

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 40

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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**Ex parte** NAGESH KADABA

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Appeal No. 2002-0419  
Application No. 08/457,732

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ON BRIEF

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Before DIXON, BARRY, and SAADAT, **Administrative Patent Judges**.  
DIXON, **Administrative Patent Judge**.

**DECISION ON APPEAL**

This is a decision on appeal from the examiner's final rejection of claims 2, 3, 7-13, 16-21, 23, 24, 28-31, 33, 40, and 41, which are all of the claims pending in this application.

We REVERSE.

The appellant's invention relates to a method and system for preparing an electronic record for shipping a parcel. An understanding of the invention can be derived from a reading of exemplary claim 16, which is reproduced below.

16. A system for preparing an electronic shipping record for a parcel, and for ordering and tracking parcel deliveries, comprising:

(a) a central computer including a tracking database for a plurality of parcels, and means for a receiving parcel pickup request, said central computer for downloading a parcel shipping procedure; and

(b) an intelligent telephone, comprising:

(1) an input device for receiving information;

(2) a data transfer device for receiving information from said central computer;

(3) an information storage device;

(4) a screen device for displaying information; and

(5) a processor coupled to said input device, said data transfer device, said information storage device, and said screen device, said processor for:

(A) communicating with said central computer via a network;

(B) receiving and storing said parcel shipping procedure from said central computer;

(C) displaying said parcel shipping procedure with said screen device as a menu of choices for selection;

(D) receiving via said parcel shipping procedure delivery information relating to a parcel;

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(E) storing said delivery information as a shipping record of said parcel; and

(F) transmitting said shipping record of said parcel to said parcel pickup request receiving means and to said tracking database, in response to receiving said delivery information.

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

Shavit et al. (Shavit)	4,799,156	Jan. 17, 1989
Dlugos, Sr. et al. (Dlugos)	5,153,842	Oct. 06, 1992
Weiss et al. (Weiss)	5,195,130	Mar. 16, 1993
Balga, Jr. et al. (Balga)	5,278,947	Jan. 11, 1994
Haddock et al. (Haddock)	5,657,378	Aug. 12, 1997
		(Filed Apr. 11, 1995)

Claims 2, 3, 7-13, 16-21, 23, 24, 28-31, 33, and 41 stand rejected under 35 U.S.C. § 103 as being unpatentable over Shavit in view of Dlugos further in view of (Haddock or Weiss). Claim 40 stands rejected under 35 U.S.C. § 103 as being unpatentable over Shavit in view of Dlugos and (Haddock or Weiss) further in view of Balga.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellant regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 37, mailed Sep. 28, 2001) for the examiner's reasoning in support of the rejections, and to appellant's brief (Paper No. 36, filed Jul. 6, 2001) and reply brief (Paper No. 38, filed Nov. 28, 2001) for appellant's arguments thereagainst.

## OPINION

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

Before addressing the examiner's rejections based upon prior art, it is an essential prerequisite that the claimed subject matter be fully understood. Analysis of whether a claim is patentable over the prior art under 35 U.S.C. §§ 102 and 103 begins with a determination of the scope of the claim. The properly interpreted claim must then be compared with the prior art. Claim interpretation must begin with the language of the claim itself. **See *Smithkline Diagnostics, Inc. v. Helena Laboratories Corp.***, 859 F.2d 878, 882, 8 USPQ2d 1468, 1472 (Fed. Cir. 1988). Accordingly, we will initially direct our attention to appellant's claim to derive an understanding of the scope and content thereof.

Before turning to the proper construction of the claims, it is important to review some basic principles of claim construction. First, and most important, the language of the claim defines the scope of the protected invention. ***Yale Lock Mfg. Co. v. Greenleaf***, 117 U.S. 554, 559 (1886) ("The scope of letters patent must be limited to the invention covered by the claim, and while the claim may be illustrated it cannot be enlarged by language used in other parts of the specification."); ***Autogiro Co. of Am. v.***

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**United States**, 384 F.2d 391, 396, 155 USPQ 697, 701 (Ct. Cl. 1967) ("Courts can neither broaden nor narrow the claims to give the patentee something different than what he has set forth [in the claim]."). **See also Continental Paper Bag Co. v. Eastern Paper Bag Co.**, 210 U.S. 405, 419 (1908); **Cimiotti Unhairing Co. v. American Fur Ref. Co.**, 198 U.S. 399, 410 (1905). Accordingly, "resort must be had in the first instance to the words of the claim" and words "will be given their ordinary and accustomed meaning, unless it appears that the inventor used them differently." **Envirotech Corp. v. Al George, Inc.**, 730 F.2d 753, 759, 221 USPQ 473, 477 (Fed. Cir. 1984). Second, it is equally "fundamental that claims are to be construed in the light of the specification and both are to be read with a view to ascertaining the invention." **United States v. Adams**, 383 U.S. 39, 49, 148 USPQ 479, 482 (1966).

Furthermore, the general claim construction principle that limitations found only in the specification of a patent or patent application should not be imported or read into a claim must be followed. **See In re Priest**, 582 F.2d 33, 37, 199 USPQ 11, 15 (CCPA 1978). One must be careful not to confuse impermissible imputing of limitations from the specification into a claim with the proper reference to the specification to determine the meaning of a particular word or phrase recited in a claim. **See E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co.**, 849 F.2d 1430, 1433, 7 USPQ2d 1129, 1131 (Fed. Cir.), **cert. denied**, 488 U.S. 986 (1988). What we are dealing with is construction of the limitations recited in the appealed claims.

Appellant argues that the combination of Dlugos and Shavit does not describe or suggest preparing a shipping request for a parcel and ordering and tracking parcel deliveries using a system that includes a central computer capable of initiating a parcel pickup request and a tracking database entry and an intelligent telephone containing a processor, for receiving and storing a parcel shipping procedure, storing delivery information as a shipping record of a parcel, and transmitting delivery information to the central computer for parcel pickup and tracking. (See brief at page 5 *et seq.*) We agree with appellant.

While the examiner labors to explain and rationalize (answer at pages 5-44) what appears to be his gut belief that the claimed invention is not patentable and obvious over some prior art, and to force the teachings of Shavit and Dlugos into the metes and bounds of the claimed invention, we find that even if these two teachings are combined with either of Haddock or Weiss, the combination still does not teach or fairly suggest the claimed invention.

First the claimed invention requires “a central computer including a tracking database for a plurality of parcels, and means for receiving a parcel pickup request, said central computer for downloading a parcel shipping procedure.” (Emphasis added.) Second, the claimed invention requires “transmitting said shipping record of said parcel to said parcel pickup request receiving means and to said tracking database, in response to receiving said delivery information.” While Shavit teaches the use of a

centralized computer for processing (on-line interactive concurrent) business transactions between a plurality of different types of independent users which includes freight service providers (Shavit abstract and col. 2) and shopping of closing details for an urgent shipment that has to be coordinated with an agent, a source, and a shipping company (Shavit at col. 6), we do not find a teaching or suggestion of a central computer that contains a “means for receiving a parcel pickup request” or an intelligent terminal that transmits the shipping record to this parcel pickup request receiving means. Shavit at col. 7 states that a “user may use the system 50 resources for its processing capability or it may use the system simply as a conduit to translate the transactions and communicate them to remote computing facilities.” Therefore, Shavit does not teach or suggest these claim limitations.

Similarly, Dlugos does not teach or suggest these claim limitations. The examiner maintains (answer at page 5) that a means for receiving a parcel pickup request were well known as evidenced by Dlugos. While Dlugos teaches that when an order is packed and prepared for shipment, the information is read from the integrated circuit package label on the parcel and other information for shipping may be input to the terminal. This information is then uploaded to a host computer for a central record. Throughout the remainder of Dlugos, various options for the use of the integrated circuit package label are discussed along with the use of the integrated circuit package label for a plurality of parcels and manifesting these parcels and processing thereof. Yet we

find no express teaching of a request of pickup of the parcel(s) nor a “means for receiving a parcel pickup request” or a step at an intelligent terminal of “transmitting said shipping record of said parcel to said parcel pickup request receiving means . . . .”

The examiner maintains throughout the argument section that the manifest data is stored and the data is transferred to the shipper in one manner or another. (See answer at page 16 *et seq.*) While this may be true, it still does not evidence the existence or suggest a “means for receiving a parcel pickup request” or a step at an intelligent terminal of “transmitting said shipping record of said parcel to said parcel pickup request receiving means . . . .” While we agree with the examiner that the parcels must get to the carrier by some means, Dlugos does not evidence a means or communication beyond the teaching at col. 13, lines 30-32, that “[t]ypically, this will occur at a regularly scheduled pick up stop that the carrier’s representative makes each day at the shipper’s premises.” The only teaching or suggestion we find within the four corners of Dlugos is a scheduled pickup that would not involve or suggest a “means for receiving a parcel pickup request” or a step at an intelligent terminal of “transmitting said shipping record of said parcel to said parcel pickup request receiving means . . . .” The numerous citations by the examiner of the recording of the date and time of delivery or pickup similarly do not evidence the existence of or suggest a “means for receiving a parcel pickup request” or a step at an intelligent terminal of “transmitting said shipping record of said parcel to said parcel pickup request receiving means . . . .”

The examiner does not rely on the teachings of Haddock or Weiss with respect to teaching or suggesting a “means for receiving a parcel pickup request” or a step at an intelligent terminal of “transmitting said shipping record of said parcel to said parcel pickup request receiving means . . .” Therefore, either of these references does not remedy the noted deficiency in the base combination. Therefore, even if we assume that the teachings of the references were properly combinable, the combination would not teach or fairly suggest the invention as recited in independent claim 16 and its dependent claims 2, 3, 7-13, 17-21.

Independent claim 23 contains similar limitations to a central computer and transmitting said delivery information and parcel pickup request to said central computer in response to receiving said delivery information which is not taught or suggested by the above combination. Therefore, even if we assume that the teachings of the references were properly combinable, the combination would not teach or fairly suggest the invention as recited in independent claim 23 and its dependent claims 24, 28-31, 33.

With respect to independent claim 41, claim 41 contains similar limitations to a central computer and transmitting said delivery information to said central computer in response to receiving said delivery information which is not taught or suggested by the above combination. Additionally, independent claim 41 recites that the central computer is configured to receive a parcel pickup request and to download a parcel shipping

procedure which is then used to receive the delivery information and transmit the delivery information as a shipping record back to the central computer. Therefore, even if we assume that the teachings of the references were properly combinable, the combination would not teach or fairly suggest the invention as recited in independent claim 41.

With respect to independent claim 40, claim 40 contains similar limitations to independent claim 1. Specifically, independent claim 40 recites a “means for receiving a parcel pickup request” or a step at an intelligent terminal of “transmitting said shipping record of said parcel to said central computer to said parcel pickup request receiving means . . .” which are not taught by the above combination and the addition of the teachings of Balga does not remedy the noted deficiency. Therefore, even if we assume that the teachings of the references were properly combinable, the combination would not teach or fairly suggest the invention as recited in independent claim 40.

Independent claim 40 contains additional limitations to displaying of a recipient list on the screen when preparing said parcel for shipping and disabling non-selected features. The examiner maintains that it would have been obvious to one of ordinary skill in the art to receive and store recipient lists and to display them on the screen with the motivation of providing an indication of the data stored and processed by the system. Again, the examiner seems to misinterpret the language of independent claim 40. The language of claim 40 requires that the recipient list is received from the central

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computer and displayed “with the screen device when preparing said parcel for shipping.” Therefore, the examiner’s line of reasoning concerning stored data does not meet the claimed limitation of “when preparing,” but rather, would go to reviewing after the parcel is prepared.

With respect to disabling the non-selectable features, the examiner takes Official Notice and references the operating systems of MACINTOSH and WINDOWS, but has not related this to whether the intelligent terminals/telephones of Haddock or Weiss use these operating systems with their limited processing capabilities. (See answer at pages 12-13.) Appellant argues that the examiner has relied upon hindsight in an attempt to reconstruct the claimed invention. (See brief at page 16.) We agree with appellant and do not find that the examiner has appropriately used Official Notice here. Therefore, for the above reasons and those set forth with respect to independent claim 1, we cannot sustain the rejection of independent claim 40.

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**CONCLUSION**

To summarize, the decision of the examiner to reject claims 2, 3, 7-13, 16-21, 23, 24, 28-31, 33, 40, and 41 under 35 U.S.C. § 103(a) is reversed.

**REVERSED**

JOSEPH L. DIXON	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
LANCE LEONARD BARRY	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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	)	
	)	
MAHSHID D. SAADAT	)	
Administrative Patent Judge	)	

JLD:clm

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