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EXAMINER

CHANG, RICHARD

ART UNIT PAPER NUMBER

2616

Table with 3 columns: SHORTENED STATUTORY PERIOD OF RESPONSE, MAIL DATE, DELIVERY MODE
3 MONTHS 04/20/2007 PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	Application No. 10/447,607	Applicant(s) SUDER ET AL.	
	Examiner Richard Chang	Art Unit 2616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1)  Responsive to communication(s) filed on 29 May 2003.
- 2a)  This action is FINAL.                      2b)  This action is non-final.
- 3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4)  Claim(s) 1-40 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5)  Claim(s) \_\_\_\_\_ is/are allowed.
- 6)  Claim(s) 1-40 is/are rejected.
- 7)  Claim(s) \_\_\_\_\_ is/are objected to.
- 8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on 27 October 2003 is/are: a)  accepted or b)  objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a)  All    b)  Some \*    c)  None of:  
         1.  Certified copies of the priority documents have been received.  
         2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
         3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
     \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1)  Notice of References Cited (PTO-892)
- 2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3)  Information Disclosure Statement(s) (PTO/SB/08)  
     Paper No(s)/Mail Date \_\_\_\_\_
- 4)  Interview Summary (PTO-413)  
     Paper No(s)/Mail Date: \_\_\_\_\_
- 5)  Notice of Informal Patent Application
- 6)  Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 11-12, 17-22, 24 and 30 are rejected under 35 U.S.C. 102(e) as being unpatentable by Wilson et al. (U.S. Patent No. 6,829,231 B1), hereinafter "Wilson".

As to claim 11, Wilson discloses an IP telephone adaptable for coupling to a first LAN, the IP telephone comprising **[Fig. 5, Abstract, Col. 8, Lines 17-28, the Local Exchange switch 205 and local ISP 215 and network switch 302 form a LAN system that allowed the internet phones to connect]**:

a first state of operation entered in response to a selection of an input by a user, wherein the first state of operation of the IP telephone results in a display of a list of telecommunications extensions coupled to a second LAN coupled to the first LAN via a WAN **[Fig. 5, Fig.6, Col.7, Lines 4-67 and Col. 8, Lines 1-39, A caller can access the directory database and directory search engine through the internet (WAN) for the callee's address and address conversion unit will convert the**

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**address to a callee's name and display it on the display of the caller's internet phone];**

a second state of operation entered in response to a selection of the input by the user, wherein the second state of operation of the IP telephone results in an automatic calling of one of the telecommunications extensions selected by the user **[Fig. 3, Col.8, Lines 7-15, The caller can select the proper callee's name display and make a call. Note, the dialer pad of the internet phone has DTMF tone transceiver 140 and it is inherent that a phone has the DTMF tone capability to have AUTO-DIALING function, such as "Re-dial"]**.

As to claim 12, Wilson discloses the IP telephone as recited in claim 11, wherein the one of the telecommunications extensions automatically called has an identifier displayed to the user on the IP telephone when the input is selected by the user **[Col. 8, Lines 7-15, Caller name displayed on the display, the user can select name from the scrolling list.]**

As to claim 17, Wilson discloses information handling system comprising:

a first local area network ("LAN") operating under an IP protocol **[Fig. 5, Abstract, Col. 8, Lines 17-28, the Local Exchange switch 205 and local ISP 215 and network switch 302 form a LAN system];**  
a first IP telephone coupled to the first LAN, the first IP telephone having a

display and a set of keys for enabling a user to enter inputs **[Fig. 2, Col. 4, Lines 39-67, Col. 5, Lines 1-38];**

a second LAN operating under the IP protocol **[Fig. 5, Col. 8, Lines 17-28, the Local Exchange switch 240 and local ISP 215 and network switch 304 form a LAN system];**

second and third telephone extensions coupled to the second LAN **[Fig.5, IP phones 245-247];**

a wide area network ("WAN") operating under the IP protocol coupling the first LAN to the second LAN **[Network 210 coupled to local ISP, implied the network 210 is a internet (WAN)];**

the first LAN including first circuitry for enabling a user of the first IP telephone to view a list including the second and third telephone extensions **[Col. 8, Lines 7-15, The display screen displays the list of the caller's request and the caller can select the intended caller for phone call];**

As to claim 18, Wilson disclose the system as recited in claim 17, further comprising:

the first LAN including second circuitry for automatically calling the second telephone extension in response to the user selecting the second telephone extension from the viewed list **[Fig. 3, Col.8, Lines 7-15, The caller can select the proper callee's name display and make a call. Note, the dialer pad of the**

**Internet phone has DTMF tone transceiver 140 and it is inherent that a phone has the DTMF tone capability to have AUTO-DIALING function].**

As to claims 19 and 20, Wilson discloses the system as recited in claim 18, wherein selection of the second telephone extension from the viewed list by the user is accomplished by selection of one of the set of keys and the selection of one of the set of keys results in an initiation of a call from the first IP telephone to the second telephone extension across the WAN **[Fig. 5, Fig. 6, Col. 8, Lines 50-67, Col. 9, Lines 1-5, Once the user select the key and dial the calling number, the call setup will establish a connection across network 210 from calling to called side. ]**.

As to claim 21, Wilson discloses the system as recited in claim 17, wherein the list is stored in a server in the second LAN, and is accessed by the first circuitry across the WAN **[Fig. 5, the Internet user database directory, can be access by the first and the 2<sup>nd</sup> LANs]**.

As to claim 22, Wilson discloses the system as recited in claim 17, wherein the first IP telephone includes circuitry for enabling the user to scroll through the displayed list **[Col. 8, Lines 7-15]**.

As to claims 24 and 30, Wilson discloses a telecommunications system comprising:

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a first IP telephone coupled to a first IP server within a first LAN [**Fig. 5, Col. 8, Lines 17-45, The IP phones 201-203 coupled to Local exchange switch and network switch and the internet domain server 308 forms a LAN**];

second and third telephone extensions coupled to a second IP server within a second LAN [**IP phones 245-247 coupled to Local exchange switch 240 and network switch 304 and the internet domain server 308 forms a second LAN, It is well known in the art the local exchange switch can connect to many extensions, such as PBX**];

a WAN coupling the first LAN to the second LAN, the first LAN, the second LAN, and the WAN communicating using an IP protocol [**Fig. 5, Col. 8, Lines 7-28, The network 210, it is IP network since it needs to establish connection via Internet ISP**];

means for displaying on the first IP telephone a list of telephone destinations stored in the second IP server in response to selection of a first input on the first IP telephone, wherein the list of telephone destinations is communicated from the second IP server over the WAN to the first IP telephone [**Col. 8, Lines 7-15, The display screen displays the list of the caller's request and the caller can select the intended caller for phone call**];

means for automatically dialing the selected one of the telephone destinations for a communications link between the first IP telephone and

the selected one of the telephone destinations in response to selection of one of the telephone destinations from the displayed list **[Fig. 3, Col.8, Lines 7-15, The caller can select the proper callee's name display and make a call. Note, the dialer pad of the Internet phone has DTMF tone transceiver 140 and it is inherent that a phone has the DTMF tone capability to have AUTO-DIALING function].**

As to claims 31-33 and 25-27, Wilson discloses the system as recited in claim 30, wherein the selection of one of the telephone destinations from the displayed list is performed in response to selection of a second input on the first IP telephone by a user. **[Fig.5 and Fig.6, Col. 8, Lines 7-17, Caller can use key pad to make request of directory, then from the screen to select the proper callee for phone call.]** And the first and second inputs are the same key button on the first IP telephone **[It is well known in the art that using one key pad to change menu and make a selection afterward]**. And the telephone destinations include the second and third telephone extensions coupled to the second IP server **[Fig. 5, Both LANs can connection many IP phone (extensions) since both sides has Local exchange Switch. It is inherent that a local switch can connect many extensions, such as PBX. ]**.

As to claims 28 and 34, Wilson discloses the system as recited in claim 32, wherein the telephone destinations include telephones external to the system **[Fig. 5, The local exchange switch inherently is able to connect local telephones and the**



**outside line phone, such as a dedicate a T1 trunk from the local exchange switch for PSTN line so that the external line can call to the local telephone].**

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-4,7 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guy et al. (U.S. Patent No. 6,298,057 B1), hereinafter "Guy, in view of Stuntebeck et al. (U.S. Patent 6,065,016), hereinafter "Stuntebeck".

As to claim 1, Guy discloses information handling system comprising:

A first local area network ("LAN")**[Fig. 1, LAN 116];**

a second LAN **[Fig.1, LAN 134];**

a wide area network ("WAN") coupling the first LAN to the second LAN

**[Fig.1, WAN 104 connected to LANs 116 and 134 through routers 114 and 132];**

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a first telecommunications device coupled to the first LAN[**Fig. Phone 106/108 connects to LAN 116 through server 112**];

a plurality of telecommunications extensions coupled to the second LAN[**Fig. 1, Phones 124,126 through the PBX and server to the LAN 134, PBX is well known to be able to have many phone extensions**];

But Guy fails to teach the system has a circuitry in the first LAN for enabling user device to observe a list of the plurality of telecommunication extensions. And another circuit for automatically calling one of the plurality of telecommunications extensions in response to the user selecting one of the plurality of telecommunications extensions from the observed list

Stuntebeck teaches a universal directory server can be connected a user LAN for end user to access and select the phone number stored in the server for automatically dialing the phone number to make a phone call [**Fig. 1, Abstract, Col. 6, Lines 39-45, user can select phone numbers (extension) from the user computer through the LAN to access the directory server and the computer can display numbers as icon then based on the number that user selected to make phone call.**]

It would have been obvious to a person of the ordinary skill in the art at the time the invention was made to implement the directory server that Stuntebeck taught into the file server 112 that Guy taught so the user in the LAN can access the directory

server and select the proper number to make a phone call automatically as specified in claim 1.

The motivation for doing so would have been to have a directory server that provide a convenient way to be accessed through a communication channel so the end user can easily to search, observe and auto-dialing the destination number without looking up another phone book.

As to claim 2, Guy modified by Stuntebeck, discloses the system as recited in claim 1, wherein communication among the first LAN, second LAN, and WAN uses IP protocol **[Guy, Col. 14, Lines 13-22]**.

As to claim 3, Guy modified by Stuntebeck, discloses the system as recited in claim 2, wherein the list of the plurality of telecommunications extensions is displayed to the user of the first telecommunications device **[Stuntebeck, Col. 6, Lines 39-45]**.

As to claim 4, Guy modified by Stuntebeck, discloses the system as recited in claim 2, wherein the list of the plurality of telecommunications extensions is played as audio to the user of the first telecommunications device **[Stuntebeck, Col. 4, Lines 28-26, since the user can use voice to access the directory server, it is inherent that the server will play back the pre-recorded selection menu to let user to select proper extension]**.

As to claim 7, Guy modified by Stuntebeck, discloses the system as recited in claim 1, wherein the list of the plurality of telecommunications extensions is stored in a server in the second LAN, and is accessed by the first circuitry across the WAN **[Stuntebeck, Fig. 1, the universal server coupled to user LAN and be access from internet (WAN) or any other access channel].**

As to claim 10, Guy modified by Stuntebeck, discloses the system as recited in claim 1, further comprising:  
a third LAN coupled to the first and second LANs via the WAN; and  
a plurality of telecommunications extensions coupled to the third LAN, the first LAN including circuitry for enabling the user to select between observing the list of the plurality of telecommunications extensions coupled to the second LAN or observing a list of the plurality of telecommunications extensions coupled to the third LAN **[Guy, Fig. 1, The WAN network is inherently for connecting a plurality of LANs in order to allow the users in those LANs can communicate to each other through WAN. ]**.

5. Claims 5-6, 8-9 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guy et al. (U.S. Patent No. 6,298,057 B1), hereinafter "Guy, in view of Stuntebeck et al. (U.S. Patent 6,065,016), hereinafter "Stuntebeck", further in view of Wilson (U.S. Patent No. 6,829,231 B1), hereinafter "Wilson".

As to claim 5, Guy modified by Stuntebeck, discloses all the limitations of claim 3 (see above), which claim 5 depends.

But Guy modified by Stuntebeck fails to disclose the telecommunication device is an IP phone.

Wilson teaches a IP telephone which has display, input key pad for user to select the phone number from a scrolling list to make call through internet **[Fig. 2, Col. 5, Lines 11-30 and Col 8, Lines 7-15]**.

It would have been obvious to a person of the ordinary skill in the art at the time the invention was made to have the IP phone taught by Wilson as a communication device to connect to the Internet system that taught by Guy and Stuntebeck so that can make a internet voice call.

The motivation for doing so is to provide a stand alone internet phone that user can access internet voice service without hooking up the computer and it is more convenient for the end user.

As to claim 6, Guy modified by Stuntebeck and Wilson, discloses the system as recited in claim 5, wherein the tactile selection of one of the plurality of telecommunications extensions from the displayed list by the user results in an initiation

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of a call from the first telecommunications device to the selected one of the plurality of telecommunications extensions across the WAN **[Wilson, Fig. 5, Fig. 6, Col. 7, Lines 45-67 and Col. 8, Lines 1-38, Lines 50-67]**.

As to claim 8, Guy modified by Stuntebeck and Wilson, discloses the system as recited in claim 6, wherein the list of the plurality of telecommunications extensions is stored in a server in the second LAN, and is accessed by the first circuitry across the WAN **[Wilson, Fig. 5, the Internet user database directory, can be access by the first and the 2<sup>nd</sup> LANs]**.

As to claim 9, Guy modified by Stuntebeck and Wilson, discloses The system as recited in claim 8, wherein the first telecommunications device includes circuitry for enabling the user to scroll through the displayed list of the plurality of telecommunications devices **[Wilson, Col. 8, Lines 7-15]**.

As to claim 23, Guy modified by Stuntebeck and Wilson, teaches all the limitations of claim 1 (see above), which claim 23 depends.

But Guy modified by Stuntebeck and Wilson, dose not disclose that there is 3<sup>rd</sup> LAN connected to the WAN and the caller's phone in the 1<sup>st</sup> LAN can display the callee's list (extensions) of the 2<sup>nd</sup> LAN and 3<sup>rd</sup> LAN.

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It would have been obvious to a person of the ordinary skill in the art at the time the invention was made to have more than 2 LANs connect to WAN (internet) and every LAN has same structure as taught by Wilson **[Wilson, Fig. 5, LAN comprises Local exchange switch and network switch]** so that a caller in one of the LANs can access the directory database of the other two LANs through WAN as specified in claim 35. Notice that, the WAN is inherently to be able to connect to a plurality of LANs together for sharing the information.

The motivation for doing so is to provide more capacity and convince for the end user of every LANs. For example, a big organization has multiple work locations and the employee in this organization can access the whole phone directory of this organization no matter where the user located

6. Claims 13-16, 29, 35-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilson (U.S. Patent No. 6,829,231 B1), hereinafter "Wilson".

As to claim 13, Wilson teaches the Internet phone system performs the functionalities as described in claim 11 **[See rejection above]**.

But Wilson dose not disclose that there is 3<sup>rd</sup> LAN connected to the WAN and the caller's phone in the 1<sup>st</sup> LAN can display the callee's list on the 2<sup>nd</sup> LAN and 3<sup>rd</sup> LAN.

It would have been obvious to a person of the ordinary skill in the art at the time the invention was made to have more than 2 LANs connect to WAN (internet) and every LAN has same structure as taught by Wilson [**Wilson, Fig. 5, LAN comprises Local exchange switch and network switch**] so that a caller in one of the LANs can access the directory database of the other two LANs through WAN as specified in claim 13. Notice that, the WAN is inherently to be able to connect to a plurality of LANs together for sharing the information.

The motivation for doing so is to provide more capacity and convince for the end user of every LANs. For example, a big organization has multiple work locations and the employee in this organization can access the whole phone directory of this organization no matter where the user located.

As to claim 14, Wilson discloses the IP telephone as recited in claim 13, further comprising:

a third state of operation of the IP telephone entered in response to a third selection of the input by the user, wherein the third state of operation of the IP telephone results in a calling of one of the telephone destinations displayed to the user, wherein the calling of the one of the telephone destinations is accomplished from the first LAN via the WAN, through the second LAN [**Col. 8, Lines 7-15, Caller name displayed on the display, the user can select name**



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from the scrolling list and, Fig. 3, Col.8, Lines 7-15, the caller can select the proper callee's name display and make a call. Note, the dialer pad of the Internet phone has DTMF tone transceiver 140 and it is inherent that a phone has the DTMF tone capability to have AUTO-DIALING function, such as "Re-dial". It is well known that in the directory selection menu, the user can choose locations, departments or units within the company (different LANs) and further choose the proper destination phone number].

As to claims 15 and 16, Wilson discloses the IP telephone as recited in claim 14, wherein the user can scroll through the list of second and third LANs to select the third LAN, wherein the second state of operation of the IP telephone will then display telephone destinations the user can potentially call through the third LAN.

And the user can scroll through the telephone destinations the user can potentially call, wherein when the third state of operation is entered, the user has selected one of the telephone destinations with the third selection of the input [Fig. 5, Fig.6 ,Col.7, Lines 4-67 and Col. 8, Lines 1-39, A caller can access the directory database and directory search engine through the internet (WAN) for the callee's address and address conversion unit will convert the address to a callee's name and display it on the display of the caller's internet phone. Col. 8, Lines 7-15, Caller name displayed on the display, the user can select name from the scrolling list.]

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As to claims 29 and 35, Wilson teaches all the limitations of claims 24 and 30 (see above), which claims 29 and 35 depends.

But Wilson does not disclose that there is 3<sup>rd</sup> LAN connected to the WAN and the caller's phone in the 1<sup>st</sup> LAN can display the callee's list on the 2<sup>nd</sup> LAN and 3<sup>rd</sup> LAN.

It would have been obvious to a person of the ordinary skill in the art at the time the invention was made to have more than 2 LANs connect to WAN (internet) and every LAN has same structure as taught by Wilson [**Wilson, Fig. 5, LAN comprises Local exchange switch and network switch**] so that a caller in one of the LANs can access the directory database of the other two LANs through WAN as specified in claim 35. Notice that, the WAN is inherently to be able to connect to a plurality of LANs together for sharing the information.

The motivation for doing so is to provide more capacity and convince for the end user of every LANs. For example, a big organization has multiple work locations and the employee in this organization can access the whole phone directory of this organization no matter where the user located.

As to claim 36, Wilson discloses a method comprising the steps of:

receiving a input from a user on an IP telephone that is networked into a first LAN operating under an IP protocol **[Fig. 5, Internet phone connect to internet through the local switch and network switch, Col. 7, Lines 45-67, user can use the alphanumeric keypad to make a request of callee search]**; in response to receipt of the input, displaying on a display on the IP telephone a first list including second and third LANs coupled to the first LAN, wherein the second and third LANs operate under the IP protocol **[Col. 7, Lines 46-67 and Col. 8, Lines 1-17, the sreen on the caller's side can display the numbers of callee after the search engine reply the search request]**;

receiving another input from the user on the IP telephone; in response to receipt of the input, displaying on the display on the IP telephone a second list of telephone destinations accessible from the second LAN **[Basically, this is same operation of the above]**;

receiving another input from the user on the IP telephone; and in response to receipt of the input, automatically dialing one of the telephone destinations accessible from the second LAN for a communications connection between the one of the telephone destinations and the IP telephone **[Col. 8, Lines 7-15, Caller name displayed on the display, the user can select name from the scrolling list and . Fig. 3, Col.8, Lines 7-15, the caller can select the proper callee's name display and make a call. Note, the dialer pad of the Internet phone has DTMF tone transceiver 140 and it is inherent that a phone has the DTMF tone capability to have AUTO-DIALING function, such as "Re-**

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**dial". It is well known that in the directory selection menu, the user can choose locations, departments or units within the company (different LANs) and further choose the proper destination phone number].**

But Wilson does not explicitly disclose those touch inputs are in order, 1<sup>st</sup>, 2<sup>nd</sup> and 3<sup>rd</sup>.

However, at the time the invention was made, it would have been obvious to a person of the ordinary skill in the art to modify the order of the touch input such that can perform the phone number selection as specified as claim 36. Since application has not disclosed that the input order solves ant problem or is for any particular purpose and it appears that the invention would perform equally well with the order of those touch input.

As to claims 37 and 38, Wilson discloses the method as recited in claim 36, before the step of receiving the second touch input, further comprising the steps of: receiving a fourth touch input from the user on the IP telephone; and in response to receipt of the fourth touch input, scrolling through the first list. and the method as recited in claim 37, before the step of receiving the third touch input, further comprising the steps of receiving a fifth touch input from the user on the IP telephone; and in response to receipt of the fifth touch input, scrolling through the second list [ **Col. 8, Lines 7-15, the user can scroll the list and select the phone number from the list. It is well known that a person in the art to design the keypad**

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**to make a scrolling list and make a selection from a phone list or to choose different list by pressing the keypad].**

As to claim 39, Wilson discloses the method as recited in claim 36, wherein the step of displaying on the display on the 1P telephone the second list further includes the steps of:

sending a message from the first LAN to the second LAN requesting the second list **[Fig. 6, Col. 7, Line 47-67];**

receiving the second list from the second LAN to the first LAN **[Col. 8, Lines 50-67, The search engine response the callee name to the caller].**

As to claim 40, Wilson discloses the method as recited in claim 39, wherein the first, second, and third LANs are coupled via a WAN **[It is inherent that the WAN can connect to many LANs].**

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard Chang whose telephone number is (571) 272-3129. The examiner can normally be reached on Monday - Friday from 8 AM to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wing Chan can be reached on (571) 272-7493. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*rk*  
rkc

Richard Chang  
Patent Examiner  
Art Unit 2616

*Seema S. Rao*  
SEEMA S. RAO 3/29/07  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600



Amendments to the Claims:

This listing of claims replaces all prior versions and listings of claims in the application:

1. (Currently Amended) An information handling system comprising:
  - a first local area network ("LAN");
  - a second LAN;
  - a wide area network ("WAN") coupling the first LAN to the second LAN;
  - a first telecommunications device coupled to the first LAN;
  - a plurality of telecommunications extensions coupled to the second LAN;
  - the first LAN including first circuitry for enabling a user of the first telecommunications device to observe a list of the plurality of telecommunications extensions; and
  - the first LAN including second circuitry for automatically calling one of the plurality of telecommunications extensions in response to the user selecting one of the plurality of telecommunications extensions from the observed list, wherein the list of the plurality of telecommunications extensions is stored in a server in the second LAN, and is accessed by the first circuitry across the WAN.
  
2. (Original) The system as recited in claim 1, wherein communication among the first LAN, second LAN, and WAN uses an IP protocol.
  
3. (Original) The system as recited in claim 2, wherein the list of the plurality of telecommunications extensions is displayed to the user of the first telecommunications device.
  
4. (Currently Amended) ~~The system as recited in claim 2,~~ An information handling system comprising:
  - a first local area network ("LAN");



a second LAN;  
a wide area network ("WAN") coupling the first LAN to the second LAN;  
a first telecommunications device coupled to the first LAN;  
a plurality of telecommunications extensions coupled to the second LAN;  
the first LAN including first circuitry for enabling a user of the first telecommunications device to observe a list of the plurality of telecommunications extensions; and  
the first LAN including second circuitry for automatically calling one of the plurality of telecommunications extensions in response to the user selecting one of the plurality of telecommunications extensions from the observed list, wherein communication among the first LAN, second LAN, and WAN uses an IP protocol, wherein the list of the plurality of telecommunications extensions is played as audio to the user of the first telecommunications device.

5. (Original) The system as recited in claim 3, wherein the first telecommunications device is an IP telephone having a display for showing the list of the plurality of telecommunications extensions, wherein the second circuitry includes a key for enabling the user to tacitly selecting one of the plurality of telecommunications extensions from the displayed list.

6. (Original) The system as recited in claim 5, wherein the tactile selection of one of the plurality of telecommunications extensions from the displayed list by the user results in an initiation of a call from the first telecommunications device to the selected one of the plurality of telecommunications extensions across the WAN.

7. (Cancelled)

8. (Currently Amended) ~~The system as recited in claim 6;~~ An information handling system comprising:

a first local area network ("LAN");

a second LAN;  
a wide area network ("WAN") coupling the first LAN to the second LAN;  
a first telecommunications device coupled to the first LAN;  
a plurality of telecommunications extensions coupled to the second LAN;  
the first LAN including first circuitry for enabling a user of the first telecommunications device to observe a list of the plurality of telecommunications extensions; and  
the first LAN including second circuitry for automatically calling one of the plurality of telecommunications extensions in response to the user selecting one of the plurality of telecommunications extensions from the observed list, wherein communication among the first LAN, second LAN, and WAN uses an IP protocol, wherein the list of the plurality of telecommunications extensions is displayed to the user of the first telecommunications device, wherein the first telecommunications device is an IP telephone having a display for showing the list of the plurality of telecommunications extensions, wherein the second circuitry includes a key for enabling the user to tacitly selecting one of the plurality of telecommunications extensions from the displayed list, wherein the tactile selection of one of the plurality of telecommunications extensions from the displayed list by the user results in an initiation of a call from the first telecommunications device to the selected one of the plurality of telecommunications extensions across the WAN, wherein the list of the plurality of telecommunications extensions is stored in a server in the second LAN, and is accessed by the first circuitry across the WAN.

9. (Original) The system as recited in claim 8, wherein the first telecommunications device includes circuitry for enabling the user to scroll through the displayed list of the plurality of telecommunications devices.

10. (Original) The system as recited in claim 1, further comprising:  
a third LAN coupled to the first and second LANs via the WAN; and

a plurality of telecommunications extensions coupled to the third LAN, the first LAN including circuitry for enabling the user to select between observing the list of the plurality of telecommunications extensions coupled to the second LAN or observing a list of the plurality of telecommunications extensions coupled to the third LAN.

11 – 16. (Cancelled)

17. (Currently Amended) An information handling system comprising:  
a first local area network ("LAN") operating under an IP protocol;  
a first IP telephone coupled to the first LAN, the first IP telephone having a display and a set of keys for enabling a user to enter inputs;  
a second LAN operating under the IP protocol;  
second and third telephone extensions coupled to the second LAN;  
a wide area network ("WAN") operating under the IP protocol coupling the first LAN to the second LAN; and  
the first LAN including first circuitry for enabling a user of the first IP telephone to view a list including the second and third telephone extensions, wherein the list is stored in a server in the second LAN, and is accessed by the first circuitry across the WAN.

18. (Original) The system as recited in claim 17, further comprising:  
the first LAN including second circuitry for automatically calling the second telephone extension in response to the user selecting the second telephone extension from the viewed list.

19. (Original) The system as recited in claim 18, wherein selection of the second telephone extension from the viewed list by the user is accomplished by selection of one of the set of keys.

20. (Original) The system as recited in claim 19, wherein the selection of one of the set

of keys results in an initiation of a call from the first IP telephone to the second telephone extension across the WAN.

21. (Cancelled)

22. (Original) The system as recited in claim 17, wherein the first IP telephone includes circuitry for enabling the user to scroll through the displayed list.

23. (Original) The system as recited in claim 1, further comprising:  
a third LAN coupled to the first and second LANs via the WAN; and  
a plurality of telephone extensions coupled to the third LAN, the first LAN including circuitry for enabling the user to select between viewing the list of the telephone extensions coupled to the second LAN or viewing a list of the plurality of telephone extensions coupled to the third LAN.

24. (Original) In a telecommunications system comprising a first IP telephone coupled to a first IP server within a first LAN, second and third telephone extensions coupled to a second IP server within a second LAN, and a WAN coupling the first LAN to the second LAN, the first LAN, the second LAN, and the WAN communicating using an IP protocol, a method comprising the steps of:

in response to selection of a first input on the first IP telephone, displaying on the first IP telephone a list of telephone destinations stored in the second IP server, wherein the list of telephone destinations is communicated from the second IP server over the WAN to the first IP telephone; and

in response to selection of one of the telephone destinations from the displayed list, automatically dialing the selected one of the telephone destinations for a communications link between the first IP telephone and the selected one of the telephone destinations.

25. (Original) The method as recited in claim 24, wherein the selection of one of the

telephone destinations from the displayed list is performed in response to selection of a second input on the first IP telephone by a user.

26. (Original) The method as recited in claim 25, wherein the first and second inputs are the same key button on the first IP telephone.

27. (Original) The method as recited in claim 24, wherein the telephone destinations include the second and third telephone extensions coupled to the second IP server.

28. (Original) The method as recited in claim 24, wherein the telephone destinations include telephones external to the system.

29. (Original) The method as recited in claim 24, wherein the system includes a third LAN coupled to the first and second LANs via the WAN, further comprising the steps of:

displaying on the first IP telephone a list of LANs coupled to the WAN, including the second and third LANs; and

performing the step of displaying the first list in response to selection of the second LAN from the displayed list of LANs.

30. (Original) A telecommunications system comprising:

a first IP telephone coupled to a first IP server within a first LAN;

second and third telephone extensions coupled to a second IP server within a second LAN;

a WAN coupling the first LAN to the second LAN, the first LAN, the second LAN, and the WAN communicating using an IP protocol;

means for displaying on the first IP telephone a list of telephone destinations stored in the second IP server in response to selection of a first input on the first IP telephone, wherein the list of telephone destinations is communicated from the second IP server over the WAN to the first IP telephone; and

means for automatically dialing the selected one of the telephone destinations for a communications link between the first IP telephone and the selected one of the telephone destinations in response to selection of one of the telephone destinations from the displayed list.

31. (Original) The system as recited in claim 30, wherein the selection of one of the telephone destinations from the displayed list is performed in response to selection of a second input on the first IP telephone by a user.

32. (Original) The system as recited in claim 31, wherein the first and second inputs are the same key button on the first IP telephone.

33. (Original) The system as recited in claim 32, wherein the telephone destinations include the second and third telephone extensions coupled to the second IP server.

34. (Original) The system as recited in claim 32, wherein the telephone destinations include telephones external to the system.

35. (Original) The system as recited in claim 31, further comprising:  
a third LAN coupled to the first and second LANs via the WAN;  
means for displaying on the first IP telephone a list of LANs coupled to the WAN,  
including the second and third LANs; and  
means for displaying the first list in response to selection of the second LAN from the displayed list of LANs.

36. (Currently Amended) A method comprising the steps of:  
receiving a first touch input from a user on an IP telephone that is networked into a first LAN operating under an IP protocol;

in response to receipt of the first touch input, displaying on a display on the IP telephone a first list including second and third LANs coupled to the first LAN, wherein the second and third LANs operate under the IP protocol;

receiving a second touch input from the user on the IP telephone;

in response to receipt of the second touch input, displaying on the display on the IP telephone a second list of telephone destinations accessible from the second LAN;

receiving a third touch input from the user on the IP telephone; and

in response to receipt of the third touch input, automatically dialing one of the telephone destinations accessible from the second LAN for a communications connection between the one of the telephone destinations and the IP telephone, wherein the step of displaying on the display on the IP telephone the second list further includes the steps of:

sending a message from the first LAN to the second LAN requesting the second list; and  
receiving the second list from the second LAN to the first LAN.

37. (Original) The method as recited in claim 36, before the step of receiving the second touch input, further comprising the steps of: receiving a fourth touch input from the user on the IP telephone; and in response to receipt of the fourth touch input, scrolling through the first list.

38. (Original) The method as recited in claim 37, before the step of receiving the third touch input, further comprising the steps of: receiving a fifth touch input from the user on the IP telephone; and in response to receipt of the fifth touch input, scrolling through the second list.

39. (Cancelled)

40. (Currently Amended) The method as recited in claim ~~39~~ 36, wherein the first, second, and third LANs are coupled via a WAN.

REMARKS

Claims 1-40 are pending in the application.

Claims 1-40 stand rejected.

I. REJECTIONS UNDER 35 U.S.C. § 102

Claims 11-12, 17-22, 24 and 30 stand rejected under 35 U.S.C. § 102(e) as being unpatentable by *Wilson et al.* (U.S. Patent No. 6,829,231). In response, Applicants respectfully traverse this rejection. As the Examiner is well aware, for a claim to be anticipated under § 102, each and every element of the claim must be found within the cited prior art reference.

With respect to claims 11 and 12, these claims have been canceled. Therefore, the rejection of these claims is moot.

With respect to claims 17-22, Applicants have amended claim 17 to incorporate the limitations of claim 21. Claim 17, as amended, now recites that the list is stored in a server in the second LAN, and is accessed by the first circuitry across the WAN. This limitation is not taught within *Wilson*.

The Examiner has asserted that the LAN associated with the IP telephones 201-203 comprises local exchange switch 205, local ISP 215 and network switch 302. First of all, Applicants traverse such an assertion of what a LAN comprises. Applicants assert that the LAN associated with IP telephones 201-203 can only comprise those telephones along with local exchange switch 205. In fact, the IP telephones 201-203 are connected to the local exchange switch 205 using public switched telephone network circuits 204. The public switched telephone network 204 cannot reasonably be inferred to be part of a local area network. Instead, the PSTN circuits 204 are actually part of the wide area network, of which the network 210 is a part of. Nevertheless, even assuming that the Examiner is correct that a LAN comprises the telephones 201-203, local exchange switch 205, network switch 302 and local ISP 215, it is clear that the database 232 is not included within this "LAN." Moreover, and correspondingly, IP telephones 245-247 would be in a LAN that also does not include database 232. Since database 232 is accessed both over the Internet, or WAN, 210, and is not included within either of the LANs



noted previously, then *Wilson* does not meet the limitations whereby the list is stored in a server in the second LAN, and is accessed by the first circuitry across the WAN, where the second LAN includes the second and third telephone extensions which are included in the list viewed by the user of the first IP telephone in the first LAN. As a result of the foregoing, *Wilson* does not teach all of the limitations of amended claim 17.

With respect to claim 24, this claim is also not anticipated for *Wilson* for the reasons noted above with respect to amended claim 17. Moreover, claim 24 recites that the list of telephone destinations is communicated from the second IP server over the WAN to the first IP telephone. This list of telephone destinations is stored in the second IP server which is coupled to the second and third telephone extensions. The first IP telephone then selects one of those telephone destinations to make a telephone call from that list. Since database 232 is not associated with a second LAN that includes one of the IP telephones 245-247, or even telephones 201-203, *Wilson* does not meet the limitations of claim 24.

With respect to claim 30, it is not anticipated by the cited prior art reference for reasons similarly given above. The list of telephone destinations communicated from the second IP server over the WAN to the first IP telephone is not taught or suggested by *Wilson*. The list of telephone destinations in database 232 is not communicated from the LAN comprising IP telephones 245-247 over the network 210 to the LAN comprising IP telephones 201-203.

With respect to claims 28 and 34, Applicants respectfully traverse the Examiner's assertions. First of all, the Examiner has mischaracterized the limitations within these claims. These claims recite that the telephone destinations may include telephones external to the system. Such telephone destinations are included in a list stored in the second IP server and which are communicated from the second IP server over the WAN to the first IP telephone. This is not taught or suggested within *Wilson*. Further, the Examiner has asserted that such limitations are inherent. Applicants respectfully traverse this inherent assertion by the Examiner. The fact that a certain result of characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. MPEP § 2112. In relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical

reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. *Id.* The Examiner's support for the inherency rejection is without any facts or technical reasoning, but is merely the Examiner's subjective opinion. This is insufficient to support a rejection based on inherency.

## II. REJECTIONS UNDER 35 U.S.C. § 103

Claims 1-4, 7 and 10 stand rejected under 35 U.S.C. § 103 as being unpatentable over *Guy et al.* (U.S. Patent No. 6,298,057) in view of *Stuntebeck et al.* (U.S. Patent No. 6,065,016).

Claim 1 has been amended to include the limitations of claim 7. Furthermore, claim 4 has been placed in independent form. In rejecting claim 7, the Examiner has asserted that this limitation is taught within *Stuntebeck* by the universal server coupled to the user LAN and accessed from the Internet or any other access channel. This does not meet the claim limitations. The claim limitations specifically recite that the list of the plurality of telecommunications extensions is stored in a server in the LAN. The UDS 10 is not part of the user LAN. Instead, the LAN is coupled to the UDS by a dedicated communication channel 58. Column 4, lines 5-9. One skilled in the art would not have been able to recreate amended claim 1 in view of the cited prior art, since not all of the claim limitations are taught or suggested by the combination of the references. Though Applicants have specifically pointed out how *Stuntebeck* does not meet the claim limitations, this is the reason used by the Examiner to reject the original claim 7. Since Applicants have traversed and shown that *Stuntebeck* does not meet the claim limitations as relied upon by the Examiner, the Examiner's *prima facie* case of obviousness cannot stand.

With respect to claim 4, the Examiner has asserted that it is inherent that the server will play back the pre-recorded selection menu to let the user to select the proper extension. Applicants respectfully traverse this inherency argument. Such an inherency argument is not supported by facts or technical reasoning, but is merely supported by the Examiner's unsupported subjective opinion.

Claims 5-6, 8-9 and 23 stand rejected under 35 U.S.C. § 103 as being unpatentable over *Guy* in view of *Stuntebeck* and further in view of *Wilson*. Applicants respectfully traverse. With

respect to claim 8, the Examiner has asserted that in *Wilson* the Internet user database directory can be accessed by the first and second LANs. The problem with the Examiner's rejection, as pointed out above, is that this does not meet the claim recitations. The claims specifically recite that the list of telecommunications extensions is found within the second LAN, not outside of the second LAN. *Wilson* clearly shows that database 232 does not reside within either of the LANs taught therein. As a result, one skilled in the art at the time the invention was made would not have been able to recreate claim 8 in view of the cited prior art. The Examiner has specifically relied upon the teachings in *Wilson* to support the rejection of claim 8, and Applicants have successfully traversed these assertions. As a result, the Examiner's *prima facie* case of obviousness must fail.

Claims 13-16, 29 and 35-40 stand rejected under 35 U.S.C. § 103 as being unpatentable over *Wilson*. In response, Applicants respectfully traverse this rejection. Claims 13-16 have been canceled.

With respect to claims 29 and 35, Applicants traverse the Examiner's motivation to modify *Wilson*. The Examiner's motivation is so that members of the big organization in multiple work locations can access the whole phone directory of this organization no matter where the user is located. The problem is that this motivation comes specifically out of the present application. See page 20, lines 12-24. As prohibited by case law, an examiner may not use the Applicant's application as a blue print for modifying prior art references. This is referred to as hindsight reasoning. The Examiner's motivation is not shown to be supported by any external factual evidence. Therefore, it can only be concluded that the Examiner came up with this motivation through Applicant's own specification.

With respect to claims 36-40, claim 36 has been amended to incorporate the limitations of claim 39. As argued above, the prior art references do not provide that the list of telephone destinations is stored within the second LAN. Amended claim 36 recites the sending of a message from the first LAN to the second LAN requesting the second list and then receiving the second list from the second LAN to the first LAN. These are not taught within *Wilson*, contrary to the Examiner's position. Column 7, lines 47-67 instead discloses that the callee's Internet

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addresses are provided by the database search engine 230 to one of the Internet callers 201-203.  
This is not sending a message to the second LAN and then receiving the list from the second  
LAN.

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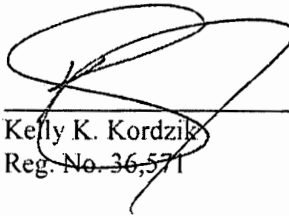
Attorney's Docket No.: 21618-013001

CONCLUSION

Please charge Deposit Account No. 06-1050 in the amount of \$60.00 for the Petition for Extension of Time fee (one month). Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: Aug. 17, 2007

  
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10/447,607	05/29/2003	Eric G. Suder	21618-013001	6094

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EXAMINER

SEFCHECK, GREGORY B

ART UNIT	PAPER NUMBER
2619	

2619

MAIL DATE	DELIVERY MODE
10/22/2007	PAPER

10/22/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

5

<b>Office Action Summary</b>	Application No. 10/447,607	Applicant(s) SUDER ET AL.	
	Examiner Gregory B. Sefcheck	Art Unit 2619	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1)  Responsive to communication(s) filed on 17 August 2007.
- 2a)  This action is **FINAL**.                      2b)  This action is non-final.
- 3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4)  Claim(s) 1-6, 8-10, 17-20, 22-38 and 40 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5)  Claim(s) \_\_\_\_\_ is/are allowed.
- 6)  Claim(s) 1-6, 8-10, 17-20, 22-38 and 40 is/are rejected.
- 7)  Claim(s) \_\_\_\_\_ is/are objected to.
- 8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \*    c)  None of:
1.  Certified copies of the priority documents have been received.
  2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

- Applicant's Amendment filed 8/17/2007 is acknowledged.
- Claims 1, 4, 8, 17, 36, 40 have been amended.
- Claims 7, 11-16, 21, 39 have been cancelled.
- Claims 1-6, 8-10, 17-20, 22-38 and 40 remain pending.

### *Specification*

1. The disclosure is objected to because of the following informalities:

Please update the related applications identified on pg. 1 of the Specification:

Serial No. 10/041332 is now patented, US Patent No. 6,925,167.

Serial No. 10/210902 is now patented, US Patent No. 7,123,699.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-3, 5, 6, 8-10, 17-20, and 22-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guy et al. (US006298057B1), hereafter Guy, in view of Wilson (US006829231B1).



Art Unit: 2619

- Regarding Claims 1-3, 5, 6, 8-10, 17-20, 22-25, 27, 29-31, 33, and 35,

Guy discloses a system and method for coupling a first LAN 102A having server 112 to a second LAN 102B having server 122 through WAN 104 utilizing IP capabilities of the LANs and WAN (Fig. 1; Col. 1, lines 51-53; Col. 14, lines 13-17; claim 1,8,17,24,30 – method in a information handling system comprising a first LAN; claim 1,8,17,24,30 – a second LAN; claim 1,8,17,24,30 – WAN coupling the first LAN to the second LAN; claim 2,17,30 – LANs and WAN operate under IP protocol; claim 24,30 – first and second IP servers within first and second LANs).

Fig. 1 also shows that a plurality of telecommunications devices are coupled to the first and second LANs 102A/B (claim 1,8,17,24,30 - first telecommunications device coupled to the first LAN; claim 1,8,17,24,27,33 - plurality of telecommunications extensions/destinations coupled to the second LAN).

Guy discloses the ability to connect a phone of the first LAN 102A to a destination phone of the second LAN 102B (Col. 6, lines 4-11; Col. 10, lines 1-7). Guy further discloses each file server 112/122 includes a directory (Fig. 4, 406) that stores a list of server codes and additional information to identify devices attached to each server (Col. 10-11, lines 30-14; claim 1,8,17,30 - wherein the list of the plurality of telecommunications extensions is stored in a server in the second LAN, and is accessed by the first circuitry across the WAN). Guy also discloses a master directory in a server of network 100 containing the information stored in each local directory (Col. 9, lines 20-25).

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However, Guy does not explicitly disclose the user of the phone in the first LAN observing a displayed list of extensions to phones in multiple (second and third) local networks remote of the user's LAN and automatically initiating a call in response to the user selecting one of the extensions from the observed list. Guy also does not explicitly disclose the user's phone as an IP phone having display and keys for user to enter first and second inputs for displaying and selecting/initiating a call, circuitry to scroll through the displayed list.

Wilson discloses an IP phone user can access a directory engine through the Internet (WAN) for displaying a list of numbers/addresses (extensions) obtained from multiple (second and third) local exchange network switches and ISPs that are remote to the user. Wilson further discloses the user initiates a call by selecting a destination from a scrolled list of potential destinations (Fig. 5,6; Col. 7-8, lines 45-15; claim 1,8,17,24,30 - first LAN including first circuitry for enabling a user of the first telecommunications device to observe/view a list of the plurality of telecommunications extensions; claim 1,8,18,24,30 - first LAN including second circuitry for automatically calling one of the plurality of telecommunications extensions in response to the user selecting one of file plurality of telecommunications extensions from the observed list; claim 3,8,24,30 - list is displayed to user of the first device; claim 5,6,8,17,19,20,24,25,30,31 - first device is IP phone having display and keys for user to enter first and second inputs for displaying and selecting/initiating a call to an extension in the second LAN over the WAN; claim 9,22 - circuitry to scroll through displayed list;

Art Unit: 2619

claim 10,23,29,35 – a third LAN and first LAN circuitry for selecting and viewing a list of a plurality of extensions coupled to the second and/or third LAN).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Guy by enabling a first device to observe a list of extensions in a remote LAN and initiating a call to a displayed number in response to selection by a user, as shown by Wilson, thereby enabling the first phone to connect to a destination phone if the number associated with the destination phone is unknown and remote of the user's LAN.

- Regarding Claims 26 and 32,

Guy discloses a system and method meeting all limitations of the parent claims.

Neither Guy nor Wilson discloses first and second inputs use the same button.

However, it is well known in the art to utilize the same button for multiple common inputs to simplify the functionality (claim 26,32 – first and second inputs use same button).

It would have been obvious to one of ordinary skill in the art at the time of the invention to use the same button for the first and second inputs disclosed by Wilson, in order to improve the ease of use for the user.

Art Unit: 2619

- Regarding Claims 28 and 34,

Guy discloses a system and method meeting all limitations of the parent claims.

Neither Guy nor Wilson explicitly discloses destinations includes telephones external to the system.

However, it is well known that local exchange switches such as those shown by Wilson are able to connect to other exchanges outside of the local system, such as over a dedicated T1 trunk (claim 28,34 – destinations includes telephones external to the system).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Guy and Wilson by enabling destinations to be telephones external to the system, thereby providing the disclosed directory services to as many capable users as can be supported.

Art Unit: 2619

3. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Guy in view of Wilson above, and further in view of Stuntebeck et al. (US006065016A), hereafter Stuntebeck.

- Regarding Claim 4,

Guy discloses a system as shown above in the rejection of claim 1 and 2.

Neither Guy nor Wilson discloses a list played to a user as audio.

Stuntebeck discloses a universal directory server (UDS) that provides remote access to the communication addresses (extensions) associated with numerous institutions, including LANs (Fig. 1; Abstract). Stuntebeck discloses a user can access the UDS through a voice recognition system, in which results are conveyed to the user as voice (audio; Col. 4, lines 17-25; claim 4 – list is played as audio to the user of the first device).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Guy and Wilson by enabling the list to be played as audio to the user, as shown by Stuntebeck, thereby allowing users to access directory services without a visual display.

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4. Claims 36-38 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilson in view of Guy.

- Regarding Claim 36-38 and 40,

Wilson discloses an IP phone connects to Internet (WAN) through multiple (first, second, third) local switches and network switches, and a user can use the alphanumeric keypad to make a request of callee search (Fig. 5; Col. 7, lines 45-67; claim 36 - in response to receipt of first input, displaying on a display on the IP telephone a first list including second and third LANs coupled to the first LAN, wherein the second and third LANs operate under the IP protocol; claim 40 – first, second, and third LANs coupled via WAN).

Wilson further discloses the screen on the caller's side can display multiple result numbers of callees in a scrolled list after the search engine replies to the search request (Col. 7, lines 46-67 and Col. 8, Lines 1-17; claim 36 - receiving another input from the user on the IP telephone; in response to receipt of the input, displaying on the display on the IP telephone a second list of telephone destinations accessible from the second LAN; claim 37 – scrolling through the list in response to fourth input).

Wilson then shows that the caller can select the proper callee's name display from the scrolled list of multiple results to initiate a call (Col. 8, lines 13-15; claim 36 - in response to receipt of third input, automatically dialing one of the telephone destinations accessible from the second LAN for a communications connection between the one of

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the telephone destinations and the IP telephone; claim 38 – scrolling through the list in response to fifth input).

Wilson does not explicitly show that the callee lists are received from a second LAN in response to sending a request message from the first LAN.

Guy discloses a system and method for coupling a first LAN 102A having server 112 to a second LAN 102B having server 122 through WAN 104 utilizing IP capabilities of the LANs and WAN. Guy discloses the ability to connect a phone of the first LAN 102A to a destination phone of the second LAN 102B (Col. 6, lines 4-11; Col. 10, lines 1-7). Guy further discloses each file server 112/122 includes a directory (Fig. 4, 406) that stores a list of server codes and additional information to identify devices attached to each server (Col. 10-11, lines 30-14), while also disclosing a master directory in a server of network 100 containing the information stored in each local directory (Col. 9, lines 20-25; claim 36 - displaying on the display on the IP telephone the second list further includes the steps of sending a request message for the list from the first LAN to the second LAN and receiving the second list from the second LAN to the first LAN).

It would have been obvious to one of ordinary skill in the art at the time of the invention to supply the Internet database in Wilson from local directories stored in each respective LAN segment of a network, as shown by Guy, thereby ensuring that the Internet (master) directory is up to date.

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***Response to Arguments***

5. Applicant's arguments with respect to the pending claims have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Hattori et al. (US006094674A)
- Lloyd (US20010037331A1)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory B. Sefcheck whose telephone number is 571-272-3098. The examiner can normally be reached on Monday-Friday, 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wing Chan can be reached on 571-272-7493. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Art Unit: 2619

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Gregory Setcheck  
Patent Examiner  
10-16-2007



AMENDMENTS

Amendments to the Specification:

Please replace the paragraphs on page 1, lines 3-14, with the following amended paragraphs:

CROSS REFERENCE TO RELATED APPLICATIONS

This application for patent is a continuation-in-part application of U.S. Patent Application Serial No. 09/775,018, entitled "QUALITY OF SERVICE IN A VOICE OVER IP TELEPHONE SYSTEM."

This application for patent is related to the following patent applications:

Serial No. 10/072,343; entitled "QUALITY OF SERVICE IN A REMOTE TELEPHONE";

Serial No. 10/041,332, now U.S. Patent No. 6,925,167; entitled "SERVICE OBSERVING IN A VOICE OVER IP TELEPHONE SYSTEM"; and

Serial No. 10/210,902, now U.S. Patent No. 7,123,699; entitled "VOICE MAIL IN A VOICE OVER IP TELEPHONE SYSTEM"; which are all hereby incorporated by reference herein.

Amendments to the Claims:

This listing of claims replaces all prior versions and listings of claims in the application:

Listing of Claims:

1. (Previously presented) An information handling system comprising:
  - a first local area network ("LAN");
  - a second LAN;
  - a wide area network ("WAN") coupling the first LAN to the second LAN;
  - a first telecommunications device coupled to the first LAN;
  - a plurality of telecommunications extensions coupled to the second LAN;
  - the first LAN including first circuitry for enabling a user of the first telecommunications device to observe a list of the plurality of telecommunications extensions; and
  - the first LAN including second circuitry for automatically calling one of the plurality of telecommunications extensions in response to the user selecting one of the plurality of telecommunications extensions from the observed list, wherein the list of the plurality of telecommunications extensions is stored in a server in the second LAN, and is accessed by the first circuitry across the WAN.
  
2. (Original) The system as recited in claim 1, wherein communication among the first LAN, second LAN, and WAN uses an IP protocol.
  
3. (Original) The system as recited in claim 2, wherein the list of the plurality of telecommunications extensions is displayed to the user of the first telecommunications device.

4. (Previously presented) An information handling system comprising:  
a first local area network ("LAN");  
a second LAN;  
a wide area network ("WAN") coupling the first LAN to the second LAN;  
a first telecommunications device coupled to the first LAN;  
a plurality of telecommunications extensions coupled to the second LAN;  
the first LAN including first circuitry for enabling a user of the first telecommunications device to observe a list of the plurality of telecommunications extensions; and  
the first LAN including second circuitry for automatically calling one of the plurality of telecommunications extensions in response to the user selecting one of the plurality of telecommunications extensions from the observed list, wherein communication among the first LAN, second LAN, and WAN uses an IP protocol, wherein the list of the plurality of telecommunications extensions is played as audio to the user of the first telecommunications device.

5. (Original) The system as recited in claim 3, wherein the first telecommunications device is an IP telephone having a display for showing the list of the plurality of telecommunications extensions, wherein the second circuitry includes a key for enabling the user to tacitly selecting one of the plurality of telecommunications extensions from the displayed list.

6. (Original) The system as recited in claim 5, wherein the tactile selection of one of the plurality of telecommunications extensions from the displayed list by the user results in an initiation of a call from the first telecommunications device to the selected one of the plurality of telecommunications extensions across the WAN.

7. (Cancelled)

8. (Previously presented) An information handling system comprising:  
a first local area network ("LAN");  
a second LAN;  
a wide area network ("WAN") coupling the first LAN to the second LAN;  
a first telecommunications device coupled to the first LAN;  
a plurality of telecommunications extensions coupled to the second LAN;  
the first LAN including first circuitry for enabling a user of the first telecommunications device to observe a list of the plurality of telecommunications extensions; and  
the first LAN including second circuitry for automatically calling one of the plurality of telecommunications extensions in response to the user selecting one of the plurality of telecommunications extensions from the observed list, wherein communication among the first LAN, second LAN, and WAN uses an IP protocol, wherein the list of the plurality of telecommunications extensions is displayed to the user of the first telecommunications device, wherein the first telecommunications device is an IP telephone having a display for showing the list of the plurality of telecommunications extensions, wherein the second circuitry includes a key for enabling the user to tacitly selecting one of the plurality of telecommunications extensions from the displayed list, wherein the tactile selection of one of the plurality of telecommunications extensions from the displayed list by the user results in an initiation of a call from the first telecommunications device to the selected one of the plurality of telecommunications extensions across the WAN, wherein the list of the plurality of telecommunications extensions is stored in a server in the second LAN, and is accessed by the first circuitry across the WAN.

9. (Original) The system as recited in claim 8, wherein the first telecommunications device includes circuitry for enabling the user to scroll through the displayed list of the plurality of telecommunications devices.

10. (Original) The system as recited in claim 1, further comprising:  
a third LAN coupled to the first and second LANs via the WAN; and  
a plurality of telecommunications extensions coupled to the third LAN, the first LAN including circuitry for enabling the user to select between observing the list of the plurality of telecommunications extensions coupled to the second LAN or observing a list of the plurality of telecommunications extensions coupled to the third LAN.

11 – 16. (Cancelled)

17. (Previously presented) An information handling system comprising:  
a first local area network ("LAN") operating under an IP protocol;  
a first IP telephone coupled to the first LAN, the first IP telephone having a display and a set of keys for enabling a user to enter inputs;  
a second LAN operating under the IP protocol;  
second and third telephone extensions coupled to the second LAN;  
a wide area network ("WAN") operating under the IP protocol coupling the first LAN to the second LAN; and  
the first LAN including first circuitry for enabling a user of the first IP telephone to view a list including the second and third telephone extensions, wherein the list is stored in a server in the second LAN, and is accessed by the first circuitry across the WAN.

18. (Original) The system as recited in claim 17, further comprising:  
the first LAN including second circuitry for automatically calling the second telephone extension in response to the user selecting the second telephone extension from the viewed list.

19. (Original) The system as recited in claim 18, wherein selection of the second telephone extension from the viewed list by the user is accomplished by selection of one of the set of keys.

20. (Original) The system as recited in claim 19, wherein the selection of one of the set of keys results in an initiation of a call from the first IP telephone to the second telephone extension across the WAN.

21. (Cancelled)

22. (Original) The system as recited in claim 17, wherein the first IP telephone includes circuitry for enabling the user to scroll through the displayed list.

23. (Original) The system as recited in claim 1, further comprising:  
a third LAN coupled to the first and second LANs via the WAN; and  
a plurality of telephone extensions coupled to the third LAN, the first LAN including circuitry for enabling the user to select between viewing the list of the telephone extensions coupled to the second LAN or viewing a list of the plurality of telephone extensions coupled to the third LAN.

24. (Original) In a telecommunications system comprising a first IP telephone coupled to a first IP server within a first LAN, second and third telephone extensions coupled to a second IP server within a second LAN, and a WAN coupling the first LAN to the second LAN, the first LAN, the second LAN, and the WAN communicating using an IP protocol, a method comprising the steps of:

in response to selection of a first input on the first IP telephone, displaying on the first IP telephone a list of telephone destinations stored in the second IP server, wherein the list of telephone destinations is communicated from the second IP server over the WAN to the first IP telephone; and

in response to selection of one of the telephone destinations from the displayed list, automatically dialing the selected one of the telephone destinations for a communications link between the first IP telephone and the selected one of the telephone destinations.



25. (Original) The method as recited in claim 24, wherein the selection of one of the telephone destinations from the displayed list is performed in response to selection of a second input on the first IP telephone by a user.

26. (Original) The method as recited in claim 25, wherein the first and second inputs are the same key button on the first IP telephone.

27. (Original) The method as recited in claim 24, wherein the telephone destinations include the second and third telephone extensions coupled to the second IP server.

28. (Original) The method as recited in claim 24, wherein the telephone destinations include telephones external to the system.

29. (Original) The method as recited in claim 24, wherein the system includes a third LAN coupled to the first and second LANs via the WAN, further comprising the steps of:

displaying on the first IP telephone a list of LANs coupled to the WAN, including the second and third LANs; and

performing the step of displaying the first list in response to selection of the second LAN from the displayed list of LANs.

30. (Original) A telecommunications system comprising:

a first IP telephone coupled to a first IP server within a first LAN;

second and third telephone extensions coupled to a second IP server within a second LAN;

a WAN coupling the first LAN to the second LAN, the first LAN, the second LAN, and the WAN communicating using an IP protocol;

means for displaying on the first IP telephone a list of telephone destinations stored in the second IP server in response to selection of a first input on the first IP telephone, wherein the list

of telephone destinations is communicated from the second IP server over the WAN to the first IP telephone; and

means for automatically dialing the selected one of the telephone destinations for a communications link between the first IP telephone and the selected one of the telephone destinations in response to selection of one of the telephone destinations from the displayed list.

31. (Original) The system as recited in claim 30, wherein the selection of one of the telephone destinations from the displayed list is performed in response to selection of a second input on the first IP telephone by a user.

32. (Original) The system as recited in claim 31, wherein the first and second inputs are the same key button on the first IP telephone.

33. (Original) The system as recited in claim 32, wherein the telephone destinations include the second and third telephone extensions coupled to the second IP server.

34. (Original) The system as recited in claim 32, wherein the telephone destinations include telephones external to the system.

35. (Original) The system as recited in claim 31, further comprising:  
a third LAN coupled to the first and second LANs via the WAN;  
means for displaying on the first IP telephone a list of LANs coupled to the WAN,  
including the second and third LANs; and  
means for displaying the first list in response to selection of the second LAN from the displayed list of LANs.

36. (Previously presented) A method comprising the steps of:

receiving a first touch input from a user on an IP telephone that is networked into a first LAN operating under an IP protocol;

in response to receipt of the first touch input, displaying on a display on the IP telephone a first list including second and third LANs coupled to the first LAN, wherein the second and third LANs operate under the IP protocol;

receiving a second touch input from the user on the IP telephone;

in response to receipt of the second touch input, displaying on the display on the IP telephone a second list of telephone destinations accessible from the second LAN;

receiving a third touch input from the user on the IP telephone; and

in response to receipt of the third touch input, automatically dialing one of the telephone destinations accessible from the second LAN for a communications connection between the one of the telephone destinations and the IP telephone, wherein the step of displaying on the display on the IP telephone the second list further includes the steps of:

sending a message from the first LAN to the second LAN requesting the second list; and

receiving the second list from the second LAN to the first LAN.

37. (Original) The method as recited in claim 36, before the step of receiving the second touch input, further comprising the steps of: receiving a fourth touch input from the user on the IP telephone; and in response to receipt of the fourth touch input, scrolling through the first list.

38. (Original) The method as recited in claim 37, before the step of receiving the third touch input, further comprising the steps of: receiving a fifth touch input from the user on the IP telephone; and in response to receipt of the fifth touch input, scrolling through the second list.

39. (Cancelled)

40. (Previously presented) The method as recited in claim 36, wherein the first, second, and third LANs are coupled via a WAN.

### REMARKS

Claims 1-6, 8-10, 17-20, 22-38 and 40 are pending in the application.

Claims 1-6, 8-10, 17-20, 22-38 and 40 stand rejected.

#### I. REJECTIONS TO SPECIFICATION

The Examiner has requested that the related applications identified on page 1 of the Specification be updated. In response, Applicants have herein updated this portion of the Specification as requested.

#### II. REJECTIONS UNDER 35 U.S.C. § 103

Claims 1-3, 5-6, 8-10, 17-20 and 22-35 stand rejected under 35 U.S.C. § 103 as being unpatentable over *Guy et al.* (U.S. Patent No. 6,298,057) in view of *Wilson* (U.S. Patent No. 6,829,231). In response, Applicants respectfully traverse these rejections.

The Examiner's rejections rely specifically upon an interpretation that *Guy* discloses a list of the plurality of telecommunications extensions being stored in a server in the second LAN, which is accessed by the first circuitry across the WAN. The Examiner cites column 10, line 30-column 11, line 14 in support of this interpretation. Applicants traverse. This language within *Guy* does not support the Examiner's assertions. Instead, *Guy* teaches that if the server code is not in the local directory, then a request goes to a master directory which is located somewhere in network 100. Column 9, lines 23-28. The master directory only contains the server code. The server code only identifies the CSU 130 to which the destination telephone is connected. Column 10, lines 33-36. Additional digits are still required in order to telephone or contact the destination telephone from the originating telephone. Such additional digits are described in column 11, line 1-column 12, line 21. Such additional digits are taught within *Guy* to be generated in the first LAN without any transmission of this information from the second LAN to the first LAN.

The result of the foregoing is that the combination of *Guy* and *Wilson* does not teach or suggest circuitry within the first LAN for enabling a user of the first telecommunications device within that first LAN to observe a list of the plurality of telecommunications extensions coupled to the second LAN, wherein the list of the plurality of telecommunications extensions is stored in a server in the second LAN and is accessed by the first circuitry across the LAN. Instead, the most that the combination of references teaches is that when a telecommunications device in the first LAN desires to call a telecommunications device in the second LAN, it may access a master directory to find out the server code associated with the server in the second LAN to which the second telecommunications device may be coupled. This is only performed if the server codes are not already known by the server in the first LAN to which the first telecommunications device is coupled. The limitation of the teachings of the combination of *Guy* and *Wilson* is that a list of telecommunications device coupled to the second LAN is not accessible by first circuitry in the first LAN. As a result, a telecommunications device coupled to the first LAN is not able to observe such a list of telecommunications extensions in the second LAN and thereby make a call to such a telephone extension. This is an important distinction for several reasons. One of them is that it permits a user in one geographic location to locate a station user in another location without the need to use a printed extension guide. Page 20, lines 21-24. This would not be possible with the combination of references asserted by the Examiner, but is with the present invention.

As a result of the foregoing, one skilled in the art at the time the invention was made would not have been able to recreate the claimed invention in view of the combination of the references.

On page 4 of the Office Action, the Examiner has made assertions as to what *Wilson* teaches. Applicants respectfully traverse such assertions and incorporate by reference Applicants' arguments made in the previous amendment with respect to the teachings of *Wilson*.

With respect to Claims 26 and 32, the Examiner asserts that it is well known in the art to utilize the same button for multiple common inputs to simplify functionality. Applicants

respectfully traverse the assertion of what is well known in the art. As a result, the Examiner is required to support such an assertion with objective evidence.

With respect to Claims 28 and 34, Applicants respectfully traverse the Examiner's assertions. The Examiner has mischaracterized the limitations within these claims. These claims recite that the telephone destinations may include telephones external to the system. Such telephone destinations are included in a list stored in the second IP server in which are communicated from the second IP server over the WAN to the first IP telephone. This is not taught or suggested within *Wilson*. Applicants traverse the Examiner's assertion of what is well known in the art, requiring the Examiner to support such assertions with objective evidence.

Claim 4 stands rejected under 35 U.S.C. § 103 as being unpatentable over *Guy* in view of *Wilson* and further in view of *Stuntebeck et al.* (U.S. Patent No. 6,065,016). Applicants respectfully traverse this rejection for reasons similarly given above.

Claims 36-38 and 40 stand rejected under 35 U.S.C. § 103 as being unpatentable over *Wilson* in view of *Guy*. Applicants respectfully traverse these rejections for reasons similarly given above.

CONCLUSION

As a result of the foregoing, it is asserted by Applicants that the remaining Claims in the Application are in condition for allowance, and respectfully request an allowance of such Claims.

Applicants respectfully request that the Examiner call Applicants' attorney at the below listed number if the Examiner believes that such a discussion would be helpful in resolving any remaining problems.

We believe there to be no fee(s) due at this time, however, if we have calculated incorrectly, please apply any charges or credits to Deposit Account No. 06-1050, referencing Attorney Docket No. 21618-013001.

Respectfully submitted,

Date: Jan. 22, 2008

  
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### REMARKS

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The result of the foregoing is that the combination of *Guy* and *Wilson* does not teach or suggest circuitry within the first LAN for enabling a user of the first telecommunications device within that first LAN to observe a list of the plurality of telecommunications extensions coupled to the second LAN, wherein the list of the plurality of telecommunications extensions is stored in a server in the second LAN and is accessed by the first circuitry across the LAN. Instead, the most that the combination of references teaches is that when a telecommunications device in the first LAN desires to call a telecommunications device in the second LAN, it may access a master directory to find out the server code associated with the server in the second LAN to which the second telecommunications device may be coupled. This is only performed if the server codes are not already known by the server in the first LAN to which the first telecommunications device is coupled. The limitation of the teachings of the combination of *Guy* and *Wilson* is that a list of telecommunications device coupled to the second LAN is not accessible by first circuitry in the first LAN. As a result, a telecommunications device coupled to the first LAN is not able to observe such a list of telecommunications extensions in the second LAN and thereby make a call to such a telephone extension. This is an important distinction for several reasons. One of them is that it permits a user in one geographic location to locate a station user in another location without the need to use a printed extension guide. Page 20, lines 21-24. This would not be possible with the combination of references asserted by the Examiner, but is with the present invention.

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Claim 4 stands rejected under 35 U.S.C. § 103 as being unpatentable over *Guy* in view of *Wilson* and further in view of *Stuntebeck et al.* (U.S. Patent No. 6,065,016). Applicants respectfully traverse this rejection for reasons similarly given above.

Claims 36-38 and 40 stand rejected under 35 U.S.C. § 103 as being unpatentable over *Wilson* in view of *Guy*. Applicants respectfully traverse these rejections for reasons similarly given above.

CONCLUSION

As a result of the foregoing, it is asserted by Applicants that the remaining Claims in the Application are in condition for allowance, and respectfully request an allowance of such Claims.

Applicants respectfully request that the Examiner call Applicants' attorney at the below listed number if the Examiner believes that such a discussion would be helpful in resolving any remaining problems.

We believe there to be no fee(s) due at this time, however, if we have calculated incorrectly, please apply any charges or credits to Deposit Account No. 06-1050, referencing Attorney Docket No. 21618-013001.

Respectfully submitted,

Date: Jan. 22, 2008

  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/447,607	05/29/2003	Eric G. Suder	21618-013001	6094
26201	7590	04/01/2008	EXAMINER	
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			MAIL DATE	DELIVERY MODE
			04/01/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



### DETAILED ACTION

- Applicant's Amendment filed 1/22/2008 is acknowledged.
- The previous objection to the specification is withdrawn in light of the present amendments to the specification.
- No amendments have been made to claims 1-6, 8-10, 17-20, 22-38 and 40, which remain pending.

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-3, 5, 6, 8-10, 17-20, and 22-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guy et al. (US006298057B1), hereafter Guy, in view of Wilson (US006829231B1).

- Regarding Claims 1-3, 5, 6, 8-10, 17-20, 22-25, 27, 29-31, 33, and 35, Guy discloses a system and method for coupling a first LAN 102A having server 112 to a second LAN 102B having server 122 through WAN 104 utilizing IP capabilities of the LANs and WAN (Fig. 1; Col. 1, lines 51-53; Col. 14, lines 13-17; claim 1,8,17,24,30 – method in a information handling system comprising a first LAN; claim 1,8,17,24,30 - a second LAN; claim 1,8,17,24,30 – WAN

coupling the first LAN to the second LAN; claim 2,17,30 – LANs and WAN operate under IP protocol; claim 24,30 – first and second IP servers within first and second LANs).

Fig. 1 also shows that a plurality of telecommunications devices are coupled to the first and second LANs 102A/B (claim 1,8,17,24,30 - first telecommunications device coupled to the first LAN; claim 1,8,17,24,27,33 - plurality of telecommunications extensions/destinations coupled to the second LAN).

Guy discloses the ability to connect a phone of the first LAN 102A to a destination phone of the second LAN 102B (Col. 6, lines 4-11; Col. 10, lines 1-7). Guy further discloses each file server 112/122 includes a directory (Fig. 4, 406) that stores a list of server codes and additional information to identify devices attached to each server (Col. 10-11, lines 30-14; claim 1,8,17,30 - wherein the list of the plurality of telecommunications extensions is stored in a server in the second LAN, and is accessed by the first circuitry across the WAN). Guy also discloses a master directory in a server of network 100 containing the information stored in each local directory (Col. 9, lines 20-25).

However, Guy does not explicitly disclose the user of the phone in the first LAN observing a displayed list of extensions to phones in multiple (second and third) local networks remote of the user's LAN and automatically initiating a call in response to the user selecting one of the extensions from the observed list. Guy also does not explicitly disclose the user's phone as an IP phone having display

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and keys for user to enter first and second inputs for displaying and selecting/initiating a call, circuitry to scroll through the displayed list.

Wilson discloses an IP phone user can access a directory engine through the Internet (WAN) for displaying a list of numbers/addresses (extensions) obtained from multiple (second and third) local exchange network switches and ISPs that are remote to the user. Wilson further discloses the user initiates a call by selecting a destination from a scrolled list of potential destinations (Fig. 5,6; Col. 7-8, lines 45-15; claim 1,8,17,24,30 - first LAN including first circuitry for enabling a user of the first telecommunications device to observe/view a list of the plurality of telecommunications extensions; claim 1,8,18,24,30 - first LAN including second circuitry for automatically calling one of the plurality of telecommunications extensions in response to the user selecting one of file plurality of telecommunications extensions from the observed list; claim 3,8,24,30 – list is displayed to user of the first device; claim 5,6,8,17,19,20,24,25,30,31 – first device is IP phone having display and keys for user to enter first and second inputs for displaying and selecting/initiating a call to an extension in the second LAN over the WAN; claim 9,22 – circuitry to scroll through displayed list; claim 10,23,29,35 – a third LAN and first LAN circuitry for selecting and viewing a list of a plurality of extensions coupled to the second and/or third LAN).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Guy by enabling a first device to observe a list of extensions in a remote LAN and initiating a call to a displayed number in response to selection by a user, as shown by Wilson, thereby enabling the first



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phone to connect to a destination phone if the number associated with the destination phone is unknown and remote of the user's LAN.

- Regarding Claims 26 and 32,

Guy discloses all limitations of the parent claims.

Neither Guy nor Wilson discloses first and second inputs using the same button.

However, it is well known in the art to utilize the same button for multiple common inputs to simplify the functionality (claim 26,32 – first and second inputs use same button).

It would have been obvious to one of ordinary skill in the art at the time of the invention to use the same button for the first and second inputs disclosed by Wilson, in order to improve the ease of use for the user.

- Regarding Claims 28 and 34,

Guy discloses all limitations of the parent claims.

Neither Guy nor Wilson explicitly discloses destinations include telephones external to the system.

However, it is well known that local exchange switches such as those shown by Wilson are able to connect to other exchanges outside of the local system, such as over a dedicated T1 trunk (claim 28,34 – destinations includes telephones external to the system).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Guy and Wilson by enabling destinations to be telephones external to the system, thereby providing the disclosed directory services to as many capable users as can be supported.

3. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Guy in view of Wilson above, and further in view of Stuntebeck et al. (US006065016A), hereafter Stuntebeck.

- Regarding Claim 4,

Guy discloses a system as shown above in the rejection of claim 1 and 2.

Neither Guy nor Wilson discloses a list played to a user as audio.

Stuntebeck discloses a universal directory server (UDS) that provides remote access to the communication addresses (extensions) associated with numerous institutions, including LANs (Fig. 1; Abstract). Stuntebeck discloses a user can access the UDS through a voice recognition system, in which results are conveyed to the user as voice (audio; Col. 4, lines 17-25; claim 4 – list is played as audio to the user of the first device).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Guy and Wilson by enabling the list to be played as audio to the user, as shown by Stuntebeck, thereby allowing users to access directory services without a visual display.

4. Claims 36-38 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilson in view of Guy.

- Regarding Claim 36-38 and 40,

Wilson discloses an IP phone connects to Internet (WAN) through multiple (first, second, third) local switches and network switches, and a user can use the alphanumeric keypad to make a request of callee search (Fig. 5; Col. 7, lines 45-67; claim 36 - in response to receipt of first input, displaying on a display on the IP telephone a first list including second and third LANs coupled to the first LAN, wherein the second and third LANs operate under the IP protocol; claim 40 – first, second, and third LANs coupled via WAN).

Wilson further discloses the screen on the caller's side can display multiple result numbers of callees in a scrolled list after the search engine replies to the search request (Col. 7, lines 46-67 and Col. 8, Lines 1-17; claim 36 - receiving another input from the user on the IP telephone; in response to receipt of the input, displaying on the display on the IP telephone a second list of telephone destinations accessible from the second LAN; claim 37 – scrolling through the list in response to fourth input).

Wilson then shows that the caller can select the proper callee's name display from the scrolled list of multiple results to initiate a call (Col. 8, lines 13-15; claim 36 - in response to receipt of third input, automatically dialing one of the telephone destinations accessible from the second LAN for a communications

connection between the one of the telephone destinations and the IP telephone;  
claim 38 – scrolling through the list in response to fifth input).

Wilson does not explicitly show that the callee lists are received from a second LAN in response to sending a request message from the first LAN.

Guy discloses a system and method for coupling a first LAN 102A having server 112 to a second LAN 102B having server 122 through WAN 104 utilizing IP capabilities of the LANs and WAN. Guy discloses the ability to connect a phone of the first LAN 102A to a destination phone of the second LAN 102B (Col. 6, lines 4-11; Col. 10, lines 1-7). Guy further discloses each file server 112/122 includes a directory (Fig. 4, 406) that stores a list of server codes and additional information to identify devices attached to each server (Col. 10-11, lines 30-14), while also disclosing a master directory in a server of network 100 containing the information stored in each local directory (Col. 9, lines 20-25; claim 36 - displaying on the display on the IP telephone the second list further includes the steps of sending a request message for the list from the first LAN to the second LAN and receiving the second list from the second LAN to the first LAN). It would have been obvious to one of ordinary skill in the art at the time of the invention to supply the Internet database in Wilson from local directories stored in each respective LAN segment of a network, as shown by Guy, thereby ensuring that the Internet (master) directory is up to date.

***Response to Arguments***

5. Applicant's arguments filed 1/22/2008 have been fully considered but they are not persuasive.

- In the Remarks on pg. 11-13 of the Amendment, Applicant contends that the combination of Guy and Wilson does not support the rejection of the pending claims. Applicant alleges the disclosure of Guy cited in the rejection only teaches of server codes in local and master directories, and not the claimed "list of the plurality of telecommunications extensions coupled to the second LAN". Further and quite separately, Applicant counters the cited disclosure of Wilson by referring to arguments presented in the amendment filed 8/17/2007, which pertain to the rejections of claims as anticipated by Wilson.
- The Examiner respectfully disagrees. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).
- Applicant's previous arguments filed 8/17/2007 with respect to Wilson's lack of disclosure of a list stored in a server in the second LAN are irrelevant to rejections based on the combination of Guy and Wilson,

since the cited disclosure of Guy clearly meets this limitation. The deficiency in Guy highlighted by Applicant, i.e. that the cited disclosure does not recite a “list of the plurality of telecommunications extensions coupled to the second LAN”, is met by the cited disclosure of Wilson, where the combination of Guy and Wilson properly rejects the pending claims.

### ***Conclusion***

**6. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory B. Sefcheck whose telephone number is 571-272-3098. The examiner can normally be reached on Monday-Friday, 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wing Chan can be reached on 571-272-7493. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Gregory B Sefcheck/  
Examiner, Art Unit 2619  
3-27-2008

/Wing F Chan/  
Supervisory Patent Examiner, Art  
Unit 2619  
3/27/08





observe a list of the plurality of telecommunications extensions. These elements are shown in Fig. 3 with the first and second LANs represented as any one of LANs 301-303 and the WAN 201 that couples any first and second LAN. Each of the LANs shows telecommunications devices coupled thereto. The LANs 301-303 also show a plurality of telecommunications extensions, e.g., IP telephones 105, 308, 313. See paragraphs [0031] - [0034]. Fig. 11 shows a process for enabling a user of a first telecommunications device in the first LAN to observe a list of a plurality of telecommunications extensions coupled to the second LAN. See paragraphs [0088] - [0089]. Fig. 8 illustrates a block circuit diagram of a telecommunications device that includes a display 810. See paragraphs [0075] - [0077]. Figs. 11 and 9A-9B illustrate selecting one of the extensions from the observed list and calling that extension. See paragraphs [0088] - [0089] and [0103]. This process is also illustrated by the state diagram in Fig. 12. See paragraph [0090].

Claim 4 recites limitations similar to Claim 1 (therefore, see citations to figures and specifications above with respect to Claim 1), with an additional limitation that the list of the telecommunications extensions is played as audio to the user of the first telecommunications device. The telecommunications device diagram in Fig. 8 shows a speaker 821.

Claims 8, 17 and 24 recite an information handling system similar to the one recited in Claim 1 (therefore, see citations to figures and specifications above with respect to Claim 1), with additional limitations the first telecommunications device is an IP telephone and a user of that IP telephone tacitly selects one of the observed extensions from the list which results in an initiation of the call to that telecommunications extension across the WAN. Further, Claims 8, 17 and 24 recite that the list of the plurality telecommunications extensions is stored in a server in the second LAN and is accessed by the first circuitry across the WAN. The IP telephones are shown in various figures, including Figs. 3 and 8. Fig. 11 illustrates a step for selecting the telecommunications extension from the list that is displayed for initiating the call, which proceeds to Fig. 9A. Figs. 11, 12, and 14 among others illustrate the storage of the list of telecommunications extensions in the second LAN, the list then being accessed across the WAN by the first LAN. See paragraphs [0031] - [0034], [0075] - [0077], [0088] - [0089], and [0090].

Further, the basic concept of accessing a list across the WAN and then making a call is described in paragraphs [0082] and [0087].

Claim 30 recites a telecommunications systems comprising a first IP telephone coupled to a first IP server within a first LAN, second and third telephone extensions coupled to a second IP server within a second LAN, and a WAN coupling the first LAN to the second LAN, the first LAN, the second LAN, and the WAN communicating using an IP protocol. These features are similar to those discussed above with respect to Claims 1, 4, 8, 17, and 24, and are well supported within the aforementioned figures and specification, such as Fig. 3 and its supporting specification recitations noted above with respect to Claim 1. See paragraphs [0031] – [0034], [0075] – [0077], [0088] – [0089], and [0090]. Claim 30 further recites a means for displaying on the first IP telephone a list of telephone destinations stored in the second IP server in response to selection of a first input on the first IP telephone, wherein the list of telephone destinations is communicated from the second IP server over the WAN to the first IP telephone. An IP telephone 105 is illustrated in Figs. 1 and 3, and is shown in more detail in Fig. 8, which shows that the IP telephone 105 has an LCD display 810. See paragraphs [0075] – [0077]. IP servers within the LANs are as shown in Fig. 3, including IP server 101 and IP server 306. IP server 101 is also shown in Figs. 1 and 2. Fig. 4 shows that IP server 101, which is representative of any of the IP servers, including IP server 306, has a hard drive 403. As a result, a list of telephone destinations may be stored within such a hard drive. Selection of a list displayed on LCD display 810 of the IP telephone shown in Fig. 8 can be performed using such input devices as the keyboard 807 or a DSS console 811. Fig. 8 in such features are discussed in paragraphs [0075] – [0081]; selection of an extension from a list is also discussed in paragraphs [0082] – [0087]. The process for permitting a user to view and select extensions on the first IP telephone is illustrated in Fig. 11, which is discussed in paragraphs [0088] – [0089]. Also there is an establishment of a connection between the two remote LANs with respect to Fig. 14, which includes a description of the sending of a message from one LAN to the other in order to request a list of the telephone extensions, which are then communicated from that second LAN over the WAN to the first WAN and specifically the IP telephone. Further, Fig. 12 illustrates a state diagram of this process, which is described in paragraph [0090]. Automatic dialing of the selected telephone

destination and a response to selection of one of the telephone destinations from a displayed list is described in paragraphs [0089] – [0090].

Claim 36 recites a method for receiving several touch inputs from a user on the IP telephone that is networked into the LAN/WAN/LAN network described above and with respect to Fig. 3 in order to again permit such a user to view a display telephone extensions at a remote LAN, and then automatically dialing that telephone destination. Claim 36 includes steps for sending a message from the first LAN to the second LAN requesting the list of telephone extensions from the second LAN, which is delivered to the first LAN from the second LAN. Claim 36 includes steps whereby a first list of second and third LANs coupled to the first LAN is provided, and then a second list of telephone destinations at a selected LAN are then provided. Such steps are shown in Figs. 11, 12, and 14 as noted above. See paragraphs [0088] – [0089] and [0090].

IV. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

1. Claims 1-3, 5-6, 8-10, 17-20 and 22-35 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Guy et al.* (U.S. Patent No. 6,298,057) in view of *Wilson* (U.S. Patent No. 6,829,231).
2. Claim 4 stands rejected under 35 U.S.C. §103(a) as being unpatentable over *Guy* in view of *Wilson* and further in view of *Stuntebeck et al.* (U.S. Patent No. 6,065,016).
3. Claims 36-38 and 40 stand rejected under 35 U.S.C. § 103 as being unpatentable over *Wilson* in view of *Guy*.

## VII. ARGUMENT

1. Claims 1-3, 5-6, 8-10, 17-20 and 22-35 are not properly rejected under 35 U.S.C. § 103 as being unpatentable over *Guy* in view of *Wilson*.

The basic test for nonobvious subject matter is whether the differences between the subject matter and the prior art are such that claimed subject matter as a whole would not have been obvious to a person having ordinary skill in the art to which a subject matter pertains. The United States Supreme court in *Graham v. John Deere & Co.*, 383 U.S. 1 (1966) set forth the factual inquiries which must be considered in applying the statutory test: (1) a determination of the scope and contents of the prior art; (2) ascertaining the differences between the prior art and the claims at issue; and (3) resolving the level of ordinary skill in the pertinent art.

In determining the scope and contents of the prior art, the Examiner must first consider the nature of the problem on which the inventor was working. Once this has been established, the Examiner must select, for purposes of comparing and contrasting with the claims at issue, prior art references which are reasonably pertinent to that problem. In selecting references, hindsight must be avoided at all costs.

In ascertaining the differences between the cited prior art and the claims at issue, the Examiner must evaluate the claimed subject matter as a whole; there is no requirement that any differences between the claimed subject matter and the cited references be "remarkable" nor that some technological discontinuity between the claimed invention and subject matter exists just outside the claims. The requisite view of the whole invention mandates consideration of not only its structure, but also of its properties and the problems solved. Further, the mere fact that the prior art can be modified does not make the modification obvious unless the prior art suggests the desirability of the modification; there must be some logical reason apparent from positive, concrete evidence that justifies the modification.

In resolving the level of ordinary skill in the pertinent art, the Examiner must step backward in time and into the shoes worn by the person of ordinary skill when the invention was

unknown and just before it was made. The hypothetical person skilled in the art can summarily be described as one who thinks along lines of conventional wisdom in the art and neither one who undertakes to innovate nor one who has the benefit of hindsight. Thus, neither an Examiner, nor a Judge, nor a genius in the art at hand, nor even the inventor is such a person skilled in the art.

*Guy* teaches a system and method for transparently transmitting aural signals across a LAN, where a user places a telephone call using the same procedure that is used when placing a telephone call over a conventional public switch network, and in certain situations if the server code is not in the local directory, then a request goes to a master directory. Column 3, lines 39-48; column 9, lines 23-28. Referring to Fig. 1 in *Guy*, the first LAN maybe represented by 102A, the WAN by 104, and the second LAN by 102B. (Note that Applicants do not necessarily admit that 102A is a local area network, since a local area network is shown in Fig. 1 as 116; however, for the sake of arguing against the rejection, 102A will be designated as the first LAN.) *Guy* describes a set-up operation for when a first telephone 106 wishes to make a call to a user at a second telephone 126, where the first telephone 106 is coupled to a file server 112, and the second telephone is coupled to a CSU 130 via a PBX 128. Column 6, lines 45-51; column 10, lines 7-9. Fig. 2 illustrates a more detailed illustration of file server 112. Column 6, lines 52. Fig. 5 also further has a description of a flow chart illustrating such a call set-up procedure. Column 9, line 66. A user activates the telephone by lifting the handset and selecting the channel line in order to transition to an off-hook state period. Column 10, lines 7-9. The user then performs the normal process of dialing a telephone number on the first telephone 106 (as described below, this telephone number is not provided to the user by the system), with the telephone associated with the second telephone 126, and a procedure is then implemented across network 104 just as if the user were making a call over a conventional public telephone system. Column 10, lines 13-17. Thus, such a procedure is completely transparent to the user and they do not have to re-learn how to use a telephone system other than what has been normally done in the prior art POTS systems. Column 10, lines 25-29. The telephone number dialed by the user on telephone 106 identifies the destination telephone 126. Column 10, lines 30-31. It is the first set of digits that are dialed by the user that identifies the destination CSU 130 to which the

second telephone 126 is connected to the second LAN 134. This first set of digits is referred to in *Guy* as the server code. Column 10, lines 32-36. In other words, the server code operates the same as an area code in the POTS. All within the first LAN 102A, a call set up unit 404 within a server memory module 214 that is in server 112 makes an attempt to retrieve such a server code from the memory module 212, which is then transmitted to the directory management unit 408. Column 10, lines 55-58. Again, this is all performed within the first LAN 102A. The directory management unit 408 searches the local directory 406 for a server that is identified with the server code dialed by the user, and if there are no server matches, then the directory management unit 408 will generate a request to a master directory, which will make a determination if the server code dialed by the user on the first telephone 106 is identified with any server in the network 100. Column 10, lines 58-65. If the server code is identified in such a master directory, then the network address of the destination CSU 130 associated with the server code is transmitted to the directory management unit 408. Column 11, lines 2-8. The directory management unit 408 transmits this network address to the call set up and tear down unit 404, which transmits the number of additional digits to the call management unit 310, and the call set-up/tear down unit 404 transmits a call set up packet to the destination CSU 130, which receives the set up packet and determines if the telephone 126 is available to receive the call. Column 11, lines 11-28.

Thus, in *Guy*, nothing more is taught than the caller on first telephone 106 dialing digits associated with the destination telephone 126. There is absolutely no teaching or suggestion within *Guy* that a list of a plurality of telecommunications extensions coupled to the second LAN is provided to the user of the first telephone 106 for observation, or hearing them. The server code accessed from the master directory is only associated with the CSU 130, and does not provide any further information that would enable the combination of the disclosures of *Guy* and *Wilson* to display a list of the telecommunications extensions coupled to the second LAN. The user in *Guy* must still rely upon a phone list that is external from the system described in *Guy* in order to make a telephone call in the network. The master directory only contains the server code. The server code only identifies the CSU 130 to which the destination telephone is connected. Column 10, lines 33-36. Additional digits are still required in order to telephone or

contact the destination telephone from the originating telephone. Column 11, line 1-column 12, line 21. There is further no teaching or suggestion within *Guy* that a list of extensions is provided from anywhere else in the network.

There is absolutely no teaching or suggestion in *Guy* to help out a user by providing the user with a list of extensions in a LAN within the *Guy* network.

In order to overcome the deficiencies of the teachings of *Guy*, the Examiner has added *Wilson* to combine with *Guy*. A problem with the Examiner's combination of *Wilson* and *Guy* is that the Examiner has expanded the teachings of *Wilson* beyond what is reasonable. The invention described in *Wilson* is sort of a hodgepodge device 50 created to permit a user to send audio packets to another user using internet addressing. *Wilson* attempts to simplify the use of the Internet for long-distance calling applications. Column 2, lines 31-32. *Wilson* merely provides a system that has services similar to those found on the POTS. See the Abstract. A list of known callees can be stored inside the device described in *Wilson*, and for unknown callee addresses, a method for retrieving such an address for a remote location is provided. Column 2, lines 47-53. The hodgepodge device 50 is shown in Fig. 2, with its circuit diagrams shown in Fig. 3. Telephone calls over the PSTN can be made with device 50 by making normal voice DTMF telephone calls using the keypad 65. Column 4, lines 60-64. Note that this mode is performed only when the user already knows the telephone number of the callee, and does not play into the description of the invention within *Wilson* that the Examiner is relying upon.

Internet access can be made by the device 50 by the user pressing the Internet access button 69 to switch between normal DTMF voice calls and internet dial-up operations, where an internet connection is made using an internal modem set. Column 5, lines 5-11. The device 50 can be connected using an RS232 jack 86 to a computer 90, but there is no further discussion of connecting the device 50 to a local area network, or LAN. Column 5, lines 33-38.

Referring to Figs. 4 and 5 in *Wilson*, each of the dial pads 50 is now referred to as dial pads 201, 202 and 203, which are each connected to PSTN circuits 204. Column 7, lines 15-17.

The PSTN circuits 204 and a local exchange switch 205 form a local telephone network within a geographic area. Column 7, lines 17-19. A similar situation is associated with the callee devices 245, 246, 247. It important to note that dial pads 201, 202 and 203 are not part of a LAN. A LAN is a data network that permits all of the devices on the network to communicate with each other, such as with the use of an Ethernet protocol. Such a LAN is disclosed in the specification of the present application in paragraph [0028], and shown in FIG. 1. A LAN, as is well known in the art, is a short distance data communications network used to link computers and peripheral devices under some form of standard control. Such a definition for a LAN is found in *Newton's Telecom Dictionary*. That definition also further states that "A LAN does not use common carrier circuits." It is clear that the dial pads 201-203 and callees 245-247 taught in *Wilson* are not connected in a LAN. More specifically, dial pads 201-203 are not coupled together in a LAN, and callees 245-247 are not coupled together in a LAN. Each of these devices 50 is separately connected to the PSTN via jacks 80 and 82 that provide a dual line access to the PSTN. Column 5, lines 25-26. A dual line service is a telephone service where two pairs of wires are connected to a premises for connection to the PSTN. See *Newton's Telecom Dictionary*. This is further supported in *Wilson* by the more detailed diagram of a dialing pad 50 in Fig. 3 which shows that the dual line access is provided by typical tip and ring connections 102 that enable the transfer of an analog signal over this dual line connection. Column 5, lines 50-56. Such internet access also requires use of a modem data pump 112. Column 6, lines 19-27. The only LAN disclosed in *Wilson* is that associated with the internet service providers (ISPs) shown in Figs. 4 and 5.

As a result, the only way each of the dial pads disclosed in *Wilson* can access the internet is by using typical dial-up modem message interchanges. And, this is the only way one of the dial pads 201-203 can communicate with one of the callees 245-247. In other words, for one of the dial pads 201-203 to "call" one of the callees 245-247, that particular callee must have an already established audio internet connection so that it is prepared to receive any audio messages from one of the dial pads 201-203. Column 7, lines 28-31. If such a callee is not already connected to the internet when it receives a message to perform audio communication from one



of the dial pads 201-203, then that callee will have to dial up into their internet service provider and obtain the sent audio message at a later time. Column 7, lines 31-33.

If the internet (IP) address of one of the callees 245-247 is not stored within a database of one of the dial pads 201-203, then the dial pad can make an internet access through internet service provider 215 to browse a user database directory 232 through a search engine 230, which stores such IP addresses, and return that IP address to the dial pad. Column 7, lines 46-64. This provides a process whereby a user of a dial pad 201-203 does not need to know the actual internet IP address of one of the callee devices 245-247, but can use a search engine 230 to enter in some other designation (e.g., alphanumeric identifier; column 7, lines 52-53 and column 8, line 59) for one of the callees 245-247, such as a user's name, to thereby have that search engine retrieve the internet IP address from a website to the dial pad 201-203. Column 8, lines 1-15. If more than one hit is made by the search engine 230, a list of names can be returned to the dial pad, and the caller using one of the dial pads 201-203 can select the one they wish from the list by looking at the list on the screen 71 of the device 50. Column 8, lines 13-50.

It should be noted that the main distinction between the device 50 shown in Fig. 5 of *Wilson* from Fig. 4 is that a single user database 232 can be accessed by a wide range of ISPs at different locations. Column 8, lines 29-30. Otherwise, the configuration in Fig. 5 is the same as the one in Fig. 4 for purposes of how *Wilson* might be relevant to the rejection in accordance with the Examiner's assertions.

Fig. 6 in *Wilson* describes an exemplary call progress flow diagram for connecting one of the dial pads 201-203 to the directory search engine 230. Column 8, lines 50-51. Note that Fig. 6 in *Wilson* does not describe the part of the flow whereby one of the dial pads makes an internet connection to one of the callees. The process *Wilson* starts with has one of the dial pads 201-203 dialing out to establish an internet connection 360 using the modem 112. Column 8, lines 52-53. Once this internet dial-up connection is made, then the user of the dial pad can enter a known internet IP address number to access, over the internet, one of the callees 245-247, or start a search for the IP address of one of the callees if it is not known. This is shown by step 370 in

Fig. 6. The search engine will perform a search 372 and respond 374 by transmitting the results 376 of that search back to the dial pad 201-203. Column 8, lines 59-65. The user of the dial pad selects a callee from the list delivered by the search engine, and the user can then accept one of the addresses provided and dial to the selected callee. Column 9, lines 1-4. It should be noted at this point that *Wilson* does not teach that one of the dial pads 201-203 is able to automatically perform the dialing process in response to some sort of selection of a name on a displayed list by the user of the dial pad 50 pressing some sort of button to select one of the names. Instead, *Wilson* merely teaches that the user can apparently view the IP address of the callee and enter in that address using the dial pad's keyboard 63. Column 8, lines 13-15.

Therefore, all that *Wilson* teaches is (1) a specialized device 50 that is a combination of a dial pad/modem that is able to access the internet with a dial-up connection over the PSTN circuits (and can also act as a normal PSTN telephone where a user can enter in PSTN-type telephone numbers to call another PSTN telephone), and (2) an ability for one of the specialized devices 50 to have audio communications with another specialized device 50 over an internet channel whereby a connection is made between these two specialized devices using typical IP internet addresses, and (3) if the IP address of a callee is not known, then an internet search engine can be used to browse to access a database on the internet that will retrieve such an IP address that is then displayed to a user of a specialized device so that the user can then enter in that IP address to the specialized device to establish the audio connection over the internet. The teachings of *Wilson* clearly show that its invention was not created to operate in a voice-over IP system with capabilities such as recited in the present claims. See column 2, lines 1-5.

All that *Guy* teaches is an ability for a telephone connected to a first LAN to communicate over a WAN to a telephone in a second LAN, and if the directory management unit of a file server in the first LAN does not know the address of a central site unit connected to a PBX in the second, it can retrieve that server code from a remote location for completing the call between the two telephones.

With respect to Claim 1 and all the other rejected claims, a result of the foregoing is that the combination of *Guy* and *Wilson* does not teach or suggest circuitry within the first LAN for enabling a user of the first telecommunications device within that first LAN to observe a list of the plurality of telecommunications extensions coupled to the second LAN, wherein the list of the plurality of telecommunications extensions is stored in a server in the second LAN and is accessed by the first circuitry across the LAN.

The combination of *Guy* and *Wilson* does NOT provide to the user of the first device in the first LAN the list of extensions the user can call in the second LAN and then a means to automatically initiate that call with a selection from that list. *Guy* provides nothing to the user of the telephone, and *Wilson* has no LANs (and as a consequence, no lists of extensions coupled to a LAN).

*Guy* does not provide any type of information identifying any type of telecommunications device within the second LAN 102B to a user of a telecommunications device within the first LAN 102A. Instead, merely a server code is provided to the directory management unit 408 so that it can complete the call when it receives the dialing digits from the telephone so that it knows what LAN to send the call to. Further, *Wilson* also does not provide a list of telecommunications devices coupled to the second LAN. In fact, callees 245-247 are not part of a LAN. More than one entry might be supplied by the search engine 230 accessing the database 232 back to one of the dial pads 201-203 for display to the user, but the fact that there is a plurality returned is only a result of the fact that the user entered in search terms that matched more than one entry in the database 232. There is nothing within *Wilson* that teaches or suggests that those plurality of entries returned for display to the user are all coupled to a separate LAN over network 210, or that such a list of search results would even list more than one of the callees 245-247.

A result is that the combination of the references does not teach or suggest that a list of the plurality of telecommunications extensions coupled to the second LAN is provided to the user of the first telecommunications device for observation.

And further, neither of the references, nor their combination, teaches circuitry for automatically calling one of those telecommunications from that list in response to the user selecting one of those extensions from the observed list. *Guy* does not even approach such a process, since the retrieval of the server code is done in response to the dialing of a telephone number already performed by the user. Further, as noted above, *Wilson* also does not teach or suggest such an automatic calling of the extension, but instead provides the list on the display 71 on one of the dial pads 201-203 so that the user can then enter in the IP internet address on the keypad 63.

The Examiner has failed to prove a *prima facie* case of obviousness because important limitations are not found within any of the cited prior art references. MPEP § 2143.03 states that to establish *prime facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

This is further an important distinction for several reasons. One of them is that it permits a user in one geographic location to locate a station user in another location without the need to use a printed extension guide. See Specification, page 20, lines 21-24. This would not be possible with the combination of references asserted by the Examiner, but is implemented with the present invention as claimed.

Furthermore, neither of the references, nor their combination, teaches or suggests that such a list of telecommunications extensions coupled to the second LAN is stored in a server in that second LAN.

Moreover, with respect to Claim 2, the Examiner has not shown how the combination of references teaches a LAN or WAN operating under an IP protocol. *Guy* does not disclose its LANs or WAN operating under an IP protocol, and *Wilson* does not disclose LANs with telephone/telecommunications extensions coupled thereto.

Claim 5 recites that the second circuitry that automatically makes the call to the remote telecommunications extension includes a key for enabling the user to tacitly select one of those extensions from the displayed list. The Examiner admits that *Guy* does not teach such a process. In fact, it is impossible for *Guy* to teach or suggest this process, since a list is nowhere to be provided to the calling user. The Examiner asserts that *Wilson* discloses this process, since *Wilson* states that the user may select a destination from this scrolled list of potential destinations. All that *Wilson* discloses is that the caller has an option of selecting from a displayed scrolled list of potential users by using the keyboard 63 to select the intended caller. *Wilson* in no way further describes what is done in response to that action. Claim 5 recites that the second circuitry includes a key for enabling the user to make such a tacit selection from the displayed list. However, second circuitry also recites automatically calling one of the extensions in response to such a selection by the user. *Wilson* teachings do not go that far, and there is no flow diagram, circuitry or any other discussion or mention within *Wilson*, or *Wilson* in combination with *Guy*, that would suggest such an automatic calling of the remote party by selection of one of the extensions in the list by a user pressing a button. Therefore, one skilled in the art at the time the invention was made would not be able to create the invention recited in Claim 5 in view of the combination of the teachings of the prior art references.

With respect to Claim 6, the foregoing arguments made with respect to Claim 5 are incorporated. Claim 6 further recites that the initiation of the call is made by that tacit selection of that button when a user presses that button to select one of the names from the list. This is in no way taught or suggested by the prior art references.

Claim 8 is patentable over the cited references for all of the arguments provided herein with respect to Claims 1-6. Claim 8 also recites that the list of plurality of telecommunications extensions stored in a server in a second LAN is accessed by the first circuitry in the first LAN across the WAN. As noted above, there is no teaching or suggestion within the combination of the references that a list of the telecommunications extensions coupled to the second LAN are stored in a server in that second LAN. Thus, there is also no teaching or suggestion that this list

is then accessed from the server in the second LAN across the WAN by circuitry in the first LAN that enables the user of the first telecommunications device to observe this list of the plurality of telecommunications extensions.

Claim 10 recites a third LAN coupled to the first and second LANs via the WAN. The third LAN includes a plurality of telecommunications extensions coupled thereto. The first LAN has circuitry that enables a user in that first LAN to select between observing between a list of the plurality of telecommunications extensions coupled to the second LAN or observe a list of the plurality of the telecommunications extensions coupled to the third LAN. In addressing this claim language, all the Examiner has done is to imply that *Wilson* teaches "a third LAN and first LAN circuitry for selecting and viewing a list of a plurality of extensions coupled to the second and/or third LAN."

First, this is a wholly inadequate rejection by the Examiner, and does not provide enough evidence to support a *prime facie* case of obviousness. The Examiner is required to prove such a suggestion by objective evidence. *Ex parte Levengood*, 28 U.S.P.Q.2d 1300, 1301 (Bd. Pat. App. & Int. 1993); *Ashland Oil, Inc. v. Delta Resins and Refractories, Inc.*, 776 F.2d 281, 227 U.S.P.Q. 657 (Fed. Cir. 1985). The legal conclusion of obviousness must be supported by facts. *Graham v. John Deere & Co.*, 383 U.S. 1 (1966). A rejection based on § 103 clearly must rest on a factual basis, and these facts must be interpreted without hindsight reconstruction of the invention from the prior art. The patentability of an invention is not to be viewed with hindsight or "viewed after the event." *Goodyear Company v. Ray-O-Vac Company*, 321 U.S. 275, 279, 64 S.Ct. 593, 88 L.Ed. 721 (1944). Instead of relying upon objective evidence to support the Examiner's assertion, the Examiner has merely supported such an obviousness rejection with the Examiner's own opinion, which is quite clearly not objective evidence as is required by the case law.

Secondly, as noted above, *Wilson* does not teach or suggest that any of the dial pads 201-203 or 245-247 are coupled to each other within a LAN. Third, as noted above, a list of such callees 245-247 is not provided by the database 232 through the search engine 230 to one of dial

pads 201-203. Fourth, there is no teaching or suggestion within the combination of references for enabling a user in the first LAN to select between observing a list of extensions coupled to the second LAN or observing a list of extensions coupled to the third LAN. The Examiner has failed to provide a *prima facie* case of obviousness because important limitations are not found within any of the cited prior art references. As noted previously, MPEP § 2143.03 states that to establish *prime facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Claim 17 is patentable for reasons similarly given herein with respect to Claims 1-6 and 8.

Claim 18 is patentable for reasons similarly given herein with respect to Claims 1-6 and 8.

Claim 19 is patentable for reasons similarly given herein with respect to Claim 8.

Claim 20 is patentable for reasons similarly given herein with respect to Claims 5 and 8.

Claim 23 is patentable for reasons similarly given herein with respect to Claim 10.

Claim 24 is patentable for reasons similarly given herein with respect to Claims 1-6, 8 and 17.

Claim 30 incorporates "means for" language that the Examiner must interpret under 35 U.S.C. § 112, sixth paragraph. The Examiner must interpret and examine this claim and others with means for language under this doctrine. See MPEP § 2182, 2183. Claim 30 recites a means for displaying on the first IP telephone a list of telephone destinations stored in the second IP server in response to selection of a first input on the first IP telephone. The second IP server has second and third telephone extensions coupled thereto in a second LAN. As noted above, the combination of the references does not teach or suggest a list of telephone destinations stored in

a second IP server within a second LAN that is coupled to second and third telephone extensions. This is also supported in Figs. 11-12 and 14 and also the call processing flow diagram illustrated in Figs. 9a and 9b, and their accompanied description. Claim 30 is also patentable for reasons given herein with respect to Claims 1-3.

The Examiner has not specifically addressed the limitations in Claims 27 and 33. For Claims 25-26 and 31-32, the Examiner provides no objective evidence as to how the references teach or suggest a second input or that the first and second inputs are the same key button. The Examiner is required to prove such a suggestion by objective evidence. *Ex parte Levengood*, 28 U.S.P.Q.2d 1300, 1301 (Bd. Pat. App. & Int. 1993); *Ashland Oil, Inc. v. Delta Resins and Refractories, Inc.*, 776 F.2d 281, 227 U.S.P.Q. 657 (Fed. Cir. 1985). The legal conclusion of obviousness must be supported by facts. *Graham v. John Deere & Co.*, 383 U.S. 1 (1966). A rejection based on § 103 clearly must rest on a factual basis, and these facts must be interpreted without hindsight reconstruction of the invention from the prior art. The patentability of an invention is not to be viewed with hindsight or "viewed after the event." *Goodyear Company v. Ray-O-Vac Company*, 321 U.S. 275, 279, 64 S.Ct. 593, 88 L.Ed. 721 (1944). Instead of relying upon an objective evidence to support the Examiner's assertion, the Examiner has merely supported such an obviousness rejection with the Examiner's own opinion, which is quite clearly not objective evidence as is required by the case law. Further, Applicants respectfully traverse the assertion of what is well known in the art. As a result, the Examiner is required to support such an assertion with objective evidence.

Claim 35 recites a third LAN coupled to the first and second LANs via the WAN. Claim 35 further recites a means for displaying on the first IP telephone a list of LANs coupled to the LAN, including the second and third LANs. This limitation has not been addressed by the Examiner in any way. For this reason alone, this claim is patentable over the cited prior art. Secondly, there is no teaching or suggestion within the prior art references of displaying a list of LANs on the telephone display in either *Guy* or *Wilson* or their combination. Further, there is no teaching or suggestion in those references for displaying the first list of telephone destinations stored in the second IP server in response to selection of the second LAN from the displayed list



of LANs. Again, the Examiner has not in any way addressed this claim limitation, and for this reason alone, Claim 35 is patentable over the cited prior art. Secondly, this limitation is not taught or suggested by the combination of the references. Claims 35 is patentable for similar reasons as provided in Claims 10 and 23.

On page 4 of the Office Action, the Examiner has made assertions as to what *Wilson* teaches. Applicants respectfully traverse such assertions and incorporate by reference Applicants' arguments made in the previous amendment with respect to the teachings of *Wilson*.

With respect to Claims 28 and 34, Applicants respectfully traverse the Examiner's assertions. The Examiner has mischaracterized the limitations within these claims. These claims recite that the telephone destinations may include telephones external to the system. Such telephone destinations are included in a list stored in the second IP server which are communicated from the second IP server over the WAN to the first IP telephone. This is not taught or suggested within *Wilson*. Applicants traverse the Examiner's assertion of what is well known in the art, requiring the Examiner to support such assertions with objective evidence.

2. Claim 4 is not properly rejected under 35 U.S.C. § 103 as being unpatentable over *Guy* in view of *Wilson* and further in view of *Stuntebeck et al.* (U.S. Patent No. 6,065,016). Applicants respectfully traverse this rejection for reasons similarly given herein for Claims 1-2.

Claim 4 further recites that the list of the plurality of telecommunications extensions is played as audio to the user of the first telecommunications device. First, this is impossible in the invention in *Guy*. Secondly, *Wilson* does not teach or suggest such a capability. In fact, *Wilson* is attempting to simplify the process of two internet devices having an audio communication between each other, because when such an IP address is dialed, up to 20 digits have to be entered by the caller. Column 2, lines 8-9. *Wilson* specifically states that a user having to remember and enter such digits is neither appealing nor practical in most situations. Column 2, lines 9-10. Thus, Applicants respectfully assert that *Wilson* actually teaches away from such an audio communication of the IP addresses. Plus, *Wilson* does not suggest playing an audio list of even

one IP address to a user of one of the dial pads 201-203, but instead specifically discloses the display of such IP addresses.

3. Claims 36-38 and 40 are not properly rejected under 35 U.S.C. § 103 as being unpatentable over *Wilson* in view of *Guy*. Applicants respectfully traverse these rejections for reasons similarly given above.

These foregoing features of displaying a list of LANs on the IP telephone is also recited in Claim 36. As a result, Claim 36 is also patentable over the cited prior art, since the Examiner has failed to prove a *prime facie* case of obviousness in rejecting these claims. In the Examiner's rejections, the Examiner merely regurgitates the claim language without pointing to a teaching within the references of such claim limitations. Fig. 5 and column 7, lines 45-67 of *Wilson* do not teach or suggest such limitations. Claim 36 further recites the display of such a list of LANs is done in response to the receiving a first touch input from a user on the telephone. There is no discussion within *Wilson*, or a combination of *Wilson* and *Guy*, of a user making a request for a list of LANs. Note further, that Claim 36 recites that the IP telephone is networked into a first LAN. As noted above, *Wilson* does not teach or suggest that the dial pads are in LANs. Claim 36 then recites that a second touch input from the user will result in the display of a list of telephone destinations that are accessible from the second LAN. As noted above, this claim limitation is not taught or suggested within *Wilson*, or *Wilson* combined with *Guy*. Claim 36 then goes on to recite that a third touch input results in an automatic dialing of one of the destinations accessible from the second LAN. As noted previously by Applicants, such an automatic dialing process is not taught or suggested by the references.

Claim 36 also recites that the displaying steps further recite a step of sending a message from the first LAN to the second LAN requesting the second list. This is not shown or discussed anywhere within the references. The Examiner attempts to overcome a deficiency in the teachings of *Wilson* with regard to this limitation and the next one by referring to *Guy*. *Guy* retrieves a server code, but does so from a master directory somewhere in a server in a network 100. There is no disclosure in *Guy* of where such a master directory is located within the

network 100. It needs to be remembered that such a server code only identifies a device that is coupled to a PBX that communicates with the telephones in a network. Additionally, a list has not been sent across the WAN to the file server 112, but instead a single server code is sent. The claim specifically recites that a list of telephone destinations accessible from a second LAN is requested and retrieves it from the second LAN. The Examiner then goes on to assert, without objective support, that it would have been obvious to supply the internet database in *Wilson* from local directories stored in each respective LAN segment of a network as shown by *Guy*, thereby insuring that the internet master directory is up to date.

First of all, without some objective support for such an assertion, the Examiner's obviousness conclusion is without merit and cannot support his combination of the references to arrive at the claimed invention. The Examiner is required to prove such a suggestion by objective evidence. *Ex parte Levengood*, 28 U.S.P.Q.2d 1300, 1301 (Bd. Pat. App. & Int. 1993); *Ashland Oil, Inc. v. Delta Resins and Refractories, Inc.*, 776 F.2d 281, 227 U.S.P.Q. 657 (Fed. Cir. 1985). The legal conclusion of obviousness must be supported by facts. *Graham v. John Deere & Co.*, 383 U.S. 1 (1966). A rejection based on § 103 clearly must rest on a factual basis, and these facts must be interpreted without hindsight reconstruction of the invention from the prior art. The patentability of an invention is not to be viewed with hindsight or "viewed after the event." *Goodyear Company v. Ray-O-Vac Company*, 321 U.S. 275, 279, 64 S.Ct. 593, 88 L.Ed. 721 (1944). Instead of relying upon objective evidence to support the Examiner's assertion, the Examiner has merely supported such an obviousness rejection with the Examiner's own opinion, which is quite clearly not objective evidence as is required by the case law.

Secondly, *Wilson* does not teach or suggest other LANs because *Wilson* does not show other LANs having telephone extensions connected thereto whereby a list is stored within such LANs for sending to update the directory database 232. Nor does *Wilson* suggest that such a process can be implemented. Furthermore, *Guy* merely teaches that a directory management unit will update its unit of server codes when it receives one. There is also no teaching or discussion in *Guy* of going out and retrieving such lists of extensions connected to other LANs, or such LANs sending such lists of attached telecommunication extensions to other LANs within the

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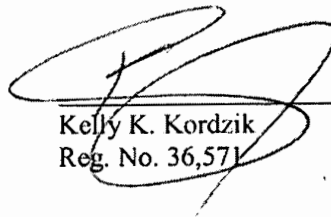
network. Thus, there is no support for the Examiner's assertion that it would have been advantageous and obvious for the database 232 in *Wilson* to be updated by all of the various LANs to ensure that its directory is up-to-date. Further, Claim 36 is patentable for similar reasons as given for Claims 1-3, 5-6 and 8.

Claim 37 recites scrolling through the first list. This first list is a list of LANs. First of all, such a list of LANs is nowhere to be taught or suggested within either of the references or their combination. Secondly, there is no teaching or suggestion for scrolling through such a list of LANs. As a result of the foregoing, one skilled in the art at the time the invention was made would not have been able to recreate the claimed invention in view of the combination of the references.

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Respectfully submitted,

Date: November 3, 2008



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### Appendix of Claims

1. An information handling system comprising:
  - a first local area network ("LAN");
  - a second LAN;
  - a wide area network ("WAN") coupling the first LAN to the second LAN;
  - a first telecommunications device coupled to the first LAN;
  - a plurality of telecommunications extensions coupled to the second LAN;
  - the first LAN including first circuitry for enabling a user of the first telecommunications device to observe a list of the plurality of telecommunications extensions; and
  - the first LAN including second circuitry for automatically calling one of the plurality of telecommunications extensions in response to the user selecting one of the plurality of telecommunications extensions from the observed list, wherein the list of the plurality of telecommunications extensions is stored in a server in the second LAN, and is accessed by the first circuitry across the WAN.
  
2. The system as recited in claim 1, wherein communication among the first LAN, second LAN, and WAN uses an IP protocol.
  
3. The system as recited in claim 2, wherein the list of the plurality of telecommunications extensions is displayed to the user of the first telecommunications device.
  
4. An information handling system comprising:
  - a first local area network ("LAN");
  - a second LAN;
  - a wide area network ("WAN") coupling the first LAN to the second LAN;
  - a first telecommunications device coupled to the first LAN;
  - a plurality of telecommunications extensions coupled to the second LAN;
  - the first LAN including first circuitry for enabling a user of the first telecommunications device to observe a list of the plurality of telecommunications extensions; and

the first LAN including second circuitry for automatically calling one of the plurality of telecommunications extensions in response to the user selecting one of the plurality of telecommunications extensions from the observed list, wherein communication among the first LAN, second LAN, and WAN uses an IP protocol, wherein the list of the plurality of telecommunications extensions is played as audio to the user of the first telecommunications device.

5. The system as recited in claim 3, wherein the first telecommunications device is an IP telephone having a display for showing the list of the plurality of telecommunications extensions, wherein the second circuitry includes a key for enabling the user to tacitly selecting one of the plurality of telecommunications extensions from the displayed list.

6. The system as recited in claim 5, wherein the tactile selection of one of the plurality of telecommunications extensions from the displayed list by the user results in an initiation of a call from the first telecommunications device to the selected one of the plurality of telecommunications extensions across the WAN.

8. An information handling system comprising:  
a first local area network ("LAN");  
a second LAN;  
a wide area network ("WAN") coupling the first LAN to the second LAN;  
a first telecommunications device coupled to the first LAN;  
a plurality of telecommunications extensions coupled to the second LAN;  
the first LAN including first circuitry for enabling a user of the first telecommunications device to observe a list of the plurality of telecommunications extensions; and

the first LAN including second circuitry for automatically calling one of the plurality of telecommunications extensions in response to the user selecting one of the plurality of telecommunications extensions from the observed list, wherein communication among the first LAN, second LAN, and WAN uses an IP protocol, wherein the list of the plurality of telecommunications extensions is displayed to the user of the first telecommunications device,

wherein the first telecommunications device is an IP telephone having a display for showing the list of the plurality of telecommunications extensions, wherein the second circuitry includes a key for enabling the user to tacitly selecting one of the plurality of telecommunications extensions from the displayed list, wherein the tactile selection of one of the plurality of telecommunications extensions from the displayed list by the user results in an initiation of a call from the first telecommunications device to the selected one of the plurality of telecommunications extensions across the WAN, wherein the list of the plurality of telecommunications extensions is stored in a server in the second LAN, and is accessed by the first circuitry across the WAN.

9. The system as recited in claim 8, wherein the first telecommunications device includes circuitry for enabling the user to scroll through the displayed list of the plurality of telecommunications devices.

10. The system as recited in claim 1, further comprising:  
a third LAN coupled to the first and second LANs via the WAN; and  
a plurality of telecommunications extensions coupled to the third LAN, the first LAN including circuitry for enabling the user to select between observing the list of the plurality of telecommunications extensions coupled to the second LAN or observing a list of the plurality of telecommunications extensions coupled to the third LAN.

17. An information handling system comprising:  
a first local area network ("LAN") operating under an IP protocol;  
a first IP telephone coupled to the first LAN, the first IP telephone having a display and a set of keys for enabling a user to enter inputs;  
a second LAN operating under the IP protocol;  
second and third telephone extensions coupled to the second LAN;  
a wide area network ("WAN") operating under the IP protocol coupling the first LAN to the second LAN; and

the first LAN including first circuitry for enabling a user of the first IP telephone to view a list including the second and third telephone extensions, wherein the list is stored in a server in the second LAN, and is accessed by the first circuitry across the WAN.

18. The system as recited in claim 17, further comprising:

the first LAN including second circuitry for automatically calling the second telephone extension in response to the user selecting the second telephone extension from the viewed list.

19. The system as recited in claim 18, wherein selection of the second telephone extension from the viewed list by the user is accomplished by selection of one of the set of keys.

20. The system as recited in claim 19, wherein the selection of one of the set of keys results in an initiation of a call from the first IP telephone to the second telephone extension across the WAN.

22. The system as recited in claim 17, wherein the first IP telephone includes circuitry for enabling the user to scroll through the displayed list.

23. The system as recited in claim 1, further comprising:

a third LAN coupled to the first and second LANs via the WAN; and  
a plurality of telephone extensions coupled to the third LAN, the first LAN including circuitry for enabling the user to select between viewing the list of the telephone extensions coupled to the second LAN or viewing a list of the plurality of telephone-extensions coupled to the third LAN.

24. In a telecommunications system comprising a first IP telephone coupled to a first IP server within a first LAN, second and third telephone extensions coupled to a second IP server within a second LAN, and a WAN coupling the first LAN to the second LAN, the first LAN, the second LAN, and the WAN communicating using an IP protocol, a method comprising the steps of:



in response to selection of a first input on the first IP telephone, displaying on the first IP telephone a list of telephone destinations stored in the second IP server, wherein the list of telephone destinations is communicated from the second IP server over the WAN to the first IP telephone; and

in response to selection of one of the telephone destinations from the displayed list, automatically dialing the selected one of the telephone destinations for a communications link between the first IP telephone and the selected one of the telephone destinations.

25. The method as recited in claim 24, wherein the selection of one of the telephone destinations from the displayed list is performed in response to selection of a second input on the first IP telephone by a user.

26. The method as recited in claim 25, wherein the first and second inputs are the same key button on the first IP telephone.

27. The method as recited in claim 24, wherein the telephone destinations include the second and third telephone extensions coupled to the second IP server.

28. The method as recited in claim 24, wherein the telephone destinations include telephones external to the system.

29. The method as recited in claim 24, wherein the system includes a third LAN coupled to the first and second LANs via the WAN, further comprising the steps of: displaying on the first IP telephone a list of LANs coupled to the WAN, including the second and third LANs; and

performing the step of displaying the first list in response to selection of the second LAN from the displayed list of LANs.

30. A telecommunications system comprising:

a first IP telephone coupled to a first IP server within a first LAN;

second and third telephone extensions coupled to a second IP server within a second LAN;

a WAN coupling the first LAN to the second LAN, the first LAN, the second LAN, and the WAN communicating using an IP protocol;

means for displaying on the first IP telephone a list of telephone destinations stored in the second IP server in response to selection of a first input on the first IP telephone, wherein the list of telephone destinations is communicated from the second IP server over the WAN to the first IP telephone; and

means for automatically dialing the selected one of the telephone destinations for a communications link between the first IP telephone and the selected one of the telephone destinations in response to selection of one of the telephone destinations from the displayed list.

31. The system as recited in claim 30, wherein the selection of one of the telephone destinations from the displayed list is performed in response to selection of a second input on the first IP telephone by a user.

32. The system as recited in claim 31, wherein the first and second inputs are the same key button on the first IP telephone.

33. The system as recited in claim 32, wherein the telephone destinations include the second and third telephone extensions coupled to the second IP server.

34. The system as recited in claim 32, wherein the telephone destinations include telephones external to the system.

35. The system as recited in claim 31, further comprising:  
a third LAN coupled to the first and second LANs via the WAN;  
means for displaying on the first IP telephone a list of LANs coupled to the WAN, including the second and third LANs; and

means for displaying the first list in response to selection of the second LAN from the displayed list of LANs.

36. A method comprising the steps of:

receiving a first touch input from a user on an IP telephone that is networked into a first LAN operating under an IP protocol;

in response to receipt of the first touch input, displaying on a display on the IP telephone a first list including second and third LANs coupled to the first LAN, wherein the second and third LANs operate under the IP protocol;

receiving a second touch input from the user on the IP telephone;

in response to receipt of the second touch input, displaying on the display on the IP telephone a second list of telephone destinations accessible from the second LAN;

receiving a third touch input from the user on the IP telephone; and

in response to receipt of the third touch input, automatically dialing one of the telephone destinations accessible from the second LAN for a communications connection between the one of the telephone destinations and the IP telephone, wherein the step of displaying on the display on the IP telephone the second list further includes the steps of:

sending a message from the first LAN to the second LAN requesting the second list; and

receiving the second list from the second LAN to the first LAN.

37. The method as recited in claim 36, before the step of receiving the second touch input, further comprising the steps of: receiving a fourth touch input from the user on the IP telephone; and in response to receipt of the fourth touch input, scrolling through the first list.

38. The method as recited in claim 37, before the step of receiving the third touch input, further comprising the steps of: receiving a fifth touch input from the user on the IP telephone; and in response to receipt of the fifth touch input, scrolling through the second list.

40. The method as recited in claim 36, wherein the first, second, and third LANs are coupled via a WAN.

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EVIDENCE APPENDIX

No evidence was submitted pursuant to §§1.130, 1.131, or 1.132 of 37 C.F.R. or of any other evidence entered by the Examiner and relied upon by Appellants in the Appeal.

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RELATED PROCEEDINGS APPENDIX

None.



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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/447,607  
Filing Date: May 29, 2003  
Appellant(s): SUDER ET AL.

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For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 11/3/2008 appealing from the Office action mailed 4/1/2008.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

6,298,057	GUY ET AL	10-2001
6,829,231	WILSON	12-2004
6,065016	STUNTEBECK ET AL	5-2000



**(9) Grounds of Rejection**

The following ground(s) of rejection, respectively reproduced below from the Final Rejection filed 4/1/2008, are applicable to the appealed claims:

***Claim Rejections - 35 USC § 103***

Claims 1-3, 5, 6, 8-10, 17-20, and 22-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guy et al. (US006298057B1), hereafter Guy, in view of Wilson (US006829231B1).

- Regarding Claims 1-3, 5, 6, 8-10, 17-20, 22-25, 27, 29-31, 33, and 35,

Guy discloses a system and method for coupling a first LAN 102A having server 112 to a second LAN 102B having server 122 through WAN 104 utilizing IP capabilities of the LANs and WAN (Fig. 1; Col. 1, lines 51-53; Col. 14, lines 13-17; claim 1,8,17,24,30 – method in a information handling system comprising a first LAN; claim 1,8,17,24,30 - a second LAN; claim 1,8,17,24,30 – WAN coupling the first LAN to the second LAN; claim 2,17,30 – LANs and WAN operate under IP protocol; claim 24,30 – first and second IP servers within first and second LANs).

Fig. 1 also shows that a plurality of telecommunications devices are coupled to the first and second LANs 102A/B (claim 1,8,17,24,30 - first telecommunications device coupled to the first LAN; claim 1,8,17,24,27,33 - plurality of telecommunications extensions/destinations coupled to the second LAN).

Guy discloses the ability to connect a phone of the first LAN 102A to a destination phone of the second LAN 102B (Col. 6, lines 4-11; Col. 10, lines 1-7). Guy

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further discloses each file server 112/122 includes a directory (Fig. 4, 406) that stores a list of server codes and additional information to identify devices attached to each server (Col. 10-11, lines 30-14; claim 1,8,17,30 - wherein the list of the plurality of telecommunications extensions is stored in a server in the second LAN, and is accessed by the first circuitry across the WAN). Guy also discloses a master directory in a server of network 100 containing the information stored in each local directory (Col. 9, lines 20-25).

However, Guy does not explicitly disclose the user of the phone in the first LAN observing a displayed list of extensions to phones in multiple (second and third) local networks remote of the user's LAN and automatically initiating a call in response to the user selecting one of the extensions from the observed list. Guy also does not explicitly disclose the user's phone as an IP phone having display and keys for user to enter first and second inputs for displaying and selecting/initiating a call, circuitry to scroll through the displayed list.

Wilson discloses an IP phone user can access a directory engine through the Internet (WAN) for displaying a list of numbers/addresses (extensions) obtained from multiple (second and third) local exchange network switches and ISPs that are remote to the user. Wilson further discloses the user initiates a call by selecting a destination from a scrolled list of potential destinations (Fig. 5,6; Col. 7-8, lines 45-15; claim 1,8,17,24,30 - first LAN including first circuitry for enabling a user of the first telecommunications device to observe/view a list of the plurality of telecommunications

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extensions; claim 1,8,18,24,30 - first LAN including second circuitry for automatically calling one of the plurality of telecommunications extensions in response to the user selecting one of file plurality of telecommunications extensions from the observed list; claim 3,8,24,30 – list is displayed to user of the first device; claim 5,6,8,17,19,20,24,25,30,31 – first device is IP phone having display and keys for user to enter first and second inputs for displaying and selecting/initiating a call to an extension in the second LAN over the WAN; claim 9,22 – circuitry to scroll through displayed list; claim 10,23,29,35 – a third LAN and first LAN circuitry for selecting and viewing a list of a plurality of extensions coupled to the second and/or third LAN).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Guy by enabling a first device to observe a list of extensions in a remote LAN and initiating a call to a displayed number in response to selection by a user, as shown by Wilson, thereby enabling the first phone to connect to a destination phone if the number associated with the destination phone is unknown and remote of the user's LAN.

- Regarding Claims 26 and 32,

Guy discloses all limitations of the parent claims.

Neither Guy nor Wilson discloses first and second inputs using the same button.

However, it is well known in the art to utilize the same button for multiple common inputs to simplify the functionality (claim 26,32 – first and second inputs use same button).

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It would have been obvious to one of ordinary skill in the art at the time of the invention to use the same button for the first and second inputs disclosed by Wilson, in order to improve the ease of use for the user.

- Regarding Claims 28 and 34,

Guy discloses all limitations of the parent claims.

Neither Guy nor Wilson explicitly discloses destinations include telephones external to the system.

However, it is well known that local exchange switches such as those shown by Wilson are able to connect to other exchanges outside of the local system, such as over a dedicated T1 trunk (claim 28,34 – destinations includes telephones external to the system).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Guy and Wilson by enabling destinations to be telephones external to the system, thereby providing the disclosed directory services to as many capable users as can be supported.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Guy in view of Wilson above, and further in view of Stuntebeck et al. (US006065016A), hereafter Stuntebeck.

- Regarding Claim 4,

Guy discloses a system as shown above in the rejection of claim 1 and 2.

Neither Guy nor Wilson discloses a list played to a user as audio.

Stuntebeck discloses a universal directory server (UDS) that provides remote access to the communication addresses (extensions) associated with numerous institutions, including LANs (Fig. 1; Abstract). Stuntebeck discloses a user can access the UDS through a voice recognition system, in which results are conveyed to the user as voice (audio; Col. 4, lines 17-25; claim 4 – list is played as audio to the user of the first device).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Guy and Wilson by enabling the list to be played as audio to the user, as shown by Stuntebeck, thereby allowing users to access directory services without a visual display.

Claims 36-38 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilson in view of Guy.

- Regarding Claim 36-38 and 40,

Wilson discloses an IP phone connects to Internet (WAN) through multiple (first, second, third) local switches and network switches, and a user can use the alphanumeric keypad to make a request of callee search (Fig. 5; Col. 7, lines 45-67; claim 36 - in response to receipt of first input, displaying on a display on the IP telephone a first list including second and third LANs coupled to the first LAN, wherein the second and third LANs operate under the IP protocol; claim 40 – first, second, and third LANs coupled via WAN).

Wilson further discloses the screen on the caller's side can display multiple result numbers of callees in a scrolled list after the search engine replies to the search request (Col. 7, lines 46-67 and Col. 8, Lines 1-17; claim 36 - receiving another input from the user on the IP telephone; in response to receipt of the input, displaying on the display on the IP telephone a second list of telephone destinations accessible from the second LAN; claim 37 – scrolling through the list in response to fourth input).

Wilson then shows that the caller can select the proper callee's name display from the scrolled list of multiple results to initiate a call (Col. 8, lines 13-15; claim 36 - in response to receipt of third input, automatically dialing one of the telephone destinations accessible from the second LAN for a communications connection between the one of

the telephone destinations and the IP telephone; claim 38 – scrolling through the list in response to fifth input).

Wilson does not explicitly show that the callee lists are received from a second LAN in response to sending a request message from the first LAN.

Guy discloses a system and method for coupling a first LAN 102A having server 112 to a second LAN 102B having server 122 through WAN 104 utilizing IP capabilities of the LANs and WAN. Guy discloses the ability to connect a phone of the first LAN 102A to a destination phone of the second LAN 102B (Col. 6, lines 4-11; Col. 10, lines 1-7). Guy further discloses each file server 112/122 includes a directory (Fig. 4, 406) that stores a list of server codes and additional information to identify devices attached to each server (Col. 10-11, lines 30-14), while also disclosing a master directory in a server of network 100 containing the information stored in each local directory (Col. 9, lines 20-25; claim 36 - displaying on the display on the IP telephone the second list further includes the steps of sending a request message for the list from the first LAN to the second LAN and receiving the second list from the second LAN to the first LAN).

It would have been obvious to one of ordinary skill in the art at the time of the invention to supply the Internet database in Wilson from local directories stored in each respective LAN segment of a network, as shown by Guy, thereby ensuring that the Internet (master) directory is up to date.

**(10) Response to Argument**

- Appellant's arguments on pgs. 8-12 of the Brief have been fully considered but they are not persuasive. On pgs. 7-8, Appellant contends that Guy provides no teaching or suggestion that a list of a plurality of telecommunications extensions coupled to the second LAN is provided to the user of the first telephone for observation. On pgs. 8-11, Appellant contends the claim rejections expand the teachings of Wilson beyond what is reasonable, since Wilson's system merely provides for services similar to POTS and does not disclose LANs. Thus, Appellant contends that the combination of Guy and Wilson does not provide a user of a first device in the first LAN with a list of extensions the user can call in the second LAN or means to automatically initiate the call with a selection from the list, since Guy provides nothing to the user of the telephone and Wilson discloses users (callers/callees) connected to local exchange switches over PSTN circuits instead of LANs.
- The Examiner respectfully disagrees. Appellant's individual arguments pertaining to the references of Guy and Wilson cannot show nonobviousness when the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). It is admitted in the Final Rejection filed 4/1/2008 that Guy does not disclose the user of the first phone in the first LAN observing a displayed list of extensions to phones in remote



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LANs. Guy is relied upon in the rejection to disclose one of a plurality of telecommunication devices in first and second LANs communicatively coupled through a WAN, including voice transmission. Guy is further shown to utilize information from file servers 112/122 of the respective LANs and a master directory of the local file servers in order to implement the transmission. Thus, Guy is shown to meet all claim limitations **except** the ability of the calling user in a first network to observe a list of extensions in a second network and automatically calling one of those extensions in response to the user selecting an extension from the observed list. However, the rejection shows that these deficiencies in Guy are remedied by Wilson, which discloses a user in a first local network accessing a directory engine through the Internet in order to observe a displayed list of numbers/addresses from multiple other local networks remote to the user of the first local network. The rejections clearly rely on the disclosure of Guy to meet the claim limitations concerning LANs. However, regardless of what is shown in Guy, Wilson repeatedly discloses that the users of the phones 201-203 and 245-247 utilize the PSTN **and standard LAN/WAN technology** to access the Internet, directory engine, etc. Thus, Wilson and Guy are each shown to be applicable within a LAN/WAN environment. Therefore, the combination of Guy and Wilson properly meets all limitations of the pending claims.

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- Appellant's arguments on pgs. 11, 13, and 14 of the Brief concerning claims 1, 5, and 6 have been fully considered but they are not persuasive. Appellant contests that Wilson does not teach or suggest an automatic calling of the selected extension from the observed list. Appellant argues that the cited portion of Wilson (Col. 8, lines 13-15) merely teaches that the user can view the IP address of the callee but must manually enter the displayed address/number into the dial pad's keyboard.
- The Examiner respectfully disagrees. For convenience, the cited portion of column 8 in Wilson is shown below:

"When a callee's address matching the caller's search request is found, the name is displayed on the display screen of the dial pad. The caller then has the option of completing the call to the address. When more than one hit is made, the names of the qualifying user callees are displayed. The caller then has the option of selecting from a scrolled list of potential users using the dial pad's keyboard 63 to select the intended caller."

Wilson's disclosure that the caller "then has the option of completing the call to the address" does not say anything about using the keyboard, much less require manual keyboard entry for connecting to the searched caller. As acknowledged by Appellant in subsequent arguments on pg. 18 of the Brief, Wilson explicitly discloses that a user having to remember and enter these digits is neither appealing nor practical in most situations (Col. 2, lines 8-9). Furthermore, the above disclosure of "selecting from a scrolled list....using the

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keyboard" refers to a scenario in which more than one hit is made for the callee's request. Wilson's disclosure pre-dates the conventional use of touch-screen displays, thus it is disclosed to use the keyboard to make the appropriate selection. For example, the calling user may enter a digit, or use the respective arrow and Enter buttons on a keyboard to select the appropriate one of multiple search hits, as would be evident to one of ordinary skill in the art at the time of the invention. As such, these disclosures of Wilson would not be considered to require manual entry of the number/address to connect to an intended callee when the number/address has been received and observed from a directory search, as alleged by Appellant. Therefore, the pending claim rejections are deemed proper.

- Appellant's arguments on pg. 13 of the Brief concerning claim 1 have been fully considered but they are not persuasive. Appellant contends that permitting a user in one geographic location to locate a user in another location without the need to use a printed extension guide would not be possible with the combination of references asserted in the rejection.
- The Examiner respectfully disagrees. Firstly, it is noted that " permitting a user in one geographic location to locate a user in another location without the need to use a printed extension guide" is not an explicit claim limitation. Regardless, as shown above, Wilson specifically discloses the ability of a user to locate a remote user without the need to use a printed extension

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guide (i.e. by accessing a directory in the Internet). Therefore, this conceptual distinction presented by Appellant is met by Wilson and the rejection based upon the combination of Guy and Wilson is proper.

- Appellant's arguments on pg. 13 and 14 of the Brief concerning claims 1 and 8 have been fully considered but they are not persuasive. Appellant contends that neither Guy nor Wilson teaches or suggests a list of extensions coupled to the second LAN is stored in a server of the second LAN.
- The Examiner respectfully disagrees. As shown above, Guy discloses file servers 112/122 of first and second LANs and a master directory of the file servers while Wilson discloses a directory engine of user numbers/addresses connected to various local networks. Therefore, the contested claim limitation is met based upon the combination of Guy and Wilson, and the rejection is proper.
- Appellant's arguments on pg. 13 of the Brief concerning claim 2 have been fully considered but they are not persuasive. Appellant contends that the combination of references does not teach a LAN or WAN operating under an IP protocol because Guy does not disclose LANs/WAN operating under an IP protocol and Wilson does not disclose LANs with extensions.
- The Examiner respectfully disagrees. Guy explicitly discloses the Internet as an example of a WAN (Col. 4, lines 62-64). Thus, the contested claim

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limitation of “communication....uses an IP protocol” is met by Guy and the rejection based upon the combination of Guy and Wilson is proper.

- Appellant’s arguments on pgs. 15-17 of the Brief concerning claims 10, 30, and 35 have been fully considered but they are not persuasive. Appellant contends that the rejection has merely implied that Wilson teaches a third LAN from which extensions coupled to the third LAN can be viewed and selected.
- The Examiner respectfully disagrees. As shown in the rejection, Fig. 5 of Wilson shows that a displayed list of numbers/addresses (i.e. extensions) are collected from multiple local exchange and/or network switches and ISPs remote to the requesting user. This showing of multiple paths to the directory from various local exchange/network switches and ISPs meets the contested claim limitations of a third (or more) LAN(s) with associated extensions within the larger network, as would be apparent to one of ordinary skill in the art. Therefore, the contested claim limitation is met by Wilson and the rejection based upon the combination of Guy and Wilson is proper.
- Appellant’s arguments on pg. 16 of the Brief concerning claims 17-20, 23, and 24 rely upon the previous arguments presented above. Those arguments have been refuted above, and the rejections shown to be proper, thus the rejections of claims 17-20, 23, and 24 are also properly maintained.

- Appellant's arguments on pg. 17 of the Brief concerning claims 25-27 and 31-33 have been fully considered but they are not persuasive. Appellant contends that the rejection is merely supported by the Examiner's own opinion, providing no objective evidence as to how the references teach or suggest a second input or that the first and second inputs are the same key button.
- The Examiner respectfully disagrees. Firstly, contrary to Appellant's assertion, the limitations of claims 27 and 33 are addressed in the rejection, since Fig. 1 of Guy clearly shows that LAN extensions include telephone destinations. Regarding claims 25 and 31, the rejection of these claims shows how Wilson utilizes the keyboard of the IP phone for displaying, selecting, and connecting (multiple inputs) a destination searched from the directory by a callee user. Regarding claims 26 and 32, the rejection admits that the references do not explicitly disclose these multiple inputs utilizing the same button. The rejection of these claims relies upon common sense knowledge possessed by one of ordinary skill in the art, in which the use of a single button for successive inputs simplifies the functionality of the system, such as repeated use of the Enter button on the keyboard of Wilson to display, select and connect to a searched destination. Appellant has not previously contested this assertion of common knowledge in the art, and the

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technical line of reasoning is clearly shown in the rejection. Therefore, the rejections are proper.

- Appellant's arguments on pg. 18 of the Brief concerning claims 28 and 34 have been fully considered but they are not persuasive. Appellant contends that the rejection mischaracterizes the limitations, in which "telephone destinations include telephones external to the system".
- The Examiner respectfully disagrees. Again, as above, the rejection of claims 28 and 34 relies upon common sense knowledge possessed by one of ordinary skill in the art. Namely, that the drawings in the cited references are not indicative of the scale of actual, deployed networks. In particular, Wilson illustrates how a network diagram may be simplified (Fig. 4) from a more comprehensive/expanded view of a network's interconnections (Fig. 5). One of ordinary skill in the art would recognize that the routers and switches shown by Guy and Wilson enable connection to other routers/switches outside of the local system, extending the disclosed directory services to telephones connecting from those outside routers/switches. Therefore, the claim rejections are proper.
- Appellant's arguments on pg. 18 of the Brief concerning claim 4 have been fully considered but they are not persuasive. Appellant reiterates previous arguments related to Guy and Wilson in contending that the limitation of

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playing the list as audio to the user has not been met. Appellant fails to address the combination of Guy and Wilson with the cited portions of Stuntebeck in rejecting these claims.

- The Examiner respectfully disagrees. Previous arguments related to Guy and Wilson have been refuted as shown above. Further, neither Guy nor Wilson is relied upon to disclose playing the list as audio to the user. Stuntebeck is relied upon to disclose a directory server similar to those in Guy and Wilson. Stuntebeck further discloses the option of accessing the directory through voice recognition, where directory results are conveyed to the user as voice/audio. Therefore, the contested claim limitation is explicitly met by Stuntebeck and the combination of Guy, Wilson, and Stuntebeck properly rejects the claim.
  
- Appellant's arguments on pg. 19-21 of the Brief concerning claims 36-38 and 40 have been fully considered but they are not persuasive. Appellant contends the combination of Wilson and Guy does not meet the claimed limitations.
  
- The Examiner respectfully disagrees. Appellant's arguments reiterate the piecemeal analysis of Wilson and Guy presented in the above arguments. As shown, neither Wilson nor Guy is relied upon to individually meet all of the claim limitations. Rather, the rejections are based upon the combination of Wilson and Guy. All of the claimed limitations are shown to be met by the







certain claim limitations, then why are Applicants precluded from attacking these arguments? The Examiner's *prima facie* case of obviousness relies upon his assertions of how *Guy* teaches certain limitations and how *Wilson* teaches other certain limitations. If Applicants can show how the Examiner's interpretations of these references are incorrect, then Applicants have shown how the *prima facie* case of obviousness fails. This is what Applicants did precisely. Since the Examiner has incorrectly interpreted the teachings of *Guy* and *Wilson*, the Examiner's *prima facie* case of obviousness fails. An applicant may specifically challenge an obviousness rejection by showing that the examiner reached an incorrect conclusion of obviousness or based the obviousness determination on incorrect factual predicates. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998). As a result, the Examiner cannot simply ignore Applicants' arguments on pages 6, 7, 8, etc. with respect to each of the references by merely replying that Applicants' arguments "cannot show nonobviousness."

Moreover, Applicants actually described what each of the references teaches and does not teach, and then combined those teachings and "non-teachings" to show how the combination of the references does not arrive at the claimed invention. Applicants' arguments on those pages in the Appeal Brief must be considered! MPEP §707.07(f).

The Examiner admits that *Guy* does not disclose the automatic calling of one of the extensions in the observed list. The Examiner then asserts that *Wilson* remedies this situation. The first problem with this assertion is that *Wilson* does not disclose such a first LAN. The caller dial pads 201-203 are not coupled into a LAN, as that term is interpreted in the art. The "local telephone network" recited in column 7, line 18 of *Wilson* is not the same as a LAN. Telephones connected to a central office never were considered a LAN, which pertains to a data network. For the Examiner to interpret these claim terms in that manner is unreasonably broad. MPEP §2111.01. And, a single computer device does not make a LAN. Therefore, the combination of *Guy* and *Wilson* fails to disclose these claim limitations, and the Examiner's *prima facie* case of obviousness fails.

Furthermore, contrary to the Examiner's assertions, *Wilson does not* "repeatedly disclose[] that the users of the phones 201-203 and 245-247 utilize the PSTN and standard LAN/WAN technology to access the Internet, directory engine, etc." There is absolutely nothing in *Wilson* that discloses that the dial pads 201-203 or 245-247 access the Internet 210, etc. with standard LAN/WAN technology through the PSTN circuits 204. Moreover, Figure 4 in *Wilson* shows each of these dial pads individually connecting to the network 210 through their own PSTN circuit 204. There is no LAN! Again, an applicant may specifically challenge an obviousness rejection by showing that the examiner reached an incorrect conclusion of obviousness or based the obviousness determination on incorrect factual predicates. *In re Rouffet* at 1455. Furthermore, the disclosure in *Wilson* that each of the dial pads 50 can be connected to a computer 90 does not provide a suggestion that a plurality of such dial pads can then be coupled in a LAN and then that LAN coupled to the network 210. Since LANs were known by *Wilson*, if he had been able to couple the dial pads 201-203 or 245-247 into a LAN that is then itself connected to the network 210, he would have provided a description of such. The "standard LAN/WAN technology" referred to in *Wilson* is actually referring to the LANs and WANs in Figure 5, such as the Ethernet links 222, that permit the directory 232 to be individually accessed by each of the dial pads. It is not referring to a LAN being formed by a plurality of the dial pads 201-203 or 245-247. In fact, each of the dial pads 50 cannot be coupled into a LAN with each other, since their only connection is through a dual line service (column 5, line 26). As Applicants pointed out in the Appeal Brief, dual line service is well known in the art as a pair of wires for providing access from a home phone to the PSTN. Such teachings in *Wilson* would not lead one skilled in the art to believe that they could couple such dial pads into a LAN. Therefore, one skilled in the art would not be lead to combine *Wilson* with *Guy* since the dial pads in *Wilson* teach away from utilization in a LAN.

The Examiner disagrees that *Wilson* is limited to teaching that the user of the dial pad must manually dial the phone number retrieved. The language cited by the Examiner does not state anything about the dial pad having circuitry for automatically

calling a phone number selected by the user. The Examiner is interpreting the teachings of *Wilson* beyond the four corners of the document.

These teachings in *Wilson* are insufficient for what is required by one of ordinary skill in the art to then experiment and invent further circuitry for the dial pad to automatically call a selected name. A general incentive does not make obvious a particular result, nor does the existence of techniques by which the efforts can be carried out. *In re Kubin*, 2009 WL 877 646 (2009). In other words, “obvious to try” has long been held not to constitute obviousness. *Id.* Essentially, the Examiner is asserting that one skilled in the art at the time the invention was made would have been lead to include circuitry for automatically making the call with merely the teaching that the user makes a selection. This is not supported by *KSR*. To the contrary, the Supreme Court stated in *KSR* that a skilled artisan can only be shown to have merely pursued “known options” from a “finite number of identified, predictable solutions” for obviousness under §103 to arise. 550 US at 421. The Examiner cannot merely make such assumptions without providing objective evidence in support. The prior art does not teach the claimed limitations, and the Examiner must prove how such limitations are disclosed in the cited art. Absent that, the Examiner has failed to support his *prima facie* case of obviousness. Moreover, the Examiner has completely ignored the specific teaching in column 9, lines 1-4 of *Wilson* that once the user of the dial pad selects a remote callee, the call is placed “using the found Internet address,” and that “[i]f a dial attempt is made, the user ... dials ... to the selected callee.” Thus, *Wilson* does say something about using the keyboard to manually dial the number of the callee! **The Examiner cannot ignore the specific teaching in *Wilson* that the user is dialing the found Internet address!**

Contrary to the Examiner’s position, column 2, lines 6-10 of *Wilson* does not refute this teaching. Instead, this language in *Wilson* merely shows the disadvantage of the user having to remember the Internet address of the callee. The invention in *Wilson* then goes onto specifically address the disadvantage by providing a searchable Internet directory for obtaining such an Internet address of the callee. *Wilson’s* specification is solely directed to this aspect. The searchable database converts the

name into the Internet routing address to send to the user at the dial pad. Column 8, lines 1-7. *Wilson* does not provide any description of how the Internet address might be entered in an automatic manner in order to supposedly address a disadvantage of "entering" the digits, as the Examiner is attempting to assert.

The Examiner then makes the assertion that column 8, lines 13-15 of *Wilson* "refers to a scenario in which more than one hit is made for the callee's request," and then expands upon this "scenario" by making the following unsupported assertions:

- "it is disclosed to use the keyboard to make the appropriate selection"
- "the calling user may enter a digit, or use the respective arrow and Enter buttons on a keyboard to select the appropriate one of multiple search hits, as would be evident to one of ordinary skill in the art at the time of the invention"
- "these disclosures of *Wilson* would not be considered to require manual entry of the number/address to connect to an intended callee when the number/address has been received and observed from a directory search"

Absolutely none of these assertions by the Examiner is supported with any facts or evidence. Instead, they are all unsupported opinions by the Examiner, which are insufficient to support a *prima facie* case of obviousness. Moreover, the Examiner is making leaping assumptions of what one of ordinary skill in the art would be capable of doing having merely the references before him. The Examiner cannot now add in other supposed "conventional" art to combine with *Guy* and *Wilson* without doing so in a proper §103 rejection.

All that *Wilson* actually states is that the search engine converts the searched name to its corresponding Internet address (column 7, lines 51-53) and that "[t]he caller then has the option of selecting from a scrolled list of potential users using the dial pad's keyboard." Such a "selecting" does not teach "the first LAN including second circuitry for automatically calling one of the plurality of telecommunications extensions in response to the user selecting one of the plurality of telecommunications

extensions form the observed list.” Even considering as possibly true the Examiner’s assertion that the use of touch-screen displays pre-dates *Wilson*’s disclosure (*Wilson* merely discloses that the display screen 71 may be a conventional LCD (column 5, lines 22-24)), that would possibly merely teach to one of ordinary skill in the art that the user could select one of the entries from the scrolled list using a touch-screen on the dial pad. But, it would not teach or suggest to one of ordinary skill in the art the circuitry in the second LAN for automatically calling the callee in response to such a selection. As noted above, “obvious to try” has long been held not to constitute obviousness.

On page 14 of the Examiner’s Answer, the Examiner states that “Appellant contends that neither *Guy* nor *Wilson* teaches or suggests a list of extensions coupled to the second LAN is stored in a server of the second LAN.” That is incorrect; Applicants actually also asserted that the combination of the references fails to teach or suggest these limitations. The Examiner further asserts that “*Wilson* discloses a directory engine of user numbers/addresses connected to various local networks.” This is a mischaracterization of *Wilson* in that the directory is only coupled to a single network, which does not include any of the dial pads 245-247. This is not the same as the directory being stored in a server in a LAN that includes devices 245-247. *Guy* does not remedy this situation, since it is merely a server code that is stored, which is not provided to a user.

With respect to Claim 10, the Examiner has not shown how the references teach or suggest circuitry for enabling the user to select between observing a list of extensions coupled to the second LAN or observing a list of extensions coupled to the third LAN. *Wilson* merely discloses doing a name search. Column 2, lines 49-53; column 8, lines 8-11. With respect to Claim 35, the Examiner continues to fail to specifically address the limitations of displaying a list of LANs, etc. Moreover, *Wilson* does not teach or suggest that the directory 232 is in a network that is associated with any extensions; furthermore, the claims do not merely recite that the extensions are “associated” with the LANs.

Regarding Claim 4, the voice recognition and synthesis system 61 is disclosed in *Stuntebeck* as only being accessible with a conventional telephone. Column 4, lines 10-16 of *Stuntebeck* describe how such a user of a conventional telephone can call a live attendant who relays search results to the user, while column 4, lines 17-26 provides an alternative to the teachings in lines 10-16 with the voice recognition and synthesis system 61. A conventional telephone does not work in a LAN, therefore one skilled in the art would not have been able to combine *Stuntebeck* with *Guy* and *Wilson* in the manner as asserted by the Examiner. The contested claim limitation is not explicitly met by *Stuntebeck*.

Regarding Claim 36-38 and 40, again Applicants assert that they addressed the Examiner's "piecemeal" assertions of how each of the references addresses various claim limitations, and then Applicants asserted how the combination of the references does not meet the claims limitations. The Examiner cannot ignore Applicants' arguments. MPEP §707.07(f). Furthermore, the Examiner has not shown how all of the claim limitations have been met by the combination of references.

In summary, *Guy* discloses transferring across a WAN some information about a remote network that enables a telephone call to be completed in a correct manner. The information about the remote network is merely a server code, which only identifies the server of the remote network. It does not identify one or more particular extensions coupled to that remote network. Furthermore, this information is NEVER seen by the user; it is transparent to the user.

*Wilson* essentially discloses using a dial-up computer-like device to access a server over the Internet to obtain a phone number, and then dialing that phone number on the dial-up computer-like device to connect to a similar device over the PSTN.

As a result, the combination of *Wilson* and *Guy* does not disclose all of the claim limitations.

First, since Applicants assert that the dial pads 50 in *Wilson* cannot be utilized in a LAN, then the combination of the references does not even teach or suggest to one skilled in the art that there is a first telecommunications device coupled to a first



LAN. In fact, as asserted above, *Wilson* would lead one skilled in the art away from such a first telecommunications device coupled to a first LAN, since *Wilson* teaches away from the utilization of the dial pads in such a LAN. Furthermore, *Wilson* teaches away from a plurality of telecommunications extensions coupled to a second LAN, again since the dial pads 245-247 cannot be coupled together in a LAN.

Second, since (1) the user in *Guy* does not see the server code, (2) since an unknown phone number is obtained by a dial pad 201, 202, 203 by accessing a searchable database over the Internet, (3) since none of the dial pads 245-247 are in a LAN with such a searchable database, and (4) since none of the dial pads 245-247 are even capable of being coupled together into a LAN, the combination of the references does not teach or suggest that a user in the first LAN can observe a list of the extensions coupled to the second LAN.

Third, since all that *Guy* discloses is that a server code is stored in a server in the second LAN, and since the phone numbers in *Wilson* are stored on a third party server, which is searchable over the Internet, the combination of the references does not teach or suggest that the list of the plurality of extensions is stored in a server in the second LAN. In fact, the Examiner has completely failed to address this claim limitation in an adequate manner.

Fourth, correspondingly, the combination of the references does not teach or suggest that the list stored in a server in the second LAN is accessed by first circuitry in the first LAN over the WAN.

Fifth, since *Guy* does not even provide any information to the user, and since *Wilson* teaches that the user has to actually dial the telephone number, the combination of the references does not teach or suggest automatically calling an extension selected by the user from the list of extensions supplied.

Thus, there are several gaps in the combination of *Guy* and *Wilson* teaching or suggesting the limitations of the claims. For this reason alone, the Examiner's *prima facie* case of obviousness fails. Furthermore, the Examiner has not proven how one skilled in the art would fill in these gaps, and leap from the combination of these teachings to the claimed invention. The PTO must grant a patent if it cannot prove

Applicant : Suder et al.  
Serial No. : 10/447,607  
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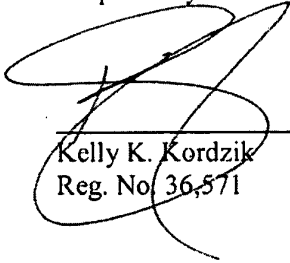
Attorney Docket No.: 21618-0013001

how one of ordinary skill in the art would have found it obvious to fill in these gaps. Such person of ordinary skill in the art is not the inventors, so the Examiner is not permitted to use the Specification as a blue print for piecing together the prior art and filling in these gaps. In order to arrive at the Examiner's *prima facie* case of obviousness rejection, the Examiner has relied solely on the teachings of the present invention to retrace the path of the inventors with hindsight to come to the conclusion that the invention was obvious. *Ortho-MacNeil Pharmaceutical, Inc., v. Mylan Lab., Inc.*, 520 F3d 1358, 1364 (Fed. Cir. 2008). Such a reasoning is always inappropriate for an obviousness test based on the language of Title 35 that requires the analysis to examine "the subject matter as a whole" to ascertain if it "would have been obvious at the time the invention was made." *Id.* The determination of obviousness is made with respect to the subject matter as a whole, not separate pieces of the claim. *Sanofi-Synthelabo v. Apotex, Inc.*, 89 USPQ 2d 1370, 1379 (Fed. Cir. 2008), citing *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007).

It is believed that no fees are due; however, please apply any other charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

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06/30/2009

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Suder et al.                      Art Unit : 2419  
Serial No. : 10/447,607                      Examiner : Gregory B. Sefcheck  
Filed : May 29, 2003                      Conf. No. : 6094  
Title : PHONE DIRECTORY IN A VOICE OVER IP TELEPHONE  
SYSTEM

**Mail Stop Appeal Brief - Patents**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

REPLY BRIEF

This is in response to the Examiner's Answer dated March 17, 2009.

On page 5 of the Examiner's Answer, regarding Claims 26 and 32, the Examiner asserts that "Guy discloses all limitations of the parent claims." If that is true, then why did the Examiner combine *Guy* with *Wilson* for his *prima facie* case of obviousness for those parent claims? For this reason alone, the Examiner has failed to prove a *prima facie* case of obviousness for Claims 26 and 32.

With respect to Claims 28 and 34, the Examiner's *prima facie* case of obviousness relies upon his assertion that the combination of the references provides "the disclosed directory services to as many capable users as can be supported." This does not even make common sense. The claims recite that the list of telephone destinations include telephones external to the system, and therefore, a user of the first telephone can connect to a telephone external to the system (first and second LANs coupled by the WAN) by selecting that external telephone from the observed list. The Examiner's assertion implies that *this* functionality is being supplied to these external telephones, which is not the claims recite. Therefore, the Examiner's assertion fails to support his *prima facie* case of obviousness.

In the Examiner's *Response to Argument*, the Examiner starts off by asserting that Applicants have attacked the references individually. This is incorrect. First, if the Examiner's rejection relies upon his individual use of each reference to attach to

certain claim limitations, then why are Applicants precluded from attacking these arguments? The Examiner's *prima facie* case of obviousness relies upon his assertions of how *Guy* teaches certain limitations and how *Wilson* teaches other certain limitations. If Applicants can show how the Examiner's interpretations of these references are incorrect, then Applicants have shown how the *prima facie* case of obviousness fails. This is what Applicants did precisely. Since the Examiner has incorrectly interpreted the teachings of *Guy* and *Wilson*, the Examiner's *prima facie* case of obviousness fails. An applicant may specifically challenge an obviousness rejection by showing that the examiner reached an incorrect conclusion of obviousness or based the obviousness determination on incorrect factual predicates. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998). As a result, the Examiner cannot simply ignore Applicants' arguments on pages 6, 7, 8, etc. with respect to each of the references by merely replying that Applicants' arguments "cannot show nonobviousness."

Moreover, Applicants actually described what each of the references teaches and does not teach, and then combined those teachings and "non-teachings" to show how the combination of the references does not arrive at the claimed invention. Applicants' arguments on those pages in the Appeal Brief must be considered! MPEP §707.07(f).

The Examiner admits that *Guy* does not disclose the automatic calling of one of the extensions in the observed list. The Examiner then asserts that *Wilson* remedies this situation. The first problem with this assertion is that *Wilson* does not disclose such a first LAN. The caller dial pads 201-203 are not coupled into a LAN, as that term is interpreted in the art. The "local telephone network" recited in column 7, line 18 of *Wilson* is not the same as a LAN. Telephones connected to a central office never were considered a LAN, which pertains to a data network. For the Examiner to interpret these claim terms in that manner is unreasonably broad. MPEP §2111.01. And, a single computer device does not make a LAN. Therefore, the combination of *Guy* and *Wilson* fails to disclose these claim limitations, and the Examiner's *prima facie* case of obviousness fails.

Furthermore, contrary to the Examiner's assertions, *Wilson does not* "repeatedly disclose[] that the users of the phones 201-203 and 245-247 utilize the PSTN and standard LAN/WAN technology to access the Internet, directory engine, etc." There is absolutely nothing in *Wilson* that discloses that the dial pads 201-203 or 245-247 access the Internet 210, etc. with standard LAN/WAN technology through the PSTN circuits 204. Moreover, Figure 4 in *Wilson* shows each of these dial pads individually connecting to the network 210 through their own PSTN circuit 204. There is no LAN! Again, an applicant may specifically challenge an obviousness rejection by showing that the examiner reached an incorrect conclusion of obviousness or based the obviousness determination on incorrect factual predicates. *In re Rouffet* at 1455. Furthermore, the disclosure in *Wilson* that each of the dial pads 50 can be connected to a computer 90 does not provide a suggestion that a plurality of such dial pads can then be coupled in a LAN and then that LAN coupled to the network 210. Since LANs were known by *Wilson*, if he had been able to couple the dial pads 201-203 or 245-247 into a LAN that is then itself connected to the network 210, he would have provided a description of such. The "standard LAN/WAN technology" referred to in *Wilson* is actually referring to the LANs and WANs in Figure 5, such as the Ethernet links 222, that permit the directory 232 to be individually accessed by each of the dial pads. It is not referring to a LAN being formed by a plurality of the dial pads 201-203 or 245-247. In fact, each of the dial pads 50 cannot be coupled into a LAN with each other, since their only connection is through a dual line service (column 5, line 26). As Applicants pointed out in the Appeal Brief, dual line service is well known in the art as a pair of wires for providing access from a home phone to the PSTN. Such teachings in *Wilson* would not lead one skilled in the art to believe that they could couple such dial pads into a LAN. Therefore, one skilled in the art would not be lead to combine *Wilson* with *Guy* since the dial pads in *Wilson* teach away from utilization in a LAN.

The Examiner disagrees that *Wilson* is limited to teaching that the user of the dial pad must manually dial the phone number retrieved. The language cited by the Examiner does not state anything about the dial pad having circuitry for automatically

calling a phone number selected by the user. The Examiner is interpreting the teachings of *Wilson* beyond the four corners of the document.

These teachings in *Wilson* are insufficient for what is required by one of ordinary skill in the art to then experiment and invent further circuitry for the dial pad to automatically call a selected name. A general incentive does not make obvious a particular result, nor does the existence of techniques by which the efforts can be carried out. *In re Kubin*, 2009 WL 877 646 (2009). In other words, “obvious to try” has long been held not to constitute obviousness. *Id.* Essentially, the Examiner is asserting that one skilled in the art at the time the invention was made would have been lead to include circuitry for automatically making the call with merely the teaching that the user makes a selection. This is not supported by *KSR*. To the contrary, the Supreme Court stated in *KSR* that a skilled artisan can only be shown to have merely pursued “known options” from a “finite number of identified, predictable solutions” for obviousness under §103 to arise. 550 US at 421. The Examiner cannot merely make such assumptions without providing objective evidence in support. The prior art does not teach the claimed limitations, and the Examiner must prove how such limitations are disclosed in the cited art. Absent that, the Examiner has failed to support his *prima facie* case of obviousness. Moreover, the Examiner has completely ignored the specific teaching in column 9, lines 1-4 of *Wilson* that once the user of the dial pad selects a remote callee, the call is placed “using the found Internet address,” and that “[i]f a dial attempt is made, the user ... dials ... to the selected callee.” Thus, *Wilson* does say something about using the keyboard to manually dial the number of the callee! **The Examiner cannot ignore the specific teaching in *Wilson* that the user is dialing the found Internet address!**

Contrary to the Examiner’s position, column 2, lines 6-10 of *Wilson* does not refute this teaching. Instead, this language in *Wilson* merely shows the disadvantage of the user having to remember the Internet address of the callee. The invention in *Wilson* then goes onto specifically address the disadvantage by providing a searchable Internet directory for obtaining such an Internet address of the callee. *Wilson’s* specification is solely directed to this aspect. The searchable database converts the

name into the Internet routing address to send to the user at the dial pad. Column 8, lines 1-7. *Wilson* does not provide any description of how the Internet address might be entered in an automatic manner in order to supposedly address a disadvantage of “entering” the digits, as the Examiner is attempting to assert.

The Examiner then makes the assertion that column 8, lines 13-15 of *Wilson* “refers to a scenario in which more than one hit is made for the callee’s request,” and then expands upon this “scenario” by making the following unsupported assertions:

- “it is disclosed to use the keyboard to make the appropriate selection”
- “the calling user may enter a digit, or use the respective arrow and Enter buttons on a keyboard to select the appropriate one of multiple search hits, as would be evident to one of ordinary skill in the art at the time of the invention”
- “these disclosures of *Wilson* would not be considered to require manual entry of the number/address to connect to an intended callee when the number/address has been received and observed from a directory search”

Absolutely none of these assertions by the Examiner is supported with any facts or evidence. Instead, they are all unsupported opinions by the Examiner, which are insufficient to support a *prima facie* case of obviousness. Moreover, the Examiner is making leaping assumptions of what one of ordinary skill in the art would be capable of doing having merely the references before him. The Examiner cannot now add in other supposed “conventional” art to combine with *Guy* and *Wilson* without doing so in a proper §103 rejection.

All that *Wilson* actually states is that the search engine converts the searched name to its corresponding Internet address (column 7, lines 51-53) and that “[t]he caller then has the option of selecting from a scrolled list of potential users using the dial pad’s keyboard.” Such a “selecting” does not teach “the first LAN including second circuitry for automatically calling one of the plurality of telecommunications extensions in response to the user selecting one of the plurality of telecommunications

extensions form the observed list.” Even considering as possibly true the Examiner’s assertion that the use of touch-screen displays pre-dates *Wilson*’s disclosure (*Wilson* merely discloses that the display screen 71 may be a conventional LCD (column 5, lines 22-24)), that would possibly merely teach to one of ordinary skill in the art that the user could select one of the entries from the scrolled list using a touch-screen on the dial pad. But, it would not teach or suggest to one of ordinary skill in the art the circuitry in the second LAN for automatically calling the callee in response to such a selection. As noted above, “obvious to try” has long been held not to constitute obviousness.

On page 14 of the Examiner’s Answer, the Examiner states that “Appellant contends that neither *Guy* nor *Wilson* teaches or suggests a list of extensions coupled to the second LAN is stored in a server of the second LAN.” That is incorrect; Applicants actually also asserted that the combination of the references fails to teach or suggest these limitations. The Examiner further asserts that “*Wilson* discloses a directory engine of user numbers/addresses connected to various local networks.” This is a mischaracterization of *Wilson* in that the directory is only coupled to a single network, which does not include any of the dial pads 245-247. This is not the same as the directory being stored in a server in a LAN that includes devices 245-247. *Guy* does not remedy this situation, since it is merely a server code that is stored, which is not provided to a user.

With respect to Claim 10, the Examiner has not shown how the references teach or suggest circuitry for enabling the user to select between observing a list of extensions coupled to the second LAN or observing a list of extensions coupled to the third LAN. *Wilson* merely discloses doing a name search. Column 2, lines 49-53; column 8, lines 8-11. With respect to Claim 35, the Examiner continues to fail to specifically address the limitations of displaying a list of LANs, etc. Moreover, *Wilson* does not teach or suggest that the directory 232 is in a network that is associated with any extensions; furthermore, the claims do not merely recite that the extensions are “associated” with the LANs.



Regarding Claim 4, the voice recognition and synthesis system 61 is disclosed in *Stuntebeck* as only being accessible with a conventional telephone. Column 4, lines 10-16 of *Stuntebeck* describe how such a user of a conventional telephone can call a live attendant who relays search results to the user, while column 4, lines 17-26 provides an alternative to the teachings in lines 10-16 with the voice recognition and synthesis system 61. A conventional telephone does not work in a LAN, therefore one skilled in the art would not have been able to combine *Stuntebeck* with *Guy* and *Wilson* in the manner as asserted by the Examiner. The contested claim limitation is not explicitly met by *Stuntebeck*.

Regarding Claim 36-38 and 40, again Applicants assert that they addressed the Examiner's "piecemeal" assertions of how each of the references addresses various claim limitations, and then Applicants asserted how the combination of the references does not meet the claims limitations. The Examiner cannot ignore Applicants' arguments. MPEP §707.07(f). Furthermore, the Examiner has not shown how all of the claim limitations have been met by the combination of references.

In summary, *Guy* discloses transferring across a WAN some information about a remote network that enables a telephone call to be completed in a correct manner. The information about the remote network is merely a server code, which only identifies the server of the remote network. It does not identify one or more particular extensions coupled to that remote network. Furthermore, this information is NEVER seen by the user; it is transparent to the user.

*Wilson* essentially discloses using a dial-up computer-like device to access a server over the Internet to obtain a phone number, and then dialing that phone number on the dial-up computer-like device to connect to a similar device over the PSTN.

As a result, the combination of *Wilson* and *Guy* does not disclose all of the claim limitations.

First, since Applicants assert that the dial pads 50 in *Wilson* cannot be utilized in a LAN, then the combination of the references does not even teach or suggest to one skilled in the art that there is a first telecommunications device coupled to a first

LAN. In fact, as asserted above, *Wilson* would lead one skilled in the art away from such a first telecommunications device coupled to a first LAN, since *Wilson* teaches away from the utilization of the dial pads in such a LAN. Furthermore, *Wilson* teaches away from a plurality of telecommunications extensions coupled to a second LAN, again since the dial pads 245-247 cannot be coupled together in a LAN.

Second, since (1) the user in *Guy* does not see the server code, (2) since an unknown phone number is obtained by a dial pad 201, 202, 203 by accessing a searchable database over the Internet, (3) since none of the dial pads 245-247 are in a LAN with such a searchable database, and (4) since none of the dial pads 245-247 are even capable of being coupled together into a LAN, the combination of the references does not teach or suggest that a user in the first LAN can observe a list of the extensions coupled to the second LAN.

Third, since all that *Guy* discloses is that a server code is stored in a server in the second LAN, and since the phone numbers in *Wilson* are stored on a third party server, which is searchable over the Internet, the combination of the references does not teach or suggest that the list of the plurality of extensions is stored in a server in the second LAN. In fact, the Examiner has completely failed to address this claim limitation in an adequate manner.

Fourth, correspondingly, the combination of the references does not teach or suggest that the list stored in a server in the second LAN is accessed by first circuitry in the first LAN over the WAN.

Fifth, since *Guy* does not even provide any information to the user, and since *Wilson* teaches that the user has to actually dial the telephone number, the combination of the references does not teach or suggest automatically calling an extension selected by the user from the list of extensions supplied.

Thus, there are several gaps in the combination of *Guy* and *Wilson* teaching or suggesting the limitations of the claims. For this reason alone, the Examiner's *prima facie* case of obviousness fails. Furthermore, the Examiner has not proven how one skilled in the art would fill in these gaps, and leap from the combination of these teachings to the claimed invention. The PTO must grant a patent if it cannot prove

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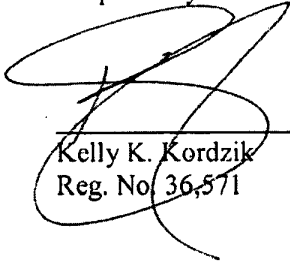
Attorney Docket No.: 21618-0013001

how one of ordinary skill in the art would have found it obvious to fill in these gaps. Such person of ordinary skill in the art is not the inventors, so the Examiner is not permitted to use the Specification as a blue print for piecing together the prior art and filling in these gaps. In order to arrive at the Examiner's *prima facie* case of obviousness rejection, the Examiner has relied solely on the teachings of the present invention to retrace the path of the inventors with hindsight to come to the conclusion that the invention was obvious. *Ortho-MacNeil Pharmaceutical, Inc., v. Mylan Lab., Inc.*, 520 F3d 1358, 1364 (Fed. Cir. 2008). Such a reasoning is always inappropriate for an obviousness test based on the language of Title 35 that requires the analysis to examine "the subject matter as a whole" to ascertain if it "would have been obvious at the time the invention was made." *Id.* The determination of obviousness is made with respect to the subject matter as a whole, not separate pieces of the claim. *Sanofi-Synthelabo v. Apotex, Inc.*, 89 USPQ 2d 1370, 1379 (Fed. Cir. 2008), citing *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007).

It is believed that no fees are due; however, please apply any other charges or credits to Deposit Account No. 06-1050.

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Date: May 18, 2009



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10/447,607	05/29/2003	Eric G. Suder	21618-0013001	6094
26201	7590	07/09/2009	EXAMINER	
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Please find below and/or attached an Office communication concerning this application or proceeding.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Suder et al.	Art Unit : 2419
Serial No. : 10/447,607	Examiner : Gregory B. Sefcheck
Filed : May 29, 2003	Conf. No. : 6094
Title : PHONE DIRECTORY IN A VOICE OVER IP TELEPHONE SYSTEM	

**Mail Stop Appeal Brief - Patents**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

SUPPLEMENTAL BRIEF ON APPEAL

This Supplemental Brief on Appeal is in response to the Office Action dated July 9, 2009.

I. REAL PARTY IN INTEREST

The real party in interest is Estech Systems, Inc., which is the assignee of the entire right and interest in the present Application.

II. RELATED APPEALS AND INTERFERENCES

There are no appeals or interferences known to Appellants, the Appellants' legal representative, or assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Claims 1-6, 8-10, 17-20, 22-38 and 40 are pending in the Application, stand rejected and are on appeal.

Claims 7, 11-16, 21 and 39 have been cancelled.

IV. STATUS OF AMENDMENTS

There were no amendments to the Claims or specification filed after the Final Rejection.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Claim 1 recites an information handling system comprising a first LAN, a second LAN, a WAN coupling the first LAN to the second LAN, a first telecommunications device coupled to

the first LAN, a plurality of telecommunications extensions coupled to the second LAN, and the first LAN including first circuitry for enabling a user of the first telecommunications device to observe a list of the plurality of telecommunications extensions. These elements are shown in Fig. 3 with the first and second LANs represented as any one of LANs 301-303 and the WAN 201 that couples any first and second LAN. Each of the LANs shows telecommunications devices coupled thereto. The LANs 301-303 also show a plurality of telecommunications extensions, e.g., IP telephones 105, 308, 313. See page 6, line 23 - page 7, line 10. Fig. 11 shows a process for enabling a user of a first telecommunications device in the first LAN to observe a list of a plurality of telecommunications extensions coupled to the second LAN. See page 20, line 25- page 22, line 11. Fig. 8 illustrates a block circuit diagram of a telecommunications device that includes a display 810. See page 16, line 21 - page 17, line 26. Figs. 11 and 9A-9B illustrate selecting one of the extensions from the observed list and calling that extension. See page 20, line 25 - page 22, line 11 and page 28, line 7 - page 29, line 4. This process is also illustrated by the state diagram in Fig. 12. See page 22, lines 12-24.

Claim 4 recites an information handling system comprising a first LAN, a second LAN, a WAN coupling the first LAN to the second LAN, a first telecommunications device coupled to the first LAN, a plurality of telecommunications extensions coupled to the second LAN, and the first LAN including first circuitry for enabling a user of the first telecommunications device to observe a list of the plurality of telecommunications extensions. These elements are shown in Fig. 3 with the first and second LANs represented as any one of LANs 301-303 and the WAN 201 that couples any first and second LAN. Each of the LANs shows telecommunications devices coupled thereto. The LANs 301-303 also show a plurality of telecommunications extensions, e.g., IP telephones 105, 308, 313. See page 6, line 23 - page 7, line 10. Fig. 11 shows a process for enabling a user of a first telecommunications device in the first LAN to observe a list of a plurality of telecommunications extensions coupled to the second LAN. See page 20, line 25- page 22, line 11. Fig. 8 illustrates a block circuit diagram of a telecommunications device that includes a display 810. See page 16, line 21 - page 17, line 26. Figs. 11 and 9A-9B illustrate selecting one of the extensions from the observed list and calling that extension. See page 20, line 25 - page 22, line 11 and page 28, line 7 - page 29, line 4. This

process is also illustrated by the state diagram in Fig. 12. See page 22, lines 12-24. Claim 4 recites an additional limitation that the list of the telecommunications extensions is played as audio to the user of the first telecommunications device. The telecommunications device diagram in Fig. 8 shows a speaker 821.

Claims 8, 17 and 24 recite an information handling system comprising a first LAN, a second LAN, a WAN coupling the first LAN to the second LAN, a first telecommunications device coupled to the first LAN, a plurality of telecommunications extensions coupled to the second LAN, and the first LAN including first circuitry for enabling a user of the first telecommunications device to observe a list of the plurality of telecommunications extensions. These elements are shown in Fig. 3 with the first and second LANs represented as any one of LANs 301-303 and the WAN 201 that couples any first and second LAN. Each of the LANs shows telecommunications devices coupled thereto. The LANs 301-303 also show a plurality of telecommunications extensions, e.g., IP telephones 105, 308, 313. See page 6, line 23 - page 7, line 10. Fig. 11 shows a process for enabling a user of a first telecommunications device in the first LAN to observe a list of a plurality of telecommunications extensions coupled to the second LAN. See page 20, line 25- page 22, line 11. Fig. 8 illustrates a block circuit diagram of a telecommunications device that includes a display 810. See page 16, line 21 - page 17, line 26. Figs. 11 and 9A-9B illustrate selecting one of the extensions from the observed list and calling that extension. See page 20, line 25 - page 22, line 11 and page 28, line 7 - page 29, line 4. This process is also illustrated by the state diagram in Fig. 12. See page 22, lines 12-24. Claims 8, 17 and 24 additionally recite that the first telecommunications device is an IP telephone and a user of that IP telephone tacitly selects one of the observed extensions from the list which results in an initiation of the call to that telecommunications extension across the WAN. Further, Claims 8, 17 and 24 recite that the list of the plurality telecommunications extensions is stored in a server in the second LAN and is accessed by the first circuitry across the WAN. The IP telephones are shown in various figures, including Figs. 3 and 8. Fig. 11 illustrates a step for selecting the telecommunications extension from the list that is displayed for initiating the call, which proceeds to Fig. 9A. Figs. 11, 12, and 14 among others illustrate the storage of the list of telecommunications extensions in the second LAN, the list then being accessed across the WAN

by the first LAN. See page 6, line 23 - page 7, line 10; page 16, line 21 - page 17, line 26; page 20, line 25 - page 22, line 11; and page 22, lines 12-24. Further, the basic concept of accessing a list across the WAN and then making a call is described on page 18, line 21 - page 19, line 6 and page 20, lines 12-24.

Claim 30 recites a telecommunications systems comprising a first IP telephone coupled to a first IP server within a first LAN, second and third telephone extensions coupled to a second IP server within a second LAN, and a WAN coupling the first LAN to the second LAN, the first LAN, the second LAN, and the WAN communicating using an IP protocol. These features are similar to those discussed above with respect to Claims 1, 4, 8, 17, and 24, and are well supported within the aforementioned figures and specification, such as Fig. 3 and its supporting specification recitations noted above with respect to Claim 1. See page 6, line 23 - page 7, line 10; page 16, line 21 - page 17, line 26; page 20, line 25 - page 22, line 11; and page 22, lines 12-24. Claim 30 further recites a means for displaying on the first IP telephone a list of telephone destinations stored in the second IP server in response to selection of a first input on the first IP telephone, wherein the list of telephone destinations is communicated from the second IP server over the WAN to the first IP telephone. An IP telephone 105 is illustrated in Figs. 1 and 3, and is shown in more detail in Fig. 8, which shows that the IP telephone 105 has an LCD display 810. See page 16, line 21 - page 17, line 26. IP servers within the LANs are as shown in Fig. 3, including IP server 101 and IP server 306. IP server 101 is also shown in Figs. 1 and 2. Fig. 4 shows that IP server 101, which is representative of any of the IP servers, including IP server 306, has a hard drive 403. As a result, a list of telephone destinations may be stored within such a hard drive. Selection of a list displayed on LCD display 810 of the IP telephone shown in Fig. 8 can be performed using such input devices as the keyboard 807 or a DSS console 811. Fig. 8 in such features are discussed on page 16, line 21 - page 18, line 20; selection of an extension from a list is also discussed on page 18, line 21 - page 20, line 24. The process for permitting a user to view and select extensions on the first IP telephone is illustrated in Fig. 11, which is discussed on page 20, line 25 - page 22, line 11. Also there is an establishment of a connection between the two remote LANs with respect to Fig. 14, which includes a description of the sending of a message from one LAN to the other in order to request a list of the telephone



extensions, which are then communicated from that second LAN over the WAN to the first WAN and specifically the IP telephone. Further, Fig. 12 illustrates a state diagram of this process, which is described on page 22, lines 12-24. Automatic dialing of the selected telephone destination and a response to selection of one of the telephone destinations from a displayed list is described on page 22, lines 4-24.

Claim 36 recites a method for receiving several touch inputs from a user on the IP telephone that is networked into the LAN/WAN/LAN network described above and with respect to Fig. 3 in order to again permit such a user to view a display telephone extensions at a remote LAN, and then automatically dialing that telephone destination. Claim 36 includes steps for sending a message from the first LAN to the second LAN requesting the list of telephone extensions from the second LAN, which is delivered to the first LAN from the second LAN. Claim 36 includes steps whereby a first list of second and third LANs coupled to the first LAN is provided, and then a second list of telephone destinations at a selected LAN are then provided. Such steps are shown in Figs. 11, 12, and 14 as noted above. See page 20, line 25 - page 22, line 24.

IV. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

1. Claims 1-3, 5-6, 8-10, 17-20 and 22-35 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Guy et al.* (U.S. Patent No. 6,298,057) in view of *Wilson* (U.S. Patent No. 6,829,231).
2. Claim 4 stands rejected under 35 U.S.C. §103(a) as being unpatentable over *Guy* in view of *Wilson* and further in view of *Stuntebeck et al.* (U.S. Patent No. 6,065,016).
3. Claims 36-38 and 40 stand rejected under 35 U.S.C. § 103 as being unpatentable over *Wilson* in view of *Guy*.

## VII. ARGUMENT

1. Claims 1-3, 5-6, 8-10, 17-20 and 22-35 are not properly rejected under 35 U.S.C. § 103 as being unpatentable over *Guy* in view of *Wilson*.

The basic test for nonobvious subject matter is whether the differences between the subject matter and the prior art are such that claimed subject matter as a whole would not have been obvious to a person having ordinary skill in the art to which a subject matter pertains. The United States Supreme court in *Graham v. John Deere & Co.*, 383 U.S. 1 (1966) set forth the factual inquiries which must be considered in applying the statutory test: (1) a determination of the scope and contents of the prior art; (2) ascertaining the differences between the prior art and the claims at issue; and (3) resolving the level of ordinary skill in the pertinent art.

In determining the scope and contents of the prior art, the Examiner must first consider the nature of the problem on which the inventor was working. Once this has been established, the Examiner must select, for purposes of comparing and contrasting with the claims at issue, prior art references which are reasonably pertinent to that problem. In selecting references, hindsight must be avoided at all costs.

In ascertaining the differences between the cited prior art and the claims at issue, the Examiner must evaluate the claimed subject matter as a whole; there is no requirement that any differences between the claimed subject matter and the cited references be "remarkable" nor that some technological discontinuity between the claimed invention and subject matter exists just outside the claims. The requisite view of the whole invention mandates consideration of not only its structure, but also of its properties and the problems solved. Further, the mere fact that the prior art can be modified does not made the modification obvious unless the prior art suggests the desirability of the modification; there must be some logical reason apparent from positive, concrete evidence that justifies the modification.

In resolving the level of ordinary skill in the pertinent art, the Examiner must step backward in time and into the shoes worn by the person or ordinary skill when the invention was

unknown and just before it was made. The hypothetical person skilled in the art can summarily be described as one who thinks along lines of conventional wisdom in the art and neither one who undertakes to innovate nor one who has the benefit of hindsight. Thus, neither an Examiner, nor a Judge, nor a genius in the art at hand, nor even the inventor is such a person skilled in the art.

*Guy* teaches a system and method for transparently transmitting aural signals across a LAN, where a user places a telephone call using the same procedure that is used when placing a telephone call over a conventional public switch network, and in certain situations if the server code is not in the local directory, then a request goes to a master directory. Column 3, lines 39-48; column 9, lines 23-28. Referring to Fig. 1 in *Guy*, the first LAN maybe represented by 102A, the WAN by 104, and the second LAN by 102B. (Note that Applicants do not necessarily admit that 102A is a local area network, since a local area network is shown in Fig. 1 as 116; however, for the sake of arguing against the rejection, 102A will be designated as the first LAN.) *Guy* describes a set-up operation for when a first telephone 106 wishes to make a call to a user at a second telephone 126, where the first telephone 106 is coupled to a file server 112, and the second telephone is coupled to a CSU 130 via a PBX 128. Column 6, lines 45-51; column 10, lines 7-9. Fig. 2 illustrates a more detailed illustration of file server 112. Column 6, lines 52. Fig. 5 also further has a description of a flow chart illustrating such a call set-up procedure. Column 9, line 66. A user activates the telephone by lifting the handset and selecting the channel line in order to transition to an off-hook state period. Column 10, lines 7-9. The user then performs the normal process of dialing a telephone number on the first telephone 106 (as described below, this telephone number is not provided to the user by the system), with the telephone associated with the second telephone 126, and a procedure is then implemented across network 104 just as if the user were making a call over a conventional public telephone system. Column 10, lines 13-17. Thus, such a procedure is completely transparent to the user and they do not have to re-learn how to use a telephone system other than what has been normally done in the prior art POTS systems. Column 10, lines 25-29. The telephone number dialed by the user on telephone 106 identifies the destination telephone 126. Column 10, lines 30-31. It is the first set of digits that are dialed by the user that identifies the destination CSU 130 to which the

second telephone 126 is connected to the second LAN 134. This first set of digits is referred to in *Guy* as the server code. Column 10, lines 32-36. In other words, the server code operates the same as an area code in the POTS. All within the first LAN 102A, a call set up unit 404 within a server memory module 214 that is in server 112 makes an attempt to retrieve such a server code from the memory module 212, which is then transmitted to the directory management unit 408. Column 10, lines 55-58. Again, this is all performed within the first LAN 102A. The directory management unit 408 searches the local directory 406 for a server that is identified with the server code dialed by the user, and if there are no server matches, then the directory management unit 408 will generate a request to a master directory, which will make a determination if the server code dialed by the user on the first telephone 106 is identified with any server in the network 100. Column 10, lines 58-65. If the server code is identified in such a master directory, then the network address of the destination CSU 130 associated with the server code is transmitted to the directory management unit 408. Column 11, lines 2-8. The directory management unit 408 transmits this network address to the call set up and tear down unit 404, which transmits the number of additional digits to the call management unit 310, and the call set-up/tear down unit 404 transmits a call set up packet to the destination CSU 130, which receives the set up packet and determines if the telephone 126 is available to receive the call. Column 11, lines 11-28.

Thus, in *Guy*, nothing more is taught than the caller on first telephone 106 dialing digits associated with the destination telephone 126. There is absolutely no teaching or suggestion within *Guy* that a list of a plurality of telecommunications extensions coupled to the second LAN is provided to the user of the first telephone 106 for observation, or hearing them. The server code accessed from the master directory is only associated with the CSU 130, and does not provide any further information that would enable the combination of the disclosures of *Guy* and *Wilson* to display a list of the telecommunications extensions coupled to the second LAN. The user in *Guy* must still rely upon a phone list that is external from the system described in *Guy* in order to make a telephone call in the network. The master directory only contains the server code. The server code only identifies the CSU 130 to which the destination telephone is connected. Column 10, lines 33-36. Additional digits are still required in order to telephone or

contact the destination telephone from the originating telephone. Column 11, line 1-column 12, line 21. There is further no teaching or suggestion within *Guy* that a list of extensions is provided from anywhere else in the network.

There is absolutely no teaching or suggestion in *Guy* to help out a user by providing the user with a list of extensions in a LAN within the *Guy* network.

In order to overcome the deficiencies of the teachings of *Guy*, the Examiner has added *Wilson* to combine with *Guy*. A problem with the Examiner's combination of *Wilson* and *Guy* is that the Examiner has expanded the teachings of *Wilson* beyond what is reasonable. The invention described in *Wilson* is sort of a hodgepodge device 50 created to permit a user to send audio packets to another user using internet addressing. *Wilson* attempts to simplify the use of the Internet for long-distance calling applications. Column 2, lines 31-32. *Wilson* merely provides a system that has services similar to those found on the POTS. See the Abstract. A list of known callees can be stored inside the device described in *Wilson*, and for unknown callee addresses, a method for retrieving such an address for a remote location is provided. Column 2, lines 47-53. The hodgepodge device 50 is shown in Fig. 2, with its circuit diagrams shown in Fig. 3. Telephone calls over the PSTN can be made with device 50 by making normal voice DTMF telephone calls using the keypad 65. Column 4, lines 60-64. Note that this mode is performed only when the user already knows the telephone number of the callee, and does not play into the description of the invention within *Wilson* that the Examiner is relying upon.

Internet access can be made by the device 50 by the user pressing the Internet access button 69 to switch between normal DTMF voice calls and internet dial-up operations, where an internet connection is made using an internal modem set. Column 5, lines 5-11. The device 50 can be connected using an RS232 jack 86 to a computer 90, but there is no further discussion of connecting the device 50 to a local area network, or LAN. Column 5, lines 33-38.

Referring to Figs. 4 and 5 in *Wilson*, each of the dial pads 50 is now referred to as dial pads 201, 202 and 203, which are each connected to PSTN circuits 204. Column 7, lines 15-17.

The PSTN circuits 204 and a local exchange switch 205 form a local telephone network within a geographic area. Column 7, lines 17-19. A similar situation is associated with the callee devices 245, 246, 247. It is important to note that dial pads 201, 202 and 203 are not part of a LAN. A LAN is a data network that permits all of the devices on the network to communicate with each other, such as with the use of an Ethernet protocol. Such a LAN is disclosed in the specification of the present application in paragraph [0028], and shown in FIG. 1. A LAN, as is well known in the art, is a short distance data communications network used to link computers and peripheral devices under some form of standard control. Such a definition for a LAN is found in *Newton's Telecom Dictionary*. That definition also further states that "A LAN does not use common carrier circuits." It is clear that the dial pads 201-203 and callees 245-247 taught in *Wilson* are not connected in a LAN. More specifically, dial pads 201-203 are not coupled together in a LAN, and callees 245-247 are not coupled together in a LAN. Each of these devices 50 is separately connected to the PSTN via jacks 80 and 82 that provide a dual line access to the PSTN. Column 5, lines 25-26. A dual line service is a telephone service where two pairs of wires are connected to a premises for connection to the PSTN. See *Newton's Telecom Dictionary*. This is further supported in *Wilson* by the more detailed diagram of a dialing pad 50 in Fig. 3 which shows that the dual line access is provided by typical tip and ring connections 102 that enable the transfer of an analog signal over this dual line connection. Column 5, lines 50-56. Such internet access also requires use of a modem data pump 112. Column 6, lines 19-27. The only LAN disclosed in *Wilson* is that associated with the internet service providers (ISPs) shown in Figs. 4 and 5.

As a result, the only way each of the dial pads disclosed in *Wilson* can access the internet is by using typical dial-up modem message interchanges. And, this is the only way one of the dial pads 201-203 can communicate with one of the callees 245-247. In other words, for one of the dial pads 201-203 to "call" one of the callees 245-247, that particular callee must have an already established audio internet connection so that it is prepared to receive any audio messages from one of the dial pads 201-203. Column 7, lines 28-31. If such a callee is not already connected to the internet when it receives a message to perform audio communication from one

of the dial pads 201-203, then that callee will have to dial up into their internet service provider and obtain the sent audio message at a later time. Column 7, lines 31-33.

If the internet (IP) address of one of the callees 245-247 is not stored within a database of one of the dial pads 201-203, then the dial pad can make an internet access through internet service provider 215 to browse a user database directory 232 through a search engine 230, which stores such IP addresses, and return that IP address to the dial pad. Column 7, lines 46-64. This provides a process whereby a user of a dial pad 201-203 does not need to know the actual internet IP address of one of the callee devices 245-247, but can use a search engine 230 to enter in some other designation (e.g., alphanumeric identifier; column 7, lines 52-53 and column 8, line 59) for one of the callees 245-247, such as a user's name, to thereby have that search engine retrieve the internet IP address from a website to the dial pad 201-203. Column 8, lines 1-15. If more than one hit is made by the search engine 230, a list of names can be returned to the dial pad, and the caller using one of the dial pads 201-203 can select the one they wish from the list by looking at the list on the screen 71 of the device 50. Column 8, lines 13-50.

It should be noted that the main distinction between the device 50 shown in Fig. 5 of *Wilson* from Fig. 4 is that a single user database 232 can be accessed by a wide range of ISPs at different locations. Column 8, lines 29-30. Otherwise, the configuration in Fig. 5 is the same as the one in Fig. 4 for purposes of how *Wilson* might be relevant to the rejection in accordance with the Examiner's assertions.

Fig. 6 in *Wilson* describes an exemplary call progress flow diagram for connecting one of the dial pads 201-203 to the directory search engine 230. Column 8, lines 50-51. Note that Fig. 6 in *Wilson* does not describe the part of the flow whereby one of the dial pads makes an internet connection to one of the callees. The process *Wilson* starts with has one of the dial pads 201-203 dialing out to establish an internet connection 360 using the modem 112. Column 8, lines 52-53. Once this internet dial-up connection is made, then the user of the dial pad can enter a known internet IP address number to access, over the internet, one of the callees 245-247, or start a search for the IP address of one of the callees if it is not known. This is shown by step 370 in

Fig. 6. The search engine will perform a search 372 and respond 374 by transmitting the results 376 of that search back to the dial pad 201-203. Column 8, lines 59-65. The user of the dial pad selects a callee from the list delivered by the search engine, and the user can then accept one of the addresses provided and dial to the selected callee. Column 9, lines 1-4. It should be noted at this point that *Wilson* does not teach that one of the dial pads 201-203 is able to automatically perform the dialing process in response to some sort of selection of a name on a displayed list by the user of the dial pad 50 pressing some sort of button to select one of the names. Instead, *Wilson* merely teaches that the user can apparently view the IP address of the callee and enter in that address using the dial pad's keyboard 63. Column 8, lines 13-15.

Therefore, all that *Wilson* teaches is (1) a specialized device 50 that is a combination of a dial pad/modem that is able to access the internet with a dial-up connection over the PSTN circuits (and can also act as a normal PSTN telephone where a user can enter in PSTN-type telephone numbers to call another PSTN telephone), and (2) an ability for one of the specialized devices 50 to have audio communications with another specialized device 50 over an internet channel whereby a connection is made between these two specialized devices using typical IP internet addresses, and (3) if the IP address of a callee is not known, then an internet search engine can be used to browse to access a database on the internet that will retrieve such an IP address that is then displayed to a user of a specialized device so that the user can then enter in that IP address to the specialized device to establish the audio connection over the internet. The teachings of *Wilson* clearly show that its invention was not created to operate in a voice-over IP system with capabilities such as recited in the present claims. See column 2, lines 1-5.

All that *Guy* teaches is an ability for a telephone connected to a first LAN to communicate over a WAN to a telephone in a second LAN, and if the directory management unit of a file server in the first LAN does not know the address of a central site unit connected to a PBX in the second, it can retrieve that server code from a remote location for completing the call between the two telephones.



With respect to Claim 1 and all the other rejected claims, a result of the foregoing is that the combination of *Guy* and *Wilson* does not teach or suggest circuitry within the first LAN for enabling a user of the first telecommunications device within that first LAN to observe a list of the plurality of telecommunications extensions coupled to the second LAN, wherein the list of the plurality of telecommunications extensions is stored in a server in the second LAN and is accessed by the first circuitry across the LAN.

The combination of *Guy* and *Wilson* does NOT provide to the user of the first device in the first LAN the list of extensions the user can call in the second LAN and then a means to automatically initiate that call with a selection from that list. *Guy* provides nothing to the user of the telephone, and *Wilson* has no LANs (and as a consequence, no lists of extensions coupled to a LAN).

*Guy* does not provide any type of information identifying any type of telecommunications device within the second LAN 102B to a user of a telecommunications device within the first LAN 102A. Instead, merely a server code is provided to the directory management unit 408 so that it can complete the call when it receives the dialing digits from the telephone so that it knows what LAN to send the call to. Further, *Wilson* also does not provide a list of telecommunications devices coupled to the second LAN. In fact, callees 245-247 are not part of a LAN. More than one entry might be supplied by the search engine 230 accessing the database 232 back to one of the dial pads 201-203 for display to the user, but the fact that there is a plurality returned is only a result of the fact that the user entered in search terms that matched more than one entry in the database 232. There is nothing within *Wilson* that teaches or suggests that those plurality of entries returned for display to the user are all coupled to a separate LAN over network 210, or that such a list of search results would even list more than one of the callees 245-247.

A result is that the combination of the references does not teach or suggest that a list of the plurality of telecommunications extensions coupled to the second LAN is provided to the user of the first telecommunications device for observation.

And further, neither of the references, nor their combination, teaches circuitry for automatically calling one of those telecommunications from that list in response to the user selecting one of those extensions from the observed list. *Guy* does not even approach such a process, since the retrieval of the server code is done in response to the dialing of a telephone number already performed by the user. Further, as noted above, *Wilson* also does not teach or suggest such an automatic calling of the extension, but instead provides the list on the display 71 on one of the dial pads 201-203 so that the user can then enter in the IP internet address on the keypad 63.

The Examiner has failed to prove a *prima facie* case of obviousness because important limitations are not found within any of the cited prior art references. MPEP § 2143.03 states that to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

This is further an important distinction for several reasons. One of them is that it permits a user in one geographic location to locate a station user in another location without the need to use a printed extension guide. See Specification, page 20, lines 21-24. This would not be possible with the combination of references asserted by the Examiner, but is implemented with the present invention as claimed.

Furthermore, neither of the references, nor their combination, teaches or suggests that such a list of telecommunications extensions coupled to the second LAN is stored in a server in that second LAN.

Moreover, with respect to Claim 2, the Examiner has not shown how the combination of references teaches a LAN or WAN operating under an IP protocol. *Guy* does not disclose its LANs or WAN operating under an IP protocol, and *Wilson* does not disclose LANs with telephone/telecommunications extensions coupled thereto.

Claim 5 recites that the second circuitry that automatically makes the call to the remote telecommunications extension includes a key for enabling the user to tacitly select one of those extensions from the displayed list. The Examiner admits that *Guy* does not teach such a process. In fact, it is impossible for *Guy* to teach or suggest this process, since a list is nowhere to be provided to the calling user. The Examiner asserts that *Wilson* discloses this process, since *Wilson* states that the user may select a destination from this scrolled list of potential destinations. All that *Wilson* discloses is that the caller has an option of selecting from a displayed scrolled list of potential users by using the keyboard 63 to select the intended caller. *Wilson* in no way further describes what is done in response to that action. Claim 5 recites that the second circuitry includes a key for enabling the user to make such a tacit selection from the displayed list. However, second circuitry also recites automatically calling one of the extensions in response to such a selection by the user. *Wilson* teachings do not go that far, and there is no flow diagram, circuitry or any other discussion or mention within *Wilson*, or *Wilson* in combination with *Guy*, that would suggest such an automatic calling of the remote party by selection of one of the extensions in the list by a user pressing a button. Therefore, one skilled in the art at the time the invention was made would not be able to create the invention recited in Claim 5 in view of the combination of the teachings of the prior art references.

With respect to Claim 6, the foregoing arguments made with respect to Claim 5 are incorporated. Claim 6 further recites that the initiation of the call is made by that tacit selection of that button when a user presses that button to select one of the names from the list. This is in no way taught or suggested by the prior art references.

Claim 8 is patentable over the cited references for all of the arguments provided herein with respect to Claims 1-6. Claim 8 also recites that the list of plurality of telecommunications extensions stored in a server in a second LAN is accessed by the first circuitry in the first LAN across the WAN. As noted above, there is no teaching or suggestion within the combination of the references that a list of the telecommunications extensions coupled to the second LAN are stored in a server in that second LAN. Thus, there is also no teaching or suggestion that this list

is then accessed from the server in the second LAN across the WAN by circuitry in the first LAN that enables the user of the first telecommunications device to observe this list of the plurality of telecommunications extensions.

Claim 10 recites a third LAN coupled to the first and second LANs via the WAN. The third LAN includes a plurality of telecommunications extensions coupled thereto. The first LAN has circuitry that enables a user in that first LAN to select between observing between a list of the plurality of telecommunications extensions coupled to the second LAN or observe a list of the plurality of the telecommunications extensions coupled to the third LAN. In addressing this claim language, all the Examiner has done is to imply that *Wilson* teaches "a third LAN and first LAN circuitry for selecting and viewing a list of a plurality of extensions coupled to the second and/or third LAN."

First, this is a wholly inadequate rejection by the Examiner, and does not provide enough evidence to support a *prime facie* case of obviousness. The Examiner is required to prove such a suggestion by objective evidence. *Ex parte Levengood*, 28 U.S.P.Q.2d 1300, 1301 (Bd. Pat. App. & Int. 1993); *Ashland Oil, Inc. v. Delta Resins and Refractories, Inc.*, 776 F.2d 281, 227 U.S.P.Q. 657 (Fed. Cir. 1985). The legal conclusion of obviousness must be supported by facts. *Graham v. John Deere & Co.*, 383 U.S. 1 (1966). A rejection based on § 103 clearly must rest on a factual basis, and these facts must be interpreted without hindsight reconstruction of the invention from the prior art. The patentability of an invention is not to be viewed with hindsight or "viewed after the event." *Goodyear Company v. Ray-O-Vac Company*, 321 U.S. 275, 279, 64 S.Ct. 593, 88 L.Ed. 721 (1944). Instead of relying upon objective evidence to support the Examiner's assertion, the Examiner has merely supported such an obviousness rejection with the Examiner's own opinion, which is quite clearly not objective evidence as is required by the case law.

Secondly, as noted above, *Wilson* does not teach or suggest that any of the dial pads 201-203 or 245-247 are coupled to each other within a LAN. Third, as noted above, a list of such callees 245-247 is not provided by the database 232 through the search engine 230 to one of dial

pads 201-203. Fourth, there is no teaching or suggestion within the combination of references for enabling a user in the first LAN to select between observing a list of extensions coupled to the second LAN or observing a list of extensions coupled to the third LAN. The Examiner has failed to provide a *prima facie* case of obviousness because important limitations are not found within any of the cited prior art references. As noted previously, MPEP § 2143.03 states that to establish *prime facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Claim 17 is patentable for reasons similarly given herein with respect to Claims 1-6 and 8.

Claim 18 is patentable for reasons similarly given herein with respect to Claims 1-6 and 8.

Claim 19 is patentable for reasons similarly given herein with respect to Claim 8.

Claim 20 is patentable for reasons similarly given herein with respect to Claims 5 and 8.

Claim 23 is patentable for reasons similarly given herein with respect to Claim 10.

Claim 24 is patentable for reasons similarly given herein with respect to Claims 1-6, 8 and 17.

Claim 30 incorporates "means for" language that the Examiner must interpret under 35 U.S.C. § 112, sixth paragraph. The Examiner must interpret and examine this claim and others with means for language under this doctrine. See MPEP § 2182, 2183. Claim 30 recites a means for displaying on the first IP telephone a list of telephone destinations stored in the second IP server in response to selection of a first input on the first IP telephone. The second IP server has second and third telephone extensions coupled thereto in a second LAN. As noted above, the combination of the references does not teach or suggest a list of telephone destinations stored in

a second IP server within a second LAN that is coupled to second and third telephone extensions. This is also supported in Figs. 11-12 and 14 and also the call processing flow diagram illustrated in Figs. 9a and 9b, and their accompanied description. Claim 30 is also patentable for reasons given herein with respect to Claims 1-3.

The Examiner has not specifically addressed the limitations in Claims 27 and 33. For Claims 25-26 and 31-32, the Examiner provides no objective evidence as to how the references teach or suggest a second input or that the first and second inputs are the same key button. The Examiner is required to prove such a suggestion by objective evidence. *Ex parte Levengood*, 28 U.S.P.Q.2d 1300, 1301 (Bd. Pat. App. & Int. 1993); *Ashland Oil, Inc. v. Delta Resins and Refractories, Inc.*, 776 F.2d 281, 227 U.S.P.Q. 657 (Fed. Cir. 1985). The legal conclusion of obviousness must be supported by facts. *Graham v. John Deere & Co.*, 383 U.S. 1 (1966). A rejection based on § 103 clearly must rest on a factual basis, and these facts must be interpreted without hindsight reconstruction of the invention from the prior art. The patentability of an invention is not to be viewed with hindsight or "viewed after the event." *Goodyear Company v. Ray-O-Vac Company*, 321 U.S. 275, 279, 64 S.Ct. 593, 88 L.Ed. 721 (1944). Instead of relying upon an objective evidence to support the Examiner's assertion, the Examiner has merely supported such an obviousness rejection with the Examiner's own opinion, which is quite clearly not objective evidence as is required by the case law. Further, Applicants respectfully traverse the assertion of what is well known in the art. As a result, the Examiner is required to support such an assertion with objective evidence.

Claim 35 recites a third LAN coupled to the first and second LANs via the WAN. Claim 35 further recites a means for displaying on the first IP telephone a list of LANs coupled to the LAN, including the second and third LANs. This limitation has not been addressed by the Examiner in any way. For this reason alone, this claim is patentable over the cited prior art. Secondly, there is no teaching or suggestion within the prior art references of displaying a list of LANs on the telephone display in either *Guy* or *Wilson* or their combination. Further, there is no teaching or suggestion in those references for displaying the first list of telephone destinations stored in the second IP server in response to selection of the second LAN from the displayed list

of LANs. Again, the Examiner has not in any way addressed this claim limitation, and for this reason alone, Claim 35 is patentable over the cited prior art. Secondly, this limitation is not taught or suggested by the combination of the references. Claims 35 is patentable for similar reasons as provided in Claims 10 and 23.

On page 4 of the Office Action, the Examiner has made assertions as to what *Wilson* teaches. Applicants respectfully traverse such assertions and incorporate by reference Applicants' arguments made in the previous amendment with respect to the teachings of *Wilson*.

With respect to Claims 28 and 34, Applicants respectfully traverse the Examiner's assertions. The Examiner has mischaracterized the limitations within these claims. These claims recite that the telephone destinations may include telephones external to the system. Such telephone destinations are included in a list stored in the second IP server which are communicated from the second IP server over the WAN to the first IP telephone. This is not taught or suggested within *Wilson*. Applicants traverse the Examiner's assertion of what is well known in the art, requiring the Examiner to support such assertions with objective evidence.

2. Claim 4 is not properly rejected under 35 U.S.C. § 103 as being unpatentable over *Guy* in view of *Wilson* and further in view of *Stuntebeck et al.* (U.S. Patent No. 6,065,016). Applicants respectfully traverse this rejection for reasons similarly given herein for Claims 1-2.

Claim 4 further recites that the list of the plurality of telecommunications extensions is played as audio to the user of the first telecommunications device. First, this is impossible in the invention in *Guy*. Secondly, *Wilson* does not teach or suggest such a capability. In fact, *Wilson* is attempting to simplify the process of two internet devices having an audio communication between each other, because when such an IP address is dialed, up to 20 digits have to be entered by the caller. Column 2, lines 8-9. *Wilson* specifically states that a user having to remember and enter such digits is neither appealing nor practical in most situations. Column 2, lines 9-10. Thus, Applicants respectfully assert that *Wilson* actually teaches away from such an audio communication of the IP addresses. Plus, *Wilson* does not suggest playing an audio list of even

one IP address to a user of one of the dial pads 201-203, but instead specifically discloses the display of such IP addresses.

3. Claims 36-38 and 40 are not properly rejected under 35 U.S.C. § 103 as being unpatentable over *Wilson* in view of *Guy*. Applicants respectfully traverse these rejections for reasons similarly given above.

These foregoing features of displaying a list of LANs on the IP telephone is also recited in Claim 36. As a result, Claim 36 is also patentable over the cited prior art, since the Examiner has failed to prove a *prime facie* case of obviousness in rejecting these claims. In the Examiner's rejections, the Examiner merely regurgitates the claim language without pointing to a teaching within the references of such claim limitations. Fig. 5 and column 7, lines 45-67 of *Wilson* do not teach or suggest such limitations. Claim 36 further recites the display of such a list of LANs is done in response to the receiving a first touch input from a user on the telephone. There is no discussion within *Wilson*, or a combination of *Wilson* and *Guy*, of a user making a request for a list of LANs. Note further, that Claim 36 recites that the IP telephone is networked into a first LAN. As noted above, *Wilson* does not teach or suggest that the dial pads are in LANs. Claim 36 then recites that a second touch input from the user will result in the display of a list of telephone destinations that are accessible from the second LAN. As noted above, this claim limitation is not taught or suggested within *Wilson*, or *Wilson* combined with *Guy*. Claim 36 then goes on to recite that a third touch input results in an automatic dialing of one of the destinations accessible from the second LAN. As noted previously by Applicants, such an automatic dialing process is not taught or suggested by the references.

Claim 36 also recites that the displaying steps further recite a step of sending a message from the first LAN to the second LAN requesting the second list. This is not shown or discussed anywhere within the references. The Examiner attempts to overcome a deficiency in the teachings of *Wilson* with regard to this limitation and the next one by referring to *Guy*. *Guy* retrieves a server code, but does so from a master directory somewhere in a server in a network 100. There is no disclosure in *Guy* of where such a master directory is located within the



network 100. It needs to be remembered that such a server code only identifies a device that is coupled to a PBX that communicates with the telephones in a network. Additionally, a list has not been sent across the WAN to the file server 112, but instead a single server code is sent. The claim specifically recites that a list of telephone destinations accessible from a second LAN is requested and retrieves it from the second LAN. The Examiner then goes on to assert, without objective support, that it would have been obvious to supply the internet database in *Wilson* from local directories stored in each respective LAN segment of a network as shown by *Guy*, thereby insuring that the internet master directory is up to date.

First of all, without some objective support for such an assertion, the Examiner's obviousness conclusion is without merit and cannot support his combination of the references to arrive at the claimed invention. The Examiner is required to prove such a suggestion by objective evidence. *Ex parte Levengood*, 28 U.S.P.Q.2d 1300, 1301 (Bd. Pat. App. & Int. 1993); *Ashland Oil, Inc. v. Delta Resins and Refractories, Inc.*, 776 F.2d 281, 227 U.S.P.Q. 657 (Fed. Cir. 1985). The legal conclusion of obviousness must be supported by facts. *Graham v. John Deere & Co.*, 383 U.S. 1 (1966). A rejection based on § 103 clearly must rest on a factual basis, and these facts must be interpreted without hindsight reconstruction of the invention from the prior art. The patentability of an invention is not to be viewed with hindsight or "viewed after the event." *Goodyear Company v. Ray-O-Vac Company*, 321 U.S. 275, 279, 64 S.Ct. 593, 88 L.Ed. 721 (1944). Instead of relying upon objective evidence to support the Examiner's assertion, the Examiner has merely supported such an obviousness rejection with the Examiner's own opinion, which is quite clearly not objective evidence as is required by the case law.

Secondly, *Wilson* does not teach or suggest other LANs because *Wilson* does not show other LANs having telephone extensions connected thereto whereby a list is stored within such LANs for sending to update the directory database 232. Nor does *Wilson* suggest that such a process can be implemented. Furthermore, *Guy* merely teaches that a directory management unit will update its unit of server codes when it receives one. There is also no teaching or discussion in *Guy* of going out and retrieving such lists of extensions connected to other LANs, or such LANs sending such lists of attached telecommunication extensions to other LANs within the

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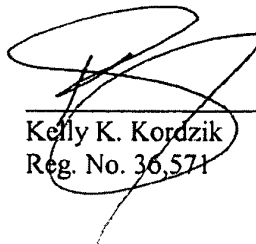
network. Thus, there is no support for the Examiner's assertion that it would have been advantageous and obvious for the database 232 in *Wilson* to be updated by all of the various LANs to ensure that its directory is up-to-date. Further, Claim 36 is patentable for similar reasons as given for Claims 1-3, 5-6 and 8.

Claim 37 recites scrolling through the first list. This first list is a list of LANs. First of all, such a list of LANs is nowhere to be taught or suggested within either of the references or their combination. Secondly, there is no teaching or suggestion for scrolling through such a list of LANs. As a result of the foregoing, one skilled in the art at the time the invention was made would not have been able to recreate the claimed invention in view of the combination of the references.

Please charge the Appeal Brief fee in the amount of \$270.00 to Deposit Account No. 06-1050. Please apply any other charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

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### Appendix of Claims

1. An information handling system comprising:
  - a first local area network ("LAN");
  - a second LAN;
  - a wide area network ("WAN") coupling the first LAN to the second LAN;
  - a first telecommunications device coupled to the first LAN;
  - a plurality of telecommunications extensions coupled to the second LAN;
  - the first LAN including first circuitry for enabling a user of the first telecommunications device to observe a list of the plurality of telecommunications extensions; and
  - the first LAN including second circuitry for automatically calling one of the plurality of telecommunications extensions in response to the user selecting one of the plurality of telecommunications extensions from the observed list, wherein the list of the plurality of telecommunications extensions is stored in a server in the second LAN, and is accessed by the first circuitry across the WAN.
  
2. The system as recited in claim 1, wherein communication among the first LAN, second LAN, and WAN uses an IP protocol.
  
3. The system as recited in claim 2, wherein the list of the plurality of telecommunications extensions is displayed to the user of the first telecommunications device.
  
4. An information handling system comprising:
  - a first local area network ("LAN");
  - a second LAN;
  - a wide area network ("WAN") coupling the first LAN to the second LAN;
  - a first telecommunications device coupled to the first LAN;
  - a plurality of telecommunications extensions coupled to the second LAN;
  - the first LAN including first circuitry for enabling a user of the first telecommunications device to observe a list of the plurality of telecommunications extensions; and

the first LAN including second circuitry for automatically calling one of the plurality of telecommunications extensions in response to the user selecting one of the plurality of telecommunications extensions from the observed list, wherein communication among the first LAN, second LAN, and WAN uses an IP protocol, wherein the list of the plurality of telecommunications extensions is played as audio to the user of the first telecommunications device.

5. The system as recited in claim 3, wherein the first telecommunications device is an IP telephone having a display for showing the list of the plurality of telecommunications extensions, wherein the second circuitry includes a key for enabling the user to tacitly selecting one of the plurality of telecommunications extensions from the displayed list.

6. The system as recited in claim 5, wherein the tactile selection of one of the plurality of telecommunications extensions from the displayed list by the user results in an initiation of a call from the first telecommunications device to the selected one of the plurality of telecommunications extensions across the WAN.

8. An information handling system comprising:

a first local area network ("LAN");

a second LAN;

a wide area network ("WAN") coupling the first LAN to the second LAN;

a first telecommunications device coupled to the first LAN;

a plurality of telecommunications extensions coupled to the second LAN;

the first LAN including first circuitry for enabling a user of the first telecommunications device to observe a list of the plurality of telecommunications extensions; and

the first LAN including second circuitry for automatically calling one of the plurality of telecommunications extensions in response to the user selecting one of the plurality of telecommunications extensions from the observed list, wherein communication among the first LAN, second LAN, and WAN uses an IP protocol, wherein the list of the plurality of telecommunications extensions is displayed to the user of the first telecommunications device,

wherein the first telecommunications device is an IP telephone having a display for showing the list of the plurality of telecommunications extensions, wherein the second circuitry includes a key for enabling the user to tacitly selecting one of the plurality of telecommunications extensions from the displayed list, wherein the tactile selection of one of the plurality of telecommunications extensions from the displayed list by the user results in an initiation of a call from the first telecommunications device to the selected one of the plurality of telecommunications extensions across the WAN, wherein the list of the plurality of telecommunications extensions is stored in a server in the second LAN, and is accessed by the first circuitry across the WAN.

9. The system as recited in claim 8, wherein the first telecommunications device includes circuitry for enabling the user to scroll through the displayed list of the plurality of telecommunications devices.

10. The system as recited in claim 1, further comprising:  
a third LAN coupled to the first and second LANs via the WAN; and  
a plurality of telecommunications extensions coupled to the third LAN, the first LAN including circuitry for enabling the user to select between observing the list of the plurality of telecommunications extensions coupled to the second LAN or observing a list of the plurality of telecommunications extensions coupled to the third LAN.

17. An information handling system comprising:  
a first local area network ("LAN") operating under an IP protocol;  
a first IP telephone coupled to the first LAN, the first IP telephone having a display and a set of keys for enabling a user to enter inputs;  
a second LAN operating under the IP protocol;  
second and third telephone extensions coupled to the second LAN;  
a wide area network ("WAN") operating under the IP protocol coupling the first LAN to the second LAN; and

the first LAN including first circuitry for enabling a user of the first IP telephone to view a list including the second and third telephone extensions, wherein the list is stored in a server in the second LAN, and is accessed by the first circuitry across the WAN.

18. The system as recited in claim 17, further comprising:

the first LAN including second circuitry for automatically calling the second telephone extension in response to the user selecting the second telephone extension from the viewed list.

19. The system as recited in claim 18, wherein selection of the second telephone extension from the viewed list by the user is accomplished by selection of one of the set of keys.

20. The system as recited in claim 19, wherein the selection of one of the set of keys results in an initiation of a call from the first IP telephone to the second telephone extension across the WAN.

22. The system as recited in claim 17, wherein the first IP telephone includes circuitry for enabling the user to scroll through the displayed list.

23. The system as recited in claim 1, further comprising:

a third LAN coupled to the first and second LANs via the WAN; and

a plurality of telephone extensions coupled to the third LAN, the first LAN including circuitry for enabling the user to select between viewing the list of the telephone extensions coupled to the second LAN or viewing a list of the plurality of telephone extensions coupled to the third LAN.

24. In a telecommunications system comprising a first IP telephone coupled to a first IP server within a first LAN, second and third telephone extensions coupled to a second IP server within a second LAN, and a WAN coupling the first LAN to the second LAN, the first LAN, the second LAN, and the WAN communicating using an IP protocol, a method comprising the steps of:

in response to selection of a first input on the first IP telephone, displaying on the first IP telephone a list of telephone destinations stored in the second IP server, wherein the list of telephone destinations is communicated from the second IP server over the WAN to the first IP telephone; and

in response to selection of one of the telephone destinations from the displayed list, automatically dialing the selected one of the telephone destinations for a communications link between the first IP telephone and the selected one of the telephone destinations.

25. The method as recited in claim 24, wherein the selection of one of the telephone destinations from the displayed list is performed in response to selection of a second input on the first IP telephone by a user.

26. The method as recited in claim 25, wherein the first and second inputs are the same key button on the first IP telephone.

27. The method as recited in claim 24, wherein the telephone destinations include the second and third telephone extensions coupled to the second IP server.

28. The method as recited in claim 24, wherein the telephone destinations include telephones external to the system.

29. The method as recited in claim 24, wherein the system includes a third LAN coupled to the first and second LANs via the WAN, further comprising the steps of: displaying on the first IP telephone a list of LANs coupled to the WAN, including the second and third LANs; and

performing the step of displaying the first list in response to selection of the second LAN from the displayed list of LANs.

30. A telecommunications system comprising:

a first IP telephone coupled to a first IP server within a first LAN;

second and third telephone extensions coupled to a second IP server within a second LAN;

a WAN coupling the first LAN to the second LAN, the first LAN, the second LAN, and the WAN communicating using an IP protocol;

means for displaying on the first IP telephone a list of telephone destinations stored in the second IP server in response to selection of a first input on the first IP telephone, wherein the list of telephone destinations is communicated from the second IP server over the WAN to the first IP telephone; and

means for automatically dialing the selected one of the telephone destinations for a communications link between the first IP telephone and the selected one of the telephone destinations in response to selection of one of the telephone destinations from the displayed list.

31. The system as recited in claim 30, wherein the selection of one of the telephone destinations from the displayed list is performed in response to selection of a second input on the first IP telephone by a user.

32. The system as recited in claim 31, wherein the first and second inputs are the same key button on the first IP telephone.

33. The system as recited in claim 32, wherein the telephone destinations include the second and third telephone extensions coupled to the second IP server.

34. The system as recited in claim 32, wherein the telephone destinations include telephones external to the system.

35. The system as recited in claim 31, further comprising:  
a third LAN coupled to the first and second LANs via the WAN;  
means for displaying on the first IP telephone a list of LANs coupled to the WAN, including the second and third LANs; and



means for displaying the first list in response to selection of the second LAN from the displayed list of LANs.

36. A method comprising the steps of:

receiving a first touch input from a user on an IP telephone that is networked into a first LAN operating under an IP protocol;

in response to receipt of the first touch input, displaying on a display on the IP telephone a first list including second and third LANs coupled to the first LAN, wherein the second and third LANs operate under the IP protocol;

receiving a second touch input from the user on the IP telephone;

in response to receipt of the second touch input, displaying on the display on the IP telephone a second list of telephone destinations accessible from the second LAN;

receiving a third touch input from the user on the IP telephone; and

in response to receipt of the third touch input, automatically dialing one of the telephone destinations accessible from the second LAN for a communications connection between the one of the telephone destinations and the IP telephone, wherein the step of displaying on the display on the IP telephone the second list further includes the steps of:

sending a message from the first LAN to the second LAN requesting the second list; and  
receiving the second list from the second LAN to the first LAN.

37. The method as recited in claim 36, before the step of receiving the second touch input, further comprising the steps of: receiving a fourth touch input from the user on the IP telephone; and in response to receipt of the fourth touch input, scrolling through the first list.

38. The method as recited in claim 37, before the step of receiving the third touch input, further comprising the steps of: receiving a fifth touch input from the user on the IP telephone; and in response to receipt of the fifth touch input, scrolling through the second list.

40. The method as recited in claim 36, wherein the first, second, and third LANs are coupled via a WAN.

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EVIDENCE APPENDIX

No evidence was submitted pursuant to §§1.130, 1.131, or 1.132 of 37 C.F.R. or of any other evidence entered by the Examiner and relied upon by Appellants in the Appeal.

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RELATED PROCEEDINGS APPENDIX

None.



the first LAN, a plurality of telecommunications extensions coupled to the second LAN, and the first LAN including first circuitry for enabling a user of the first telecommunications device to observe a list of the plurality of telecommunications extensions. These elements are shown in Fig. 3 with the first and second LANs represented as any one of LANs 301-303 and the WAN 201 that couples any first and second LAN. Each of the LANs shows telecommunications devices coupled thereto. The LANs 301-303 also show a plurality of telecommunications extensions, e.g., IP telephones 105, 308, 313. See page 6, line 23 - page 7, line 10. Fig. 11 shows a process for enabling a user of a first telecommunications device in the first LAN to observe a list of a plurality of telecommunications extensions coupled to the second LAN. See page 20, line 25- page 22, line 11. Fig. 8 illustrates a block circuit diagram of a telecommunications device that includes a display 810. See page 16, line 21 - page 17, line 26. Figs. 11 and 9A-9B illustrate selecting one of the extensions from the observed list and calling that extension. See page 20, line 25 - page 22, line 11 and page 28, line 7 - page 29, line 4. This process is also illustrated by the state diagram in Fig. 12. See page 22, lines 12-24.

Claim 4 recites an information handling system comprising a first LAN, a second LAN, a WAN coupling the first LAN to the second LAN, a first telecommunications device coupled to the first LAN, a plurality of telecommunications extensions coupled to the second LAN, and the first LAN including first circuitry for enabling a user of the first telecommunications device to observe a list of the plurality of telecommunications extensions. These elements are shown in Fig. 3 with the first and second LANs represented as any one of LANs 301-303 and the WAN 201 that couples any first and second LAN. Each of the LANs shows telecommunications devices coupled thereto. The LANs 301-303 also show a plurality of telecommunications extensions, e.g., IP telephones 105, 308, 313. See page 6, line 23 - page 7, line 10. Fig. 11 shows a process for enabling a user of a first telecommunications device in the first LAN to observe a list of a plurality of telecommunications extensions coupled to the second LAN. See page 20, line 25- page 22, line 11. Fig. 8 illustrates a block circuit diagram of a telecommunications device that includes a display 810. See page 16, line 21 - page 17, line 26. Figs. 11 and 9A-9B illustrate selecting one of the extensions from the observed list and calling that extension. See page 20, line 25 - page 22, line 11 and page 28, line 7 - page 29, line 4. This

process is also illustrated by the state diagram in Fig. 12. See page 22, lines 12-24. Claim 4 recites an additional limitation that the list of the telecommunications extensions is played as audio to the user of the first telecommunications device. The telecommunications device diagram in Fig. 8 shows a speaker 821.

Claim 8 recites an information handling system comprising a first LAN, a second LAN, a WAN coupling the first LAN to the second LAN, a first telecommunications device coupled to the first LAN, a plurality of telecommunications extensions coupled to the second LAN, and the first LAN including first circuitry for enabling a user of the first telecommunications device to observe a list of the plurality of telecommunications extensions. These elements are shown in Fig. 3 with the first and second LANs represented as any one of LANs 301-303 and the WAN 201 that couples any first and second LAN. Each of the LANs shows telecommunications devices coupled thereto. The LANs 301-303 also show a plurality of telecommunications extensions, e.g., IP telephones 105, 308, 313. See page 6, line 23 - page 7, line 10. Fig. 11 shows a process for enabling a user of a first telecommunications device in the first LAN to observe a list of a plurality of telecommunications extensions coupled to the second LAN. See page 20, line 25- page 22, line 11. Fig. 8 illustrates a block circuit diagram of a telecommunications device that includes a display 810. See page 16, line 21 - page 17, line 26. Figs. 11 and 9A-9B illustrate selecting one of the extensions from the observed list and calling that extension. See page 20, line 25 - page 22, line 11 and page 28, line 7 - page 29, line 4. This process is also illustrated by the state diagram in Fig. 12. See page 22, lines 12-24. Claim 8 additionally recites that the first telecommunications device is an IP telephone and a user of that IP telephone tacitly selects one of the observed extensions from the list which results in an initiation of the call to that telecommunications extension across the WAN. Further, Claim 8 recites that the list of the plurality telecommunications extensions is stored in a server in the second LAN and is accessed by the first circuitry across the WAN. The IP telephones are shown in various figures, including Figs. 3 and 8. Fig. 11 illustrates a step for selecting the telecommunications extension from the list that is displayed for initiating the call, which proceeds to Fig. 9A. Figs. 11, 12, and 14 among others illustrate the storage of the list of telecommunications extensions in the second LAN, the list then being accessed across the WAN

by the first LAN. See page 6, line 23 - page 7, line 10; page 16, line 21 - page 17, line 26; page 20, line 25 - page 22, line 11; and page 22, lines 12-24. Further, the basic concept of accessing a list across the WAN and then making a call is described on page 18, line 21 - page 19, line 6 and page 20, lines 12-24.

Claim 17 recites an information handling system comprising a first LAN, a second LAN, a WAN coupling the first LAN to the second LAN, a first telecommunications device coupled to the first LAN, a plurality of telecommunications extensions coupled to the second LAN, and the first LAN including first circuitry for enabling a user of the first telecommunications device to observe a list of the plurality of telecommunications extensions. These elements are shown in Fig. 3 with the first and second LANs represented as any one of LANs 301-303 and the WAN 201 that couples any first and second LAN. Each of the LANs shows telecommunications devices coupled thereto. The LANs 301-303 also show a plurality of telecommunications extensions, e.g., IP telephones 105, 308, 313. See page 6, line 23 - page 7, line 10. Fig. 11 shows a process for enabling a user of a first telecommunications device in the first LAN to observe a list of a plurality of telecommunications extensions coupled to the second LAN. See page 20, line 25- page 22, line 11. Fig. 8 illustrates a block circuit diagram of a telecommunications device that includes a display 810. See page 16, line 21 - page 17, line 26. Figs. 11 and 9A-9B illustrate selecting one of the extensions from the observed list and calling that extension. See page 20, line 25 - page 22, line 11 and page 28, line 7 - page 29, line 4. This process is also illustrated by the state diagram in Fig. 12. See page 22, lines 12-24. Claim 17 additionally recites that the first telecommunications device is an IP telephone and a user of that IP telephone tacitly selects one of the observed extensions from the list which results in an initiation of the call to that telecommunications extension across the WAN. Further, Claim 17 recites that the list of the plurality telecommunications extensions is stored in a server in the second LAN and is accessed by the first circuitry across the WAN. The IP telephones are shown in various figures, including Figs. 3 and 8. Fig. 11 illustrates a step for selecting the telecommunications extension from the list that is displayed for initiating the call, which proceeds to Fig. 9A. Figs. 11, 12, and 14 among others illustrate the storage of the list of telecommunications extensions in the second LAN, the list then being accessed across the WAN

by the first LAN. See page 6, line 23 - page 7, line 10; page 16, line 21 - page 17, line 26; page 20, line 25 - page 22, line 11; and page 22, lines 12-24. Further, the basic concept of accessing a list across the WAN and then making a call is described on page 18, line 21 - page 19, line 6 and page 20, lines 12-24.

Claim 24 recites an information handling system comprising a first LAN, a second LAN, a WAN coupling the first LAN to the second LAN, a first telecommunications device coupled to the first LAN, a plurality of telecommunications extensions coupled to the second LAN, and the first LAN including first circuitry for enabling a user of the first telecommunications device to observe a list of the plurality of telecommunications extensions. These elements are shown in Fig. 3 with the first and second LANs represented as any one of LANs 301-303 and the WAN 201 that couples any first and second LAN. Each of the LANs shows telecommunications devices coupled thereto. The LANs 301-303 also show a plurality of telecommunications extensions, e.g., IP telephones 105, 308, 313. See page 6, line 23 - page 7, line 10. Fig. 11 shows a process for enabling a user of a first telecommunications device in the first LAN to observe a list of a plurality of telecommunications extensions coupled to the second LAN. See page 20, line 25 - page 22, line 11. Fig. 8 illustrates a block circuit diagram of a telecommunications device that includes a display 810. See page 16, line 21 - page 17, line 26. Figs. 11 and 9A-9B illustrate selecting one of the extensions from the observed list and calling that extension. See page 20, line 25 - page 22, line 11 and page 28, line 7 - page 29, line 4. This process is also illustrated by the state diagram in Fig. 12. See page 22, lines 12-24. Claim 24 additionally recites that the first telecommunications device is an IP telephone and a user of that IP telephone tacitly selects one of the observed extensions from the list which results in an initiation of the call to that telecommunications extension across the WAN. Further, Claim 24 recites that the list of the plurality telecommunications extensions is stored in a server in the second LAN and is accessed by the first circuitry across the WAN. The IP telephones are shown in various figures, including Figs. 3 and 8. Fig. 11 illustrates a step for selecting the telecommunications extension from the list that is displayed for initiating the call, which proceeds to Fig. 9A. Figs. 11, 12, and 14 among others illustrate the storage of the list of telecommunications extensions in the second LAN, the list then being accessed across the WAN



by the first LAN. See page 6, line 23 - page 7, line 10; page 16, line 21 - page 17, line 26; page 20, line 25 - page 22, line 11; and page 22, lines 12-24. Further, the basic concept of accessing a list across the WAN and then making a call is described on page 18, line 21 - page 19, line 6 and page 20, lines 12-24.

Claim 30 recites a telecommunications systems comprising a first IP telephone coupled to a first IP server within a first LAN, second and third telephone extensions coupled to a second IP server within a second LAN, and a WAN coupling the first LAN to the second LAN, the first LAN, the second LAN, and the WAN communicating using an IP protocol. These features are similar to those discussed above with respect to Claims 1, 4, 8, 17, and 24, and are well supported within the aforementioned figures and specification, such as Fig. 3 and its supporting specification recitations noted above with respect to Claim 1. See page 6, line 23 - page 7, line 10; page 16, line 21 - page 17, line 26; page 20, line 25 - page 22, line 11; and page 22, lines 12-24. Claim 30 further recites a means for displaying on the first IP telephone a list of telephone destinations stored in the second IP server in response to selection of a first input on the first IP telephone, wherein the list of telephone destinations is communicated from the second IP server over the WAN to the first IP telephone. An IP telephone 105 is illustrated in Figs. 1 and 3, and is shown in more detail in Fig. 8, which shows that the IP telephone 105 has an LCD display 810. See page 16, line 21 - page 17, line 26. IP servers within the LANs are as shown in Fig. 3, including IP server 101 and IP server 306. IP server 101 is also shown in Figs. 1 and 2. Fig. 4 shows that IP server 101, which is representative of any of the IP servers, including IP server 306, has a hard drive 403. As a result, a list of telephone destinations may be stored within such a hard drive. Selection of a list displayed on LCD display 810 of the IP telephone shown in Fig. 8 can be performed using such input devices as the keyboard 807 or a DSS console 811. Fig. 8 in such features are discussed on page 16, line 21 - page 18, line 20; selection of an extension from a list is also discussed on page 18, line 21 - page 20, line 24. The process for permitting a user to view and select extensions on the first IP telephone is illustrated in Fig. 11, which is discussed on page 20, line 25 - page 22, line 11. Also there is an establishment of a connection between the two remote LANs with respect to Fig. 14, which includes a description of the sending of a message from one LAN to the other in order to request a list of the telephone

extensions, which are then communicated from that second LAN over the WAN to the first WAN and specifically the IP telephone. Further, Fig. 12 illustrates a state diagram of this process, which is described on page 22, lines 12-24. Automatic dialing of the selected telephone destination and a response to selection of one of the telephone destinations from a displayed list is described on page 22, lines 4-24.

Claim 36 recites a method for receiving several touch inputs from a user on the IP telephone that is networked into the LAN/WAN/LAN network described above and with respect to Fig. 3 in order to again permit such a user to view a display telephone extensions at a remote LAN, and then automatically dialing that telephone destination. Claim 36 includes steps for sending a message from the first LAN to the second LAN requesting the list of telephone extensions from the second LAN, which is delivered to the first LAN from the second LAN. Claim 36 includes steps whereby a first list of second and third LANs coupled to the first LAN is provided, and then a second list of telephone destinations at a selected LAN are then provided. Such steps are shown in Figs. 11, 12, and 14 as noted above. See page 20, line 25 - page 22, line 24.

#### IV. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

1. Claims 1-3, 5-6, 8-10, 17-20 and 22-35 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Guy et al.* (U.S. Patent No. 6,298,057) in view of *Wilson* (U.S. Patent No. 6,829,231).
2. Claim 4 stands rejected under 35 U.S.C. §103(a) as being unpatentable over *Guy* in view of *Wilson* and further in view of *Stuntebeck et al.* (U.S. Patent No. 6,065,016).
3. Claims 36-38 and 40 stand rejected under 35 U.S.C. § 103 as being unpatentable over *Wilson* in view of *Guy*.

## VII. ARGUMENT

1. Claims 1-3, 5-6, 8-10, 17-20 and 22-35 are not properly rejected under 35 U.S.C. § 103 as being unpatentable over *Guy* in view of *Wilson*.

The basic test for nonobvious subject matter is whether the differences between the subject matter and the prior art are such that claimed subject matter as a whole would not have been obvious to a person having ordinary skill in the art to which a subject matter pertains. The United States Supreme court in *Graham v. John Deere & Co.*, 383 U.S. 1 (1966) set forth the factual inquiries which must be considered in applying the statutory test: (1) a determination of the scope and contents of the prior art; (2) ascertaining the differences between the prior art and the claims at issue; and (3) resolving the level of ordinary skill in the pertinent art.

In determining the scope and contents of the prior art, the Examiner must first consider the nature of the problem on which the inventor was working. Once this has been established, the Examiner must select, for purposes of comparing and contrasting with the claims at issue, prior art references which are reasonably pertinent to that problem. In selecting references, hindsight must be avoided at all costs.

In ascertaining the differences between the cited prior art and the claims at issue, the Examiner must evaluate the claimed subject matter as a whole; there is no requirement that any differences between the claimed subject matter and the cited references be "remarkable" nor that some technological discontinuity between the claimed invention and subject matter exists just outside the claims. The requisite view of the whole invention mandates consideration of not only its structure, but also of its properties and the problems solved. Further, the mere fact that the prior art can be modified does not make the modification obvious unless the prior art suggests the desirability of the modification; there must be some logical reason apparent from positive, concrete evidence that justifies the modification.

In resolving the level of ordinary skill in the pertinent art, the Examiner must step backward in time and into the shoes worn by the person of ordinary skill when the invention was

unknown and just before it was made. The hypothetical person skilled in the art can summarily be described as one who thinks along lines of conventional wisdom in the art and neither one who undertakes to innovate nor one who has the benefit of hindsight. Thus, neither an Examiner, nor a Judge, nor a genius in the art at hand, nor even the inventor is such a person skilled in the art.

*Guy* teaches a system and method for transparently transmitting aural signals across a LAN, where a user places a telephone call using the same procedure that is used when placing a telephone call over a conventional public switch network, and in certain situations if the server code is not in the local directory, then a request goes to a master directory. Column 3, lines 39-48; column 9, lines 23-28. Referring to Fig. 1 in *Guy*, the first LAN maybe represented by 102A, the WAN by 104, and the second LAN by 102B. (Note that Applicants do not necessarily admit that 102A is a local area network, since a local area network is shown in Fig. 1 as 116; however, for the sake of arguing against the rejection, 102A will be designated as the first LAN.) *Guy* describes a set-up operation for when a first telephone 106 wishes to make a call to a user at a second telephone 126, where the first telephone 106 is coupled to a file server 112, and the second telephone is coupled to a CSU 130 via a PBX 128. Column 6, lines 45-51; column 10, lines 7-9. Fig. 2 illustrates a more detailed illustration of file server 112. Column 6, lines 52. Fig. 5 also further has a description of a flow chart illustrating such a call set-up procedure. Column 9, line 66. A user activates the telephone by lifting the handset and selecting the channel line in order to transition to an off-hook state period. Column 10, lines 7-9. The user then performs the normal process of dialing a telephone number on the first telephone 106 (as described below, this telephone number is not provided to the user by the system), with the telephone associated with the second telephone 126, and a procedure is then implemented across network 104 just as if the user were making a call over a conventional public telephone system. Column 10, lines 13-17. Thus, such a procedure is completely transparent to the user and they do not have to re-learn how to use a telephone system other than what has been normally done in the prior art POTS systems. Column 10, lines 25-29. The telephone number dialed by the user on telephone 106 identifies the destination telephone 126. Column 10, lines 30-31. It is the first set of digits that are dialed by the user that identifies the destination CSU 130 to which the

second telephone 126 is connected to the second LAN 134. This first set of digits is referred to in *Guy* as the server code. Column 10, lines 32-36. In other words, the server code operates the same as an area code in the POTS. All within the first LAN 102A, a call set up unit 404 within a server memory module 214 that is in server 112 makes an attempt to retrieve such a server code from the memory module 212, which is then transmitted to the directory management unit 408. Column 10, lines 55-58. Again, this is all performed within the first LAN 102A. The directory management unit 408 searches the local directory 406 for a server that is identified with the server code dialed by the user, and if there are no server matches, then the directory management unit 408 will generate a request to a master directory, which will make a determination if the server code dialed by the user on the first telephone 106 is identified with any server in the network 100. Column 10, lines 58-65. If the server code is identified in such a master directory, then the network address of the destination CSU 130 associated with the server code is transmitted to the directory management unit 408. Column 11, lines 2-8. The directory management unit 408 transmits this network address to the call set up and tear down unit 404, which transmits the number of additional digits to the call management unit 310, and the call set-up/tear down unit 404 transmits a call set up packet to the destination CSU 130, which receives the set up packet and determines if the telephone 126 is available to receive the call. Column 11, lines 11-28.

Thus, in *Guy*, nothing more is taught than the caller on first telephone 106 dialing digits associated with the destination telephone 126. There is absolutely no teaching or suggestion within *Guy* that a list of a plurality of telecommunications extensions coupled to the second LAN is provided to the user of the first telephone 106 for observation, or hearing them. The server code accessed from the master directory is only associated with the CSU 130, and does not provide any further information that would enable the combination of the disclosures of *Guy* and *Wilson* to display a list of the telecommunications extensions coupled to the second LAN. The user in *Guy* must still rely upon a phone list that is external from the system described in *Guy* in order to make a telephone call in the network. The master directory only contains the server code. The server code only identifies the CSU 130 to which the destination telephone is connected. Column 10, lines 33-36. Additional digits are still required in order to telephone or

contact the destination telephone from the originating telephone. Column 11, line 1-column 12, line 21. There is further no teaching or suggestion within *Guy* that a list of extensions is provided from anywhere else in the network.

There is absolutely no teaching or suggestion in *Guy* to help out a user by providing the user with a list of extensions in a LAN within the *Guy* network.

In order to overcome the deficiencies of the teachings of *Guy*, the Examiner has added *Wilson* to combine with *Guy*. A problem with the Examiner's combination of *Wilson* and *Guy* is that the Examiner has expanded the teachings of *Wilson* beyond what is reasonable. The invention described in *Wilson* is sort of a hodgepodge device 50 created to permit a user to send audio packets to another user using internet addressing. *Wilson* attempts to simplify the use of the Internet for long-distance calling applications. Column 2, lines 31-32. *Wilson* merely provides a system that has services similar to those found on the POTS. See the Abstract. A list of known callees can be stored inside the device described in *Wilson*, and for unknown callee addresses, a method for retrieving such an address for a remote location is provided. Column 2, lines 47-53. The hodgepodge device 50 is shown in Fig. 2, with its circuit diagrams shown in Fig. 3. Telephone calls over the PSTN can be made with device 50 by making normal voice DTMF telephone calls using the keypad 65. Column 4, lines 60-64. Note that this mode is performed only when the user already knows the telephone number of the callee, and does not play into the description of the invention within *Wilson* that the Examiner is relying upon.

Internet access can be made by the device 50 by the user pressing the Internet access button 69 to switch between normal DTMF voice calls and internet dial-up operations, where an internet connection is made using an internal modem set. Colum 5, lines 5-11. The device 50 can be connected using an RS232 jack 86 to a computer 90, but there is no further discussion of connecting the device 50 to a local area network, or LAN. Column 5, lines 33-38.

Referring to Figs. 4 and 5 in *Wilson*, each of the dial pads 50 is now referred to as dial pads 201, 202 and 203, which are each connected to PSTN circuits 204. Column 7, lines 15-17.

The PSTN circuits 204 and a local exchange switch 205 form a local telephone network within a geographic area. Column 7, lines 17-19. A similar situation is associated with the callee devices 245, 246, 247. It important to note that dial pads 201, 202 and 203 are not part of a LAN. A LAN is a data network that permits all of the devices on the network to communicate with each other, such as with the use of an Ethernet protocol. Such a LAN is disclosed in the specification of the present application in paragraph [0028], and shown in FIG. 1. A LAN, as is well known in the art, is a short distance data communications network used to link computers and peripheral devices under some form of standard control. Such a definition for a LAN is found in *Newton's Telecom Dictionary*. That definition also further states that "A LAN does not use common carrier circuits." It is clear that the dial pads 201-203 and callees 245-247 taught in *Wilson* are not connected in a LAN. More specifically, dial pads 201-203 are not coupled together in a LAN, and callees 245-247 are not coupled together in a LAN. Each of these devices 50 is separately connected to the PSTN via jacks 80 and 82 that provide a dual line access to the PSTN. Column 5, lines 25-26. A dual line service is a telephone service where two pairs of wires are connected to a premises for connection to the PSTN. See *Newton's Telecom Dictionary*. This is further supported in *Wilson* by the more detailed diagram of a dialing pad 50 in Fig. 3 which shows that the dual line access is provided by typical tip and ring connections 102 that enable the transfer of an analog signal over this dual line connection. Column 5, lines 50-56. Such internet access also requires use of a modem data pump 112. Column 6, lines 19-27. The only LAN disclosed in *Wilson* is that associated with the internet service providers (ISPs) shown in Figs. 4 and 5.

As a result, the only way each of the dial pads disclosed in *Wilson* can access the internet is by using typical dial-up modem message interchanges. And, this is the only way one of the dial pads 201-203 can communicate with one of the callees 245-247. In other words, for one of the dial pads 201-203 to "call" one of the callees 245-247, that particular callee must have an already established audio internet connection so that it is prepared to receive any audio messages from one of the dial pads 201-203. Column 7, lines 28-31. If such a callee is not already connected to the internet when it receives a message to perform audio communication from one

of the dial pads 201-203, then that callee will have to dial up into their internet service provider and obtain the sent audio message at a later time. Column 7, lines 31-33.

If the internet (IP) address of one of the callees 245-247 is not stored within a database of one of the dial pads 201-203, then the dial pad can make an internet access through internet service provider 215 to browse a user database directory 232 through a search engine 230, which stores such IP addresses, and return that IP address to the dial pad. Column 7, lines 46-64. This provides a process whereby a user of a dial pad 201-203 does not need to know the actual internet IP address of one of the callee devices 245-247, but can use a search engine 230 to enter in some other designation (e.g., alphanumeric identifier; column 7, lines 52-53 and column 8, line 59) for one of the callees 245-247, such as a user's name, to thereby have that search engine retrieve the internet IP address from a website to the dial pad 201-203. Column 8, lines 1-15. If more than one hit is made by the search engine 230, a list of names can be returned to the dial pad, and the caller using one of the dial pads 201-203 can select the one they wish from the list by looking at the list on the screen 71 of the device 50. Column 8, lines 13-50.

It should be noted that the main distinction between the device 50 shown in Fig. 5 of *Wilson* from Fig. 4 is that a single user database 232 can be accessed by a wide range of ISPs at different locations. Column 8, lines 29-30. Otherwise, the configuration in Fig. 5 is the same as the one in Fig. 4 for purposes of how *Wilson* might be relevant to the rejection in accordance with the Examiner's assertions.

Fig. 6 in *Wilson* describes an exemplary call progress flow diagram for connecting one of the dial pads 201-203 to the directory search engine 230. Column 8, lines 50-51. Note that Fig. 6 in *Wilson* does not describe the part of the flow whereby one of the dial pads makes an internet connection to one of the callees. The process *Wilson* starts with has one of the dial pads 201-203 dialing out to establish an internet connection 360 using the modem 112. Column 8, lines 52-53. Once this internet dial-up connection is made, then the user of the dial pad can enter a known internet IP address number to access, over the internet, one of the callees 245-247, or start a search for the IP address of one of the callees if it is not known. This is shown by step 370 in



Fig. 6. The search engine will perform a search 372 and respond 374 by transmitting the results 376 of that search back to the dial pad 201-203. Column 8, lines 59-65. The user of the dial pad selects a callee from the list delivered by the search engine, and the user can then accept one of the addresses provided and dial to the selected callee. Column 9, lines 1-4. It should be noted at this point that *Wilson* does not teach that one of the dial pads 201-203 is able to automatically perform the dialing process in response to some sort of selection of a name on a displayed list by the user of the dial pad 50 pressing some sort of button to select one of the names. Instead, *Wilson* merely teaches that the user can apparently view the IP address of the callee and enter in that address using the dial pad's keyboard 63. Column 8, lines 13-15.

Therefore, all that *Wilson* teaches is (1) a specialized device 50 that is a combination of a dial pad/modem that is able to access the internet with a dial-up connection over the PSTN circuits (and can also act as a normal PSTN telephone where a user can enter in PSTN-type telephone numbers to call another PSTN telephone), and (2) an ability for one of the specialized devices 50 to have audio communications with another specialized device 50 over an internet channel whereby a connection is made between these two specialized devices using typical IP internet addresses, and (3) if the IP address of a callee is not known, then an internet search engine can be used to browse to access a database on the internet that will retrieve such an IP address that is then displayed to a user of a specialized device so that the user can then enter in that IP address to the specialized device to establish the audio connection over the internet. The teachings of *Wilson* clearly show that its invention was not created to operate in a voice-over IP system with capabilities such as recited in the present claims. See column 2, lines 1-5.

All that *Guy* teaches is an ability for a telephone connected to a first LAN to communicate over a WAN to a telephone in a second LAN, and if the directory management unit of a file server in the first LAN does not know the address of a central site unit connected to a PBX in the second, it can retrieve that server code from a remote location for completing the call between the two telephones.

With respect to Claim 1 and all the other rejected claims, a result of the foregoing is that the combination of *Guy* and *Wilson* does not teach or suggest circuitry within the first LAN for enabling a user of the first telecommunications device within that first LAN to observe a list of the plurality of telecommunications extensions coupled to the second LAN, wherein the list of the plurality of telecommunications extensions is stored in a server in the second LAN and is accessed by the first circuitry across the LAN.

The combination of *Guy* and *Wilson* does NOT provide to the user of the first device in the first LAN the list of extensions the user can call in the second LAN and then a means to automatically initiate that call with a selection from that list. *Guy* provides nothing to the user of the telephone, and *Wilson* has no LANs (and as a consequence, no lists of extensions coupled to a LAN).

*Guy* does not provide any type of information identifying any type of telecommunications device within the second LAN 102B to a user of a telecommunications device within the first LAN 102A. Instead, merely a server code is provided to the directory management unit 408 so that it can complete the call when it receives the dialing digits from the telephone so that it knows what LAN to send the call to. Further, *Wilson* also does not provide a list of telecommunications devices coupled to the second LAN. In fact, callees 245-247 are not part of a LAN. More than one entry might be supplied by the search engine 230 accessing the database 232 back to one of the dial pads 201-203 for display to the user, but the fact that there is a plurality returned is only a result of the fact that the user entered in search terms that matched more than one entry in the database 232. There is nothing within *Wilson* that teaches or suggests that those plurality of entries returned for display to the user are all coupled to a separate LAN over network 210, or that such a list of search results would even list more than one of the callees 245-247.

A result is that the combination of the references does not teach or suggest that a list of the plurality of telecommunications extensions coupled to the second LAN is provided to the user of the first telecommunications device for observation.

And further, neither of the references, nor their combination, teaches circuitry for automatically calling one of those telecommunications from that list in response to the user selecting one of those extensions from the observed list. *Guy* does not even approach such a process, since the retrieval of the server code is done in response to the dialing of a telephone number already performed by the user. Further, as noted above, *Wilson* also does not teach or suggest such an automatic calling of the extension, but instead provides the list on the display 71 on one of the dial pads 201-203 so that the user can then enter in the IP internet address on the keypad 63.

The Examiner has failed to prove a *prima facie* case of obviousness because important limitations are not found within any of the cited prior art references. MPEP § 2143.03 states that to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

This is further an important distinction for several reasons. One of them is that it permits a user in one geographic location to locate a station user in another location without the need to use a printed extension guide. See Specification, page 20, lines 21-24. This would not be possible with the combination of references asserted by the Examiner, but is implemented with the present invention as claimed.

Furthermore, neither of the references, nor their combination, teaches or suggests that such a list of telecommunications extensions coupled to the second LAN is stored in a server in that second LAN.

Moreover, with respect to Claim 2, the Examiner has not shown how the combination of references teaches a LAN or WAN operating under an IP protocol. *Guy* does not disclose its LANs or WAN operating under an IP protocol, and *Wilson* does not disclose LANs with telephone/telecommunications extensions coupled thereto.

Claim 5 recites that the second circuitry that automatically makes the call to the remote telecommunications extension includes a key for enabling the user to tacitly select one of those extensions from the displayed list. The Examiner admits that *Guy* does not teach such a process. In fact, it is impossible for *Guy* to teach or suggest this process, since a list is nowhere to be provided to the calling user. The Examiner asserts that *Wilson* discloses this process, since *Wilson* states that the user may select a destination from this scrolled list of potential destinations. All that *Wilson* discloses is that the caller has an option of selecting from a displayed scrolled list of potential users by using the keyboard 63 to select the intended caller. *Wilson* in no way further describes what is done in response to that action. Claim 5 recites that the second circuitry includes a key for enabling the user to make such a tacit selection from the displayed list. However, second circuitry also recites automatically calling one of the extensions in response to such a selection by the user. *Wilson* teachings do not go that far, and there is no flow diagram, circuitry or any other discussion or mention within *Wilson*, or *Wilson* in combination with *Guy*, that would suggest such an automatic calling of the remote party by selection of one of the extensions in the list by a user pressing a button. Therefore, one skilled in the art at the time the invention was made would not be able to create the invention recited in Claim 5 in view of the combination of the teachings of the prior art references.

With respect to Claim 6, the foregoing arguments made with respect to Claim 5 are incorporated. Claim 6 further recites that the initiation of the call is made by that tacit selection of that button when a user presses that button to select one of the names from the list. This is in no way taught or suggested by the prior art references.

Claim 8 is patentable over the cited references for all of the arguments provided herein with respect to Claims 1-6. Claim 8 also recites that the list of plurality of telecommunications extensions stored in a server in a second LAN is accessed by the first circuitry in the first LAN across the WAN. As noted above, there is no teaching or suggestion within the combination of the references that a list of the telecommunications extensions coupled to the second LAN are stored in a server in that second LAN. Thus, there is also no teaching or suggestion that this list

is then accessed from the server in the second LAN across the WAN by circuitry in the first LAN that enables the user of the first telecommunications device to observe this list of the plurality of telecommunications extensions.

Claim 10 recites a third LAN coupled to the first and second LANs via the WAN. The third LAN includes a plurality of telecommunications extensions coupled thereto. The first LAN has circuitry that enables a user in that first LAN to select between observing between a list of the plurality of telecommunications extensions coupled to the second LAN or observe a list of the plurality of the telecommunications extensions coupled to the third LAN. In addressing this claim language, all the Examiner has done is to imply that *Wilson* teaches "a third LAN and first LAN circuitry for selecting and viewing a list of a plurality of extensions coupled to the second and/or third LAN."

First, this is a wholly inadequate rejection by the Examiner, and does not provide enough evidence to support a *prime facie* case of obviousness. The Examiner is required to prove such a suggestion by objective evidence. *Ex parte Levengood*, 28 U.S.P.Q.2d 1300, 1301 (Bd. Pat. App. & Int. 1993); *Ashland Oil, Inc. v. Delta Resins and Refractories, Inc.*, 776 F.2d 281, 227 U.S.P.Q. 657 (Fed. Cir. 1985). The legal conclusion of obviousness must be supported by facts. *Graham v. John Deere & Co.*, 383 U.S. 1 (1966). A rejection based on § 103 clearly must rest on a factual basis, and these facts must be interpreted without hindsight reconstruction of the invention from the prior art. The patentability of an invention is not to be viewed with hindsight or "viewed after the event." *Goodyear Company v. Ray-O-Vac Company*, 321 U.S. 275, 279, 64 S.Ct. 593, 88 L.Ed. 721 (1944). Instead of relying upon objective evidence to support the Examiner's assertion, the Examiner has merely supported such an obviousness rejection with the Examiner's own opinion, which is quite clearly not objective evidence as is required by the case law.

Secondly, as noted above, *Wilson* does not teach or suggest that any of the dial pads 201-203 or 245-247 are coupled to each other within a LAN. Third, as noted above, a list of such callees 245-247 is not provided by the database 232 through the search engine 230 to one of dial

pads 201-203. Fourth, there is no teaching or suggestion within the combination of references for enabling a user in the first LAN to select between observing a list of extensions coupled to the second LAN or observing a list of extensions coupled to the third LAN. The Examiner has failed to provide a *prima facie* case of obviousness because important limitations are not found within any of the cited prior art references. As noted previously, MPEP § 2143.03 states that to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Claim 17 is patentable for reasons similarly given herein with respect to Claims 1-6 and 8.

Claim 18 is patentable for reasons similarly given herein with respect to Claims 1-6 and 8.

Claim 19 is patentable for reasons similarly given herein with respect to Claim 8.

Claim 20 is patentable for reasons similarly given herein with respect to Claims 5 and 8.

Claim 23 is patentable for reasons similarly given herein with respect to Claim 10.

Claim 24 is patentable for reasons similarly given herein with respect to Claims 1-6, 8 and 17.

Claim 30 incorporates "means for" language that the Examiner must interpret under 35 U.S.C. § 112, sixth paragraph. The Examiner must interpret and examine this claim and others with means for language under this doctrine. See MPEP § 2182, 2183. Claim 30 recites a means for displaying on the first IP telephone a list of telephone destinations stored in the second IP server in response to selection of a first input on the first IP telephone. The second IP server has second and third telephone extensions coupled thereto in a second LAN. As noted above, the combination of the references does not teach or suggest a list of telephone destinations stored in

a second IP server within a second LAN that is coupled to second and third telephone extensions. This is also supported in Figs. 11-12 and 14 and also the call processing flow diagram illustrated in Figs. 9a and 9b, and their accompanied description. Claim 30 is also patentable for reasons given herein with respect to Claims 1-3.

The Examiner has not specifically addressed the limitations in Claims 27 and 33. For Claims 25-26 and 31-32, the Examiner provides no objective evidence as to how the references teach or suggest a second input or that the first and second inputs are the same key button. The Examiner is required to prove such a suggestion by objective evidence. *Ex parte Levengood*, 28 U.S.P.Q.2d 1300, 1301 (Bd. Pat. App. & Int. 1993); *Ashland Oil, Inc. v. Delta Resins and Refractories, Inc.*, 776 F.2d 281, 227 U.S.P.Q. 657 (Fed. Cir. 1985). The legal conclusion of obviousness must be supported by facts. *Graham v. John Deere & Co.*, 383 U.S. 1 (1966). A rejection based on § 103 clearly must rest on a factual basis, and these facts must be interpreted without hindsight reconstruction of the invention from the prior art. The patentability of an invention is not to be viewed with hindsight or "viewed after the event." *Goodyear Company v. Ray-O-Vac Company*, 321 U.S. 275, 279, 64 S.Ct. 593, 88 L.Ed. 721 (1944). Instead of relying upon an objective evidence to support the Examiner's assertion, the Examiner has merely supported such an obviousness rejection with the Examiner's own opinion, which is quite clearly not objective evidence as is required by the case law. Further, Applicants respectfully traverse the assertion of what is well known in the art. As a result, the Examiner is required to support such an assertion with objective evidence.

Claim 35 recites a third LAN coupled to the first and second LANs via the WAN. Claim 35 further recites a means for displaying on the first IP telephone a list of LANs coupled to the LAN, including the second and third LANs. This limitation has not been addressed by the Examiner in any way. For this reason alone, this claim is patentable over the cited prior art. Secondly, there is no teaching or suggestion within the prior art references of displaying a list of LANs on the telephone display in either *Guy* or *Wilson* or their combination. Further, there is no teaching or suggestion in those references for displaying the first list of telephone destinations stored in the second IP server in response to selection of the second LAN from the displayed list

of LANs. Again, the Examiner has not in any way addressed this claim limitation, and for this reason alone, Claim 35 is patentable over the cited prior art. Secondly, this limitation is not taught or suggested by the combination of the references. Claim 35 is patentable for similar reasons as provided in Claims 10 and 23.

On page 4 of the Office Action, the Examiner has made assertions as to what *Wilson* teaches. Applicants respectfully traverse such assertions and incorporate by reference Applicants' arguments made in the previous amendment with respect to the teachings of *Wilson*.

With respect to Claims 28 and 34, Applicants respectfully traverse the Examiner's assertions. The Examiner has mischaracterized the limitations within these claims. These claims recite that the telephone destinations may include telephones external to the system. Such telephone destinations are included in a list stored in the second IP server which are communicated from the second IP server over the WAN to the first IP telephone. This is not taught or suggested within *Wilson*. Applicants traverse the Examiner's assertion of what is well known in the art, requiring the Examiner to support such assertions with objective evidence.

2. Claim 4 is not properly rejected under 35 U.S.C. § 103 as being unpatentable over *Guy* in view of *Wilson* and further in view of *Stantebeck et al.* (U.S. Patent No. 6,065,016). Applicants respectfully traverse this rejection for reasons similarly given herein for Claims 1-2.

Claim 4 further recites that the list of the plurality of telecommunications extensions is played as audio to the user of the first telecommunications device. First, this is impossible in the invention in *Guy*. Secondly, *Wilson* does not teach or suggest such a capability. In fact, *Wilson* is attempting to simplify the process of two internet devices having an audio communication between each other, because when such an IP address is dialed, up to 20 digits have to be entered by the caller. Column 2, lines 8-9. *Wilson* specifically states that a user having to remember and enter such digits is neither appealing nor practical in most situations. Column 2, lines 9-10. Thus, Applicants respectfully assert that *Wilson* actually teaches away from such an audio communication of the IP addresses. Plus, *Wilson* does not suggest playing an audio list of even



one IP address to a user of one of the dial pads 201-203, but instead specifically discloses the display of such IP addresses.

3. Claims 36-38 and 40 are not properly rejected under 35 U.S.C. § 103 as being unpatentable over *Wilson* in view of *Guy*. Applicants respectfully traverse these rejections for reasons similarly given above.

These foregoing features of displaying a list of LANs on the IP telephone is also recited in Claim 36. As a result, Claim 36 is also patentable over the cited prior art, since the Examiner has failed to prove a *prime facie* case of obviousness in rejecting these claims. In the Examiner's rejections, the Examiner merely regurgitates the claim language without pointing to a teaching within the references of such claim limitations. Fig. 5 and column 7, lines 45-67 of *Wilson* do not teach or suggest such limitations. Claim 36 further recites the display of such a list of LANs is done in response to the receiving a first touch input from a user on the telephone. There is no discussion within *Wilson*, or a combination of *Wilson* and *Guy*, of a user making a request for a list of LANs. Note further, that Claim 36 recites that the IP telephone is networked into a first LAN. As noted above, *Wilson* does not teach or suggest that the dial pads are in LANs. Claim 36 then recites that a second touch input from the user will result in the display of a list of telephone destinations that are accessible from the second LAN. As noted above, this claim limitation is not taught or suggested within *Wilson*, or *Wilson* combined with *Guy*. Claim 36 then goes on to recite that a third touch input results in an automatic dialing of one of the destinations accessible from the second LAN. As noted previously by Applicants, such an automatic dialing process is not taught or suggested by the references.

Claim 36 also recites that the displaying steps further recite a step of sending a message from the first LAN to the second LAN requesting the second list. This is not shown or discussed anywhere within the references. The Examiner attempts to overcome a deficiency in the teachings of *Wilson* with regard to this limitation and the next one by referring to *Guy*. *Guy* retrieves a server code, but does so from a master directory somewhere in a server in a network 100. There is no disclosure in *Guy* of where such a master directory is located within the

network 100. It needs to be remembered that such a server code only identifies a device that is coupled to a PBX that communicates with the telephones in a network. Additionally, a list has not been sent across the WAN to the file server 112, but instead a single server code is sent. The claim specifically recites that a list of telephone destinations accessible from a second LAN is requested and retrieves it from the second LAN. The Examiner then goes on to assert, without objective support, that it would have been obvious to supply the internet database in *Wilson* from local directories stored in each respective LAN segment of a network as shown by *Guy*, thereby insuring that the internet master directory is up to date.

First of all, without some objective support for such an assertion, the Examiner's obviousness conclusion is without merit and cannot support his combination of the references to arrive at the claimed invention. The Examiner is required to prove such a suggestion by objective evidence. *Ex parte Levengood*, 28 U.S.P.Q.2d 1300, 1301 (Bd. Pat. App. & Int. 1993); *Ashland Oil, Inc. v. Delta Resins and Refractories, Inc.*, 776 F.2d 281, 227 U.S.P.Q. 657 (Fed. Cir. 1985). The legal conclusion of obviousness must be supported by facts. *Graham v. John Deere & Co.*, 383 U.S. 1 (1966). A rejection based on § 103 clearly must rest on a factual basis, and these facts must be interpreted without hindsight reconstruction of the invention from the prior art. The patentability of an invention is not to be viewed with hindsight or "viewed after the event." *Goodyear Company v. Ray-O-Vac Company*, 321 U.S. 275, 279, 64 S.Ct. 593, 88 L.Ed. 721 (1944). Instead of relying upon objective evidence to support the Examiner's assertion, the Examiner has merely supported such an obviousness rejection with the Examiner's own opinion, which is quite clearly not objective evidence as is required by the case law.

Secondly, *Wilson* does not teach or suggest other LANs because *Wilson* does not show other LANs having telephone extensions connected thereto whereby a list is stored within such LANs for sending to update the directory database 232. Nor does *Wilson* suggest that such a process can be implemented. Furthermore, *Guy* merely teaches that a directory management unit will update its unit of server codes when it receives one. There is also no teaching or discussion in *Guy* of going out and retrieving such lists of extensions connected to other LANs, or such LANs sending such lists of attached telecommunication extensions to other LANs within the

network. Thus, there is no support for the Examiner's assertion that it would have been advantageous and obvious for the database 232 in *Wilson* to be updated by all of the various LANs to ensure that it is directory is up-to-date. Further, Claim 36 is patentable for similar reasons as given for Claims 1-3, 5-6 and 8.

Claim 37 recites scrolling through the first list. This first list is a list of LANs. First of all, such a list of LANs is nowhere to be taught or suggested within either of the references or their combination. Secondly, there is no teaching or suggestion for scrolling through such a list of LANs. As a result of the foregoing, one skilled in the art at the time the invention was made would not have been able to recreate the claimed invention in view of the combination of the references.

Respectfully submitted,

Date: Sept. 2, 2009



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## Appendix of Claims

1. An information handling system comprising:
  - a first local area network ("LAN");
  - a second LAN;
  - a wide area network ("WAN") coupling the first LAN to the second LAN;
  - a first telecommunications device coupled to the first LAN;
  - a plurality of telecommunications extensions coupled to the second LAN;
  - the first LAN including first circuitry for enabling a user of the first telecommunications device to observe a list of the plurality of telecommunications extensions; and
  - the first LAN including second circuitry for automatically calling one of the plurality of telecommunications extensions in response to the user selecting one of the plurality of telecommunications extensions from the observed list, wherein the list of the plurality of telecommunications extensions is stored in a server in the second LAN, and is accessed by the first circuitry across the WAN.
  
2. The system as recited in claim 1, wherein communication among the first LAN, second LAN, and WAN uses an IP protocol.
  
3. The system as recited in claim 2, wherein the list of the plurality of telecommunications extensions is displayed to the user of the first telecommunications device.
  
4. An information handling system comprising:
  - a first local area network ("LAN");
  - a second LAN;
  - a wide area network ("WAN") coupling the first LAN to the second LAN;
  - a first telecommunications device coupled to the first LAN;
  - a plurality of telecommunications extensions coupled to the second LAN;
  - the first LAN including first circuitry for enabling a user of the first telecommunications device to observe a list of the plurality of telecommunications extensions; and

the first LAN including second circuitry for automatically calling one of the plurality of telecommunications extensions in response to the user selecting one of the plurality of telecommunications extensions from the observed list, wherein communication among the first LAN, second LAN, and WAN uses an IP protocol, wherein the list of the plurality of telecommunications extensions is played as audio to the user of the first telecommunications device.

5. The system as recited in claim 3, wherein the first telecommunications device is an IP telephone having a display for showing the list of the plurality of telecommunications extensions, wherein the second circuitry includes a key for enabling the user to tacitly selecting one of the plurality of telecommunications extensions from the displayed list.

6. The system as recited in claim 5, wherein the tactile selection of one of the plurality of telecommunications extensions from the displayed list by the user results in an initiation of a call from the first telecommunications device to the selected one of the plurality of telecommunications extensions across the WAN.

8. An information handling system comprising:  
a first local area network ("LAN");  
a second LAN;  
a wide area network ("WAN") coupling the first LAN to the second LAN;  
a first telecommunications device coupled to the first LAN;  
a plurality of telecommunications extensions coupled to the second LAN;  
the first LAN including first circuitry for enabling a user of the first telecommunications device to observe a list of the plurality of telecommunications extensions; and

the first LAN including second circuitry for automatically calling one of the plurality of telecommunications extensions in response to the user selecting one of the plurality of telecommunications extensions from the observed list, wherein communication among the first LAN, second LAN, and WAN uses an IP protocol, wherein the list of the plurality of telecommunications extensions is displayed to the user of the first telecommunications device,

wherein the first telecommunications device is an IP telephone having a display for showing the list of the plurality of telecommunications extensions, wherein the second circuitry includes a key for enabling the user to tacitly selecting one of the plurality of telecommunications extensions from the displayed list, wherein the tactile selection of one of the plurality of telecommunications extensions from the displayed list by the user results in an initiation of a call from the first telecommunications device to the selected one of the plurality of telecommunications extensions across the WAN, wherein the list of the plurality of telecommunications extensions is stored in a server in the second LAN, and is accessed by the first circuitry across the WAN.

9. The system as recited in claim 8, wherein the first telecommunications device includes circuitry for enabling the user to scroll through the displayed list of the plurality of telecommunications devices.

10. The system as recited in claim 1, further comprising:  
a third LAN coupled to the first and second LANs via the WAN; and  
a plurality of telecommunications extensions coupled to the third LAN, the first LAN including circuitry for enabling the user to select between observing the list of the plurality of telecommunications extensions coupled to the second LAN or observing a list of the plurality of telecommunications extensions coupled to the third LAN.

17. An information handling system comprising:  
a first local area network ("LAN") operating under an IP protocol;  
a first IP telephone coupled to the first LAN, the first IP telephone having a display and a set of keys for enabling a user to enter inputs;  
a second LAN operating under the IP protocol;  
second and third telephone extensions coupled to the second LAN;  
a wide area network ("WAN") operating under the IP protocol coupling the first LAN to the second LAN; and

the first LAN including first circuitry for enabling a user of the first IP telephone to view a list including the second and third telephone extensions, wherein the list is stored in a server in the second LAN, and is accessed by the first circuitry across the WAN.

18. The system as recited in claim 17, further comprising:

the first LAN including second circuitry for automatically calling the second telephone extension in response to the user selecting the second telephone extension from the viewed list.

19. The system as recited in claim 18, wherein selection of the second telephone extension from the viewed list by the user is accomplished by selection of one of the set of keys.

20. The system as recited in claim 19, wherein the selection of one of the set of keys results in an initiation of a call from the first IP telephone to the second telephone extension across the WAN.

22. The system as recited in claim 17, wherein the first IP telephone includes circuitry for enabling the user to scroll through the displayed list.

23. The system as recited in claim 1, further comprising:

a third LAN coupled to the first and second LANs via the WAN; and  
a plurality of telephone extensions coupled to the third LAN, the first LAN including circuitry for enabling the user to select between viewing the list of the telephone extensions coupled to the second LAN or viewing a list of the plurality of telephone extensions coupled to the third LAN.

24. In a telecommunications system comprising a first IP telephone coupled to a first IP server within a first LAN, second and third telephone extensions coupled to a second IP server within a second LAN, and a WAN coupling the first LAN to the second LAN, the first LAN, the second LAN, and the WAN communicating using an IP protocol, a method comprising the steps of:

in response to selection of a first input on the first IP telephone, displaying on the first IP telephone a list of telephone destinations stored in the second IP server, wherein the list of telephone destinations is communicated from the second IP server over the WAN to the first IP telephone; and

in response to selection of one of the telephone destinations from the displayed list, automatically dialing the selected one of the telephone destinations for a communications link between the first IP telephone and the selected one of the telephone destinations.

25. The method as recited in claim 24, wherein the selection of one of the telephone destinations from the displayed list is performed in response to selection of a second input on the first IP telephone by a user.

26. The method as recited in claim 25, wherein the first and second inputs are the same key button on the first IP telephone.

27. The method as recited in claim 24, wherein the telephone destinations include the second and third telephone extensions coupled to the second IP server.

28. The method as recited in claim 24, wherein the telephone destinations include telephones external to the system.

29. The method as recited in claim 24, wherein the system includes a third LAN coupled to the first and second LANs via the WAN, further comprising the steps of: displaying on the first IP telephone a list of LANs coupled to the WAN, including the second and third LANs; and

performing the step of displaying the first list in response to selection of the second LAN from the displayed list of LANs.

30. A telecommunications system comprising:  
a first IP telephone coupled to a first IP server within a first LAN;



second and third telephone extensions coupled to a second IP server within a second LAN;

a WAN coupling the first LAN to the second LAN, the first LAN, the second LAN, and the WAN communicating using an IP protocol;

means for displaying on the first IP telephone a list of telephone destinations stored in the second IP server in response to selection of a first input on the first IP telephone, wherein the list of telephone destinations is communicated from the second IP server over the WAN to the first IP telephone; and

means for automatically dialing the selected one of the telephone destinations for a communications link between the first IP telephone and the selected one of the telephone destinations in response to selection of one of the telephone destinations from the displayed list.

31. The system as recited in claim 30, wherein the selection of one of the telephone destinations from the displayed list is performed in response to selection of a second input on the first IP telephone by a user.

32. The system as recited in claim 31, wherein the first and second inputs are the same key button on the first IP telephone.

33. The system as recited in claim 32, wherein the telephone destinations include the second and third telephone extensions coupled to the second IP server.

34. The system as recited in claim 32, wherein the telephone destinations include telephones external to the system.

35. The system as recited in claim 31, further comprising:  
a third LAN coupled to the first and second LANs via the WAN;  
means for displaying on the first IP telephone a list of LANs coupled to the WAN, including the second and third LANs; and

means for displaying the first list in response to selection of the second LAN from the displayed list of LANs.

36. A method comprising the steps of:  
receiving a first touch input from a user on an IP telephone that is networked into a first LAN operating under an IP protocol;  
in response to receipt of the first touch input, displaying on a display on the IP telephone a first list including second and third LANs coupled to the first LAN, wherein the second and third LANs operate under the IP protocol;  
receiving a second touch input from the user on the IP telephone;  
in response to receipt of the second touch input, displaying on the display on the IP telephone a second list of telephone destinations accessible from the second LAN;  
receiving a third touch input from the user on the IP telephone; and  
in response to receipt of the third touch input, automatically dialing one of the telephone destinations accessible from the second LAN for a communications connection between the one of the telephone destinations and the IP telephone, wherein the step of displaying on the display on the IP telephone the second list further includes the steps of:  
sending a message from the first LAN to the second LAN requesting the second list; and  
receiving the second list from the second LAN to the first LAN.

37. The method as recited in claim 36, before the step of receiving the second touch input, further comprising the steps of: receiving a fourth touch input from the user on the IP telephone; and in response to receipt of the fourth touch input, scrolling through the first list.

38. The method as recited in claim 37, before the step of receiving the third touch input, further comprising the steps of: receiving a fifth touch input from the user on the IP telephone; and in response to receipt of the fifth touch input, scrolling through the second list.

40. The method as recited in claim 36, wherein the first, second, and third LANs are coupled via a WAN.

EVIDENCE APPENDIX

No evidence was submitted pursuant to §§1.130, 1.131, or 1.132 of 37 C.F.R. or of any other evidence entered by the Examiner and relied upon by Appellants in the Appeal.

Applicant : Suder et al.  
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Filed : May 29, 2003  
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RELATED PROCEEDINGS APPENDIX

None.



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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* ERIC G. SUDER and HAROLD E. A. HANSEN II

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Appeal 2010-000868  
Application 10/447,607  
Technology Center 2400

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*Before* DEBRA K. STEPHENS, JASON V. MORGAN, and  
MICHAEL R. ZECHER, *Administrative Patent Judges*.

STEPHENS, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) (2002) from a final rejection of claims 1-6, 8-10, 17-20, 22-38, and 40. Claims 7, 11-16, 21, and 39 have been cancelled. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM-IN-PART.

*Introduction*

According to Appellants, the invention relates to use of Voice over Internet Protocol (“IP”) technology to transmit voice conversations. In the invention, a user can observe and dial numbers from lists that are stored in the Voice over IP system. (Abstract; Spec. 1, ¶¶Technical Field).

STATEMENT OF THE CASE

*Exemplary Claim*

Claim 1 is an exemplary claim and is reproduced below:

1. An information handling system comprising:
  - a first local area network (“LAN”);
  - a second LAN;
  - a wide area network (“WAN”) coupling the first LAN to the second LAN;
  - a first telecommunications device coupled to the first LAN;
  - a plurality of telecommunications extensions coupled to the second LAN;

the first LAN including first circuitry for enabling a user of the first telecommunications device to observe a list of the plurality of telecommunications extensions; and

the first LAN including second circuitry for automatically calling one of the plurality of telecommunications extensions in response to the user selecting one of the plurality of telecommunications extensions from the observed list, wherein the list of the plurality of telecommunications extensions is stored in a server in the second LAN, and is accessed by the first circuitry across the WAN.

*Prior Art*

Stuntebeck	US 6,065,016	May 16, 2000
Guy	US 6,298,057 B1	Oct. 2, 2001
Wilson	US 6,829,231 B1	Dec. 7, 2004

(filed Dec. 31, 1996)

*Rejections*

(1) Claims 1-3, 5, 6, 8-10, 17-20, and 22- 35 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Guy and Wilson.

(2) Claim 4 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Guy, Wilson, and Stuntebeck.

(3) Claims 36-38 and 40 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Wilson and Guy.

We have only considered those arguments that Appellants actually raised in the Briefs. Arguments Appellants could have made but chose not to make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii)(2009).



ISSUE 1

*35 U.S.C. § 103(a): claims 1, 3, 8, 9, 17, 22, 24, 29, and 30*

Appellants assert their invention is not obvious over Guy and Wilson because Guy teaches a caller on a first telephone dialing digits associated with a destination telephone (App. Br. 10). According to Appellants, Guy teaches only that the server code accessed from the master director is only associated with the specific central site unit (CSU) (*id.*).

Thus, Appellants assert, Guy does not teach or suggest that a list of a plurality of telecommunications extensions coupled to the second LAN is provided to the user of the first telephone for observation (App. Br. 10-11).

Further, Appellants argue Wilson teaches a device that allows access to the internet; one of the devices to have audio communications with another device over an internet channel whereby a connection is made between the devices using typical IP internet addresses; and if the IP address is not known, using an internet search engine to browse an access database on the internet and display the address so the user can enter the address to establish the connection (App. Br. 14). Appellants argue Wilson does not disclose a LAN (App. Br. 11-15).

*Issue 1:* Has the Examiner erred in finding the combination of Guy and Wilson would have taught or suggested “a first LAN...for enabling a user of the first telecommunications device to observe a list of the plurality of telecommunications extensions” and “the first LAN...for automatically calling one of the plurality of telecommunications extensions in response to

the user selecting one of the plurality of telecommunications extensions from the observed list, wherein the list of the plurality of telecommunications extensions is stored in a server in the second LAN” as recited in claim 1?

#### ANALYSIS

We agree with the Examiner’s findings and conclusions (Ans. 10-14). Specifically, Appellants have not persuaded us the Examiner erred in finding Guy would teach or suggest all the claim limitations except the ability of the calling user in a first network to observe a list of extensions in a second network and automatically calling one of those extensions in response to the user selecting an extension from the observed list (*see* Ans. 11). For emphasis we note Guy discloses a first network that can access a directory stored on a second network (Fig. 1; col. 9, ll. 20-26; col. 10, l. 58 to col. 11, l. 8). We also agree with the Examiner that Wilson teaches or at least suggests that a user observes a list of the plurality of telecommunications extensions and automatically calls the chosen number (Ans. 12-14). Wilson teaches that Internet addresses can be stored on a user database that is on a different network than the caller (Fig. 4; col. 7, ll. 48-53). Wilson also teaches or at least suggests that a caller is presented with names of qualifying callees (col. 8, ll. 8-15). The caller may select the intended caller and complete the call to the address (*id.*). Thus, Wilson teaches or at least suggests allowing a user to observe a list of the plurality of telecommunication extensions and automatically call the selected telecommunication extension.

We agree with the Examiner that Appellants are arguing the references individually (Ans. 10-11). Specifically, it is apparent from the Examiner's line of reasoning in the Answer that the basis for the obviousness rejection is the combination of Guy and Wilson. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *See In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986).

As to Appellants' arguments that Wilson does not teach a LAN, 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 any one 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. *In re Keller*, 642 F.2d 413 (CCPA 1981) (citations omitted).

Nor has Appellant shown that combining the teachings of Guy and Wilson in this manner would have been uniquely challenging or otherwise beyond the level of ordinarily skilled artisans. As such, we find this enhancement would have been obvious. *See KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 417 (2007) (noting that if a technique has been used to improve one device, and an ordinarily skilled artisan would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill); *see also Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007).

With respect to claim 30, Appellants argue the Examiner has not examined the claims in light of the “means-plus-function” limitations. As to the “means-plus-function” limitations, Appellants have pointed to corresponding structure in their Appeal Brief (App. Br. 6-7). As to “means for automatically dialing,” those portions of the Specification to which Appellants point set forth very general structure. Appellants point to Specification page 22, ll. 4-24 as means for automatically dialing. (App. Br. 7). The cited portions disclose the steps for choosing a callee including pressing a key to begin call processing. No specific structure has been identified and thus, “means for automatically dialing” may be generally construed as a key. Similarly, Appellants’ citations to Fig. 8, element 810 and pages 16, line 21 – page 17, line 26 generally describe a display as a display with no specific structure.

To meet a “means plus function” limitation, the prior art must (a) perform the identical function recited in the means limitation and (b) perform that function using the structure disclosed in the specification or an equivalent structure. *See Carroll Touch, Inc. v. Electro Mech. Sys., Inc.*, 15 F.3d 1573, 1578 (Fed. Cir. 1993); *Valmont Indus., Inc. v. Reinke Mfg. Co.*, 983 F.2d 1039, 1042 (Fed. Cir. 1993); *Johnston v. IVAC Corp.*, 885 F.2d 1574, 1580 (Fed. Cir. 1989).

In light of Appellants’ correspondence of general structure to the recited “means-plus-function” limitations, we find no error in the Examiner’s findings that both Guy and Wilson teach or at least suggest the structure disclosed in the Specification and the identical function for the invention disclosed in the Specification and as recited in claim 30.

Specifically, both Guy and Wilson teach or at least suggest means for displaying on the first IP telephone a list of telephone destinations in response to selection of a first input on the first IP telephone, wherein the list of telephone destinations is communicated from the second IP server over the WAN to the first IP telephone. Additionally, the combination of Guy and Wilson teaches or at least suggests means for automatically dialing the selected one of the telephone destinations for a communications link between the first IP telephone and the selected one of the telephone destinations in response to selection of one of the telephone destinations from the displayed list.

Appellants presented no persuasive arguments or evidence that the Examiner erred in finding the combination would have taught or suggested the invention as recited in independent claim 1; commensurately recited in independent claims 8, 17, 24, and 30; and dependent claims 3, 9, 22, and 29, not separately argued.

Accordingly, the Examiner did not err in rejecting claims 1, 3, 8, 9, 17, 22, 24, 29, and 30 under 35 U.S.C. § 103(a) for obviousness over Guy and Wilson.

## ISSUE 2

*35 U.S.C. § 103(a): claims 2, 5, 6, 18-20, 25-28 and 31-34*

With respect to claim 2, Appellants merely recite the Examiner has not shown the combination of Guy and Wilson teaches the recited limitation (App. Br. 13). Appellant has failed to present *substantive* arguments and supporting *evidence* persuasive of Examiner error. *See In re Lovin*, 652 F.3d

1349, 1357 (Fed. Cir. 2011) (stating that interpreting 37 C.F.R. § 41.37(c)(1)(vii) to require a more substantive argument than a naked assertion that the prior art fails to teach limitation in order to address a claim separately, is not an unreasonable interpretation of the rule). Additionally, any arguments not presented are waived. *See Ex parte Borden*, 93 USPQ2d 1473, 1474 (BPAI 2010) (informative).

With respect to claim 5, we agree with the Examiner that Wilson teaches or fairly suggests automatically dialing a selected extension from a displayed list (Ans. 5 and 12-13).

We also agree with the Examiner's findings regarding claim 6 in that pressing a key is a tactile selection (Ans. 12-13).

As to claims 18-20, Appellants do not present any arguments, but state that each claim is patentable for "reasons similarly given herein with respect to" other claims (App. Br. 19). For the reasons set forth above and because Appellants have not presented any persuasive evidence or argument specific to the recited limitations, the Examiner has not erred in finding the combination of Guy and Wilson would have taught or suggested the present invention as recited.

With respect to claims 27 and 33, Appellants present no specifics, but instead, set forth conclusory statements unsupported by factual evidence (App. Br. 20). Mere attorney arguments and conclusory statements that are unsupported by factual evidence are entitled to little probative value. *In re Geisler*, 116 F.3d 1465, 1470 (Fed. Cir. 1997); *see also In re De Blauwe*, 736 F.2d 699, 705 (Fed. Cir. 1984); and *Ex parte Belinne*, No. 2009-004693, 2009 WL 2477843, at \*3-4 (BPAI Aug. 10, 2009) (informative). With

respect to claims 25 27 and 31-33, Appellants have set forth that the Examiner provides no objective evidence of obviousness and traverse the assertion of what is well known in the art (App. Br. 20). We agree with the Examiner.

As to claims 25, 26, 31, and 32, Appellants' argument that a first and second input are the same key button is unpersuasive. As clarified in *KSR*, the skilled artisan is "a person of ordinary creativity, not an automaton." See *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 421 (2007). Appellants have presented no evidence that using the same key button for two different inputs was "uniquely challenging or difficult for one of ordinary skill in the art" or "represented an unobvious step over the prior art." *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007) (citing *KSR*, 550 U.S. at 418).

With respect to claims 28 and 34, we agree with the Examiner that Wilson teaches or suggests the telephone destinations include telephones external to the system (Ans. 17; see also Fig. 5). Additionally, we find Wilson's storing of callee Internet addresses teaches or suggests that telephone destinations external to the system may be stored (col. 7, ll. 48-53). Again we find that storing telephone destinations external to the network would have been within the skill of an ordinary artisan.

Accordingly, we find Appellants have not shown the Examiner erred in finding the combination of Guy and Wilson would have taught or suggested the invention as recited in claims 2, 5, 6, 18-20, 25-28 and 31-34. Thus, the Examiner did not err in rejecting claims 2, 5, 6, 18-20, 25-28 and 31-34 under 35 U.S.C. § 103(a) for obviousness over Guy and Wilson.

ISSUE 3

*35 U.S.C. § 103(a): claims 10, 23, and 35*

With respect to claims 10 and 23 (App. Br. 18-19), the Examiner has not shown Guy, Wilson or the combination thereof, teaches or suggests enabling the user to select between observing the list coupled to the second and to the third LAN. Specifically, the Examiner has not shown with specificity where Wilson teaches or suggests that a user may select between observing two different directories (*see* Ans. 15).

As to the arguments set forth for claim 35 (App. Br. 20-21), we find Guy discloses a directory that includes servers (col. 9, ll. 23-26) and Wilson shows a system with multiple networks. Thus, we find listing these as LANs instead of CSUs or servers would have been within the skills of an ordinary artisan. However, the Examiner has not shown with specificity where the references teach or suggest displaying an initial list (list of LANs) and then displaying another list (the first list) in response to a selection made from the initial list.

Thus, the Examiner has not set forth a *prima facie* case for claims 10, 23, and 35. Accordingly, the Examiner erred in rejecting claims 10, 23, and 35 under 35 U.S.C. § 103(a) for obviousness over Guy and Wilson.

ISSUE 4

*35 U.S.C. § 103(a): claim 4*



Appellants are again arguing the references individually (App. Br. 21-22). Specifically, Appellants argue that the limitation is “impossible in Guy” and not taught by Wilson and further, that Wilson “teaches away” from the present invention as recited in claim 4 (*id.*). However, the Examiner is relying on Stuntebeck as disclosing this limitation. Appellants have not provided any persuasive arguments or evidence to persuade us of error in the Examiner’s findings. Further, Appellants have not shown a person of ordinary skill, upon reading Wilson, would be discouraged from following the path set out by the Appellants, or would be led in a direction divergent from the path that was taken by the Appellant. *See In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994).

Accordingly, we are not persuaded of error in the Examiner’s conclusion that the invention as recited in claim 4 would have been obvious under 35 U.S.C. § 103(a) for obviousness over Guy, Wilson, and Stuntebeck.

#### ISSUE 5

##### *35 U.S.C. § 103(a): claims 36-38 and 40*

Appellants assert their invention is not obvious over Wilson and Guy because the Examiner has not shown all the limitations are taught or suggested by the combination of Wilson and Guy (App. Br. 22-23). Specifically, Appellants argue neither reference teaches or suggests making a request for a list of LANs, a touch input, or automatic dialing (App. Br. 22). Further, Appellants argue the Examiner has not provided objective evidence indicating that it would have been obvious to supply the internet

database in Wilson from local directories stored in each respective LAN segment of a network as shown by Guy and instead assert the Examiner is using hindsight (App. Br. 23). Appellants further argue Wilson does not teach or suggest other LANs having telephone extensions connected thereto whereby a list is stored within such LANs for sending to update the directory database, or Guy teaches retrieving or sending lists of extensions connected to other LANs (App. Br. 23-24). Additionally, according to Appellants, with respect to claim 37, the Examiner has not shown that either a list of LANs or scrolling through such a list is taught or suggested (App. Br. 24).

*Issue 5:* Has the Examiner erred in finding the combination of Wilson and Guy would have taught or suggested the invention as recited in independent claims 36 and claim 37?

#### ANALYSIS

We agree with the Examiner's findings and conclusion and emphasize the following (Ans. 8-9). Specifically, Wilson discloses providing a directory of callee Internet addresses and displaying callee information (col. 7, ll. 48-53; col. 8, ll. 8-13) and Guy discloses providing a master directory (col. 9, ll. 20-26). Thus, we find the references teach or suggest in response to an input, displaying a list and as set forth with respect to claim 1, automatic dialing. We conclude an ordinary artisan would have had the skills to provide a directory of LANs – a directory of information – in response to a request. Appellants have not defined “touch input” and thus, we also find pressing a key is a touch input. We further agree that Wilson teaches or suggests selecting a callee from a list of potential users using a

keyboard (col. 8, ll. 8-15). We disagree with Appellants' argument that the Examiner used hindsight as the Examiner has articulated a reason with a rational underpinning to support the legal conclusion. In addition, Appellants have not shown that the combination was uniquely challenging or more than the application of a known technique to a piece of prior art.

Additionally, we again note Appellants are arguing the references individually when the Examiner relied upon the combination of the teachings of Guy and Wilson.

As to claim 37, Wilson teaches scrolling through a list (col. 8, ll. 13-15) and thus, teaches or suggests "receiving a fourth touch input from the user on the IP telephone, and in response to receipt of the fourth touch input, scrolling through the first list" (*see* Ans. 8).

Accordingly, the Examiner did not err in finding the combination of Wilson and Guy would have taught or suggested the invention as recited in claims 36 and 37 and claims 38 and 40, not separately argued. Therefore, the Examiner did not err in rejecting claims 36-38 and 40 under 35 U.S.C. § 103(a) for obviousness over Wilson and Guy.

#### DECISION

The Examiner's rejection of claims 1-3, 5, 6, 8, 9, 17-20, 22, and 24-34 under 35 U.S.C. § 103(a) as being obvious over Guy and Wilson is affirmed.

The Examiner's rejection of claims 10, 23, and 35 under 35 U.S.C. § 103(a) as being obvious over Guy and Wilson is reversed.

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The Examiner's rejection of claim 4 under 35 U.S.C. § 103(a) as being unpatentable over Guy, Wilson, and Stuntebeck is affirmed.

The Examiner's rejection of claims 36-38 and 40 under 35 U.S.C. § 103(a) as being obvious over Wilson and Guy is affirmed.

AFFIRMED-IN-PART

tj



references and how such references did not teach or suggest the limitations in the manner that the Examiner was asserting. If an Examiner uses a single reference to show where a limitation is taught or suggested within the prior art, then Appellants should be able to traverse such an assertion by simply showing how the reference does not teach or suggest that particular limitation. It should be noted that an applicant may specifically challenge an obvious rejection by showing that the Board based its obviousness determination on incorrect factual predicates. *In re Rouffet* at 1455. Appellants further address the foregoing in several instances hereinafter.

On page 6 of the Decision on Appeal, the Board asserts that Appellants have not shown that combining the teachings of *Guy* and *Wilson* would have been uniquely challenging or otherwise beyond the level of ordinary skilled artisans. Appellants disagree. Throughout Appellants' arguments on pages 8–12 of the Appeal Brief, Appellants provided arguments as to why it would be difficult to combine the references because of various teachings within each of the references that would make such a combination difficult. These arguments were not merely arguing the references individually, but instead were arguments presenting reasons why one of ordinary skill in the art would not combine the references because the references had particular features that would not lead one of ordinary skill in the art to the combination of the references. All of these arguments were ignored by the Examiner and the Board contrary to MPEP §707.07(f).

More specifically, on page 12 of the Appeal Brief, Appellants provided several arguments as to how the combination of the references would not arrive at the claimed invention, but the Board decided to completely ignore such arguments in its decision. Instead, the Board decided to side with the Examiner's very loosely reasoned arguments. The Examiner's line of reasoning is merely his own opinion, and Appellants' arguments against such lines of reasoning should be given equal weight. Moreover, Appellants respectfully assert that such an action by the Board is absent of any full and reasoned explanation, and is not a sound decision. *In re Lee*, 277 F.3d 1338 (Fed. Cir. 2002). In fact, such an action by the Board is arbitrary.

Claims 1, 4, 8, 18, 24, 30, and 36 all recite that circuitry or a method implemented within circuitry automatically call one of the plurality of telecommunications extensions in response to the user selecting one of the extensions from the observed list. The Board determined at the bottom of page 5 of the Decision on Appeal that *Wilson* teaches or at least suggests such a

functionality. The Examiner in the Examiner's Answer admitted that *Guy* does not meet this claim limitation, but that it was met by *Wilson*. On pages 10–11 of the Appeal Brief, Appellants provide their arguments as to how *Wilson* does not teach an ability to automatically perform the dialing process in response to selection of a name on a displayed list by the user of the dial pad 50 pressing some sort of button to select one of the names. The Board and the Examiner have completely ignored this argument, and have not addressed Appellants' arguments in any form or fashion, except for the statement on page 9 of the Decision on Appeal with respect to Claim 5, where the Board agrees with the Examiner that *Wilson* teaches or fairly suggests automatically dialing a selected extension from a displayed list.

In response, Appellants respectfully assert that they provided very good arguments as to the interpretation of the teachings of *Wilson*. The Examiner disagreed and provided his own interpretation. This Board merely stated that it agreed with the Examiner without providing any explanation as to why the Examiner's interpretation was believed or considered correct over Appellants'. Appellants respectfully assert that this Board cannot merely state that it agrees with the position of the Examiner without providing a full and reasoned explanation as to why the Examiner's interpretation was more correct than Appellants'. Otherwise, the Board's decision is not a sound decision. *In re Lee*, 277 F.3d 1338 (Fed. Cir. 2002). In fact, such an action by the Board is arbitrary. For such an important limitation that distinguishes the claimed invention from the prior art, Appellants deserve more than a three line affirmation of the Examiner's rejection by the Board. The decision on patentability must be made based upon consideration of all the evidence, including the evidence submitted by the examiner and the evidence submitted by the applicant. MPEP §2142. A decision to make or maintain a rejection in the face of all the evidence must show that it was based on the totality of the evidence. *Id.*

Moreover, the Examiner's arguments on pages 12–13 of the Answer are full of assumptions and not facts. For a *prima facie* case of obviousness to reject a claim, it is the burden of the Examiner to prove such a *prima facie* case of obviousness with facts and objective evidence, not assumptions. If Appellants can show that the Examiner's facts, evidence, and arguments are flawed, then the balance of the decision should go to Appellants, not the Examiner. It is not the burden of Appellants to show that their claim is patentable; instead, it is the burden of the Examiner to show that the claim is not patentable. Appellants do believe that

they have shown that the Examiner erred in his obviousness rejection, and did not set forth a *prima facie* case of obviousness.

More specifically with respect to the cited portion of column 8 in *Wilson* cited by the Examiner, a caller selecting from a scrolled list of potential users does not in any way teach or even suggest in a specifically sufficient manner that such a selection is performed with key touches into a device that will then automatically dial the selected callee. *Wilson* in column 2, lines 8--9 making the assertion that it is not appealing for a user to have to remember to enter digits does not in any way prove the Examiner's position. Note that *Wilson* stated that it was not appealing to remember and enter the digits. If the IP address is displayed, then that alleviates the need to remember the address. This statement in *Wilson* does not suggest automatic dialing, but is merely directed at the user not having to remember the looked up address. The Examiner's assertion that *Wilson*'s disclosure that the caller then has the option of completing the call to the address does not say anything about using the keyboard, and requiring manual keyboard entry for connecting to the searched caller does not in any way support the Examiner's position that a manual entry would not be used. Appellants noted on page 11 of the Appeal Brief that *Wilson* disclosed the user dialing the selected callee. Column 9, lines 1--4. This language is describing the process flow in Figure 6 of *Wilson*. Step 386 specifically states that the "User Accepts Address and Dials." A user dialing is well-known for indicating that the user is performing a process of entering a callee's number to call the callee. *Wilson* nowhere teaches or suggests that the device performs such dialing, which would be in an automatic manner, i.e., without the user's help, upon acceptance of the address. The preponderance of the evidence supports Appellants' interpretation and not the Examiner's. The legal standard of "a preponderance of evidence" requires the evidence to be more convincing than the evidence which is offered in opposition to it. MPEP §2142. To not fully evaluate Appellants' arguments is arbitrary by the Board.

Furthermore, the Examiner's interpretation of *Wilson* is broadening the teachings of *Wilson* beyond the four corners of that reference, which is essentially using hindsight reasoning gleaned from Appellants' application. In fact, the Examiner's interpretation is essentially reading limitations into the *Wilson* disclosure that are not actually there. A reference is good for teaching or suggesting what it actually discloses. If an Examiner is going to broaden such a teaching, then this cannot be based solely on the Examiner's unsupported opinion.



Regarding Claim 30, the Board only refers to Appellants' citations in the Specification of page 22, lines 4–24; FIG. 8, element 810, and page 16, line 21–page 17, line 26. This is not all of the language in the Specification that pertains to and supports the limitations in Claim 30. In the Second Supplemental Brief On Appeal, the Board is respectfully requested to refer to pages 6–7 where Appellants also cite page 16, line 21–page 18, line 20, and page 18, line 21–page 20, line 24 of the Specification for support of Claim 30. Furthermore, Appellants also cite to FIG. 11 and page 20, line 25–page 22, line 11. Appellants also cite to FIG. 12, and page 22, line 12–24 along with a citation to page 22, lines 4–24.

Therefore, there is significantly more of the Specification that Appellants cited to in support of Claim 30 just within the Summary in Appellants' Appeal Brief, which this Board has ignored. Within all of those citations, there is significantly more disclosure for support of these “means plus function” limitations. For example, FIG. 8 shows that the IP telephony device 105 includes a DSP 801, which is a well-known processor for performing various tasks and algorithms. FIGS. 11 and 12 provide flow and state diagrams of such algorithms implemented within the IP telephony device 105, which would be implemented within such a DSP 801. These figures show how the remote extension is automatically dialed upon pressing of one of the keys on the telephony device 105. As a result, very specific structures have been identified within FIG. 8 for performing the functions within the “means plus function” limitations. It is very clear that it is incorrect to construe the “means for automatically dialing” limitation as merely a key. Clearly, Appellants have identified within the Specification the specific structure of the IP telephony device 105 with its various components, including the DSP 801, along with identifying specific algorithms implemented within the DSP 801 for performing these functions as recited within Claim 30.

Moreover, the prior art does not perform the identical function recited in the “means plus function” limitations. A DSP and its algorithms for performing the functions as supported in FIGS. 11 and 12 of the Specification are not shown in any way to reside within the prior art references. Nor does the prior art teach or suggest an identical or an equivalent structure for performing such functions. Therefore, the cited prior art does not meet these “means plus function” limitations.

Regarding Issue 2 beginning on page 8 of the Decision on Appeal, Appellants respectfully assert that they do not have to prove that the prior art does not show a limitation if the Examiner has not shown that it does. The Examiner merely asserting that the prior art shows the Internet does not show that the prior art is operating under an IP protocol. Appellants do not have to present any substantive argument and supporting evidence when the Examiner has not even shown that the prior art teaches or suggests operating under IP protocol. It is the Examiner's burden to show that the prior art references teach or suggest this limitation. The Examiner has not done so, because the Examiner has merely rejected this claim limitation with his own subjective opinion, along with the mere assumption that the existence of the Internet being disclosed within one or both of the references is sufficient to show that an IP protocol is being utilized. Moreover, the assertion by Appellants that *Guy* does not disclose its LANs or WAN operating under an IP protocol is a substantive argument. Moreover, it is significantly more substantive than the Examiner's unsupported statement on page 3 of the Office Action dated March 17, 2009 that "LANs and WAN operate under IP protocol" with respect to his assertions of what *Guy* discloses. Appellants do not have to disprove the unsupported assertion by the Examiner; instead, it is the Examiner who must prove that *Guy* actually discloses this limitation, using facts and not mere opinion and conclusory statements.

Regarding Claims 5 and 6, as previously asserted herein, the Decision on Appeal merely agrees with the Examiner without discussing Appellants' arguments at all. Appellants provided significant arguments on page 14 of the Appeal Brief with respect to these two claims. It does not seem that the Board in any way considered Appellants' arguments. Moreover, such an assertion by the Board is absent of any full and reasoned explanation, and is not a sound decision. *In re Lee*, 277 F.3d 1338 (Fed. Cir. 2002). In fact, such a statement by the Board is arbitrary.

With respect to Claims 27 and 33, the Board on page 9 of the Decision on Appeal asserts that Appellants set forth conclusory statements unsupported by factual evidence. Appellants asserting that the Examiner has not specifically addressed the limitations in Claims 27 and 33 is not merely conclusory. It is the Examiner's obligation and burden to show a *prima facie* case of obviousness. If the Examiner does not do this, Appellants do not have to do anything in response. Claims 27 and 33 recite that the telephone destinations include the second and third

telephone extensions coupled to the second IP server. The Examiner asserting on page 3 of the Office Action a “plurality of telecommunications extension/destinations coupled to the second LAN” is not addressing the claim limitations in claims 27 and 33 which recite language different than what the Examiner has stated. A “second LAN” is not necessarily an “IP Server.” “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Regarding Claim 4, the Board asserted that Appellants were arguing the references individually and did not provide any persuasive arguments or evidence how a person of ordinary skill upon reading *Wilson* would be discouraged from following the path set out by Appellants or would be led in a direction divergent from the path that was taken by Appellant. To the contrary, on page 18 of the Appeal Brief, Appellants did provide an argument as to why *Wilson* teaches away from the recited limitations. Moreover, Appellants argued that the recited claim limitation is impossible in *Guy*, and that *Wilson* does not teach or suggest such a capability and in fact teaches away from such an audio communication of the IP addresses. This is not arguing the references individually; instead, this is presenting arguments as to why one of ordinary skill in the art would not be motivated to combine the teaching of *Stuntebeck* into the teachings of *Guy* and *Wilson*. In other words, Appellants provided very good arguments against the combination of the references. Appellants cannot understand in any way how the Board can make the assertion that Appellants did not show how a person of ordinary skill would be discouraged from the combination when Appellants specifically provided arguments to this exact issue. Moreover, such an assertion by the Board is absent of any full and reasoned explanation, and is not a sound decision. *In re Lee*, 277 F.3d 1338 (Fed. Cir. 2002). In fact, such a statement by the Board is arbitrary. If this Board is going to make the assertion that Appellants did not provide sufficient arguments, then Appellants would appreciate this Board providing reasons why Appellants’ specific arguments in their Appeal Brief were insufficient.

Regarding Claims 36–38 and 40, Appellants in the Appeal Brief on page 19 asserted that the Examiner merely regurgitated the claim language without pointing to a teaching within the references of such claim limitations. The Appeal Board has done the same thing on pages 13–14 of the Decision on Appeal. The Board did not provide any reasoning to support their decision that the Examiner is correct over Appellants. Therefore, the Examiner and the Board have

rejected these claims by merely making blanket statements that the references teach or suggest the claim limitations. Such an assertion by the Board is absent of any full and reasoned explanation, and is not a sound decision. *In re Lee*, 277 F.3d 1338 (Fed. Cir. 2002). In fact, such a statement by the Board is arbitrary. The Board has also made the assertion that Appellants were arguing the references individually. To the contrary, Appellants asserted that there was no discussion within *Wilson*, or a combination of *Wilson* and *Guy*, of a user making a request for a list of LANs. Appellants also asserted that the Claim 36 recitation of a second touch input from the user will result in the display of a list of telephone destinations that are accessible from the second LAN is not taught or suggested within *Wilson*, or *Wilson* combined with *Guy*. An Applicant may specifically challenge an obvious rejection by showing that the Board based its obviousness determination on incorrect factual predicates. *In re Rouffet* at 1455. In the Appeal Brief, Appellants provided a rebuttal as to how the Examiner was relying upon an incorrect factual predicate in support of his rejection, but the Board improperly ignored such a rebuttal. Appellants also asserted that the automatic dialing process is not taught or suggested by the references.

The Board has disagreed with Appellants' argument that the Examiner used hindsight, and that the Examiner had articulated a reason with a rational underpinning to support the legal conclusion. Rejections on obviousness grounds cannot be sustained by mere conclusory statements. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007), citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). Instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *Id.* This requirement is as much rooted in the Administrative Procedure Act, which ensures due process and non-arbitrary decision making, as it is in §103. *Id.* The Examiner's assertion "that it would have been obvious to supply the internet database in *Wilson* from local directory stored in each respective LAN segment of a network as shown by *Guy*, thereby insuring that the internet master directory is up to date" is not a sufficiently articulated reason with a rational underpinning. All that is an unsupported personal opinion of this Examiner, which is gleaned using hindsight from Appellants' application. A sufficiently articulated reason with a rational underpinning must be based on something other than merely a personal opinion using hindsight; instead, it requires some sort of rational underpinning that provides logical reasons why such an update would be

performed, etc. For example, examples of such rational underpinnings provided in MPEP §2141 do not include mere personal opinion, but instead include rationales that show predictable results, the prior art showing such combinations in similar technologies, etc. If the United States Patent Office supported such blanket unsupported personal opinions of examiners on every occasion, there would never be another issued patent in the United States.

Moreover with respect to arguing the references individually, it is the Examiner who has asserted that *Wilson* discloses the limitation of “in response to receipt of first input, displaying on a display on the IP telephone a first list including second and third LANs coupled to the first LAN, wherein the second and third LANs operate under the IP protocol,” citing Figure 5 and column 7, lines 45–67 of *Wilson*. Appellants on page 19 of the Appeal Brief specifically traversed this assertion and stated that *Wilson* does not teach or suggest this limitation. Therefore, the Board is allowing the Examiner to attack a claim limitation with an individual reference, but is apparently not permitting Appellants to traverse such an assertion by specifically attacking that reference in an individual manner also. An applicant may specifically challenge an obvious rejection by showing that the Board based its obviousness determination on incorrect factual predicates. *In re Rouffet* at 1455. In the Appeal Brief, Appellants provided a rebuttal as to how the Examiner was relying upon an incorrect factual predicate in support of his rejection, but the Board improperly ignored such a rebuttal.

In summary, Appellants respectfully assert that the Board did not present a full and reasoned explanation of its decision in support of the Examiner’s rejections. *In re Lee*, 277 F.3d 1338 (Fed. Cir. 2002). Not only did the Board not reach a sound decision, but it failed to articulate the reasons for that decision. *Id.* Therefore, Appellants respectfully assert that the Examiner failed to present a *prima facie* case of obviousness, and the Board failed to properly address the applicable statutes and case law in its review of this appeal.

Applicant believes that no fees are due at this time. However, should any further fees be required, the Commissioner is authorized to charge such fees to Deposit Account No. 504410, referencing Attorney Docket No. 21618-013001.

Applicant : Suder et al.  
Serial No. : 10/447,607  
Filed : May 29, 2003  
Page : 10 of 10

Attorney Docket No. 21618-013001

Respectfully submitted,

Date: June 25, 2012

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* ERIC G. SUDER and HAROLD E. A. HANSEN II

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Appeal 2010-000868  
Application 10/447,607  
Technology Center 2400

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*Before* DEBRA K. STEPHENS, JASON V. MORGAN, and  
MICHAEL R. ZECHER, *Administrative Patent Judges*.

STEPHENS, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING



## INTRODUCTION

Appellants request rehearing of our Decision (“Decision”) mailed April 23, 2012, wherein we affirmed the rejection of claims 1-6, 8, 9, 17-20, 22, 24- 34, 36-38, and 40 as being unpatentable over various combinations of references.

## ANALYSIS

In their Request for Rehearing, Appellants allege that the Board’s Decision misapprehended or Appellants’ arguments (Req. 8-9).

### ISSUE 1

*35 U.S.C. § 103(a): claims 1, 3, 8, 9, 17, 22, 24, 29, and 30*

#### *Claim 1*

Appellants contend the references of Guy and Wilson cannot be combined together “because the references had particular features that would not lead one of ordinary skill in the art to the combination of the references” (Req. 2). We disagree.

The Examiner relies upon Wilson as teaching or suggesting “first circuitry for enabling a user of the first telecommunication device [coupled to the first LAN] to observe/view a list of the plurality of telecommunications extension” (which are coupled to the second LAN), and “second circuitry for automatically calling one of the plurality of telecommunications extensions in response to the user selecting one of the plurality of telecommunications extensions from the observed list” (Ans. 4-5 and 11).

To justify combining reference teachings in support of a rejection it is not necessary that a device shown in one reference can be physically

inserted into the device shown in the other. *In re Griver*, 53 CCPA 815, 354 F.2d 377, 148 USPQ 197 (1966); *In re Billingsley*, 47 CCPA 1108, 279 F.2d 689, 126 USPQ 370 (1960). 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 any one 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. *In re Wood*, 599 F.2d 1032, 202 USPQ 171 (CCPA 1979); *In re Passal*, 57 CCPA 1151, 426 F.2d 828, 165 USPQ 720 (1970); *In re Richman*, 57 CCPA 1060, 424 F.2d 1388, 165 USPQ 509 (1970); *In re Rosselet*, 52 CCPA 1533, 347 F.2d 847, 146 USPQ 183 (1965).

*In re Keller*, 642 F.2d 413, 425 (CCPA 1981).

Here, Wilson teaches or suggests that an observer on one network can observe a list of extensions in a second network (Ans. 3-4; Decision 5). Thus, we agree with the Examiner that Appellants are arguing the references individually. Additionally, although not relied upon, we agree with the Examiner (Ans. 11) that Wilson teaches or at least suggests LAN/WAN technology (*see also*, Fig. 4). (Note Appellants have indicated the WAN may be several types of networks including a PSTN network (Spec. 6, ll. 4-6; and Fig. 3).

Appellants argue the specific circuitry of Wilson (Req. 2-4); however, the specific circuitry is not recited in claim 1. As both Wilson and Guy teach or at least suggest the use of LANs and WANs, we find an ordinary artisan at the time of the invention would have had the skills to connect LAN and WAN networks.

Appellants further argue Wilson does not teach “automatically” calling a telecommunication extension in response to the user selecting one

of the telecommunications extensions from the observed list (Req. 2-4). We disagree with Appellants that Wilson does not teach or suggest this feature as set forth in our Decision (Decision 5). Thus, given the teaching or at least suggestion of Wilson to automatically dial a selected number, we conclude it would have been obvious to an ordinary artisan at the time of the invention. Moreover, consistent with the Examiner's and our conclusion (Ans. 12-14; Decision 5-6) and, further, going to the obviousness of such a feature at the time of the invention, we find incorporating the feature – speed dialing – would have been within the skills of an ordinary artisan at the time of the invention.

Therefore, Appellants did not persuade us of error in the Examiner's findings and conclusions. Accordingly, consistent with the Examiner's conclusions, we agree one of ordinary skill in the art at the time of the invention would have found it obvious to combine the technique of Wilson into the system of Guy.

*Claim 30*

Appellants argue we considered only certain citations in the Specification as showing the “means plus function” limitations (Req. 5). However, the Examiner set forth the portions of Wilson and Guy that taught the specific “means plus function” limitations (Ans. 3-5). We agree with the Examiner that the cited prior art teaches or at least teaches the “means plus function” structure for the recited limitations.

Appellants have not persuaded us that the Examiner was in error. Indeed, Appellants did not articulate sufficient evidence or argument in their

Appeal Brief as to why the Examiner's mapping is in error. Instead, Appellants merely argued the Examiner had not interpreted the "means for" language.

Moreover, as we noted, the only indication by Appellants as to the corresponding structure for the "means plus function" limitations disclosed general structure (Decision 7; App. Br. 6-7). For example, Appellants set forth "[a]utomatic dialing of the selected telephone destination and a response to selection of one of the telephone destinations from a displayed list is described on page 22, lines 4-24" (App. Br. 6-7). Thus, based on Appellants' citation, we found the "circuitry for automatically calling" to be a key (Decision 7). We agree that this key only *activates* the automatic dialing, however, in light of Appellants' mapping, the structure disclosed was limited to a key.

Now Appellants provide citations that encompass pages 16, line 21 through page 22, line 24 as disclosing the structure for the "means plus function" limitations (Req. 5). However, even if we were to consider the further citations, these portions disclose well-known elements such as a Texas Instruments Model 54-2 DSP, an LCD display, and memory. Again, Appellants have not specified the particular structure for each "means plus function" limitation.

Therefore, In light of the record before us, Appellants have not persuaded us of error in the Examiner's findings and conclusions.

*Claim 2*

Appellants argue the prior art, although teaching the Internet, does not show that the prior art is operating under an IP protocol. Appellants merely set forth conclusory statements (App. Br. 16). However, the Examiner pointed to Guy as disclosing the Internet as an example of a WAN (Ans. 13-15). Since the Internet operates using IP protocol and Guy teaches or at least suggests LANs coupled to a WAN, we find Guy teaches or at least suggests to an ordinary artisan at the time of the invention, communication among the first and second LAN and the WAN uses an IP protocol.

Accordingly, Appellants have not persuaded us of error in our findings and conclusions.

*Claims 5 and 6*

Appellants' arguments were fully considered but were not persuasive as we set forth in our Decision (Decision 9). Indeed, we conclude the recited limitations would have been obvious to one of ordinary skill in the art at the time of the invention. As such, we find Appellants' assertions that we overlooked the arguments for claims 5 and 6 unpersuasive

*Claims 27 and 33*

Appellants' argument regarding claims 27 and 33 was that "[t]he Examiner has not specifically addressed the limitations in Claims 27 and 33" (App. Br. 20). The Examiner set forth specific findings regarding these claims by providing specific citations to Guy (Ans. 3-4). The Examiner may have made an abbreviated reference to the limitations; however, the cited

portions fairly teach or suggest the specific limitations. Appellants provided no additional arguments or evidence to persuade us otherwise. Thus, based on our review, we are not persuaded of error in the Examiner's findings and conclusions.

*Claim 4*

Appellants, in their Appeal Brief, argued only that Wilson does not teach or suggest “the list of plurality of telecommunications extensions is played as audio to the user of the first telecommunications device” (App. Br. 21). As we set forth in our Decision (Decision 12), the Examiner is relying on Stuntebeck as disclosing this limitation. Appellants did not present any arguments or evidence regarding Stuntebeck. Moreover, Appellants’ argument as to why Wilson teaches away is unpersuasive. “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.” *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994). “A known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use.” *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994). It follows Wilson does not teach away from an audio communication of the IP address.

Thus, Appellants have not persuaded us of error.

*Claims 36-38 and 40*

Appellants have not persuaded us of error in our finding that the combination of Wilson and Guy teach or at least suggest the invention as recited in claim 36. Again we find Appellants are arguing the references individually.

We also emphasize, as set forth by the Examiner, Wilson teaches or at least suggests displaying a list of data in response to user input and in response to another input, displaying a subset of that data (col. 7, l. 45- col. 8, l. 15). One of ordinary skill in the art would have had the skills at the time of the invention to display the list of LANs (*see, e.g.*, Wilson, Fig. 6 displaying a directory; *see also* Reply Br. 7 – Guy discloses transferring across a WAN a server code of a remote network. (We find since a server may act as a gateway to a LAN, providing a server code may indicate the LAN. Displaying the received server codes in a list would have been within the skills of an ordinary artisan)).

As to Appellants additional arguments (Rehearing 7-9), we are not persuaded the Examiner was relying upon incorrect factual findings or that the Examiner provided inadequate or flawed reasoning for the combination of references.

DECISION

Accordingly, we have granted Appellants' Request to the extent that we have reconsidered the original Decision but have DENIED it with respect to making any changes to the Decision.

REHEARING DENIED

Appeal 2010-000868  
Application 10/447,607

tj



<b>Notice of Allowability</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/447,607	SUDER ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	GREGORY SEFCHECK	2477	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--**

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1.  This communication is responsive to board decision of 4/23/2012 and Decision on Reconsideration of 8/1/2012.
2.  An election was made by the applicant in response to a restriction requirement set forth during the interview on \_\_\_\_; the restriction requirement and election have been incorporated into this action.
3.  The allowed claim(s) is/are 1-6, 9, 17-20, 22, 30, 32-34, and 36-38, renumbered 1-19.
4.  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a)  All    b)  Some\*    c)  None    of the:
    1.  Certified copies of the priority documents have been received.
    2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_ .
    3.  Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

5.  A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
  6.  CORRECTED DRAWINGS ( as "replacement sheets") must be submitted.
    - (a)  including changes required by the Notice of Draftsperson's Patent Drawing Review ( PTO-948) attached
      - 1)  hereto or 2)  to Paper No./Mail Date \_\_\_\_.
    - (b)  including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).**
7.  DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

- |  |  |
|--|--|
| 1. <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 5. <input type="checkbox"/> Notice of Informal Patent Application                      |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 6. <input type="checkbox"/> Interview Summary (PTO-413),<br>Paper No./Mail Date ____ . |
| 3. <input type="checkbox"/> Information Disclosure Statements (PTO/SB/08),<br>Paper No./Mail Date ____     | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment                    |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit<br>of Biological Material | 8. <input type="checkbox"/> Examiner's Statement of Reasons for Allowance              |
|  | 9. <input type="checkbox"/> Other ____.  |

/Gregory B Sefcheck/  
Primary Examiner, Art Unit 2477  
10-19-2012

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### DETAILED ACTION

- The Board Decision of 4/23/2012 and Decision on Reconsideration of 8/1/2012 are acknowledged.
- The rejections of claims 1-6, 8, 9, 17-20, 22, and 24-34 have been affirmed.
- The rejections of claims 10, 23, and 35 have been reversed.
- Claims 1, 4, 17, 30, 32, and 36-38 have been amended as shown below, substantially incorporating the limitations of the reversed claims, and are allowed.
- Claims 2, 3, 5, 6, 9, 18-20, 22, 33, and 34 as previously presented are also allowed due to dependence from allowed claims.
- Claims 8, 10, 23-29, 31, and 35 are cancelled. Claims 7, 11-16, 21, and 39 have been previously cancelled.
- Allowed claims 1-6, 9, 17-20, 22, 30, 32-34, and 36-38 have been renumbered accordingly, as indicated on the Issue Classification Sheet.

The application has been amended as follows, as discussed with Kelly Kordzik on 10/23/2012:

In the Specification:

pg. 3, line 15, "FIGURES 9A-9C" has been changed to - - FIGURES 9A-9B - -

In the claims:

1. (currently amended) An information handling system comprising:  
a first local area network ("LAN");

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a second LAN;  
a wide area network ("WAN") coupling the first LAN to the second LAN;  
a third LAN coupled to the first and second LANs via the WAN;  
a first telecommunications device coupled to the first LAN;  
a plurality of telecommunications extensions coupled to the second LAN;  
the first LAN including first circuitry for enabling a user of the first telecommunications device to observe a list of the plurality of telecommunications extensions; [[and]]

the first LAN including second circuitry for automatically calling one of the plurality of telecommunications extensions in response to the user selecting one of the plurality of telecommunications extensions from the observed list, wherein the list of the plurality of telecommunications extensions is stored in a server in the second LAN, and is accessed by the first circuitry across the WAN; and

a plurality of telecommunications extensions coupled to the third LAN, the first LAN including circuitry for enabling the user to select between observing the list of the plurality of telecommunications extensions coupled to the second LAN or observing a list of the plurality of telecommunications extensions coupled to the third LAN.

2. (original) The system as recited in claim 1, wherein communication among the first LAN, second LAN, and WAN uses an IP protocol.

3. (original) The system as recited in claim 2, wherein the list of the plurality of telecommunications extensions is displayed to the user of the first telecommunications device.

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4. (currently amended) The system as recited in claim 1 ~~An information handling system comprising:~~

~~a first local area network ("LAN");~~

~~a second LAN;~~

~~a wide area network ("WAN") coupling the first LAN to the second LAN;~~

~~a first telecommunications device coupled to the first LAN;~~

~~a plurality of telecommunications extensions coupled to the second LAN;~~

~~the first LAN including first circuitry for enabling a user of the first telecommunications device to observe a list of the plurality of telecommunications extensions; and~~

~~the first LAN including second circuitry for automatically calling one of the plurality of telecommunications extensions in response to the user selecting one of the plurality of telecommunications extensions from the observed list, wherein communication among the first LAN, second LAN, and WAN uses an IP protocol, wherein the list of the plurality of telecommunications extensions is played as audio to the user of the first telecommunications device.~~

5. (original) The system as recited in claim 3, wherein the first telecommunications device is an IP telephone having a display for showing the list of the plurality of telecommunications extensions, wherein the second circuitry includes a key for enabling the user to tacitly selecting one of the plurality of telecommunications extensions from the displayed list.

6. (original) The system as recited in claim 5, wherein the tactile selection of one of the plurality of telecommunications extensions from the displayed list by the user results in an initiation of a call from the first telecommunications device to the selected one of the plurality of telecommunications extensions across the WAN.

7. (cancelled)

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8. (cancelled)

9. (currently amended) The system as recited in claim 1 [[8]], wherein the first telecommunications device includes circuitry for enabling the user to scroll through the displayed list of the plurality of telecommunications extensions ~~devices~~.

10. (cancelled)

11.-16. (cancelled)

17. (currently amended) An information handling system comprising:  
a first local area network ("LAN") operating under an IP protocol;  
a first IP telephone coupled to the first LAN, the first IP telephone having a display and a set of keys for enabling a user to enter inputs;  
a second LAN operating under the IP protocol;  
second and third telephone extensions coupled to the second LAN;  
a wide area network ("WAN") operating under the IP protocol coupling the first LAN to the second LAN; [[and]]  
a third LAN coupled to the first and second LANs via the WAN;  
the first LAN including first circuitry for enabling a user of the first IP telephone to view a list including the second and third telephone extensions, wherein the list is stored in a server in the second LAN, and is accessed by the first circuitry across the WAN; and  
a plurality of telephone extensions coupled to the third LAN, the first LAN including circuitry for enabling the user to select between viewing the list of the telephone extensions coupled to the second LAN or viewing a list of the plurality of telephone extensions coupled to the third LAN.

18. (original) The system as recited in claim 17, further comprising:

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the first LAN including second circuitry for automatically calling the second telephone extension in response to the user selecting the second telephone extension from the viewed list.

19. (original) The system as recited in claim 18, wherein selection of the second telephone extension from the viewed list by the user is accomplished by selection of one of the set of keys.

20. (original) The system as recited in claim 19, wherein the selection of one of the set of keys results in an initiation of a call from the first IP telephone to the second telephone extension across the WAN.

21. (cancelled)

22. (original) The system as recited in claim 17, wherein the first IP telephone includes circuitry for enabling the user to scroll through the displayed list.

23. (cancelled)

24. (cancelled)

25. (cancelled)

26. (cancelled)

27. (cancelled)

28. (cancelled)

29. (cancelled)

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30. (currently amended) A telecommunications system comprising:  
a first IP telephone coupled to a first IP server within a first LAN;  
second and third telephone extensions coupled to a second IP server within a second LAN;  
a WAN coupling the first LAN to the second LAN, the first LAN, the second LAN, and the WAN communicating using an IP protocol;  
a third LAN coupled to the first and second LANs via the WAN;  
means for displaying on the first IP telephone a list of telephone destinations stored in the second IP server in response to selection of a first input on the first IP telephone, wherein the list of telephone destinations is communicated from the second IP server over the WAN to the first IP telephone; [[and]]  
means for automatically dialing the selected one of the telephone destinations for a communications link between the first IP telephone and the selected one of the telephone destinations in response to selection of one of the telephone destinations from the displayed list, wherein the selection of one of the telephone destinations from the displayed list is performed in response to selection of a second input on the first IP telephone by a user;  
means for displaying on the first IP telephone a list of LANs coupled to the WAN, including the second and third LANs; and  
means for displaying the first list in response to selection of the second LAN from the displayed list of LANs.

31. (cancelled)

32. (currently amended) The system as recited in claim 30 [[31]], wherein the first and second inputs are the same key button on the first IP telephone.

33. (original) The system as recited in claim 32, wherein the telephone destinations include the second and third telephone extensions coupled to the second IP

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server.

34. (original) The system as recited in claim 32, wherein the telephone destinations include telephones external to the system.

35. (cancelled)

36. (currently amended) A method comprising the steps of:

receiving a first touch input from a user on an IP telephone that is networked into a first LAN operating under an IP protocol;

in response to receipt of the first touch input, displaying on a display on the IP telephone a first list including second and third LANs coupled to the first LAN, wherein the second and third LANs operate under the IP protocol, wherein the first, second, and third LANs are coupled via a WAN;

receiving a second touch input from the user on the IP telephone;

in response to receipt of the second touch input, displaying on the display on the IP telephone a second list of telephone destinations accessible from the second LAN;

receiving a third touch input from the user on the IP telephone; [[and]]

in response to receipt of the third touch input, automatically dialing one of the telephone destinations accessible from the second LAN for a communications connection between the one of the telephone destinations and the IP telephone, wherein the step of displaying on the display on the IP telephone the second list further includes the steps of:

sending a message from the first LAN to the second LAN requesting the second list; and

receiving the second list from the second LAN to the first LAN;

receiving a fourth touch input from the user on the IP telephone; and

in response to receipt of the fourth touch input, displaying on the display on the IP telephone a third list of telephone destinations accessible from the third LAN, wherein the step of displaying on the display on the IP telephone the third list further includes the steps of:



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sending a message from the first LAN to the third LAN requesting the third list; and  
receiving the third list from the third LAN to the first LAN.

37. (currently amended) The method as recited in claim 36, before the step of receiving the second touch input, further comprising the steps of: receiving a fifth ~~fourth~~ touch input from the user on the IP telephone; and in response to receipt of the fifth ~~fourth~~ touch input, scrolling through the first list.

38. (currently amended) The method as recited in claim 37, before the step of receiving the third touch input, further comprising the steps of: receiving a sixth ~~fifth~~ touch input from the user on the IP telephone; and in response to receipt of the sixth ~~fifth~~ touch input, scrolling through the second list.

39. (cancelled)

40. (cancelled)

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GREGORY SEFCHECK whose telephone number is (571)272-3098. The examiner can normally be reached on Monday-Friday, 7:30am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chirag Shah can be reached on 571-272-3144. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Gregory B Sefcheck/  
Primary Examiner, Art Unit 2477  
10-23-2012