed the examiner's rationale and application of the references to the claims, at pages 11-13 of the answer³, and we find that the examiner's explanation is reasonable and presents a prima facie case of obviousness with regard to the subject matter of claims 12 and 13. We will sustain the rejection of claims 12 and 13 under 35 U.S.C. 103.

³We note that the examiner has apparently inadvertently stated that Chen is combined with "Gordon," rather than Herbst, at page 13 of the answer.

Appellant argues that Herbst uses an electronic mail system and requires a recipient to access a conventional fax machine, not achieving the level of privacy and confidentiality reached by the instant invention.

We find nothing in the instant claims which would preclude the electronic mail system taught by Herbst nor do we find anything explicit in the claims regarding any particular level of privacy or confidentiality. Similarly, we find nothing in the claims which would preclude the use of the special cover sheet taught by Herbst and argued by appellant at page 6 of the brief.

Appellant further argues that Herbst uses an "electronic mail system rather than the claimed telephone system for the actual transmission of the fax" [brief-top of page 6]. This argument is not persuasive since the documents are transmitted, in Herbst, over telephone lines, by using the electronic mail system. Appellant's argument would appear to indicate that electronic mail systems and telephone systems are, somehow, mutually exclusive, when, in fact, electronic mail systems rely on telephone systems to transmit the mail over the telephone

lines via a modem. Clearly, Herbst uses a telephone system for transmission of a fax.

The examiner employs Chen for the teaching of communications details between a facsimile store-and-forward computer and a central server computer. As explained by the examiner, at page 13 of the answer, the teachings of Herbst and Chen are combined so that the details of the communication, as taught by Chen, are applied to the communication between central server 14 (fax controller) and the facsimile store-and-forward service computer (4') of Herbst. Thus, it is not persuasive for appellant to contend [brief-page 6] that Chen does not disclose a system for transmitting fax documents to a file associated with a particular user in a networked computer system such that the fax message can be retrieved from a computer in the networked computer system because the examiner relies on Herbst for this teaching.

Appellant takes issue with the examiner's characterization of Herbst's fax controller 14 as a "networked computer system" as recited in claims 12 and 13. As the examiner explains, at page 19 of the answer, facsimile controller 14 of Herbst has a modem, a microprocessor, a RAM and an I/O device connecting bus

20 to a computer terminal port and there is a source listing for the computer program used with the microprocessor. The examiner concludes, therefrom, that "the fax controller can be a fax computer or according to claims 12 and 13, a central server computer disposed on the networked computer system." We find no fault with the examiner's reasoning and we have no reply brief from appellant refuting the examiner's reasoning. Appellant's response, in toto, to the examiner's allegations is merely to state that "this is not true" [brief-page 6] and to point to page 2, lines 3-9 of the instant specification. We have referred to that portion of the specification which refers to a typical LAN system. The claims are not specifically directed to a LAN system and, to the extent that they are, we do not understand how a reference in the specification to a LAN system refutes the examiner's allegation that the fax controller of Herbst serves the function of the claimed "networked computer system."

Appellant further takes issue with the examiner's identification of computer 70 of Herbst as the claimed "first facsimile-compatible modem coupled to the facsimile

store-and-forward computer." As explained by the examiner, at page 20 of the answer, "the computer 70 connected to the fax controller receives the fax message, store [sic, stores] them in the disk storage 76 and transmits it to other local computer 70. Therefore, the computer 70 connected to the fax controller can represent the facsimile store-and-forward computer as claimed in claims 12 and 13." While we may find fault with the grammar, we find no fault with the examiner's reasoning. In response, appellant merely "disagrees" [brief-bottom of page 6] and refers to column 9, lines 4-14 of Herbst, alleging that the description therein does not disclose a first facsimile compatible modem. If appellant is suggesting that no "modem" is explicitly described therein, we agree with the examiner that a modem is inherently taught by Herbst since telephone communication between computers is employed.

While appellant discusses a reference to "Normura" [sic, Normura] at page 7 of the brief, we note that this reference no longer forms part of the examiner's rejection. Insofar as the argument at page 7 of the brief concerns Herbst, appellant contends that the reference does not teach a "LAN server to allow a group of user's [sic] to share a single fax modem

residing at that server." It is not clear what claim language appellant relies on for this argument since the claims do not require a "LAN server."

We have considered each and every one of appellant's arguments but do not find them to overcome the examiner's prima facie case of obviousness. Accordingly, we will sustain the examiner's rejection of claims 1 through 13 under 35 U.S.C. 103.

The examiner's decision is affirmed.

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

AFFIRMED

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