

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 11

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES R. CORLISS

Appeal No. 2002-1761
Application No. 09/169,757

ON BRIEF

Before THOMAS, KRASS and GROSS, Administrative Patent Judges.
KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-6 and 8-26.

The invention is directed to providing short message services (SMS). In particular, the invention permits a voice mail subscriber to be notified in a timely and efficient manner that a voice message has been left even when the subscriber is not near the telephone. A SMS message notification is made to

Appeal No. 2002-1761
Application No. 09/169,757

the subscriber outside of the wireline and wireless networks. The SMS message notification is routed through the Internet to the voice mail subscriber at one or multiple locations or message receiving devices. It is alleged that SMS is conventionally operable only within a wireless network.

Representative independent claim 1 is reproduced as follows:

1. A method for providing voice messaging notification to a voice mail subscriber over the Internet, the voice mail subscriber having a telephone serviced by one of a wireless and wireline switch, the method comprising:

receiving a voice message from a calling party for the telephone associated with the voice mail subscriber;

forwarding the voice message to a mailbox for storage therein;

generating a Short Message Services message notification upon receipt of the voice message;

transmitting the message notification to a messaging service node; and

routing the message notification to the voice mail subscriber over a local Internet gateway to provide indication to the voice mail subscriber of the stored voice message.

The examiner relies on the following references:

Pepe et al. (Pepe)	5,742,905	Apr. 21, 1998
Amin	6,014,559	Jan. 11, 2000
		(filed Apr. 10, 1997)

Appeal No. 2002-1761
Application No. 09/169,757

Claims 8-14 and 16-26 stand rejected under 35 U.S.C. § 102(b) as anticipated by Pepe.

Claims 1-6 and 15 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner offers Pepe, alone, with regard to claim 15, adding Amin with regard to claims 1-6.

Reference is made to the brief and answer for the respective positions of appellant and the examiner.

OPINION

An anticipatory reference is one which describes all of the elements of the claimed invention so as to have placed a person of ordinary skill in the art in possession thereof. In re Spada, 911 F.2d 205, 15 USPQ2d 1655 (Fed. Cir. 1990).

It is the examiner's position that Pepe anticipates claims 8-14 and 16-26. With regard to claim 8, for example, the examiner makes the following observations regarding the portions of the reference meeting the claim language:

providing at least one Internet gateway in communication with a communication network: Figure 1, elements 29, 40.

providing an adjunct processor in communication with a messaging service node and the Internet gateway: Figure 3, elements 46, 44, 42, 40.

providing at least one database in communication with the adjunct processor, the database including at least one designated destination server corresponding to the subscriber: Figure 3, elements 46, 44, and column 5, lines 51-67.

Appeal No. 2002-1761
Application No. 09/169,757

detecting at the service node a Short Message Services message notification from the subscriber's voice mailbox: Figure 3, elements 46, 44, 42, 40 and column 4, lines 57-67.

transmitting the message notification to the adjunct processor: Figure 3, service provider 40, and column 5, lines 51-67.

determining at the adjunct processor the at least one designated destination server for the subscriber: Figure 3, service provider 40.

routing the message notification to the at least one local Internet gateway: Figure 3, service provider 40.

transmitting from the adjunct processor to the local Internet gateway the at least one designated destination server for the subscriber: Figure 3, elements 44, 42, 40.

routing the message notification to the at least one designated destination server: column 5, lines 51-67.

For his part, appellant argues that many claimed limitations are not disclosed by Pepe. In particular, appellant cites "detecting at [a] service node a Short Message Services message notification from the subscriber's voice mailbox" and "transmitting the message notification to adjunct processor." Appellant urges that Pepe cannot disclose these claim limitations because Pepe's PCI network does not use Short Message Services, but uses AMIS-Analog Protocol instead.

Appellant also argues that Pepe makes no determination at the adjunct processor of the at least one designated destination

Appeal No. 2002-1761
Application No. 09/169,757

server for the subscriber, as claimed. Instead, appellant urges that Pepe's PCI network includes a PCI server which must be used in order for Pepe's system to be operational.

We will not sustain the rejection of claims 8-14 and 16-26 under 35 U.S.C. § 102(b) because the burden of establishing anticipation rests, in the first instance, with the examiner and it is our opinion that the examiner has not carried his burden.

In applying Pepe to the claims, the examiner points, broadly to general portions of the reference, as in "Figure 3" or "Figure 2," elements "44, 42, 40," etc. However, the examiner never sets forth a one-to-one correspondence between the claimed elements and what, exactly, is deemed to correspond to those elements in the reference. For example, what is the claimed "adjunct processor" in the reference? The examiner does not expressly say. Where is the claimed "messaging service node" in the reference? The examiner does not expressly say. What, in the reference, corresponds to the claimed "designated destination server"? Again, the examiner does not expressly say.

Thus, while Pepe certainly is very relevant to the instant claimed invention in its communications network, providing an Internet gateway, detecting message notifications, and optionally routing message notifications, it is hard to follow the

Appeal No. 2002-1761
Application No. 09/169,757

examiner's exact reasoning for concluding that the reference discloses each and every claimed element and/or step.

Moreover, appellant reasonably questioned the claimed step of "determining at the adjunct processor the at least one designated destination server for the subscriber," arguing that Pepe makes no such determination because one must always use the PCI server in Pepe. Yet, the examiner makes no response, preferring to remain silent in the response section of the answer. Since the examiner never particularly pointed out, in Pepe, what the examiner considers to be the claimed "designated destination server" and the claimed "adjunct processor," and now remains silent in the face of appellant's argument that the claimed "determining" step is not disclosed by Pepe, we are at a loss as to adopting any reasoning which would sustain the examiner's position.

Accordingly, we will not sustain the rejection of claims 8-14 and 16-26 under 35 U.S.C. § 102(b) because to do so, we would need to speculate as to the whether Pepe does, in fact, provide for each and every claimed step, and we would need to speculate as to the examiner's rationale with regard to how Pepe allegedly meets these claim limitations. A proper rejection under 35 U.S.C. § 102(b) may not be based on such speculation.

Appeal No. 2002-1761
Application No. 09/169,757

With regard to the rejection of claim 15 under 35 U.S.C. § 103, the examiner now appears to take the view that Pepe does not disclose SMS for message notification, but contends that it would have been obvious because "SMS is well known, using for sending or receiving, short alphanumeric messages to or from mobile telephones."

We will not sustain the rejection of claim 15 under 35 U.S.C. § 103 because, in our view, the examiner has not established a case of prima facie obviousness.

Initially, we note the inconsistency of the examiner's rationale, first contending, at page 4 of the answer, that Pepe teaches the routing of SMS notification to the subscriber Internet gateway to provide an indication to the subscriber of the stored voice mail message, citing Figure 1, elements 26, 29, 40, 39 and 32, and column 5, lines 51-67, and then, in the very next sentence, apparently conceding that Pepe does not disclose message notification by SMS, but holding that since SMS is well known, it purportedly would have been obvious to use SMS in Pepe for sending or receiving short alphanumeric messages to or from mobile telephones.

The examiner has not adequately come to grips with the SMS limitation of the claim. Appellant does not deny that SMS was

Appeal No. 2002-1761
Application No. 09/169,757

known, but contends that it was "presently operable only within the wireless network" (brief-page 3) and that the invention is in SMS message notification to a subscriber *outside* of the wireline and wireless networks, wherein the SMS message notification is routed through the Internet to a voice mail subscriber at one or multiple locations or message receiving devices. Thus, it appears that the examiner is alleging obviousness at the very heart of appellant's alleged invention without pointing to an adequate showing of why the claimed subject matter would have been obvious.

The examiner does point to column 5, lines 51-67, along with elements 26, 29 and 40 of Figure 1 of Pepe. However, reference to that portion of the reference offers no clear suggestion of SMS message notification since that portion relates only to PCI communication and that a subscriber may have options in selecting "cross-media notification of incoming messages..." To the extent that Pepe mentions "short text message" at column 21, line 49, and to the extent that this *may* suggest some type of SMS message notification (since this is what the examiner refers to in his response, at page 7 of the answer), we would note that this portion of the reference appears to relate to messages to the caller rather than notification to the subscriber that a voice

Appeal No. 2002-1761
Application No. 09/169,757

mail message has been left for the subscriber. Accordingly, the examiner has not successfully pointed to anything in Pepe which would have suggested to the artisan the SMS message notification set forth in the instant claims. Therefore, we will not sustain the rejection of claim 15 under 35 U.S.C. § 103.

We now turn to the rejection of claims 1-6 under 35 U.S.C. § 103.

It is the examiner's view that Amin discloses the claimed invention but for routing the message notification over a local Internet network. The examiner then turns to Pepe for a disclosure of a personal communications Internet network for routing messages over the Internet gateway to provide indication to the subscriber of stored voice mail messages, specifically pointing to Figure 1, elements 26, 29, 40, 39 and 32, and to column 5, lines 51-67 of Pepe. The examiner then concludes that it would have been obvious to use "Pepe's technique in Amin's invention to send voice information messages over Internet in order to increase the use of delivering voice mail message in log distance system [sic]" (answer-pages 3-4).

Again, we will not sustain the examiner's rejection under 35 U.S.C. § 103 because the examiner has not established a prima facie case of obviousness of the instant claimed subject matter.

Appeal No. 2002-1761
Application No. 09/169,757

As explained supra, the portion of Pepe cited by the examiner does not teach or suggest the routing of messages over an Internet gateway for informing a subscriber that there is a voice mail message waiting. That portion of Pepe does disclose that a subscriber may receive a message regarding receipt of a voice mail message, but that notification appears to come from a pager, i.e., a wireless network, not, necessarily, via the Internet. Most certainly, there is no suggestion in that portion of Pepe on which the examiner relies, of generating a Short Message Service message notification and routing that type of message over a local Internet gateway, as required by independent claim 1. Accordingly, the examiner's combination of Pepe with Amin will not result in the instant claimed subject matter.

Appeal No. 2002-1761
Application No. 09/169,757

The examiner's decision rejecting claims 1-6 and 15 under
35 U.S.C. § 103 and claims 8-14 and 16-26 under 35 U.S.C.
§ 102(b) is reversed.

REVERSED

JAMES D. THOMAS)	
Administrative Patent Judge)	
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ERROL A. KRASS)	BOARD OF PATENT
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Appeal No. 2002-1761
Application No. 09/169,757

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