

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 32

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHARLES A. LEMAIRE, and
and BRYAN L. STRIEMER

Appeal No. 1998-0610
Application 08/584,726¹

ON BRIEF

Before McKELVEY, Senior Administrative Patent Judge, and LEE and MEDLEY,
Administrative Patent Judges.

LEE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's rejection of appellants' claims 1-34. No claim has been allowed. The real party in interest is International Business Machines Corporation.

References relied on by the Examiner

Freeman	4,602,279	Jul. 22, 1986
Rodriguez et al. (Rodriguez)	4,479,124	Oct. 23, 1984
Yamaguchi	4,742,516	May 3, 1988

¹ Application for patent filed January 11, 1996. According to appellants, it is a continuation of application 07/993,163, filed December 18, 1992.

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Fisch et al. (Fisch '085)	4,949,085	Aug. 14, 1990
DeLuca et al. (DeLuca)	5,025,252	Jun. 18, 1991
Fisch et al. (Fisch '579)	5,153,579	Oct. 6, 1992

Parsons, "Voice and Speech Processing", pp. 92-95, 280-289, McGraw-Hill (1987).

The Rejections on Appeal

Claims 1-3 and 10 stand rejected under 35 U.S.C. § 103 as being unpatentable over Yamaguchi and Parsons.

Claim 4 stand rejected under 35 U.S.C. § 103 as being unpatentable over Yamaguchi, Parsons, and Freeman.

Claims 5-9, 18-23, and 25-28 stand rejected under 35 U.S.C. § 103 as being unpatentable over Yamaguchi, Parsons, and Rodriguez.

Claims 11-15 stand rejected under 35 U.S.C. § 103 as being unpatentable over Yamaguchi, Parsons, and Fisch '579.

Claims 11, 16, 17, 29 and 32-34 stand rejected under 35 U.S.C. § 103 as being unpatentable over Yamaguchi, Parsons, and DeLuca.²

Claim 24 stands rejected under 35 U.S.C. § 103 as being unpatentable over Yamaguchi, Parsons, Rodriguez and Freeman.

Claims 29-31 stand rejected under 35 U.S.C. § 103 as being unpatentable over Yamaguchi, Parsons and Fisch '085.

² We recognize that claims 32-34 are not expressly included in the examiner's stated ground of rejection. However, they are specifically discussed in the body of the rejection and the appellants have assumed that these claims have been rejected.

The appellants have represented that in this appeal, all claims stand or fall together.
(Br. at 5).

The Invention

The claimed invention is directed to a communication system wherein digitally coded textual data items are transmitted for reception by receivers which include audio conversion means for regenerating analog speech signals corresponding to the transmitted data items. Each data item includes digitally coded speech allophone information, special codes for inflection, and one or more index terms representing the content.

Representative claim 1 is reproduced below:

1. A broadcast communications system, comprising:

at a first physical location, a transmitting means, including a source of digitally coded textual data items, each digitally coded textual data item carrying both digitally coded speech allophone information and special codes for inflection to be transmitted and one or more digitally coded index terms relating to the subjects of that item's information,

means for broadcasting said items in a sequence via a transmission medium;

at a plurality of different physical locations, a plurality of receiving means, each operable by a different user, and including

detecting means for accepting said sequence of items,

profile means for storing a profile comprising certain ones of said index terms selected by said user, said profile being potentially different for each of said receiving means,

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selection means coupled to said detecting means for passing only certain of said items, said certain items being those having index terms corresponding to those in said profile,

memory means coupled to said selection means for storing at least the digitally coded speech allophone information and special codes for inflection of said certain items as said certain items are received,

switch means operable by said used for choosing among said items stored in said memory means, and

audio conversion means coupled to said memory means and responsive to said switch means for regenerating analog speech signals corresponding to at least the digitally coded speech allophone information and special codes for inflection of each of said chosen items stored in said memory means.

Opinion

The rejections are reversed.

A reversal of the rejection on appeal should not be construed as an affirmative indication that the appellants' claims are patentable over prior art. We address only the positions and rationale as set forth by the examiner and on which the examiner's rejection of the claims is based.

It is the examiner who has the initial burden to present a factual basis supporting the conclusion of prima facie obviousness. As is stated by the Court of Customs and Patent Appeals in In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967):

A rejection based on section 103 clearly must rest on a factual basis, and these facts must be interpreted without hindsight reconstruction of the invention from the prior art. In making this evaluation, all facts must be considered. The Patent Office [examiner] has the initial duty of supplying the

factual basis for its rejection. It may not, because it may doubt that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis. (Emphasis in original).

The examiner correctly states (answer at 15): “The crux of Applicant’s arguments appear to rest on the issue of whether the prior art of record teaches or suggests broadcasting from a transmitter of digitally coded speech allophone information and special inflection codes for inflection.” The examiner concludes (answer at 15) “[t]he prior art of record clearly establishes that it would have been obvious to one skilled at the time the invention was made to broadcast from a transmitter of digitally coded speech allophone information and special inflection codes for inflection.” That conclusion, however, is unsupported by sufficient factual basis.

The examiner stated (answer at 6) that although Yamaguchi does not explicitly teach that the broadcast text data includes “digitally coded speech allophone information,” Parsons teaches text-to-speech synthesis comprising a two-step procedure of text-to-phoneme conversion and phoneme-to-speech conversion, wherein the phoneme is “speech allophone information.” The examiner further stated that it would have been obvious to one with ordinary skill to “substitute the phonemes used in text-to-speech conversion as taught by Parsons” for the general teaching of transmitted text as taught by Yamaguchi.

The rationale of the examiner is explained as follows (answer at 7): “[B]y transmitting phonemes, the laborious step of converting text-to-phonemes (Parsons, page 286, lines 6-7) can be advantageously performed by the base station, and not by the receivers.” But the examiner has cited no prior art which discloses or reasonably suggests that phonemes associated with written text should be generated at a transmitting base station and included in the broadcast transmission. On this record, the motivation for this feature is improperly derived solely from the appellants’ own specification.

The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggests the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. In re Fritch, 972 F.2d at 1266, 23 USPQ2d at 1784. We are not inclined to dispense with proof by evidence when the proposition at issue is not supported by a teaching in a prior art reference, common knowledge or capable of unquestionable demonstration. See, e.g., In re Knapp-Monarch Co., 296 F.2d 230, 232, 132 USPQ 6, 8 (CCPA 1961).

Furthermore, a substitution of phonemes for corresponding text as is proposed by the examiner would not yield the appellants’ claimed invention which requires “digitally coded speech allophone information to be transmitted.” Contrary to the examiner’s

apparent belief, allophones and phonemes are not the same, nor are they equivalents. As is explained in Parsons on page 94, lines 6-8, a “phoneme” is a set of phonetically similar sounds which are accepted by speakers of the language as the same sound, and members of the set are called allophones. In that regard, note also that even Parsons (page 281) describes the selection of proper allophones as a task to be performed during the second stage process of converting phonemes to speech. Consequently, allophones and phonemes are clearly not the same. A “phoneme” constitutes a genus. Allophones are species within the genus. Transmission of genus information does not satisfy the appellants’ claimed feature of broadcasting more detailed species information. The examiner has not pointed to any prior art which reasonably would have suggested broadcasting digitally coded speech allophone information. We agree with the appellants that punctuation symbols and accent symbols within the transmitted written text of Yamaguchi cannot be regarded as “allophones” as that term is known to those with ordinary skill in the art. Note that those symbols are also themselves a part of the original expression of Yamaguchi’s written text.

CONCLUSION

The rejection of claims 1-3 and 10 under 35 U.S.C. § 103 as being unpatentable over Yamaguchi and Parsons is reversed.

The rejection of claim 4 under 35 U.S.C. § 103 as being unpatentable over Yamaguchi, Parsons, and Freeman is reversed.

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The rejection of claims 5-9, 18-23, and 25-28 under 35 U.S.C. § 103 as being unpatentable over Yamaguchi, Parsons, and Rodriguez is reversed.

The rejection of claims 11-15 stand under 35 U.S.C. § 103 as being unpatentable over Yamaguchi, Parsons, and Fisch '579 is reversed.

The rejection of claims 11, 16, 17, 29 and 32-34 under 35 U.S.C. § 103 as being unpatentable over Yamaguchi, Parsons, and DeLuca is reversed.

The rejection of claim 24 under 35 U.S.C. § 103 as being unpatentable over Yamaguchi, Parsons, Rodriguez and Freeman is reversed.

The rejection of claims 29-31 under 35 U.S.C. § 103 as being unpatentable over Yamaguchi, Parsons and Fisch '085 is reversed.

REVERSED

FRED E. McKELVEY, Senior)
Administrative Patent Judge)
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) BOARD OF PATENT
JAMESON LEE) APPEALS AND
Administrative Patent Judge) INTERFERENCES
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)
)
SALLY C. MEDLEY)
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cc: Andrew J. Dillon
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