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BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte SAMUEL H. IV CHRISTIE

Appeal 2010-008692
Application 10/628,180
Technology Center 2600

Before: KALYAN K. DESHPANDE, TREVOR M. JEFFERSON, and MICHAEL J. STRAUSS, *Administrative Patent Judges*.

STRAUSS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

Appellant appeals under 35 U.S.C. § 134 from a final rejection of claims 1-19 and 21-33. Claim 20 has been canceled. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

INVENTION

The claims are directed to audio call screening for hosted voicemail systems. Spec., ¶ [0001]. Claim 1, reproduced below, is illustrative of the claimed subject matter:

> 1. A method for allowing call screening in a hosted voicemail system environment comprising:
>
> directing a call to a hosted voicemail system, which serves as a voicemail system for a telephone terminal, wherein the call is initially directed to the hosted voicemail system before being directed to the telephone terminal; and
>
> allowing the telephone terminal to monitor a message being left in the hosted voicemail system.

REFERENCES

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Kasiviswanathan	US 6,215,857 B1	Apr. 10, 2001
Simpson	US 7,245,713 B1	Jul. 17, 2007
Lection	US 2004/0096046 A1	May 20, 2004

REJECTIONS

The Examiner made the following rejections:

Claims 1-16 and 33 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Simpson and Kasiviswanathan. Ans. 3.

Claims 17-19 and 21-32 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Simpson, Kasiviswanathan, and Lection. Ans. 7.

APPELLANT'S CONTENTIONS

1. Neither Simpson nor Kasiviswanathan teaches that a call is initially directed to the voicemail system before being directed to the telephone terminal. App. Br. 8.

2. The combination of Simpson and Kasiviswanathan is improper. App. Br. 9-11.

ISSUES ON APPEAL

Based on Appellant's arguments in the Appeal Brief (App. Br. 7-12) the issues presented on appeal are whether the Examiner erred in combining the disclosures of Simpson and Kasiviswanathan and whether the asserted combinations of references teaches or suggests the invention as recited in the disputed claims.

ANALYSIS

We have reviewed the Examiner's rejections in light of Appellant's arguments that the Examiner has erred.

We disagree with Appellant's conclusions as to all rejections. We adopt as our own (1) the findings and reasons set forth by the Examiner in the action from which this appeal is taken and (2) the reasons set forth by the Examiner in the Examiner's Answer in response to Appellant's Appeal Brief. We concur with the conclusions reached by the Examiner. We highlight the following arguments for emphasis.

Rejection of Claims 1-16 and 33 under 35 U.S.C. § 103(a) over Simpson and Kasiviswanathan

In connection with contention 1, Appellant argues that neither Simpson nor Kasiviswanathan teaches that a call is initially directed to the voicemail system before being directed to the telephone terminal. App. Br. 8. Appellant asserts that "Kasiviswanathan does not teach or suggest initially directing a call to the hosted voicemail system and **then to the telephone terminal.**" App. Br. 8 (emphasis in original). The Examiner responds that Kasiviswanathan teaches initially directing a call to a hosted voicemail system. Ans. 9 (citing to Kasiviswanathan col. 2, ll. 64-67; col. 4, ll. 55-58). The Examiner relies on Simpson, not Kasiviswanathan, for disclosing directing a call to a subscriber's telephone terminal after the call is routed to the voice mail system. Ans. 3. That is, the Examiner applies Kasiviswanathan only for disclosing the call is *initially* directed to the hosted voicemail system. *Id*. Therefore, Appellant is improperly responding to the rejection by attacking the references separately, even though the rejection is based on the combined teachings of the references. Nonobviousness cannot be established by attacking the references individually when the rejection is predicated upon a combination of prior art disclosures. *See In re Merck & Co. Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). Therefore, Appellant's argument does not persuade us of error on the part of the Examiner.

Furthermore, Appellant's argument is not persuasive because it presumes the wholesale incorporation of the system of Kasiviswanathan into the system of Simpson such that the function of directing the call to the telephone terminal to allow a message to be monitored would be disabled. This presumption is not supported by the evidence. As articulated by the

Examiner, "the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in anyone or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art." Ans. 10 (citing to *In re Keller*, 642 F.2d 413 (CCPA 1981)). Furthermore, the artisan is not compelled to blindly follow the teaching of one prior art reference over the other without the exercise of independent judgment (*see Lear Siegler, Inc. v. Aeroquip Corp.*, 733 F.2d 881, 889 (Fed. Cir. 1984). While Appellant has posited an inoperable combination, we are not persuaded that one skilled in the art would blindly incorporate the teachings of Kasiviswanathan into the system of Simpson as proposed by Appellant while ignoring the remainder of Simpson's teaching to establish a three-way conference call. *See* Simpson col. 2, ll. 6-21. We therefore find Appellant's argument unpersuasive of Examiner error.

For the reasons discussed *supra*, we find that Appellant has failed to provide sufficient evidence or argument to persuade us that that the combination of Simpson and Kasiviswanathan fails to teach or suggest the disputed claim limitations.

In connection with contention 2 Appellant argues that the combination of Simpson and Kasiviswanathan is improper. App. Br. 9-11. According to Appellant "Kasiviswanathan teaches away from Simpson and the claimed invention because Kasiviswanathan teaches that all calls should be forwarded directly to the voicemail system without ringing the called party so that the called party is not disturbed (Kasiviswanathan, Abstract)." App. Br. 10. The Examiner responds that Simpson teaches two scenarios, the first without call monitoring and, therefore, according to Kasiviswanathan,

without ringing the called party. Ans. 10. The second scenario according to Simpson routes the call to a telephone network-based voice mail system wherein the called party is bridged with the calling party and the voice mail system to allow the called party to monitor. *Id*. The Examiner relies on Kasiviswanathan "only [for] one specific [teaching that] the call is initially directed to the hosted voicemail system." *Id* (emphasis in original). Therefore, we disagree that the "do not disturb," no ringing feature disclosed by Kasiviswanathan teaches away from incorporating the feature relied upon by the Examiner, i.e., that the call is initially directed to the hosted voicemail system before being directed to the telephone terminal. At that point, according to Simpson, a three-way conference call would be attempted to allow monitoring of the message being recorded. Again Appellant's argument is improperly based on bodily incorporation of the disclosure of Kasiviswanathan into the structure of Simpson when the test for obviousness is instead what the combination of references would have suggested to those of ordinary skill in the art.

Furthermore, Appellant has failed to provide other sufficient evidence or argument in support of the contention that Kasiviswanathan teaches away from Simpson. "'A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.'" *Ricoh Co., Ltd. v. Quanta Computer, Inc.*, 550 F.3d 1325, 1332 (Fed. Cir. 2008) (citations omitted). A reference does not teach away if it merely expresses a general preference for an alternative invention from amongst options available to the ordinarily skilled artisan, and the reference does not discredit or discourage investigation into the invention claimed. *In re Fulton*, 391 F.3d 1195, 1201

(Fed. Cir. 2004). Absent such evidence we find that the Examiner did not err.

For the reasons *supra* we are not persuaded that Kasiviswanathan teaches away from the asserted combination with Simpson.

Appellant further argues that Simpson teaches away from the claimed invention because "Simpson discloses that the call is initially directed to the terminal of the called party, and is only forwarded to the voicemail system if the terminal is busy or does not answer." App. Br. 10 citing Simpson, col. 1, lines 56-63; *see also* Fig. 2, steps 210,215, and 220. Appellant's argument does not persuade us of error on the part of the Examiner because Appellant is responding to the rejection by attacking the references separately, even though the rejection is based on the combined teachings of the references. In particular Kasiviswanathan is relied upon for initially directing the call to the hosted voicemail system as an alternative to initially directing the call to the terminal of the called party. Merely disclosing or even expressing a general preference for initially directing a call to the terminal of the called party instead of to the hosted voicemail system does not constitute a "teaching away." *See* discussion *supra*. Therefore, we find that Appellant has not provided sufficient evidence or argument to support a finding that the applied references teach away from the disputed combination.

Appellant next argues that "the combination of Simpson and Kasiviswanathan is also improper because if Simpson and Kasiviswanathan were combined, it would render both Simpson and Kasiviswanathan unsatisfactory for their intended purposes." App. Br. 10-11. According to Appellant, forwarding the call directly to voicemail would not allow the called party to monitor the message thereby defeating the purpose of Simpson. App. Br. 11. Conversely, directing the call to the telephone

terminal according to Simpson would defeat the purpose of Kasiviswanathan to avoid disturbing the called party. *Id.* Therefore, Appellant argues, the combination would render the references unsatisfactory for their intended purposes and is therefore improper. *Id.* We disagree. Simpson discloses a system and method that, upon routing a call to a voice mail system, a three-way conference call is established between the incoming calling party, the voice mail system and the subscriber, i.e., called party. Simpson col. 2, ll. 13-18. "In order to set up the three-way conference call, the second network element, places a call to the subscriber at the subscriber's telephone directory number so that the subscriber may answer and listen to the voice mail message being recorded by the incoming calling party." *Id.* Thus, even if the call is initially directed to the hosted voicemail system as suggested by Kasiviswanathan, the system according to Simpson would attempt to initiate a three-way conference call to include the telephone terminal of the called party thereby allowing the telephone terminal to monitor a message being left in the hosted voicemail system. *See id.* Therefore Appellant's argument fails to persuade us that the asserted combination would defeat the intended purpose of Simpson.

For the reasons discussed *supra*, we find that Appellant has failed to provide sufficient evidence or argument to persuade us that the combination of Simpson and Kasiviswanathan is improper or fails to teach or suggest the disputed claim limitations. Therefore, we sustain the rejection of independent claims 1 and 33 for the reasons presented *supra* and of claims 2-16 not separately argued.

Rejection of Claims 17-19 and 21-32 under 35 U.S.C. § 103(a) over Simpson, Kasiviswanathan, and Lection

The rejections of claims 17-19 and 21-32 are not argued separately[1]. Therefore, we sustain the rejections of claims 17-19 and 21-32 for the reasons presented *supra* in connection with claims 1-16 and 33.

CONCLUSIONS

On the record before us, we conclude that the Examiner did not err in rejecting claims 1-16 and 33 under 35 U.S.C. § 103(a) over Simpson and Kasiviswanathan and in rejecting claims 17-19 and 21-32 under 35 U.S.C. § 103(a) over Simpson, Kasiviswanathan, and Lection.

DECISION

The decision of the Examiner to reject claims 1-19 and 21-33 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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[1] Merely restating an argument towards a second claim, where the argument is already asserted in support of a first claim, is not considered an argument for separate patentability of the two claims.