The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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 DINESH KASHINATH ANVEKAR, BHASKARPILLAI GOPINATH, RAJIV MANGLA and SRIDHAR SUNDARAM

Appeal No. 2006-1978
Application No. 10/027,572

ON BRIEF

Before HAIRSTON, RUGGIERO, and BLANKENSHIP, Administrative Patent Judges.

RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the final rejection of claims 1-19, which are all of the claims pending in this application.

The disclosed invention relates to a short message service (SMS) message system in which a separate SMS exchange system implements value-added service capability. More particularly, the value-added services range from a simple data

insertion in a SMS message to the complex initiation of a teleconference call using inter-exchanged SMS messages.

Claim 1 is illustrative of the invention and reads as follows:

1. A method for processing a short message service (SMS) message comprising

embedding a value-added field in the SMS message by an originator of the SMS message, the field being indicative of a value-added service requested by the originator, and

instantiating the value-added service from the combination of the field supplied by the originator and originator-specific data pre-stored in an originator database.

The Examiner relies on the following prior art:

Lehto et al. (Lehto)	US 2002/0177455 A1	Nov. 28, 2002 (filed May 23, 2001)
Alperovich et al. (Alperovich)	WO 99/57927	Nov. 11, 1999

Claim 19 stands finally rejected under 35 U.S.C. § 102(b) as being anticipated by Alperovich. Claims 1-18 stand finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Alperovich in view of Lehto.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Brief (Substitute, filed March 10, 2006) and Answer (mailed September 21, 2005) for their respective details.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the Examiner, and the evidence of anticipation and obviousness relied upon by the Examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellants' arguments set forth in the Brief 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 Alperovich reference does not fully meet the invention as set forth in claim 19. We are further of the opinion 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 recited in claims 1-5, 7-11, 13, and 15-18. We reach the opposite conclusion with respect to the Examiner's obviousness rejection of claims 6, 12, and 14. Accordingly, we affirm-in-part.

As a general proposition in an appeal involving a rejection under 35 U.S.C. § 103, an Examiner is under a burden to make out a prima facie case of obviousness. If that burden is met, the burden of going forward then shifts to Appellants 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 In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); 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).

With respect to the Examiner's 35 U.S.C. § 103(a) rejection of claims 1-5, 7-11, 13, and 15-18, based on the combination of Alperovich and Lehto, after reviewing the Examiner's analysis (Answer, pages 4-11), it is our opinion that the stated position is sufficiently reasonable that we find that the Examiner has at least satisfied the burden of presenting a prima facie case of obviousness. The burden is, therefore, upon Appellants to come forward with evidence and/or arguments which persuasively rebut the Examiner's prima facie case. 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 waived [see 37 CFR 41.37(c)(1)(vii)].

With respect to independent claim 1, Appellants' arguments in response to the Examiner's 35 U.S.C. § 103(a) rejection assert a failure to establish a prima facie case of obviousness since all of the claimed limitations are not taught or suggested by the applied prior art references. After careful review of the disclosures of Alperovich and Lehto in light of the arguments of record, we are in general agreement with the Examiner's position as stated in the Answer.

Initially, Appellants attempt (Brief, pages 12, 13, 16, 17, and 20-22) to draw a distinction between the claimed invention and the cited prior art by asserting that, unlike the claimed invention, Alperovich pre-pends a new header onto a standard SMS message only on or after the user creates the payload for the message. Appellants make similar arguments (Brief, pages 14, 15, 18, and 19) with respect to Lehto by contending that the extension data in Lehto is embedded into the SMS message only after a user creates the "funny" which fills the message payload.

After reviewing the language of appealed independent claim 1 in light of Appellants' arguments, however, we find that such arguments are not commensurate with the scope of the claim. As pointed out by the Examiner (Answer, pages 13 and 14), there is no time line set forth in the claim for when or which data is to be used in creating the SMS message. Similarly, to whatever

extent Alperovich and Lehto create non-standard messages and/or utilize non-conventional transmission and processing techniques as asserted by Appellants, no such non-standard messages or non-conventional processing is precluded by the language of appealed claim 1.

It is axiomatic that, in proceedings before the PTO, claims in an application are to be given their broadest reasonable interpretation consistent with the specification, and that claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983). Moreover, limitations are not to be read into the claims from the specification. In re Van Geuns, 988 F.2d 1181, 1184, 26 USPQ2d 1057, 1059 (Fed. Cir. 1993) citing In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

We further find to be unpersuasive Appellants' argument (Brief, pages 25-27) that the Examiner has misinterpreted the language of claim 1 by treating the claim language "value-added field" as reciting "value-added data." Aside from the fact that we find no error in the Examiner's interpretation of the "extension" in Lehto and the "header" in Alperovich as "fields," we agree with the Examiner (Answer, pages 17 and 18) that the "instantiation" operation in both Alperovich

and Lehto, as well as in Appellant's disclosed invention, is a result of the combination of the "data" in the fields with pre-stored user data. This is confirmed by Appellants' remarks (Brief, at 26) which state "the phrase **'value-added service'**" is the result of instantiating the combination of generic data (emphasis added) supplied by the user via the **value-added field** and the user-specific data pre-stored in the database.

In view of the above discussion, we are of the opinion, for all of the reasons articulated by the Examiner, that the ordinarily skilled artisan would have recognized and appreciated that the value-added service disclosed by the short-messaging system of Lehto would serve as an obvious enhancement to the system of Alperovich. Accordingly, since it is our view that the Examiner's prima facie case of obviousness based on the combination of Alperovich and Lehto has not been overcome by any convincing arguments from Appellants, the Examiner's 35 U.S.C. § 103(a) rejection of claim 1 is sustained.

We also sustain the Examiner's obviousness rejection based on the combination of Alperovich and Lehto of claims 2-5, 7-11, 13, and 15-18. Appellants' arguments in the Brief make no separate arguments for patentability of

these claims but, instead, rely on arguments made with respect to claim 1, which arguments we found to be unpersuasive for all of the reasons discussed supra.

We also make the observation, referring to our earlier discussion of Alperovich, that Alperovich discloses, as presently recited in claim 1, the embedding of a field, i.e. header field 320, in an SMS message by an originator of the message. From our review of Alperovich, we fail to see why, considering the data populating this header field, such a header field would not be reasonably interpreted by the ordinarily skilled artisan as a "valued-added" field as claimed. In other words, the "value" added to the SMS message 310 in Alperovich is designated by the "private" identifier 325 (along with group ID 328), which is indicative of a "value-added service," i.e., the delivery of a "private" message requested by the originator. Further, as disclosed by Alperovich (page 6, lines 13-24), the "value-added service" is "instantiated" by the combination, i.e., comparison, of the populated field 320, i.e., the group ID, supplied by the originator and the list of originator-specific group ID's stored in SIM card 308 .

In view of the above discussion and analysis of the disclosure of the Alperovich reference, it is our opinion that, although we found no error in the Examiner's proposed combination of Alperovich and Lehto as discussed supra, the Lehto reference is not necessary for a proper rejection of at least claim 1 since all of the claimed elements are in fact present in the disclosure of Alperovich. A disclosure that anticipates under 35 U.S.C. § 102 also renders the claim unpatentable under 35 U.S.C. § 103, for "anticipation is the epitome of obviousness." Jones v. Hardy, 727 F.2d 1524, 1529, 220 USPQ 1021, 1025 (Fed. Cir. 1984). See also In re Fracalossi, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982); In re Pearson, 494 F.2d 1399, 1402, 181 USPQ 641, 644 (CCPA 1974).

Turning to a consideration of the Examiner's 35 U.S.C. § 103(a) rejection of claims 6, 12, and 14 based on the combination of Alperovich and Lehto, we do not sustain this rejection. We note that, while we found Appellants' arguments to be unpersuasive with respect to the obviousness rejection of claims 1-5, 7-11, 13, and 15-18 discussed above, we reach the opposite conclusion with respect to the rejection of claims 6, 12, and 14. Each of these claims relates to "teleconferencing" in which the embedded value-added field in the SMS message

is a “teleconferencing” field. In addressing the “teleconferencing” language of these claims, the Examiner takes the position (Answer, page 12) that the messaging capability of the system disclosed by Alperovich includes what the Examiner characterizes as a “group call/service” and that this “group call/service is a tele-service which is a teleconference, a communication between an exclusive group.”

We agree with Appellants, however, that what is actually described by Appellants is an SMS system with “broadcast message” capability. In accordance with this disclosed capability, Alperovich describes the sending of a message by an originator to a restricted group of recipients identified by a group identification number. We find, however, no evidence presented by the Examiner to support the Examiner’s conclusion that such a “broadcast message” capability would be recognized as equivalent to a “teleconferencing” function. To the contrary, the evidence of record supports Appellants’ contention that, as described in Appellants’ specification and as argued by Appellants (Brief, page 7), the ordinarily skilled artisan would recognize a “teleconference” as one in which a group of individuals have the ability to engage in concurrent, two-way communication. In our view, the

"broadcast message" system described by Alperovich in which a restricted group of recipients passively receives a message from an originator falls well short of what the evidence of record would indicate as being recognized as "teleconferencing" as claimed.

It is well settled that "the Board cannot simply reach conclusions based on its own understanding or experience - or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings." In re Zurko, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). See also In re Lee, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002), in which the court required evidence for the determination of unpatentability by clarifying that the principles of "common knowledge" and "common sense" may only be applied to analysis of evidence, rather than be a substitute for evidence. The court has also recently expanded their reasoning on this topic in In re Thrift, 298 F. 3d 1357, 1363, 63 USPQ2d 2002, 2008 (Fed. Cir. 2002).

We further do not sustain the Examiner's 35 U.S.C. § 102(b) rejection, based on Alperovich, of independent claim 19 which is also directed to the teleconferencing aspect of Appellants' invention. As discussed supra with regard to claims 6, 12, and 14, we find no disclosure in Alperovich which would reasonably correspond to the teleconferencing features as set forth in claim 19.

In summary, we have not sustained the Examiner's 35 U.S.C. § 102(b) rejection of claim 19. With respect to the Examiner's 35 U.S.C. § 103(a) rejection of claims 1-18, we have sustained the rejection of claims 1-5, 7-11, 13, and 15-18, but have not sustained the rejection of claims 6, 12, and 14. Accordingly, the Examiner's decision rejecting appealed claims 1-19 is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv)(effective September 13, 2004).

AFFIRMED-IN-PART

KENNETH W. HAIRSTON Administrative Patent Judge	)	
	)	BOARD OF PATENT APPEALS
JOSEPH F. RUGGIERO Administrative Patent Judge	)	AND
	)	INTERFERENCE
HOWARD B. BLANKENSHIP Administrative Patent Judge	)	

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