

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS M. SIEP and RONALD E. STAFFORD

Appeal No. 2000-1690
Application No. 08/697,808¹

ON BRIEF

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

DECISION ON APPEAL

This is a decision on appeal from the Examiner's final rejection of claims 1-18, which are all of the claims pending in the present application.

We reverse.

BACKGROUND

Appellants' invention is directed to a network of processing devices that communicate between one another based on the presence of a master processing device. The processing devices

¹ Application for patent filed August 30, 1996.

Appeal No. 2000-1690
Application No. 08/697,808

communicate between one another if the master device is present and has allowed communication or if the master device is not a member of the group (specification, page 9).

Representative independent claim 1 is reproduced below:

1. A network comprising:

a master or teacher processing device including circuitry for transmitting data to and receiving data from a plurality of student or client processing devices and for generating signals indicating whether said plurality of client or student processing devices are allowed to communicate between each other; and

a plurality of client or student processing devices, each client processing device have circuitry to communicate with said master device and to select and communicate with any of the other client processing devices if said master processing device has generated a signal indicating that said client processing devices are allowed to communicate between one another or if said master processing device is not present or otherwise not in communication with said plurality of client processing devices.

The Examiner relies on the following references in rejecting the claims:

| | | |
|-------------------------|-----------|-----------------------|
| Lewis et al. (Lewis) | 5,303,042 | Apr. 12, 1994 |
| Buchholz et. (Buchholz) | 5,493,569 | Feb. 20, 1996 |
| Riddle | 5,572,582 | Nov. 5, 1996 |
| | | (filed Feb. 24, 1995) |

Jim M. Ng et al. (Ng), "Interactive Group Discussion System for Distance Education," IEEE Multimedia Engineering Education, 1994, pp. 270-275.

Appeal No. 2000-1690
Application No. 08/697,808

Claims 1, 2, 4, 6, 7, 9-11, 14-16 and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ng and Riddle.

Claims 3 and 8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ng, Riddle and Buchholz.

Claims 5, 12, 13 and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ng, Riddle and Lewis.

Rather than reiterate the viewpoints of the Examiner and Appellants regarding the above-noted rejections, we make reference to the answer (Paper No. 13, mailed October 6, 1999) for the Examiner's reasoning, the appeal brief (Paper No. 12, filed July 19, 1999) and the reply brief (Paper No. 15, filed January 10, 2000) for Appellants' arguments thereagainst.

OPINION

With respect to the rejection of claims 1, 2, 4, 6, 7, 9-11, 14-16 and 18, Appellants argue that Ng discloses an interactive group discussion system in which the participant who has the "floor control" can modify files while others share their views with the group (brief, page 7). Appellants further assert that while the tutor is the only one who can mostly "modify" the shared information, nothing in the system of Ng prevents a group discussion or students from communicating with one another when a

Appeal No. 2000-1690
Application No. 08/697,808

shared screen is used (brief, page 7 and reply brief, page 2). Although Appellants recognize the disclosure of a group teleconferencing system by Riddle, Appellants assert that the mere desire to include teleconferencing capabilities in Ng does not suggest combining the prior art teachings (brief, page 9 and reply brief, page 4).

In response to Appellants' arguments, the Examiner asserts that the interactive group discussion of Ng provides for communication between students if the tutor "decides to pass the floor to one of said students to allow communication between one another" (answer, page 8). The Examiner further recognizes that Ng fails to explicitly disclose the communication between client processing devices if the master processing device is absent or not in communication with the client devices and relies on Riddle for teaching a teleconferencing system which allows all users to share and manipulate data (id.).

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). The conclusion that the claimed subject matter is obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge

Appeal No. 2000-1690
Application No. 08/697,808

generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

Furthermore, the Examiner must produce factual basis supported by teaching in a prior art reference or shown to be common knowledge of unquestionable demonstration, consistent with the holding in Graham v. John Deere Co., 383 U.S. 1 (1966). Our reviewing court requires this evidence in order to establish a prima facie case. In re Piasecki, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984); In re Cofer, 354 F.2d 664, 668, 148 USPQ 268, 271-72 (CCPA 1966).

A review of Ng reveals that the reference relates to an interactive group discussion system by which students may share their views through either a shared screen or an audio channel. Ng further describes the floor control (page 272, left-hand column) as:

In the group discussion session, the tutor will be the one manipulating the file most of the time while the students can feed in their comments in another window; also it is often undesirable to allow the student to edit the file simultaneously. Hence, a floor control mechanism is used so that only the person who has the floor can modify the shared data. [Emphasis added.]

Appeal No. 2000-1690
Application No. 08/697,808

We further find that Ng addresses the situation in which the tutor is disconnected (page 274, right-hand column, first paragraph) by stating that:

During the absence of the tutor, the student in the meeting whose name is the highest on the PCL [*Present Conferee List*] list will temporary take the role as the coordinator. However, the students can also choose to close the session if they so desire.

Therefore, when the tutor is disconnected and not present, the meeting can go on if one of the students assumes the role of the coordinator, or the meeting may be terminated.

Riddle, on the other hand, discloses a teleconferencing system that provides for transferring of audio and video data so that users can communicate with one another (col. 1, lines 15-29). Additionally, Riddle refers to an application program that controls the conference (col. 6, lines 40-48). Thus, Riddle merely relates to a teleconferencing system which is controlled by an application program so that a group of users may communicate with one another.

As the Federal Circuit states, "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." In re Fritch,

Appeal No. 2000-1690
Application No. 08/697,808

972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992), citing In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). The court further reasons in Karsten Mfg. Corp. v. Cleveland Gulf Co., 242 F.3d 1376, 1385, 58 USPQ2d 1286, 1293 (Fed. Cir. 2001) that for an invention to be obvious in view of a combination of references, there must be some suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to select the references and combine them in the way that would produce the claimed invention.

Based on these well-settled principals, we do not find that one of ordinary skill in the art would have combined Riddle's teleconferencing system with the group discussion system of Ng and allow the client devices to communicate between one another in the absence of the master device. Riddle generally describes a teleconferencing system for a group of users while Ng is directed to a group discussion system that requires a coordinator at all times. Furthermore, we agree with Appellants that the desire to have communication between the client devices when the master device is absent is insufficient to teach or suggest to one of ordinary skill in the art to include Riddle's teleconferencing system in Ng. In that regard, Ng actually requires that another student user assume the role of the

Appeal No. 2000-1690
Application No. 08/697,808

coordinator when the tutor is absent while nothing in Riddle points to the combination of a teleconferencing system with a group discussion system.

In view of our analysis above, we find that the Examiner has failed to set forth a prima facie case of obviousness with respect to claim 1 because the necessary teachings and suggestions for combining Ng and Riddle are not shown. Independent claim 7 also recites a network including a master calculator and a plurality of client calculators while claim 14 recites a method of communicating between a master device and a group of client devices. Similar to claim 1, both claims 7 and 14 require communication between client devices if the master device has allowed such communication or is absent. As discussed above with respect to claim 1, the prior art neither teaches nor suggests that the client devices communicate between one another based on the absence of or permission by the master device. Accordingly, we cannot sustain the 35 U.S.C. § 103 rejection of independent claims 1, 7 and 14, as well as dependent claims 2, 4, 6, 9-11, 15, 16 and 18, over Ng and Riddle.

We note that the Examiner relies on Buchholz for the use of a wireless local area network (LAN) connecting a plurality of user devices (col. 3, lines 53-63) in combination with Ng and

Appeal No. 2000-1690
Application No. 08/697,808

Riddle to reject claims 3 and 8 under 35 U.S.C. § 103(a). Similarly, the Examiner relies on the disclosure of Lewis related to downloading files to a printer (col. 5, lines 1-3) in combination with Ng and Riddle to reject claims 5, 12, 13 and 17. We find nothing in Buchholz or Lewis that is directed to the client devices communicating between one another if the master device is absent or has allowed such communication. Assuming, arguendo, that it would have been obvious to combine the network of Buchholz or the printing capabilities of Lewis with the teachings of Ng and Riddle, as held by the Examiner, neither Buchholz nor Lewis overcomes the above noted deficiencies in the rejection of base claims 1, 7 and 14. Accordingly, we do not sustain the 35 U.S.C. § 103 rejection of claims 3 and 8 over Ng, Riddle and Buchholz and claims 5, 12, 13 and 17 over Ng, Riddle and Lewis.

Appeal No. 2000-1690
Application No. 08/697,808

CONCLUSION

In view of the foregoing, the decision of the Examiner rejecting claims 1-18 under 35 U.S.C. § 103 is reversed.

REVERSED

| | | |
|-----------------------------|---|-----------------|
| ERROL A. KRASS |) | |
| Administrative Patent Judge |) | |
| |) | |
| |) | |
| |) | |
| |) | BOARD OF PATENT |
| LEE E. BARRETT |) | APPEALS |
| Administrative Patent Judge |) | AND |
| |) | INTERFERENCES |
| |) | |
| |) | |
| |) | |
| MAHSHID D. SAADAT |) | |
| Administrative Patent Judge |) | |

MDS/ki

Appeal No. 2000-1690
Application No. 08/697,808

Texas Instruments Incorporated
P.O. Box 655474, M/S 3999
Dallas, TX 75265