

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(2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

MAILED

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

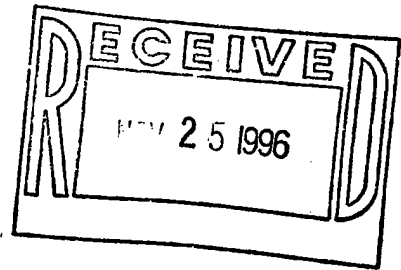
NOV 20 1996

ALEKSANDER SZLAM,
JAMES W. CROOKS, JR.
and CURTIS G. MARKS

Junior Party,¹

v.

RONALD A. KATZ,
Senior Party.²



Patent Interference No. 103,697

Before CALVERT, URYNOWICZ, and MARTIN, Administrative Patent Judges.

URYNOWICZ, Administrative Patent Judge.

¹ Patent 4,797,911 granted January 10, 1989, based on Application 07/062,944, filed June 16, 1987.

² Application 07/335,923, filed April 10, 1989. Accorded benefit U.S. Application 07/194,258, filed May 16, 1988, now Patent No. 4,845,739, granted July 4, 1989; which is a continuation-in-part of Application 07/018,244 filed February 24, 1987, now Patent No. 4,792,968, granted December 20, 1988.

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FINAL DECISION

On June 28, 1996, a paper was filed by the party Katz comprising a statement of an expedited procedure for resolving this proceeding as to count 1 (Paper No. 10). The procedure was previously assented to in a conference call among the Administrative Patent Judge (APJ) and counsel for the parties.

In accord with that procedure, on July 19, 1996 the party Szlam et al. (Szlam) filed a motion under 37 CFR § 1.633(g) (Paper No. 11) attacking the benefit accorded Katz under 35 U.S.C. § 120 in the notice declaring the interference of the February 24, 1987 filing date of U.S. Application S.N. 07/018,244 (the '244 application), which application matured into U.S. Patent 4,792,968 (the '968 patent). Extrinsic to the agreement, Szlam moved under 37 CFR § 1.633(c) to add proposed count 2 to the interference and to require Katz to add a claim to its involved application corresponding to count 2. Szlam also moved under 37 CFR § 1.633(f) to accord Katz the benefit of the February 24, 1987 filing date of the '244 application with respect to count 2. On August 27, 1996, the party Katz filed a response to the Szlam motions (Paper No. 13). In the response, Katz opposed Szlam's motion attacking the benefit accorded it with respect to count 1 of the February 24, 1987 filing date of the '244 application and stated that it is not opposed to Szlam's motions with respect to proposed count 2. In answer to Katz's

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opposition paper, Szlam filed a reply on September 10, 1996 (Paper No. 14). In the reply, Szlam maintained that its motion under 37 CFR § 1.633(g) to deny benefit should be granted over Katz's opposition and that, in view of the concurrence between the parties regarding the addition of proposed count 2 to the interference, the motion to add count 2 should be granted.

In accord with the procedure agreed upon, the motion under 37 CFR § 1.633(g) is before a panel of the Board for decision, the decision to be final as between the parties to resolve the interference. If count 1 is supported by the disclosure in the '244 application, then Katz will be awarded priority as to that count. Otherwise, Szlam will be accorded priority as to the subject matter of the count.

Whereas the party Katz does not oppose Szlam's motions with respect to proposed count 2, in our discretion we will decide those motions.

Count 1

Count 1 reads as follows:

Apparatus to be utilized with a telephone facility for on-line handling of customer data contained in a memory comprising:

an operator terminal for use by a person to communicate through the telephone facility;

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interface switching means for receiving incoming calls;

means connected to said interface switching means for directly providing a caller telephone number from said telephone facility;

computer means coupled to said interface switching means for connecting an incoming call by a caller to said operator terminal and responsive to said caller telephone number for causing said memory to provide to said operator terminal data on a selected customer which has a telephone number corresponding to said caller telephone number from said telephone facility;

whereby said operator terminal provides data entries to said memory; and

said memory is updated with said customer data on said selected customer by incorporating said data entries into said data on said customer.

The claims of the parties which correspond to count 1 are:

Szlam: Claims 42

Katz : Claims 98 and 101

Positions of the Parties with Respect to
the Issue of Benefit under 35 U.S.C. § 120

In its motion Szlam admits that the '244 application has support for all of the limitations of count 1 except for the "computer means" recitation at lines 10-15. It is not alleged by the junior party that the application does not support computer means coupled to interface switching means for connecting an incoming call by a caller to an operator terminal as defined at lines 10-12 of the count. Rather, it is Szlam's position that the computer means 22 of the application is not "responsive to said caller telephone number for causing said memory to provide to said operator terminal data on a selected customer which has a

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telephone number corresponding to said caller telephone number from said telephone facility" as defined at lines 12-15. Szlam asserts that although the telephone facility may provide the telephone number of the caller and that this and certain other information about the caller may be provided to the operator terminal from memory 114, the provision of the caller telephone number by the telephone facility does not, directly or indirectly, cause the memory 114 of Fig. 4 to transfer information about the caller to the operator terminal. According to Szlam, the system disclosed in the '244 application collects information manually input by the caller or, in the case of the caller's telephone number, the ANI information provided by the telephone facility. The system then asks the caller to verify the information manually input by the caller or the ANI information provided by the telephone facility. In response, if the caller requests operator assistance, the system will send to the operator terminal the information which was manually input and/or verified by the caller. The system does not send any other information about the caller which may be in the memory register 114 of Fig. 4. If the caller does not need operator assistance, then no information is sent to the operator terminal.

In opposition, Katz asserts the '244 application discloses that several alternative numbers, including a caller's telephone number, can be used for purposes of identifying a caller (col.

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14, 11. 4-6)³ and that a caller's telephone number can be received directly from the telephone system (col. 5, 1. 59-61). The senior party Katz further asserts that the '244 application discloses the referral of incoming calls to an operator and the providing of data, including caller identification, to the operator terminal (col. 9, 1. 64 through col. 10, 1. 2).

Opinion

We are of the opinion that the '244 application of the party Katz does not support the limitation of count 1 in question and that Katz is not entitled to benefit under 35 U.S.C. § 120 of the filing date of that application with respect to the count. Katz's arguments are deficient in that they do not specifically address the position taken by party Szlam. Szlam's argument is that Katz's computer means 22 is not responsive to a caller telephone number for the purpose defined in the count. Although memory 114 of Fig. 4 provides to an operator terminal data on a selected customer, which data can include a telephone number corresponding to a caller telephone number from a telephone facility, Katz has not directed our attention to any disclosure in the '244 application which establishes that this function of memory 114 is accomplished because computer 22 is responsive to

³ For ease of citation, reference is to the '968 patent, which is based upon the '244 application.

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the caller telephone number. In contrast, Szlam has indicated that the system of the '244 application only provides information on the caller to an operator if the caller specifically requests to be connected to an operator or if the caller cannot complete the transaction and an abort occurs. Consonant with Szlam's position, the '244 application discloses that memory 114 provides its data to an operator terminal (1) in response to a caller who specifically requests to be connected to an operator, as by pushing the asterisk button (*) (col. 9, ll. 55-67), (2) in response to the voice generator asking the caller to provide (by voice) more detailed information as name, address, etc. which is recorded for later processing (col. 9, ll. 60-67) and (3) in response to a caller's inability to complete a call, as where the caller is not identified in the files of a mail order house (col. 10, ll. 19-22).

Whereas the '244 application does not support count 1 under 35 U.S.C. § 112, first paragraph, Katz is not entitled to benefit of its filing date and party Szlam is senior party by virtue of the June 16, 1987 filing date of the application which matured into its involved patent. Accordingly, in view of our finding above and the aforementioned agreement reached by the parties and the APJ, Szlam is entitled to prevail as to count 1.

Szlam's Motion to Add Count 2

Szlam's unopposed motion to add count 2 to this proceeding and to require Katz to add a claim corresponding to count 2 to its involved application and its unopposed motion to award Katz benefit of the '244 application are granted for the reasons given by Szlam in the motion. As noted by Szlam, count 2 is directed to a species which is separately patentable from count 1 because it provides that a caller may input data for the customer account directly into memory and, if the caller requests the assistance of an operator, the system will transfer the information input by the caller to the operator terminal so that the operator may input data for the customer account into the memory.

In accord with 37 CFR § 1.637(c)(1)(iv), Szlam has designated its patent claim 53 as corresponding to count 2. Since the rules of practice do not require a party to show that the other uninvolved claims of the patent do not correspond to count 2, we take no position as to their status with respect to this count.

In view of our findings above, judgment in this proceeding is now proper.

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Judgment

Judgment as to the subject matter of count 1 is awarded to Aleksander Szlam, James W. Crooks, Jr. and Curtis G. Marks. On the present record the party Szlam is entitled to its patent containing claim 42 and the party Katz is not entitled to a patent containing its claims 98 and 101.

Judgment as to the subject matter of count 2 is awarded to Ronald A. Katz. On the present record, the party Katz is entitled to a patent containing its claim 102 and the party Szlam is not entitled to its patent containing claim 53.


IAN A. CALVERT
Administrative Patent Judge

STANLEY M. URYNOWICZ, JR.
Administrative Patent Judge

John C. Martin
JOHN C. MARTIN
Administrative Patent Judge

BOARD OF PATENT
APPEALS AND
INTERFERENCES

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Aleksander Szlam et al.:

Charles L. Warner, II
Jones & Askew
191 Peachtree Street, N.E.
37th Floor
Atlanta, GA 30303-1769

Ronald A. Katz:

Billy A. Robbins et al.
Nilsson, Wurst & Green
707 Wilshire Blvd., 32nd Floor
Los Angeles, CA 90017

SMU/cam