

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANDREW F. BULFER

Appeal No. 1998-2705
Application No. 08/867,773

ON BRIEF

Before HAIRSTON, KRASS and FLEMING, Administrative Patent Judges

FLEMING, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1 through 9, all of the claims pending in the present application. Claims 10 through 18 have been canceled.

The invention relates to a method of providing a speech-based interface to Dual Tone Multi-frequency (DTMF) controlled

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telecommunication systems. In particular, Appellant discloses on page 3 of the specification that the invention provides a telecommunication network service for converting spoken words to individual DTMF signals to be furnished to an automatic system responsive to touch tone control thereof.

Independent claim 1 is reproduced as follows:

1. A method for providing a telecommunications network service performed within a telecommunications network for use with an automated system responsive to Dual-Tone Multi-Frequency (DTMF) signals (touch-tones), the method comprising the steps of:

prompting the caller to initiate a first call to the automated system initiating a second call in the network to a facility for performing speech recognition;

bridging the first and second calls;

receiving the spoken utterance comprising the spoken word;

performing speech recognition on the spoken utterance, thereby identifying the spoken word;

classifying the spoken utterance into one of a set of categories based on said identification of the spoken word, each of said categories having a DTMF signal associated therewith;

generating, within the telecommunications network, the DTMF signal associated with the category into which said spoken utterance has been classified; and

transmitting the generated DTMF signal through the telecommunications network to the automated system.

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The Examiner relies on the following references:

Hou et al. (Hou) 1994	5,353,336	Oct. 4,
McMahan et al. (McMahan) 28, 1995	5,402,477	Mar.

Claims 1 through 9 stand rejected under 35 U.S.C. § 103 as being unpatentable over McMahan in view of Hou.

Rather than reiterate the arguments of Appellant and the Examiner, reference is made to the brief and answer for the respective details thereof.

OPINION

We will not sustain the rejection of claims 1 through 9 under 35 U.S.C. § 103.

The Examiner has failed to set forth a *prima facie* case. It is the burden of the Examiner to establish why one having ordinary skill in the art would have been led to the claimed invention by the express teachings or suggestions found in the prior art, or by implications contained in such teachings or suggestions. *In re Sernaker*, 702 F.2d 989, 995, 217 USPQ 1, 6 (Fed. Cir. 1983). "Additionally, when determining obviousness, the claimed invention should be considered as a whole; there is no legally recognizable 'heart' of the

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invention." *Para-Ordnance Mfg. v. SGS Importers Int'l, Inc.*,
73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995),
cert. denied, 519 U.S. 822 (1996), *citing W.L. Gore & Assocs.,
Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1548, 220 USPQ 303, 309
(Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

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On pages 6 and 7 of the brief, Appellant argues that neither Hou nor McMahan teaches or suggests all the features of Appellant's claimed limitations. In particular, Appellant argues that Hou and McMahan fail to teach or suggest the steps recited in Appellant's claim 1 as follows:

prompting the caller to initiate a first call to the automated system; initiating a second call in the network to a facility for performing speech recognition; [and] bridging the first and second calls.

In particular, Appellant argues that Hou does not teach Appellant's step of initiating a second call in a network to a speech recognition system. Rather, the Hou patent teaches placing a first call to a voice directed communications system. The voice directed communications system then launches a second call to a destination specified by the first call. Appellant argues that Hou contemplates an entirely different process than Appellant's step of initiating a second call to a speech recognition system. Appellant further argues that McMahan does not teach placing calls to a speech recognition system because McMahan performs the speech to DTMF conversion in the telephone itself.

On page 6 of the Answer, the Examiner responds to the

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above Appellant's arguments. In particular, the Examiner points to Hou for teaching the initiation of a first call by way of a subscriber requesting a response. The Examiner points to col. 3, lines 35-37. The Examiner argues that Hou teaches initiating a second call in the network facility for performing speech recognition as system 100, in response to call home, places an outgoing call. The Examiner directs us to col. 3, lines 36-40. Finally, the Examiner argues that Hou teaches bridging the first and second calls as system 100 causes switch 10 to interconnect the outgoing call with the subscriber's incoming call. The Examiner directs us to col. 3, lines 37-42.

Upon our review of Hou, we find that Hou teaches in col. 3, lines 24-42 that a subscriber may define a number of voice identified calling labels and associate the labels with respective telephone numbers. For example, the subscriber may associate the label call home with the subscriber's home telephone number. Hou teaches that when the subscriber places a call to system 100 shown in Fig. 1 for the purpose of placing a call to a particular location, e.g., home, then all the subscriber needs to do to respond to a particular system

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100 request is to say "call home." System 100, in response thereto, associates the spoken identified call home with the subscriber's home telephone and then places the outgoing telephone call thereto to switch 10 and network 200. System 100 then causes switch 10 to interconnect the outgoing call with the subscriber's incoming call. In col. 5, lines 14-46, Hou teaches that system 100 includes SIU 21, which is a number of digital signal processors which operate to perform a number of different voice processing functions including speech recognition. Therefore, we find that Hou teaches that the first call prompted by the caller is to the speech recognition system, which is SIU 21, within voice directed communications system 100. Therefore, Hou does not teach prompting the call to initiate a first call to the automated system, initiating a second call in the network to a facility for performing speech recognition, and bridging first and second calls as recited in Appellant's claim 1.

We are not inclined to dispense with proof by evidence when the proposition at issue is not supported by a teaching in a prior art reference or shown to be common knowledge of unquestionable demonstration. Our reviewing court requires

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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 Knapp-Monarch Co.*, 296 F.2d 230, 232, 132 USPQ 6, 8 (CCPA 1961); *In re Cofer*, 354 F.2d 664, 668, 148 USPQ 268, 271-72 (CCPA 1966). Our reviewing court states in *In re Piasecki*, 745 F.2d 1468, 223 USPQ 785, 788 (Fed. Cir. 1984) the following:

The Supreme Court in *Graham v. John Deere Co.*, 383 U.S. 1 (1966), focused on the procedural and evidentiary processes in reaching a conclusion under Section 103. As adapted to ex parte procedure, Graham is interpreted as continuing to place the "burden of proof on the Patent Office which requires it to produce the factual basis for its rejection of an application under section 102 and 103". *Citing In re Warner*, 379 F.2d 1011, 1020, 154 USPQ 173, 177 (CCPA 1967).

In view of the foregoing, we have not sustained the rejection of claims 1 through 9 under 35 U.S.C. § 103. Accordingly, the Examiner's decision is reversed.

REVERSED

KENNETH W. HAIRSTON)
Administrative Patent Judge)
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