

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ELIZABETH COUNTRYMAN, TIMOTHY J. LORELLO,
MARK TITUS AND DARA UNG

Appeal No. 2003-0330
Application No. 09/533,805

ON BRIEF

Before THOMAS, JERRY SMITH and BLANKENSHIP, 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 final rejection of claims 1-38, which constituted all the claims in the application. A first amendment after final rejection was filed on January 9, 2002 and was entered by the examiner. This amendment cancelled claims 3, 15, 24 and 33. A second amendment after final rejection was filed on

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June 6, 2002 and was also entered by the examiner. Accordingly, this appeal is directed to the rejection of claims 1, 2, 4-14, 16-23, 25-32 and 34-38.

The disclosed invention pertains to a method and apparatus for managing a call between an originator and a destination in a telecommunication network. More particularly, the invention relates to prepaid telephone calls, and the invention routes call signaling, but not the call itself, to a service control point if the call is associated with a prepaid service.

Representative claim 1 is reproduced as follows:

1. A method of managing a call between an originator and a destination in a telecommunications network, comprising:

receiving a call initiation from an originator;

determining one of a plurality of service types associated with a call relating to said call initiation;

routing call signaling and not said call itself to a service control point if said service type is a prepaid service type, said service control point having a database of profiles of a plurality of subscribers in a telecommunications network; and

establishing a communication link between said originator and said destination.

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The examiner relies on the following references:

Donovan et al. (Donovan)	6,075,982	June 13, 2000 (filed Sep. 23, 1997)
Granberg	6,195,543	Feb. 27, 2001 (filed June 01, 1998)

Claims 1, 2, 4-14, 16-23, 25-32 and 34-38 stand rejected under 35 U.S.C. § 103(a). As evidence of obviousness the examiner offers Donovan in view of Granberg.

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 rejection advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejection. 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 rejection 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

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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 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. 1988), 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.,

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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 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 by appellants [see 37 CFR §1.192(a)].

With respect to independent claims 1, 13, 23 and 32, the examiner essentially finds that Donovan teaches the claimed invention except that Donovan does not specifically disclose

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routing call signaling and not the call itself to a service control point. The examiner notes that the prepaid platform in Donovan inherently could be a service control point. The examiner cites Granberg as teaching a system which routes call signaling and not the call itself to a service control point. The examiner finds that it would have been obvious to the artisan to modify Donovan to route the call signaling and not the call itself to a service control point as taught by Granberg [answer, pages 3-4].

Although appellants nominally assert that independent claims 1, 13, 23 and 32 stand or fall separately, appellants make the identical arguments for each of these claims so that we will consider them together. Appellants argue that Donovan and Granberg relate to two entirely different systems, and the artisan would not have been motivated to combine Donovan and Granberg for this reason. Appellants also argue that neither Donovan nor Granberg involves a Signal Transfer Point (STP) as the claimed invention does. Appellants also argue that neither Donovan nor Granberg teaches routing call signaling and not the call itself to a service control point for prepaid calls [brief, pages 4-7].

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The examiner responds that although Donovan implies that both the call signaling and the call itself are routed through the prepaid platform, Donovan also indicates the need to send call signaling only in order to save funds on setting up telephone line infrastructure. The examiner also asserts that prepaid calling is a type of service like call forwarding and call waiting which are taught by Granberg. The examiner also disputes appellants' contention that the teachings of Donovan and Granberg cannot be combined because they relate to different systems [answer, pages 7-11].

Appellants respond that the examiner is incorrect in asserting that Donovan suggests a need to send call signaling and not the call itself because Donovan specifically routes both the call signaling and the call itself to the prepaid platform. Appellants also dispute the examiner's unsupported contention that prepaid calls are similar to types of service such as call waiting and call forwarding. Appellants argue that there is no teaching that the SCP of Granberg can be used for prepaid calls [reply brief, pages 1-3].

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We will not sustain the examiner's rejection of independent claims 1, 13, 23 or 32 or of any of the claims which depend therefrom for essentially the reasons argued by appellants in the briefs. Although we agree with the examiner that the teachings of Donovan and Granberg are combinable for at least some purposes, we agree with appellants that the combined teachings fail to support the examiner's rejection. Most importantly, the examiner's finding that prepaid calls can be routed through the SCP of Granberg is unsupported by the reference. The examiner simply equates prepaid calling with call forwarding and call waiting although there is nothing in Granberg which supports this assertion. There is nothing in Granberg which suggests that the supplementary services, such as call waiting, call forwarding and call barring, can include a service such as prepaid calls. Appellants argue that the SCP of Granberg does not apply to prepaid calling. On this record, there is no evidence to support the examiner's assertion that the prepaid calls of Donovan can be routed in the claimed manner by using SCPs as taught by Granberg. Although the collective teachings of Donovan and Granberg suggest that in some cases call signaling

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and not the call itself can be routed to an SCP, there is no teaching within these references that prepaid calls can be routed in this manner.

With respect to independent claims 37 and 38, the examiner finds that Donovan teaches determining whether a call requires one of a prepaid call service or postpaid call service based on Translation Type mapping capability of at least one of a Signaling Control Connection Part (SCCP) layer of Signaling System 7 (SS7) and SS7 User Part (ISUP) messaging [answer, pages 5-6]. Appellants argue that Donovan and Granberg both fail to teach determination of a service type, e.g., either a prepaid call service type or postpaid call service type, based on Translation Type mapping or Translation Type capability [brief, pages 13-14]. The examiner responds that Donovan uses the same standards disclosed by appellants [answer, pages 13-14]. Appellants respond that Donovan fails to teach how the determination is made as to what the service type is. Appellants argue that nowhere does Donovan teach determining a service type based on Translation Type mapping or Translation Type capability [reply brief, page 3].

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We will not sustain the examiner's rejection of claims 37 and 38 for the reasons argued by appellants in the briefs. The applied prior art references say nothing about making service type determinations based on Translation Type mapping capability. The examiner simply states that "Donovan in view of Granberg shows determining if the call is one of a prepaid type and a postpaid type based on Translation Type mapping capability of at least one of a Signaling Control Connection Point (SCCP) layer of Signaling System 7 (SS7) and SS7 User Part (ISUP) messaging [answer, pages 13-14]. We have carefully reviewed the applied references, but we can find nothing in these references which supports the examiner's assertion. The examiner's position is tantamount to saying that Translation Type mapping capability is inherent in the operation of Donovan. There is no evidence on this record to support the examiner's position. Obviousness cannot be established on the examiner's unsupported opinions. Appellants argue that "Donovan fails to teach how the determination is made as to what the service type is. Nowhere does Donovan teach determining a service type based on **Translation Type mapping or Translation Type capability**" [reply brief, page 3]. Appellants' position with respect to Donovan

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appears to be correct. Therefore, on this record, we are unable to sustain the examiner's rejection of claims 37 and 38.

In summary, we have not sustained the examiner's rejection of any of the claims on appeal. Therefore, the decision of the examiner rejecting claims 1, 2, 4-14, 16-23, 25-32 and 34-38 is reversed.

REVERSED

JAMES D. THOMAS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JERRY SMITH)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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HOWARD B. BLANKENSHIP)	
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