

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte TERENCE EDWARD SUMNER

Appeal No. 2002-1696
Application No. 08/921,884

ON BRIEF

Before JERRY SMITH, RUGGIERO, and BARRY, *Administrative Patent Judges*.
BARRY, *Administrative Patent Judge*.

DECISION ON APPEAL

A patent examiner rejected claims 1-19. The appellant appeals therefrom under 35 U.S.C. § 134(a). We reverse.

BACKGROUND

The invention at issue on appeal "relates . . . to selective call messaging. . . ." (Spec. at 1.) Selective call messaging uses a selective address to deliver a message to a single subscriber and a group message to deliver a message to a group of subscribers. Group messaging is efficient for conveying data (e.g., reports on weather, sports, or news) to many subscribers via a single transmission. (*Id.*) Because all

subscribers addressed by a group message display the same message, however, the appellant asserts that conventional selective call messaging has been limited by "an inability to subscriber-customize a group message." (*Id.*)

Accordingly, the appellant's invention delivers a master message addressed to a first group of subscribers and a corresponding records message addressed to a second group of subscribers. (*Id.* at 25.) For example, a master message may contain a weather reporting template for subscribers in several cities, while separate records messages may contain weather data for each city. (*Id.* at 9.) Upon receipt of the master message and corresponding records message, a subscriber forms a "subscriber-customized group message" from the master message, the records message, and local data stored in the subscriber. (*Id.* at 25.) The appellant asserts that his invention "retains the high efficiency characteristics of the prior art group messaging . . . while adding a significant degree of customization for each subscriber receiving the group message." (Appeal Br. at 5.)

A further understanding of the invention can be achieved by reading the following claim.

1. A method in a selective call messaging system for delivering a subscriber-customized group message, the method comprising the steps of:

delivering a master message addressed to a first group of subscriber units and a corresponding records message addressed to a

second group of subscriber units, the records message comprising a plurality of records, each record including subscriber-customized information corresponding to a subscriber unit that will receive the records message; and

when the subscriber-customized group message has been formed completely in the subscriber unit of the second group, presenting the subscriber-customized group message to a user by the subscriber unit, the subscriber-customized group message formed from the master message and from at least one of:

one of the plurality of records corresponding to the subscriber unit, and

local information stored in the subscriber unit.

Claims 1-19¹ stand rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 5,345,227 ("Fascenda") and U.S. Patent No. 5,535,428 ("King").

OPINION

Rather than reiterate the positions of the examiner or the appellant *in toto*, we address the point of contention therebetween. The examiner asserts, "King shows a system where the record information is only given to groups interested in that specific record information." (Examiner's Answer at 5.) He adds, "[e]liminating traffic on the system by only sending sports info to individuals interested about that particular team.

¹Although the examiner's statement of the rejection, (Examiner's Answer at 4), omits claim 19, the other portions of his answer evidence that the claim is rejected. (*Id.* at 2, 8, 9).

See col. 3 first paragraph." (*Id.*) The appellant argues, "Fascenda and King do not customize the information sent to each subscriber unit in a group call message, as does the instant invention, as claimed." (Appeal Br. at 9.)

In addressing the point of contention, the Board conducts a two-step analysis. First, we construe claims at issue to determine their scope. Second, we determine whether the construed claims would have been obvious.

1. CLAIM CONSTRUCTION

"Analysis begins with a key legal question -- *what* is the invention *claimed*?" *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1567, 1 USPQ2d 1593, 1597 (Fed. Cir. 1987). Here, independent claim 1 recites in pertinent part the following limitations: "delivering a master message addressed to a first group of subscriber units and a corresponding records message addressed to a second group of subscriber units, the records message comprising a plurality of records, each record including subscriber-customized information corresponding to a subscriber unit that will receive the records message. . . ." Independent claims 10 and 17 include similar limitations. Giving the independent claims their broadest, reasonable construction, the limitations require that a message comprise records, each record including data customized to a subscriber that will receive the message.

2. OBVIOUSNESS DETERMINATION

Having determined what subject matter is being claimed, the next inquiry is whether the subject matter would have been obvious. "In rejecting claims under 35 U.S.C. Section 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness." *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993) (citing *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992)). "A *prima facie* case of obviousness is established when the teachings from the prior art itself would . . . have suggested the claimed subject matter to a person of ordinary skill in the art." *In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) (quoting *In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976)).

Here, King discloses "a communication system 100 comprising a terminal 105 for transmitting messages concerning sports events to a plurality of radio receivers 110, such as portable pagers or transceivers, over the air." Col. 2, ll. 59-63. Although such messages may comprise records, "for example, . . . details about which team is at bat, the inning of the game, the number of outs for the team at bat, and the score of the game," col. 4, ll. 6-9, we are unpersuaded that each record includes data customized to a radio receiver that will receive the message. To the contrary, "King teach[es] sending the **same** information to all subscriber units" (Appeal Br. at 9.) Specifically, the paragraph cited by the examiner explains that "the radio receivers 110 receive common

messages about sports events," col. 3, ll. 1-2; "the same message is provided to all of the receivers 110." *Id.* at ll. 19-20.²

The examiner does not allege, let alone show, that the addition of Fascenda cures the aforementioned deficiency of King. Absent a teaching or suggestion of a message comprising records, each record including data customized to a subscriber that will receive the message, we are unpersuaded of a *prima facie* case of obviousness. Therefore, we reverse the obviousness rejection of claim 1; of claim 2-9, which depend therefrom; of claim 10; of claims 11-16, which depend therefrom; of claim 17; and of claims 18 and 19, which depend therefrom.

Besides addressing the examiner's rejection, the appellant expresses his "wishes to appeal the objection to claims 14 and 16 under CFR 1.75(c)." (Appeal Br. at 3.) Rather than by appeal to the Board of Patent Appeals and Interferences, however, such an objection is to be settled by petition to the Director of the U.S. Patent and Trademark Office. *See In re Hengehold*, 440 F.2d 1395, 1403, 169 USPQ 473, 479 (CCPA 1971). Therefore, neither the examiner's statement of the objection nor the appellant's arguments attacking the objection were considered in deciding this appeal.

²Upon receipt of the same message, the radio receivers "decide whether to display all or part of the information." (Appeal Br. at 9.)

CONCLUSION

In summary, the rejection of claims 1-19 under § 103(a) is reversed.

REVERSED

JERRY SMITH
Administrative Patent Judge

JOSEPH F. RUGGIERO
Administrative Patent Judge

LANCE LEONARD BARRY
Administrative Patent Judge

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