

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte TODD M. ALTMAN and SEAN P. MALONEY

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Appeal No. 2004-1379  
Application No. 09/823,458

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ON BRIEF

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Before JERRY SMITH, GROSS, and BARRY, 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 rejection of claims 1, 3-20 and 22, which constitute all the claims remaining in the application.

The disclosed invention pertains to a method for providing information to a consumer carrying a portable communication device. More particularly, the consumer is provided with information based on the location of the consumer

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and the information is filtered by user preferences stored in the communication device.

Representative claim 1 is reproduced as follows:

1. A method comprising:

identifying a reference location; and

providing consumer information determined at least in part on a vendor's proximity to the reference location, wherein the consumer information being received by a portable communication device is filtered by user preferences stored in the portable communication device.

The examiner relies on the following references:

Amin et al. (Amin)	6,353,398	Mar. 05, 2002 (filed Oct. 22, 1999)
Titmuss et al. (Titmuss)	6,397,040	May 28, 2002 (filed Apr. 09, 1998)

Claims 1, 3-20 and 22 stand rejected under 35 U.S.C.

§ 103(a). As evidence of obviousness the examiner offers Amin in view of Titmuss.

Rather than repeat the arguments of appellants or the examiner, we make reference to the brief 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

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rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the brief 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 particular art would 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 affirm.

Appellants have indicated that for purposes of this appeal the claims will all stand or fall together as a single group (brief, page 5). Consistent with this indication appellants have made no separate arguments with respect to any of the claims on appeal. Accordingly, all the claims before us will stand or fall together. Note In re King, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986); In re Sernaker, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983). Therefore, we will consider the rejection against independent claim 1 as representative of all the claims on appeal.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to

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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.), 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., 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 applicants to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of

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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, 1051-52, 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 (see 37 CFR § 41.37(c)(1)(vii)(2004)).

With respect to representative, independent claim 1, the examiner essentially finds that Amin teaches the claimed invention except that Amin fails to disclose that the user preferences to be filtered are stored in the portable communication device. The examiner finds that this is well known in the art as evidenced by Titmuss. The examiner finds that it would have been obvious to the artisan to apply the Titmuss concept to the Amin portable communication device in order to deliver more relevant information to the user (answer, pages 3-4).

Appellants argue that the rejection is improper because the modification of Amin proposed by the examiner would render the structure of Amin unsatisfactory for its intended purpose.

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Appellants argue that in Amin the system, not the user, determines what information gets displayed to the user whereas in Titmuss, the user determines what information gets displayed. As noted, appellants argue that modifying Amin to filter information as taught by Titmuss would destroy the purpose of Amin (brief, pages 6-8).

The examiner responds that the proposed modification would not destroy the purpose of the Amin system. Specifically, the examiner notes that the same information would still be pushed to the portable device with the proposed modification, but only the information displayed to the user would be affected by the modification. Thus, the examiner asserts that the proposed modification would have been made because it would provide more relevant information to the user (answer, pages 7-8).

We will sustain the examiner's rejection of the claims on appeal for essentially the reasons argued by the examiner in the answer. We agree with the examiner that the proposed modification of Amin would not defeat the purpose of the Amin device. Titmuss simply suggests filtering data after it has been downloaded from the source of the data. The amount of information pushed to the portable device in Amin would be the same regardless of whether that information is further filtered

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as taught by Titmuss. Titmuss teaches the desirability of using prestored user preferences so that only the most desirable downloaded information gets displayed to the user. We agree with the examiner that the artisan would have been motivated to modify Amin's device so as to use prestored user preferences to filter the data in the manner taught by Titmuss in order to display only the data most desired by the user.

In summary, we have sustained the examiner's rejection of the claims on appeal. Therefore, the decision of the examiner rejecting claims 1, 3-20 and 22 is affirmed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

JERRY SMITH	)	
Administrative Patent Judge	)	
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ANITA PELLMAN GROSS	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
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LANCE LEONARD BARRY	)	
Administrative Patent Judge	)	

JS/hh

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