

The opinion in support of the decision being entered today is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANDY L. RUSE and BLAKE A. SWEETEN

Appeal 2007-0374
Application 09/891,167
Technology Center

Decided: August, 10 2007

Before KENNETH W. HAIRSTON, LANCE LEONARD BARRY, and,
JEAN R. HOMERE, *Administrative Patent Judges*.

BARRY, *Administrative Patent Judge*.

I. STATEMENT OF THE CASE

A Patent Examiner rejected claims 1-18. The Appellants appeal therefrom under 35 U.S.C. § 134(a). We have jurisdiction under 35 U.S.C. § 6(b).

A. INVENTION

The invention at issue on appeal delivers messages based on a trend analysis. Because of the rapid development of computers and communications, people can be reached many ways. For example, a person may have one or more cellular telephones, a home telephone connected to the local public switched telephone network, an office telephone connected to a private branch exchange, and one or more e-mail accounts accessible via the Internet, a local area network, or a wide area network. Further, many people also have voice mail, a satellite telephone, a pager, fax machines, or wireless application protocol cellular telephones. A problem with having so many different ways to contact a person is knowing where to begin. (Specification 1.)

Accordingly, the Appellants' invention comprises modules for monitoring, trend analysis, and forwarding. For its part, the monitoring module monitors a user's responses to incoming calls and messages. More specifically, the module stamps the responses with a time-of-day and day-of-week and stores these in a database. Once an adequate number of responses have been stored in the database, the trend analysis module performs a statistical trend analysis on the responses. The latter module generates a table indicating the probability of contacting the user via a specific method for a specific time period and day of the week. Whenever an incoming call or message arrives thereafter, the forwarding module accesses the trend analysis table and forwards the incoming call or message via the method having the highest probability of contacting the user. (*Id.* 16.)

B. ILLUSTRATIVE CLAIM

Claim 1, which further illustrates the invention, follows:

1. A method for forwarding messages, comprising:

monitoring locations of responses to incoming messages along with the time of day and day of week;

storing each response along the associated time of day and day of week in a database;

performing a statistical trend analysis on a user basis to determine a probability of contacting the user for a given time of day and day of week at a given location;

storing in a trend analysis table the result of the statistical trend analysis performed; and

transferring incoming messages to the location in the trend analysis table with the highest probability of contacting the user.

C. REJECTION

Claims 1-18 stand rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 6,405,035 ("Singh") and U.S. Patent No. 6,028,514 ("Lemelson").

II. ISSUE

"Rather than reiterate the positions of parties *in toto*, we focus on the issue therebetween." *Ex Parte Filatov*, No. 2006-1160, 2007 WL 1317144, at *2 (B.P.A.I. 2007). The Examiner admits, "Singh does not disclose monitoring when and where a **response** is transmitted due to the incoming message." (Answer 10.) He finds, however, "Lemelson taught the concept

of monitoring for **responses** to paged messages. (Col 16, line 53 – Col 17, line 14)." (*Id.*) The Examiner then makes the following allegations.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Singh and Lemelson because the teachings of Lemelson to monitor the response to messages [sic] would improve the system of Singh by improving the probability of forwarding messages to the correct location of the user as determining the location of the response to messages would provide the current location of the user. Furthermore, in determining the location of where a response was sent, this would would [sic] indicate a location that the client has been for an extended period of length instead of at the time of accessing a message. Transmitting to this location would further increase the likelihood that messages will be forwarded to where the client currently is located.

(Answer 10-11.) The Appellants "respectfully submit that there is no suggestion or motivation to combine Singh and Lemelson beyond the impermissible use of hindsight." (Reply Br. 3.) Therefore, the issue is whether the Examiner has presented evidence to support his allegation that a person of ordinary skill in the relevant field would have been prompted to combine teachings of Singh and Lemelson in the way the claimed invention does.

III. LAW

"[I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does." *KSR Int'l v. Teleflex Inc.*, 127 S.Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007). A reason to combine teachings from the prior art "may be found in explicit or implicit teachings within the

references themselves, from the ordinary knowledge of those skilled in the art, or from the nature of the problem to be solved." *WMS Gaming Inc. v. Int'l Game Tech.*, 184 F.3d 1339, 1355, 51 USPQ2d 1385, 1397 (Fed. Cir. 1999) (citing *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998)). "The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular." *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) (citing *C.R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed.Cir.1998)). "Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence.'" *Id., Id.*

IV. ANALYSIS

Here, Singh "is directed to a message system that forwards messages to the subscriber such that they [sic] may receive the message in a timely manner." (Col. 1, ll. 53-55.) More specifically, the reference explains that "timeliness is important to the subscriber who buys and sells stocks on the stock market. The subscriber will want to be notified at the time a particular stock of interest either reaches a predetermined high or low value such that the subscriber can sell or buy the stock." (*Id.* ll. 13-17.) As aforementioned, the Examiner admits, "Singh does not disclose monitoring when and where a **response** is transmitted due to the incoming message." (Answer 10.)

For its part, Lemelson "provide[s] a compact, electronic personal emergency safety warning unit to be carried by persons or provided in homes, buildings, automobiles or the like . . . to permit transmission of

requests for assistance when dangerous or emergency conditions are encountered." (Col. 5, ll. 38-46.) More specifically, the secondary reference's "FIGS. 5A and 5B provide a high level flow chart for the operation of [a] central alarm and warning monitor/response center 10 . . . in response to a received alarm message generated by warning unit 12. . . ." (Col. 16, ll. 10-13.)

The part of Lemelson relied on by the Examiner describes "broadcasting an emergency assistance/response page. This paging signal is intended to illicit [sic] a response from emergency assistance/response personnel that may be in the vicinity or area of the warning unit 12 that issued the original distress message." (*Id.* ll. 52-56.) The Examiner is correct that "the monitor center 10 checks for responses to the paging message at unit block 206." (*Id.* ll. 56-58.) Furthermore, "[o]nce a response message is received at block 214, control is passed to block 216 which sends a confirmation message to warning unit 12 that will inform the user of the warning unit that emergency assistance/response is en-route." (Col. 17, ll. 14-18.)

"If no response to the page is received after a designated time," (col. 16, ll. 58-59), the page is retransmitted until "a total of 'M' tries have been made. . . ." (Col. 16, l. 66 – col. 17, l. 1.) If no response is received after the M tries, "control is passed to dispatch back-up assistance/response block 212 where assistance/response is dispatched even though it may take longer to reach the location of the warning unit 12 than it would have if

responded to at the time the alarm message was originated." (Col. 17, ll. 7-11.)

In summary, Lemelson checks for responses to a paging message to ensure that emergency assistance/response personnel answer a request for assistance. Because Singh does not mention transmitting a request for assistance upon encountering dangerous or emergency conditions, however, we are unpersuaded that a person of ordinary skill in the relevant field would have been prompted to combine Lemelson's checking of responses with Singh's message system. Furthermore, the Examiner has presented no evidence to support his allegation that checking for responses to messages would have "improv[ed] the probability of forwarding messages to the correct location of the user as determining the location of the response to messages would provide the current location of the user," (Answer 11), or "would further increase the likelihood that messages will be forwarded to where the client currently is located." (*Id.*)

V. ORDER

For the aforementioned reasons, we reverse the rejection of claims 1-18. The "Appellants . . . request that the Board of Patent Appeals and Interferences . . . direct the Examiner to pass the case to issue." (Reply Br. 13.) "Withdrawal of the rejections is [also] . . . requested." (*Id.*) In an *ex parte* appeal, however, the Board "is basically a board of review C we review . . . rejections made by patent examiners." *Ex parte Gambogi*, 62 USPQ2d 1209, 1211 (B.P.A.I. 2001). We lack authority to direct an examiner to withdraw an Office action or to issue a Notice of Allowance.

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It is Patent Examiners who have the authority to withdraw their rejections, M.P.E.P. §§ 707.07(e), 1004, 1005, and to allow claims. *Id.* at §§ 1005, 1302.13.

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REVERSED

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