

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte YU SUNG (EDUARDO) YEH and DARRYL SHEPHERD

Appeal No. 2004-1952
Application No. 09/207,954

HEARD: FEBRUARY 22, 2005

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

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 35-37, 45 and 46.

The invention is directed to an integrated, interactive telephone and computer network communication system. The particular claims on appeal before us are directed to an embodiment comprising a method for a server to deliver a marketing message employing a telephone conferencing function.

OPINION

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). To reach a conclusion of obviousness under Section 103, the examiner must produce a factual basis supported by a teaching in a prior art reference or shown to be common knowledge of unquestionable demonstration. Our reviewing court requires this evidence in order to establish a prima facie case. In re Piasecki, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984). The examiner may satisfy his/her burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead the individual to combine the relevant teachings of the references. In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

In applying Mendler to independent claim 35, the examiner contends that Mendler teaches receiving a telephone call from a caller at a server, i.e., the customer calls MCI and provides the numbers of his/her closest friends; querying the caller by the server for a third-party telephone number; and receiving the third-party telephone number (i.e., the system receives the third

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party telephone numbers to enable the customer to receive discounts on those called numbers) (citing page 3, paragraphs 4 and 5). The examiner further indicates, with respect to the claimed steps of establishing by the server a telephone call between the caller and the third party and delivering to the caller and the third party a marketing message during the telephone conference call, that since the MCI system is partly responsible for taking 5 percent of AT&T's market share (citing page 3, paragraph 4 of Mendler), and since "it is well known" to place conference calls that deliver marketing messages (e.g., mortgage companies call individuals responsible for decision making by conference calls to deliver the marketing message, motivating both parties to agree on certain specifics of a proposed deal) (see pages 3-4 of the answer), it would have been obvious "to have included delivering a conference marketing message to the friends and family of the customer because such a modification would save time by enabling the MCI operators to deliver the same message to the two parties at the same time" (answer, page 4).

With regard to independent claim 36, adding the limitation of receiving a call from a caller having a calling card with a predetermined number of minutes on the card, the examiner takes

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"Official notice" that it was "well known for callers to place phone calls with calling cards said calling cards have a predetermined number of minutes based on the money amount purchased" (answer, page 4). Thus, the examiner concludes that it would have been obvious to have included a calling card "because such a modification would enable the caller to prepay for the call ahead of time" (answer, page 4).

With regard to claim 37, the examiner takes Official notice that it was well known to credit or pay customers for their attention to advertisements. With regard to claims 45 and 46, the examiner takes Official notice that it was old and well known in marketing to target advertisements based on demographic information of a person.

The examiner cites Riddle for how well it was known to deliver marketing messages. In particular, the examiner contends that Riddle teaches, in the abstract, enabling teleconference members to share files during a conference call. The examiner further alleges that Riddle's file sharing accessory allows advertisements 205 to be viewed by two parties, and that Riddle teaches promoting to two parties that a file is available, citing column 1, lines 47-59, and column 3, lines 45-53.

Appellants, for their part, contend that Riddle does not teach marketing messages and, so, does not support the fact alleged in the examiner's "Official notice," which has been challenged by appellants. Appellants allege that what is missing from the Official notice is "the connection between the 'advertisement' of [Riddle] and the marketing message of the claims. The 'advertisement' of [Riddle] is not a marketing message at all. Rather, it is a notice that a particular file is available for download during a computer-based teleconference" (principal brief, page 4).

In addition to the argument that the examiner has improperly relied on "Official notice," appellants further contend that claim 35 recites a plurality of steps that are performed by or at a server, and that the examiner has not alleged that a server even exists in Mendler, let alone that the server performs the claimed tasks (principal brief, page 5). In fact, appellants point out, the tasks described in Mendler are all performed by people, not servers. Further, allege appellants, if the examiner is asserting that the operators in Mendler would be replaced by a server, the examiner "has identified no teaching that a server calling a potential customer with another existing customer already on the line would in any way increase the likelihood that

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the potential customer would, in fact, become a customer. The [examiner] has seemingly implied that saying no to the operator while a friend or a family member is on the line might be difficult, but there is no evidence of any 'peer pressure' when the potential customer is simply saying 'no' to a machine instead of a person" (principal brief, page 6).

In addition to the arguments supra, with regard to claims 36, 37, and 46, appellants argue that the examiner has not identified anything to show that a calling card number would be useful in the context of delivering, by a server, a marketing message during a teleconference.

We agree with appellants and will not sustain the rejection of claims 35-37, 45, and 46 under 35 U.S.C. § 103.

Initially, we note that the patent to Riddle appears to form a considerable part of the examiner's rejection, yet the statement of rejection mentions only Mendler. Where a reference is relied on to support a rejection, whether or not in a minor capacity, there would appear to be no excuse for not positively including the reference in the statement of the rejection. In re Hoch, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970). This, alone, would be reason enough to reverse the stated rejection. However, since appellants clearly know that Riddle is

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employed to support the rejection and have had an opportunity to respond, and have responded, to the real rejection, appellants are not prejudiced by our treating the rejection as one based on the combination of Mendler and Riddle and proceeding to decide the case on its merits.

The instant claims are all directed to a method for a communication "server" to deliver a marketing message. We agree with appellants that there is nothing in the disclosure of Mendler about such a "server" performing the claimed functions. The examiner responds by referring to page 3, paragraph 4, of Mendler, wherein a "client-server" is recited. However, this recitation by the reference clearly refers to a system of Bell-Atlantic, referenced in the preceding paragraph. Yet, the examiner is relying on the MCI "Friends and Family" program for the various claimed steps. There is no indication in Mendler, especially in the portion regarding MCI's "Friends and Family" billing plan, that callers call a server, that that server queries the caller for telephone numbers of family and friends, that that server then establishes a conference call between the caller and one of those family and friend members, and/or that that server delivers to the caller and to his/her friend or family member a marketing message during the conference call.

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Such a server, having the claimed capabilities, or any server, for that matter, is not disclosed or suggested by the MCI "Friends and Family" billing plan relied on by the examiner.

Moreover, assuming, arguendo, that Mendler did suggest such a server, an assumption with which we disagree, we agree with appellants that Riddle does not provide for the missing "marketing message," as claimed. While Riddle may share files in a teleconferencing environment, there is no indication therein that a "marketing message" is delivered to the teleconferencing parties. File sharing in Riddle, where one "advertises" for files (e.g., see column 13, lines 25-30), is just not the same as a marketing message, as claimed. But, even if one would consider such to be a "marketing message," as claimed, the examiner has provided no convincing reason why the skilled artisan would have sought to make the combination and provide for the claimed "marketing message" in a teleconferencing environment. Even if we accept that it was "well known" to provide marketing messages, as alleged by the examiner, this is not a reason to provide for such messages by delivering them from a server to a caller and a third party during a telephone conference call, as claimed.

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Because the examiner has failed to establish a prima facie case of obviousness, we will not sustain the rejection of claims 35-37, 45, and 46 under 35 U.S.C. § 103.

The examiner's decision is reversed.

REVERSED

ERROL A. KRASS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
ANITA PELLMAN GROSS)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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ROBERT E. NAPPI)	
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