

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEFFREY B. REIFMAN, KURT D. DELBENE, CHRIS E. TOBEY
and RENEE MARCEAU

Appeal No. 96-2040
Application No. 08/221,370¹

ON BRIEF

Before KRASS, MARTIN and LEE, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 18 through 20 and 72 through 102.

¹ Application for patent filed March 31, 1994.

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The invention is directed to a system and method for facsimile load balancing. More particularly, in a system containing a plurality of facsimile machines, when the workload of a first facsimile machine exceeds a predetermined value, a stored data file from the first facsimile machine is transferred to another facsimile machine for transmission to a designated recipient by the other facsimile machine rather than the first facsimile machine.

Representative independent claim 75 is reproduced as follows:

75. A method in first and second facsimile machines for facsimile communication, the first and second facsimile machines being coupled together with the first facsimile machine having a workload value corresponding to a plurality of data files stored in the first facsimile machine awaiting transmission to corresponding designated recipients, the method comprising the steps of:

determining the workload for the first facsimile machine; and if said determined workload value exceeds a threshold value, transferring at least a first stored data file from the first facsimile machine to the second facsimile machine.

The examiner relies on the following reference:

Mizutori et al. (Mizutori) 4,967,288 Oct. 30,
1990

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Claims 18 through 20 and 72 through 102 stand rejected under 35 U.S.C. 103 as unpatentable over Mizutori.

Reference is made to the brief and answer for the respective positions of appellants and the examiner.

OPINION

We reverse.

In our view, while the instant independent claims appear rather broad in nature, the examiner has simply not made out a prima facie case of obviousness regarding the claimed subject matter.

Each of the instant independent claims requires, at least, the determination of a workload value for a first facsimile machine, the determination of whether that workload value exceeds a predetermined value and, if the workload value does, indeed, exceed the predetermined value, then transferring stored data files from the first facsimile machine to another facsimile machine. Thus, there must be a determination that the workload value exceeds a *predetermined* value.

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We find no such *predetermined* value taught or suggested in Mizutori.

On the contrary, as pointed out by appellants, and not seriously disputed by the examiner, Mizutori alleviates imbalances in image data processing by storage and exchange units, not facsimile machines, as such, and does so by periodically calculating the quantity of image information per communication line in each storage and exchange unit and requiring transfer of files between storage and exchange units to produce equal workloads between units regardless of any *predetermined* number of files within any one storage and exchange unit. From the discussion at column 5, lines 6-30 of Mizutori, Mizutori appears to balance unequal workloads only at preset times, rather than by comparing a workload value with a predetermined value and transferring files only when the predetermined value is exceeded, as in the instant claimed invention. The claimed *predetermined* value ensures that transfers of files between facsimile machines occurs only when a facsimile machine is overloaded whereas Mizutori's device requires transfer of files in order to equalize workloads even

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where one of the storage and exchange units is not overloaded and could easily handle its unequal workload, thus wasting valuable processing time as compared with the instant claimed system and method.

The examiner's response [answer-page 4] is to contend that "this difference is simply a difference in the criterion used to define what workload is excessive." We agree that there is a difference based on a criterion used to define what workload is excessive (Mizutori considers any imbalance to be excessive while the instant claimed invention considers there to be an excessive workload only when the workload value exceeds a predetermined value) but that criterion may clearly constitute a nonobvious, or patentable, difference. Thus, even assuming the examiner is correct in the assessment that there is a difference between the instant claimed invention and that disclosed by Mizutori, i.e., "simply a difference in the criterion," an analysis under 35 U.S.C. 103 requires not only that the examiner identify such a difference but also that the examiner then explain why, after assessing the level of those skilled in the art, the skilled artisan would have found the claimed subject matter, as a whole, to have been

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obvious. Thus, while the examiner has indicated a difference, the examiner has failed to present any rationale as to why the instant claimed subject matter, as a whole, containing this difference, would have been obvious, within the meaning of 35 U.S.C. 103. Accordingly, no prima facie case of obviousness has been presented.

The examiner also states [answer-page 4] that it "is not clear that Applicant's [sic, applicants'] claimed 'predetermined' workload must be some fixed number of bytes...rather than the result of an operation which computes a threshold prior to the workload shift." We disagree. The meaning of "predetermined" would appear to require at least some determination at a previous time, i.e., previous to any operation. Further, since the claims call for a "predetermined value," it is clear that what is intended is a number which has been determined previous to any operation. Accordingly, contrary to the examiner's position, the claimed "predetermined value" is not a threshold value which is computed as a result of some operation but rather a fixed number determined beforehand. In the preferred embodiment, for example, that number is 5.

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We base our decision on the examiner's rejection and rationale therefor, as well as on appellants' arguments thereagainst. While we make no warranty, one way or the other, that no proper rejection of the instant claims and/or any individual claim might be made by applying the Mizutori reference in some way different from that of the examiner, it is clear to us, for the reasons supra, that the examiner has simply failed to establish a case of prima facie obviousness.

Accordingly, the examiner's decision rejecting claims 18 through 20 and 72 through 102 under 35 U.S.C. 103 is reversed.

REVERSED

ERROL A. KRASS)
Administrative Patent Judge)
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JOHN C. MARTIN)	APPEALS AND
Administrative Patent Judge)	
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)	INTERFERENCES
)	
JAMESON LEE)	
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