

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte LEONARD KLEINROCK  
and JOEL E. SHORT

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Appeal No. 2001-2260  
Application 08/712,502

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ON BRIEF

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Before THOMAS, HAIRSTON, and JERRY SMITH, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-9, 11, 13, 14, 17-30 and 45-47, which constitute all the claims remaining in the application.

The disclosed invention pertains to a method and apparatus for connecting a user to a computer information network by providing access numbers to a remotely located computing device for subsequent access to the information network.

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Representative claim 1 is reproduced as follows:

1. A method for connecting a user to a computer information network comprising the steps of:

providing a central processing station comprising a database including an index of computer network access numbers and associated information for using the numbers;

accessing the central processing station from a remote computing device through a transmission line;

receiving location identifying information from the remote computing device;

comparing the received location identifying information with the index of network access numbers stored in the database;

selecting at least one appropriate computer network access number from the database;

downloading the selected appropriate computer network access number to the remote computing device.

The examiner relies on the following references:

Abel et al. (Abel)	5,289,371	Feb. 22, 1994
Weinberger et al. (Weinberger)	5,425,085	June 13, 1995
Chinnock et al. (Chinnock)	5,426,427	June 20, 1995

Claims 1-9, 11, 13, 14, 17-30 and 45-47 stand rejected under 35 U.S.C. § 103. As evidence of obviousness the examiner offers Chinnock in view of Weinberger with respect to claims 1, 7-9, 11, 13, 14, 25, 26, 45 and 46, and Abel is added to this combination with respect to claims 2-6, 12, 17, 18 and 47. Although not

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specifically listed in either rejection, claims 19-24 and 27-30 are apparently subject to the first noted rejection.

Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs and the answer for the respective details thereof.

#### OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in the claims on appeal. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837

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F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the

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arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered and are deemed to be waived [see 37 CFR § 1.192(a)].

We consider first the rejection of the claims based on Chinnock and Weinberger. The examiner explains how he finds the claimed invention to be obvious over the applied references [answer, pages 3-6]. With respect to independent claims 1 and 45, appellants argue that Chinnock does not teach a system for receiving location identifying information and using this information to search a database to select and download a computer network access number to a remote computing device. Appellants also argue that Weinberger teaches a least cost routing device but the information is based on the dialed telephone number and not on the location of the remote device. Appellants argue that there is no motivation to modify the Chinnock system with the least cost routing feature of Weinberger because the user in Chinnock has already accessed the network

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[brief, pages 5-7 and 9]. With respect to independent claim 25, appellants argue that neither Chinnock nor Weinberger teaches using the telephone number of a remote computing device which was used to call the central processing station in selecting the appropriate access number [id., page 8].

With respect to claims 1 and 45, the examiner responds that each of the host computers in Chinnock has the access numbers of the other host computers. The examiner also notes that since Chinnock determines the host computer based on information supplied by the user, Chinnock teaches receiving location identifying information of the user [answer, pages 8-10]. With respect to independent claim 25, the examiner repeats the latter argument [id., page 10].

We will not sustain the examiner's rejection of independent claims 1, 25 and 45. A key feature of these claims is that a network access number is downloaded to the user's computer based on the location of the user. Thus, in the claimed invention, the access number is selected based on the user's location. The host computers in Chinnock are selected after the user has already accessed the network. The particular host computer selected in Chinnock is based on the type of information which the user is looking for and is not based on the location of

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the user. Although Chinnock teaches that the host computer is selected based on user supplied information, there is no suggestion that this information includes location information of the user. The user's location is completely unrelated to the type of information that the user is looking for on the network. Therefore, the examiner's finding that Chinnock teaches receiving location identifying information is incorrect. Since this key feature of each of the independent claims is not taught or suggested by Chinnock or Weinberger, the examiner has failed to establish a prima facie case of the obviousness of these claims.

Since independent claims 1, 25 and 45 are not rendered obvious by the collective teachings of Chinnock and Weinberger, and since the additional teachings of Abel do not overcome the deficiencies discussed above, we also do not sustain the examiner's rejection of any of the dependent claims.

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In summary, we have not sustained either of the examiner's rejections of the claims on appeal. Therefore, the decision of the examiner rejecting claims 1-9, 11, 13, 14, 17-30 and 45-47 is reversed.

REVERSED

JAMES D. THOMAS	)	
Administrative Patent Judge	)	
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	)	
	)	
KENNETH W. HAIRSTON	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
JERRY SMITH	)	
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