

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte AJIT PENDSE
and GREGORY H. KISOR

Appeal No. 1999-2304
Application 08/667,242

ON BRIEF

Before JERRY SMITH, GROSS and BARRY, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-26, which constitute all the claims in the application.

The disclosed invention pertains to the field of multi-point electronic conference scheduling. More particularly, the invention facilitates selective access by

the user to one or more private address books as well as to one or more remote independent public directory services having names and electronic conferencing connection addresses to a plurality of persons who the user might wish to participate in the conference.

Representative claim 1 is reproduced as follows:

1. An apparatus comprising:

an execution unit for executing programming instructions;

a storage medium coupled to the execution unit having stored therein a plurality of programming instructions to be executed by the execution unit, wherein while being executed, the programming instructions facilitates scheduling of a multi-point electronic conference with a multi-point electronic conferencing control service for a user, including facilitating selective access by the user to one or more private address books and one or more remote independent public directory services having names and electronic conferencing connection addresses of a plurality of persons for selection by the user of one or more of said persons to be scheduled participants of the multi-point electronic conference being scheduled.

The examiner relies on the following references:

Weiner	4,862,390	Aug. 29, 1989
Saiki	5,642,156	June 24, 1997
	(effectively filed Mar. 01,	
1994)		
Ludwig et al. (Ludwig)	5,689,641	Nov. 18, 1997
		(filed Oct. 01,
1993)		

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Claims 1-26 stand rejected under 35 U.S.C. § 112, first paragraph, for failing to provide a written description of the claimed invention and for failing to provide an enabling disclosure of the claimed invention. Claims 1-10, 12-23, 25 and 26 also stand rejected under 35 U.S.C. § 103. As evidence of obviousness the examiner offers Saiki in view of Ludwig with respect to claims 1-5, 7-10, 12-18, 20-23, 25 and 26, and the examiner adds Weiner with respect to claims 6 and 19.

Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the prior art rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

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It is our view, after consideration of the record before us, that the disclosure complies with the written description and enablement requirements of 35 U.S.C. § 112. We are also of the view that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 1-10, 12-23, 25 and 26. Accordingly, we reverse.

We consider first the rejection of claims 1-26 under the first paragraph of 35 U.S.C. § 112. These claims stand or fall together as a single group [brief, page 6]. The examiner has argued that the disclosure fails to satisfy both the written description and the enablement requirements of 35 U.S.C. § 112. These are separate requirements of Section 112, and we will consider these requirements separately.

The purpose of the written description requirement is to ensure that the applicants convey with reasonable clarity to those skilled in the art that they were in possession of the invention as of the filing date of the application. For the purposes of the written description requirement, the invention is "whatever is now claimed." Vas-cath, Inc. v.

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Mahurkar, 935 F.2d 1555, 1564, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991).

The rejection asserts that the specification does not provide written description support for the recitation "remote independent public directory services having names and electronic conference connection addresses of a plurality of persons" in each of the independent claims. The examiner particularly questions the "public" of public directory services [answer, pages 4-5]. Appellants argue that the recitation in question clearly appears in the specification at several locations except for the term "remote" [brief, page 9]. Appellants note, however, that Figure 1 of the application clearly shows that the directory services 108 are separate or remote from the execution unit 104. The examiner responds that there are two meanings for the term "public" and the specification does not support the meaning argued by appellants [answer, pages 9-10]. Appellants respond that the disclosed use of the Deutches Telecom T-Online directory service is clearly a remote independent public directory service as claimed [reply brief].

We agree with the position argued by appellants for

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essentially the reasons set forth in the briefs. The question of the scope of the contested phrase in the independent claims is not a proper basis for rejecting these claims on the written description requirement of 35 U.S.C. § 112. The scope of the claims should be addressed when considering patentability over the prior art. The originally filed specification clearly provides almost literal support for the invention now being claimed by appellants. Therefore, we do not sustain this rejection of the appealed claims.

To comply with the enablement clause of the first paragraph of 35 U.S.C. § 112, the disclosure must provide an adequate description such that the artisan could practice the claimed invention without undue experimentation. In re Scarbrough, 500 F.2d 560, 566, 182 USPQ 298, 303 (CCPA 1974); In re Brandstadter, 484 F.2d 1395, 1407, 179 USPQ 286, 295 (CCPA 1973).

The rejection asserts that it would require undue experimentation to make remote independent public directory services having names and connection addresses of people [answer, pages 5-6]. Appellants argue that the invention does not require that anyone make a remote independent public

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directory service, but rather, the invention only requires that such a service be accessed [brief, page 10].

We again agree with the position argued by appellants. The claimed invention only requires that access to remote independent public directory services be facilitated, not that such services be created. The examiner has not provided any reasonable basis for asserting that this access would require undue experimentation to implement. Therefore, we do not sustain this rejection of the appealed claims.

We now consider the rejections of the claims under 35 U.S.C. § 103. In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to

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support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts

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to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered [see 37 CFR § 1.192(a)].

The rejection of all claims on this basis fundamentally relies on a combination of Saiki and Ludwig. The examiner asserts that Saiki teaches the claimed invention except for a remote independent public directory service. The examiner cites Ludwig as teaching this feature, and the examiner finds that it would have been obvious to the artisan to add this feature to Saiki [answer, page 7]. Appellants argue that the remote directory services disclosed by Ludwig are private address books because they are confined to persons

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who are part of the organization and, therefore, are not public as that term is used in the application [brief, pages 11-14].

Once again, we agree with the position argued by appellants. The examiner is correct that the phrase "one or more remote independent public directory services" should be given its broadest reasonable interpretation consistent with the specification. The main point of appellants' specification, however, is that the public directory service is available to permit the scheduling of a participant in a multi-point electronic conference who is not in the user's private address books. Appellants' disclosed use of the term public directory services is consistent with the usual meaning of public which is that knowledge is accessible to all. The address books of Ludwig are not "public" since they are only available to users of the network.

Therefore, we do not sustain the rejection of the claims based on Saiki and Ludwig. Since Weiner does not overcome the deficiencies of Saiki and Ludwig, we also do not sustain the rejection of the claims based on all three references.

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In summary, we have not sustained any of the examiner's rejections of the claims on appeal. Therefore, the decision of the examiner rejecting claims 1-26 is reversed.

REVERSED

JERRY SMITH)
Administrative Patent Judge)
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) BOARD OF PATENT
ANITA PELLMAN GROSS)
Administrative Patent Judge) APPEALS AND
)
) INTERFERENCES
)
LANCE LEONARD BARRY)
Administrative Patent Judge)

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