

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES E. WICKS and DAVID FINE

Appeal No. 2002-0410
Application No. 08/802,575

ON BRIEF

Before RUGGIERO, DIXON, and BLANKENSHIP, **Administrative Patent Judges**.
DIXON, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-18, which are all of the claims pending in this application.

We REVERSE.

Appellants' invention relates to a pricing information pager. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. A paging system comprising:
 - a bargain information database;
 - a processor for accessing said bargain information database; and
 - a transmitter for transmitting said information to a pager.

The prior art of record relied upon by the examiner in rejecting the appealed claims is as follows:

Wang et al. (Wang)	5,649,289	Jul. 15, 1997 (Filed July 10, 1995)
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Claims 1-18 stand rejected under 35 U.S.C. § 103 as being unpatentable over Wang.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejection, we make reference to the examiner's answer (Paper No. 12, mailed Jan. 8, 1999) and the examiner's supplemental answer (Paper No. 14, mailed Jun. 23, 1999) for the examiner's reasoning in support of the

Appeal No. 2002-0410
Application No. 08/802,575

rejection, and to appellants' brief (Paper No. 11, filed Sep. 29, 1998) and reply brief (Paper No. 13, filed Mar. 4, 1999) for appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art reference, and to the respective positions articulated by appellants and the examiner. As a consequence of our review, we make the determinations which follow.

Appellants argue that Wang does not teach or suggest the use of "a bargain information database" as recited in independent claims 1 and 9. We agree with appellants.

The examiner maintains throughout the Final Rejection, the Examiner's Answer and Supplemental Examiner's Answer that it would have been obvious to one of ordinary skill in the art to include any type of message information in the messaging system of Wang, such as bargain information. We disagree with the examiner's conclusion which goes well beyond any level of reasonableness. If we were to find this argument persuasive, we would have to find that any data is obvious in view of a teaching of any other type of completely unrelated data. Here, Wang merely teaches the storage of subscriber information for locating the customers in a customer paging area and storage of the message to be processed. (Wang at col. 2). From this basic

teaching of storing message data and locating data, we find it unreasonable to extrapolate this operational data to reach the conclusion that any message containing data from a stored database and communicated to a specific subscriber by a processor would have been obvious.¹ This would require us to speculate, which we decline to do.

Additionally, appellants argue that the message data stored in Wang is not a database. (See brief at pages 8-9). We agree with appellants and find that the request for transmission of a page and the associated message data is not a database and would not in our opinion have fairly suggested the storage and use of or compiling of a “bargain information database.” Therefore, the examiner has not set forth a *prima facie* case of obviousness of the claimed invention, and we cannot sustain the rejection of independent claims 1 and 9 and their dependent claims 2-8 and 10-18.

¹ While we do agree with the examiner that the breadth of the method claim is quite broad, and we do find it quite well known that many shoppers have networked and spread the word of bargains so as to get the great deals, the examiner has provided no such evidence that the type of methodology or a similar methodology has been reduced to a tangible technological based system using a database and a processor whether the mode of notice is phone, page, email or traditional paper mail. The examiner has cited and expressly stated that the Champion, III et al. patent (4,812,843) has not been applied against the claims. Therefore, we have not relied upon this teaching. From our review of the abstract of the Champion, III et al. patent we note that the patent teaches that “[t]he system provides information . . . which may be of interest to a subscriber including airline flight and related travel and stock information.” The system “ automatically provides the subscriber with updated information concerning changes in status or condition.” Additionally, we note that the examiner has not indicated any search in class 705, which is directed to many of the automated business methods. Upon return of the case to the examiner, the examiner should consider a search in this area.

Appeal No. 2002-0410
Application No. 08/802,575

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-18 under 35 U.S.C. § 103(a) is reversed.

REVERSED

JOSEPH F. RUGGIERO
Administrative Patent Judge

JOSEPH L. DIXON
Administrative Patent Judge

HOWARD B. BLANKENSHIP
Administrative Patent Judge

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Appeal No. 2002-0410
Application No. 08/802,575

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