

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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

Appeal No. 2005-1705
Application 09/455,956

ON BRIEF

Before JERRY SMITH, RUGGIERO 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 rejection of claims 1, 2, 4-9 and 11-44, which constitute all the claims pending in the application.

The disclosed invention pertains to a method and apparatus for recording game or sports information received from many different input devices into a database and presenting the stored information to viewers using many different types of output devices.

Representative claim 1 is reproduced as follows:

1. A method of transmitting sport data, said method comprising the steps of:

(a) establishing a communication connection between a mobile terminal and a sport server using a public cellular communications network so that the mobile terminal is in communication with the sport server;

(b) determining, by the sport server, a type of mobile terminal used and at least display parameters of the mobile terminal and selecting a prompt display to be communicated to the mobile terminal based on the determined display parameters of the mobile terminal;

(c) setting the mobile terminal in a sport data input mode in response to receiving the prompt display and selecting a selected sport to which sport data to be inputted pertains;

(d) inputting the sport data into the mobile terminal in communication with the sport server;

(e) directly transmitting the inputted sport data from the mobile terminal to the sport server as the sports data is input by the user in said step (d);

(f) recording, by the sports server, the sport data in a sport database; and

(g) transmitting the sport data from the sport server to an output device which has requested the sport data and adapting, by a filter adapting device, the sport data to a desired format for the output device.

The examiner relies on the following references:

Wayner	5,557,717	Sep. 17, 1996
Emery et al. (Emery)	5,727,057	Mar. 10, 1998
Lobb et al. (Lobb)	5,810,680	Sep. 22, 1998
Moriarty et al. (Moriarty)	6,062,991	May 16, 2000 (filed Apr. 05, 1996)
Eiba	6,117,013	Sep. 12, 2000 (filed July 25, 1997)

The admitted prior art disclosed by appellant.

Claims 1, 2, 4-9, 11-32, 37, 38, 41 and 42¹ stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Lobb in view of Moriarty and Eiba. Claims 33 and 34 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Lobb in view of Moriarty and Eiba and further in view of the admitted prior art. Claims 35, 39 and 43 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Lobb in view of Moriarty and Eiba and further in view of Wayner. Claims 36, 40 and 44 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings

¹ Although claims 37, 38, 41 and 42 are not listed in the statement of the rejection in the answer, the explanation of the rejection in the Final Rejection refers to these claims.

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of Lobb in view of Moriarty and Eiba and further in view of Emery.

Rather than repeat the arguments of appellant 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 rejections advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellant's arguments set forth in the briefs along with the examiner's rationale in support of the rejections 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 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.

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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.), 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

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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 appellant have been considered in this decision. Arguments which appellant 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)].

We consider first the rejection of claims 1, 2, 4-9, 11-32, 37, 38, 41 and 42 based on the teachings of Lobb, Moriarty and Eiba. The examiner has indicated how he finds the claimed invention to be unpatentable over the collective teachings of Lobb, Moriarty and Eiba [Final Rejection, pages 2-4]. With respect to independent claims 1 and 12, appellant argues that the applied references fail to teach or suggest that 1) the sports server determines a type of mobile terminal used and display parameters of the mobile terminal and that the sports server selects a prompt display to be communicated to the mobile terminal based on the determined display parameters of the mobile

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terminal, and 2) that the sports server transmits the sports data from the sport server to an output device which has requested the sports data, and wherein the sports data is adapted to a desired format for the output device by a dedicated filter. With respect to the first point, appellant argues that since all parts of the Lobb and Moriarty systems are designed to work with each other, there is no need for the central computer to determine the type of input device and the display characteristics thereof.

Appellant argues that Eiba also fails to teach or suggest anything related to the determination of the type of the device in communication with the server. With respect to the second point, appellant argues that any input and output devices in Lobb and Moriarty are designed as part of the overall system, thus obviating the requirement for adapting the data. Appellant also argues that Eiba fails to teach or suggest this limitation.

Finally, appellant argues that there is no motivation for combining the teachings of Eiba with those of Lobb and Moriarty [brief, pages 6-10].

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With respect to the first of appellant's arguments, the examiner responds that Lobb and Moriarty are not restricted to golf course-specific radio communication systems and that the central computer in Lobb is used to determine the type of input devices in communication with the system. The examiner supports this statement by pointing to the fact that Lobb uses NAVSTAR global positioning systems. The examiner also responds that Eiba must determine the type of game device that is receiving the transmission from the computer server. With respect to the second of appellant's arguments, the examiner responds that the plurality of devices recited as possible game devices in Eiba disclose a need for dedicated data filters in the server taught by Lobb and Moriarty. Finally, the examiner repeats the motivation for combining the cited references as set forth in the rejection [answer, pages 3-8].

Appellant responds that the use of a global positioning system does not imply that the device is not part of a system designed for use with a golf course computer system. Thus, appellant reiterates the argument that the central server in Lobb or Moriarty does not have to determine the type of terminal being used and characteristics to format the output. Appellant also responds that the fact that Eiba allows different terminals to be

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used fails to disclose that a filter is required at a central server for filtering data sent out to various different devices. Appellant also reiterates his position that there is no motivation for combining the applied references [reply brief, pages 1-4].

We will not sustain the examiner's rejection of independent claims 1 and 12 for essentially the reasons argued by appellant in the briefs. Most importantly, we agree with appellant that the input terminals in Lobb and Moriarty are specifically designed to be used with the central computer and are basically all the same. Therefore, there is no need to determine the type of mobile terminal used and selecting prompt displays based on that determination. We also agree with appellant that there is no basis for combining the teachings of Eiba with the teachings of Lobb and Moriarty. Lobb and Moriarty relate to the management of data on a golf course. Eiba relates to a device for displaying winning lottery numbers. We see no reason why the artisan would have been motivated to apply the teachings of the lottery device of Eiba to the golf course devices of Lobb and Moriarty except in an improper attempt to reconstruct the claimed invention in hindsight. Since we have not sustained the examiner's rejection with respect to

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independent claims 1 and 12, we also do not sustain the rejection with respect to dependent claims 2, 4-9, 11, 13-23, 32, 37, 38, 41 and 42.

With respect to independent claim 24, appellant argues that since the input devices of Lobb and Moriarty are designed as part of the system, there is no teaching or suggestion for indicating display characteristics of the mobile terminal to the sport server as claimed. Appellant also argues that Eiba fails to teach or suggest that a mobile terminal indicates display parameters to the sports server. Finally, appellant repeats the motivation to combine argument discussed above [brief, pages 11-12].

We will not sustain the examiner's rejection of independent claim 24 for essentially the reasons discussed above with respect to claims 1 and 12. Since we have not sustained the rejection of independent claim 24, we also do not sustain the rejection of dependent claims 25-31.

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With respect to claims 33-36, 39, 40, 43 and 44, which are rejected on the teachings of Lobb, Moriarty and Eiba in addition to either the admitted prior art, Wayner and Emery, we will not sustain the examiner's rejection of these claims because neither the admitted prior art, Wayner nor Emery overcomes the deficiencies of the basic combination of references as discussed above.

In summary, we have not sustained any of the examiner's rejections of the claims on appeal. Therefore, the decision of the examiner rejecting claims 1, 2, 4-9 and 11-44 is reversed.

REVERSED

JERRY SMITH)	
Administrative Patent Judge)	
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JOSEPH F. RUGGIERO)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
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HOWARD B. BLANKENSHIP)	
Administrative Patent Judge)	

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