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

Paper No. 30

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KIMMO DJUPSJOBACKA, PEKKA OLLIKAINEN,
JUKKA HAUTANEN, ESA EROLA, ERKKI TANSKANEN,
LLARI SAARIKIVI, ARI AARNIO, KLAUS OESCH,
RIITTA JOKELA, and TAPIO HAMEEN-ANTTILA

Appeal No. 2004-1309
Application No. 09/410,978

HEARD: November 17, 2004

Before: KRASS, DIXON, and NAPPI, **Administrative Patent Judges**.

NAPPI, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 of the final rejection of claims 1 through 43, which constitute all the claims in the application.

Invention

The invention relates to a system to facilitate shopping by using a mobile device. The mobile device provides the user with an indication of available selected goods or services and an itinerary of the user to visit the vendors to obtain the selected goods or services. See page 2 of appellants' originally filed specification.

Claim 1 is representative of the invention and reproduced below:

1. A method of facilitating shopping with a mobile device to obtain a plurality of at least one of purchased goods or services from a group of vendors located at a shopping location comprising:

communicating from the mobile device with at least one server a selection of at least one of the goods or the services to be purchased by a user of the mobile device on or before the user shops at the shopping location;

the at least one server, in response to information stored therein regarding vendors located at the shopping location and the at least one of the goods or the services offered by the vendors and the selection of the plurality of the at least one of the goods or the services to be purchased by the user, causes at least an identification of the vendors from which available selected goods or services may be purchased and the available selected at least one of the goods or the services to be transmitted to the mobile device; and

the mobile device provides to the user an identification of the available selected at least one of the goods or the services to be purchased and an itinerary of the user setting forth at least a choice of an order in which the user physically visits the identified vendors at the shopping location to obtain the at least one of the goods or the services to be purchased which itinerary is a function of at least one profile of the user.

References

The reference relied upon by the examiner is:

DeLorme et al. (DeLorme)	5,948,040	Sep. 07, 1999 (filed Feb. 06, 1997)
Bull et al. (Bull)	PCT WO 98/35469	Aug. 13, 1998

Rejection at Issue

Claims 1 through 43 stand rejected under 35 U.S.C. § 103 as being obvious over Bull in view of DeLorme. Throughout the opinion we make reference to the briefs[1] 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.

With full consideration being given to the subject matter on appeal, the examiner's rejection and the arguments of appellants and examiner, for the reasons stated *infra* we will not sustain the examiner's rejection of claims 1 through 43 under 35 U.S.C. § 103.

Appellants argue, on page 12 of the brief, that while Bull does teach a user profile, it does not teach a user profile as is claimed. Further, on page 14 of the brief, appellants argue

> While DeLorme, et al. do suggest a trip literary, the trip itinerary is <u>not</u> a function of at least one profile of the user causing a choice of order in which the user physically visits the identified vendors either along a trip or

[1] Appellants filed an Appeal Brief on May 30, 2003 and appellants filed a Reply Brief on November 5, 2003.

> at a shopping location to obtain selected goods or services. To the contrary, it is readily apparent that the DeLorme, et al. system pertains to defining a trip itinerary <u>without regard to the order of obtaining selected goods or services along the trip</u> and certainly not with respect to a function of at least one user profile.

The Examiner responds to these arguments, on page 15 of the answer stating

> [I]t appears that Appellant misinterprets the clear and unmistakable teachings of the applied references, and proceeds to apply an improper interpretation of the applied references as the basis for the Examiner's rejection. Claims 1 and 30 pertain to the use of the profile as a source of input information that facilitates the narrowing of the information retrieved, i.e. the itinerary. Bull and Delorme teach the claimed user profile through-out the referenced document.

Further, the examiner argues " the Bull reference that was relied upon for the user profile and itinerary limitations and the DeLorme reference applied for the physical shopping limitation (see paper number 12) nevertheless DeLorme additionally discloses individual user profiles as input for subsequent determination of itineraries throughout the referenced document."

We are not convinced by the examiner's claim interpretation and reasoning. Claims will be given their broadest reasonable interpretation consistent with the specification, limitations appearing in the specification will not be read into the claims. ***In re Etter*** 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985). "[I]nterpreting what is *meant* by a word in a claim 'is not to be confused with adding an extraneous limitation appearing in the specification, which is improper.'" (emphasis original) ***In re Cruciferous Sprout Litigation,*** 301 F.3d 1343, 1348, 64 USPQ2d 1202, 1205, (Fed. Cir. 2002) (citing ***Intervet America***

Inc v. Kee-Vet Laboratories Inc. 12 USPQ2d 1474, 1476 (Fed. Cir. 1989)). "[T]he terms used in the claims bear a "heavy presumption" that they mean what they say and have the ordinary meaning that would be attributed to those words by persons skilled in the relevant art." ***Texas Digital Sys, Inc. v. Telegenix, Inc.,*** 308 F.3d 1193, 1202, 64 USPQ2d 1812, 1817 (Fed. Cir. 2002).

Independent claim 1 contains the limitations, "communicating from the mobile device with at least one server a selection," "the at least one server, in response to … the selection… causes at least an identification of the vendors … to be transmitted to the mobile device" and "the mobile device provides to the user an identification of the available selected at least one of the goods or the services to be purchased and an itinerary of the user setting forth at least a choice of an order in which the user physically visits the identified vendors at the shopping location to obtain the at least one of the goods or the services to be purchased which itinerary is a function of at least one profile of the user". Independent claim 30 contains similar limitations. We find that these limitations

require that the mobile device provide two things to the user, a) an indication of the available goods or services based upon the servers response to the selection and b) an itinerary for the user to physically visit the vendors. Further the itinerary is a function of the user profile. The common meaning of the word

"function" is a "factor related to or dependent upon other factors"[2]. Thus, we find that the claimed profile is a factor upon which the itinerary of physical locations is dependent.

While we concur with the Examiner's statement on page 15 of the brief, that both Bull and DeLorme teach a profile, we do not find that the profile taught is a factor upon which the itinerary of physical locations is dependent. Bull teaches that the profiles are used to narrow the information retrieval, see page 5 lines 28 to 30. DeLorme teaches that the profiles are to reduce repetitive data entry; all of the profiles disclosed are directed to the selection of goods or services (see Column 61, lines 5-26). However, as stated ***surpa***, the claimed invention includes two types of information to be provided to the user and the claimed user profiles are a factor upon which the itinerary of physical locations is

[2] Definition from the Random House College Dictionary, Revised Edition, 1982.

dependent and not a criteria used to narrow the selection. Thus, we find that neither Bull nor DeLorme teaches the claimed user profile. Accordingly, we will not sustain the examiner's rejections of claims 1 through 43 under 35 U.S.C. § 103.

REVERSED

ERROL A. KRASS Administrative Patent Judge	)	
JOSEPH L. DIXON Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
ROBERT E. NAPPI Administrative Patent Judge	)	

REN/vsh

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