

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

3  
4 UNITED STATES PATENT AND TRADEMARK OFFICE

5  
6  
7 BEFORE THE BOARD OF PATENT APPEALS  
8 AND INTERFERENCES

9  
10  
11 *Ex parte* BJORN MARKUS JAKOBSSON

12  
13  
14 Appeal 2007-1751  
15 Application 09/769,511  
16 Technology Center 3600

17  
18  
19 Decided: July 26, 2007

20  
21  
22 Before WILLIAM F. PATE, LINDA E. HORNER, and ANTON W. FETTING,  
23 *Administrative Patent Judges.*

24 FETTING, *Administrative Patent Judge.*

25 DECISION ON APPEAL

26  
27  
28 STATEMENT OF CASE

29 Bjorn Markus Jakobsson (Appellant) seeks review under 35 U.S.C. § 134 of a  
30 final rejection of claims 2-6 and 8-19, the only claims pending in the application on  
31 appeal.

32 We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6.

33  
34 We AFFIRM.

1       The Appellant invented improved techniques for controlling access of  
2 telemarketers or other types of call originators to user terminals of a  
3 communication system (Specification 2). An understanding of the invention can  
4 be derived from a reading of exemplary claim 16, which is reproduced below  
5 [bracketed matter added].

6           16. A method for controlling access of call originators to user  
7 terminals in a communication system, the method comprising the  
8 steps of:

9           [1] storing for a given user terminal of the system a set of *user-*  
10 *specified* access cost information to be applied to one or more  
11 incoming calls directed to the user terminal; and

12           [2] determining an amount to charge an originator of a given  
13 incoming call directed to the user terminal [3] based at least in part on  
14 an access cost for the given incoming call as determined from the  
15 user-specified access cost information;

16           [4] wherein the user-specified access cost information is at least in  
17 part entered by the user at a web site associated with a service  
18 provider that implements the storing and determining steps. (emphasis  
19 not in original.)

20  
21       This appeal arises from the Examiner's Final Rejection, mailed January 31,  
22 2006. The Appellant filed an Appeal Brief in support of the appeal on October 9,  
23 2006, and the Examiner mailed an Examiner's Answer to the Appeal Brief on  
24 December 8, 2006. A Reply Brief was filed on December 27, 2006.

25

PRIOR ART

The prior art references of record relied upon by the Examiner in rejecting the appealed claims are:

|                 |                                     |               |
|-----------------|-------------------------------------|---------------|
| Haralambopoulos | US 5,148,474                        | Sep. 15, 1992 |
| Greene          | US 5,568,541                        | Oct. 22, 1996 |
| Chang           | US 5,958,016                        | Sep. 28, 1999 |
| Lynch-Aird      | US 6,240,402 B1                     | May 29, 2001  |
|                 | (§ 371 filing date Mar. 11, 1998)   |               |
| Harrison        | US 6,595,424 B1                     | July 22, 2003 |
|                 | (provisionally filed Jan. 26, 1996) |               |

REJECTIONS

Claims 2-5, 8-12, and 15-19 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Greene, Lynch-Aird, and Chang.

Claim 6 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Greene, Lynch-Aird, Chang, and Harrison.

Claims 13 and 14 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Greene, Lynch-Aird, Chang, Harrison, and Haralambopoulos.

ISSUES

The issues pertinent to this appeal are whether the Appellant has sustained its burden of showing the Examiner erred in rejecting:



1           06. Thus, “user-specified access cost information” is information in some  
2           way pertaining to costs that are stated, either directly or indirectly, by the  
3           user as a condition for the ability to communicate with a user.

4           *Greene*

5           07. Greene is directed towards adding a surcharge to the cost per call for  
6           telephone solicitations and for crediting a portion of the surcharge to the  
7           account of the person called (Green, col. 1, ll. 8-11).

8           08. In one embodiment of Greene’s invention, the subscriber's specified  
9           call billing parameters are incorporated into a standard Automatic  
10          Message Accounting record which is generated by a carrier switch  
11          network for each call. This record is sent to a billing system which  
12          processes the charges for inclusion in the network bill sent to the caller  
13          and credits a portion of those charges to the account of the person called  
14          (Greene, col. 2, ll. 61-67).

15          09. If a call using Greene’s invention is made from a preselected number,  
16          i.e., a number which has been approved for direct access to the  
17          subscriber, the call is completed in a conventional manner. However, if  
18          the number of the calling party is not on the list of pre-approved  
19          numbers, the call is identified as a telephone solicitation, and the  
20          automated answering system advises the person making the call that a  
21          surcharge may or will (at the subscriber's option) be added to their bill  
22          (Green, col. 3, ll. 43-51).

---

<sup>1</sup> American Heritage Dictionary of the English Language (4<sup>th</sup> ed. 2000).

1           10. Greene's subscribers enter or program preselected telephone numbers  
2                   and/or a local exchange into their telephone system (Greene, col. 3,  
3                   ll. 27-29).

4           11. In Greene's invention, the subscriber has an option to void or waive  
5                   the surcharge as for example, by pressing one or more keys on his  
6                   telephone key pad. If, for example, the subscriber is sympathetic to a  
7                   particular charity or solicitation, he or she may void the surcharge at any  
8                   time during the conversation by causing the call to bypass the billing and  
9                   crediting functions (Green, col. 3, l. 65 – col. 4, l. 4).

10           *Lynch-Aird*

11           12. Lynch-Aird is directed towards charge allocation in multi-user  
12                   networks in which access to the network is not controlled by the network  
13                   provider (Lynch-Aird, col. 1, ll. 5-8).

14           13. Lynch-Aird provides a communication network with at least two user  
15                   access points, wherein each user may be allocated a plurality of user  
16                   identifiers associated with respective predetermined charging schemes.  
17                   The network is arranged to accept communications including user  
18                   identifiers in each of a destination identifier field and a source identifier  
19                   field and a communication monitoring point is arranged to monitor user  
20                   identifiers in a communication to determine the charging scheme  
21                   (Lynch-Aird, col. 2, ll. 43-55).

22           *Chang*

23           14. Chang is directed towards providing telephone service customers with  
24                   a standardized interface for access to service control and management

1 elements of a communication network, such as the telephone network,  
2 via a public packet switched data network, such as the Internet (Chang,  
3 col. 1, ll. 6-11).

4 *Haralambopoulos*

5 15. Haralambopoulos is directed towards specifying value added  
6 telephone charges (Haralambopoulos, col. 1, ll. 7-15).

7 16. Haralambopoulos allows the caller to alter the billing by a user action  
8 (Haralambopoulos, col. 5, ll. 1-19).

9  
10 PRINCIPLES OF LAW

11 *Claim Construction*

12 During examination of a patent application, pending claims are given  
13 their broadest reasonable construction consistent with the specification. *In*  
14 *re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969);  
15 *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364, 70 USPQ2d 1827,  
16 1834 (Fed. Cir. 2004).

17 Although a patent applicant is entitled to be his or her own lexicographer of  
18 patent claim terms, in *ex parte* prosecution it must be within limits. *In re Corr*,  
19 347 F.2d 578, 580, 146 USPQ 69, 70 (CCPA 1965). The applicant must do so by  
20 placing such definitions in the Specification with sufficient clarity to provide a  
21 person of ordinary skill in the art with clear and precise notice of the meaning that  
22 is to be construed. *See In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ 2d 1671, 1674  
23 (Fed. Cir. 1994) (although an inventor is free to define the specific terms used to  
24 describe the invention, this must be done with reasonable clarity, deliberateness,

1 and precision; where an inventor chooses to give terms uncommon meanings, the  
2 inventor must set out any uncommon definition in some manner within the patent  
3 disclosure so as to give one of ordinary skill in the art notice of the change).

4 *Obviousness*

5 A claimed invention is unpatentable if the differences between it and the  
6 prior art are “such that the subject matter as a whole would have been obvious at  
7 the time the invention was made to a person having ordinary skill in the art.”  
8 35 U.S.C. § 103(a) (2000); *KSR Int’l v. Teleflex Inc.*, 127 S. Ct. 1727, 82 USPQ2d  
9 1385 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 13-14 (1966).

10 In *Graham*, the Court held that that the obviousness analysis is bottomed on  
11 several basic factual inquiries: “[1] the scope and content of the prior art are to be  
12 determined; [(2)] differences between the prior art and the claims at issue are to be  
13 ascertained; and [(3)] the level of ordinary skill in the pertinent art resolved.” 383  
14 U.S. at 17. *See also KSR Int’l v. Teleflex Inc.*, 127 S. Ct. 1727, 82 USPQ2d 1385  
15 (2007).

16 A combination of familiar elements according to known methods is likely to be  
17 obvious when it does no more than yield predictable results. *KSR*, at 1731, 82  
18 USPQ2d at 1396.

19 For the same reason, “if a technique has been used to improve one device, and  
20 a person of ordinary skill in the art would recognize that it would improve similar  
21 devices in the same way, using the technique is obvious unless its actual  
22 application is beyond that person’s skill.” *Id.*

23 “In determining whether the subject matter of a patent claim is obvious, neither  
24 the particular motivation nor the avowed purpose of the patentee controls. What

1 matters is the objective reach of the claim. If the claim extends to what is obvious,  
2 it is invalid under § 103.” *Id.* at 1741-42, 82 USPQ2d at 1397.

3 “One of the ways in which a patent’s subject matter can be proved obvious is  
4 by noting that there existed at the time of invention a known problem for which  
5 there was an obvious solution encompassed by the patent’s claims.” *Id.* at 1742,  
6 82 USPQ2d at 1397.

7 ANALYSIS

8 *Claims 2-5, 8-12, and 15-19 rejected under 35 U.S.C. § 103(a) as obvious over*  
9 *Greene, Lynch-Aird, and Chang.*

10 *Independent Claim 16*

11 The Appellant argues claims 2-5, 8, 10, 11, and 15-19 as a group.  
12 Accordingly, we select claim 16 as representative of the group. Claims 9 and 12  
13 are argued separately.

14 The Examiner found that Greene discloses claim element [2], wherein the  
15 access cost is charged to the originator and credit at least in part to an account of a  
16 called party associated with the user terminal (Answer 3, second to last ¶).  
17 However the Examiner further found that Greene does not disclose the remaining  
18 limitations of claim 16 (Answer 3, last ¶).

19 To overcome this deficiency, the Examiner found that Lynch-Aird discloses  
20 claim element [1], that charging information can be maintained in a suitable  
21 charging table; and claim element [3], in which an entry is kept against each  
22 allocated recipient identifier indicating the charging scheme associated with the  
23 recipient identifier (Answer 4, first ¶).

1 The Examiner also found that Chang discloses claim element [4], a web page  
2 which enables subscriber access to control and reporting functionalities of a  
3 communication network, such as the advanced intelligent telephone network  
4 (Answer 4, second ¶).

5 The Examiner concluded that it would have obvious to one of ordinary skill to  
6 modify Greene to include the feature of Lynch-Aird and Chang to provide  
7 recipient identifiers to indicate that the corresponding customer received the call  
8 and to determine which party pays, as well as, providing the subscriber with online  
9 capabilities to modify their service.

10 The Appellant contends that in independent claim 16, it is the user (i.e., the  
11 entity receiving the incoming call) in the claimed method that specifies the access  
12 cost information rather than the service provider, network operator or other entity  
13 (Br. 5, second to last ¶).

14 The Appellant contends that Lynch-Aird does not describe access cost  
15 information specified by the user (Br. 7, first ¶). With respect to Greene, Appellant  
16 notes that Greene refers to "subscriber's specified call billing parameters" rather  
17 than subscriber-specified call billing parameters (emphasis in original). The  
18 Appellant further contends that the Examiner explicitly states on p. 2 of the final  
19 Office Action that "Greene does not disclose that the user-specified access cost  
20 information includes one or more access rules specified by the user and indicates a  
21 particular access cost for an incoming call under one or more specified conditions."  
22 The Appellant concludes that Greene, like Lynch-Aird, does not teach or suggest  
23 "user-specified access cost information" like that claimed in claim 16 (Br. 7 second  
24 to last ¶).

1       The Appellant also contends the Examiner failed to show some suggestion or  
2 motivation, either in the references themselves or in the knowledge generally  
3 available to one of ordinary skill in the art, to modify the reference or to combine  
4 reference teachings (Br. 8, second to last ¶).

5       Thus, the issues under contention are whether Greene or Lynch-Aird shows a  
6 set of *user-specified* access cost information to be applied to one or more incoming  
7 calls directed to the user terminal, and whether it is proper to combine the applied  
8 references.

9       The claim element “user-specified access cost information” is construed  
10 according to its broadest reasonable interpretation as information in some way  
11 pertaining to costs that are stated, either directly or indirectly, by the user as a  
12 condition for the ability to communicate with a user (FF 06).

13       Greene describes the subscriber's specified call billing parameters incorporated  
14 into a record sent to a billing system which processes the charges for inclusion in  
15 the network bill sent to the caller (FF 08).

16       We find that a subscriber’s specified call billing parameter is information in  
17 some way pertaining to costs that are stated, either directly or indirectly, by the  
18 user as a condition for the ability to communicate with a user.

19       Thus, Green shows the claim element of a set of *user-specified* access cost  
20 information to be applied to one or more incoming calls directed to the user  
21 terminal, and we find the Appellant’s arguments unpersuasive.

22

23

1           The remaining issue is whether the applied references are properly  
2 combined.

3           We find that Greene is directed towards charging a surcharge to a caller  
4 (FF 07), that Lynch-Aird is directed towards applying different charging schemes  
5 to calls by using multiple recipient identifiers when multiple networks are  
6 involved, (FF 12-13) and Chang is directed toward providing telephone users with  
7 an internet interface to manage their accounts (FF 14).

8           We further find that the Examiner's stated motivation to provide recipient  
9 identifiers to indicate that the corresponding customer received the call and to  
10 determine which party pays, as well as, providing the subscriber with online  
11 capabilities to modify their service is supported by these teachings with the art  
12 applied.

13           We understand the Examiner's findings as to motivation to be that Greene  
14 provides the basic call charging scheme, but its high level teachings raise some  
15 implementation detail issues, such as how the system actually traps the identities of  
16 the caller and subscriber. Lynch-Aird is directed toward solving this  
17 implementation detail by the use of originator and recipient identifiers (FF 12-13).  
18 Similarly, Greene does not identify the mechanism that its subscriber would  
19 employ to actually provide the information needed to implement the charging  
20 scheme. Chang is directed toward solving that implementation detail by providing  
21 a standardized interface for managing telephone service through an internet  
22 interface (FF 14).

23           As held in *KSR*, a combination of familiar elements according to known  
24 methods is likely to be obvious when it yields predictable results. Fleshing out

1 Green with implementation details such as party identifiers and an administrative  
2 interface does no more than so identify the parties and allow administration.

3 Similarly, it is the objective reach of the claim that controls, not the patentee's  
4 particular motivation, and one of the ways to show obviousness is noting a known  
5 problem for which there was an obvious solution encompassed by the claim at  
6 issue. *See KSR*. The objective reach of this claim extends no further than Greene,  
7 which identified the known problem regarding the need to charge callers, with  
8 Lynch-Aird and Chang providing obvious implementation detail solutions.

9 Therefore, it would have been obvious to a person of ordinary skill in the art to  
10 have combined Lynch-Aird's and Chang's implementation details to Greene's  
11 caller charging scheme to reach the claimed subject matter.

12 Thus, we find that the applied references are properly combined, and we find  
13 the Appellant's arguments unpersuasive.

14  
15 *Dependent Claim 9*

16 The Appellant separately argues the patentability of claim 9. Claim 9 adds the  
17 limitation that the user-specified cost information is stored in a database associated  
18 with the user terminal.

19 Appellant's argument is that, the examiner fails to point with any level of  
20 specificity where the proposed reference combination teaches or suggests this  
21 limitation (Br. 9:Second full ¶).

1       Greene's subscribers enter or program preselected telephone numbers and/or a  
2 local exchange into their telephone system (FF 10). Greene does not describe the  
3 physical characteristics delineating the telephone system's location, but the act of  
4 entering this data into their phone system at least suggests that the data be, if not  
5 outright implies that the data is, stored locally, similar to the storage of speed dial  
6 numbers in handset databases. Thus, we find the Appellant's arguments  
7 unpersuasive.

8 *Dependent Claim 12*

9       The Appellant separately argues the patentability of claim 12. Claim 12 adds  
10 the limitation that a user associated with the terminal is permitted to waive the  
11 access cost for the given incoming call [from intermediate claim 11] wherein the  
12 waiver of the access cost is in response to an offer from the call originator made  
13 after the incoming call is routed to and accepted at the user terminal.

14       Appellant's argument is that Greene does not teach or suggest that the "waiver  
15 of the access cost is a result of an offer and acceptance in the manner claimed "  
16 (Br. 9:Last full ¶).

17       In response to the Appellant's argument, the Examiner asserts that Greene  
18 teaches that the subscriber has an option to void or waive the surcharge, and if the  
19 subscriber is sympathetic to a particular charity or solicitation, he or she may void  
20 the surcharge at any time during the conversation by causing the call to bypass the  
21 billing and crediting functions (Answer 10-11). This is consistent with our  
22 findings (FF 11).

23       This portion of Greene clearly recites that the waiver may be made in response  
24 to a solicitation, which may be characterized as an offer. Therefore, we find the  
25 Appellant's arguments unpersuasive.

1 The Appellant has not separately argued claims 2-5, 8, 10, 11, and 15-19, and  
2 thus they fall with claim 16.

3 Accordingly we sustain the Examiner's rejection of claims 2-5, 8-12, and 15-19  
4 rejected under 35 U.S.C. § 103(a) as obvious over Greene, Lynch-Aird, and  
5 Chang.

6  
7 *Claim 6 rejected under 35 U.S.C. § 103(a) as obvious over Greene, Lynch-Aird,*  
8 *Chang, and Harrison.*

9 The Appellant contends that claim 6 is patentable for the same reasons as claim  
10 16 (Br. 10:Top of page), and therefore claim 6 stands or falls with claim 16. We  
11 found the Appellant's arguments, *supra*, regarding claim 16 unpersuasive.

12 Accordingly we sustain the Examiner's rejection of claim 6 under 35 U.S.C.  
13 § 103(a) as obvious over Greene, Lynch-Aird, Chang, and Harrison.

14  
15 *Claims 13 and 14 rejected under 35 U.S.C. § 103(a) as obvious over Greene,*  
16 *Lynch-Aird, Chang, Harrison, and Haralambopoulos.*

17 Claim 13 adds the limitation that the set of user-specified access cost  
18 information comprises one or more access rules specified by the user and  
19 indicating a particular access cost for an incoming call under one or more specified  
20 conditions, and at least one of the one or more access rules is associated with an  
21 identifier of a particular call originator.

22 The Examiner found that Haralambopoulos discloses that the service provider  
23 (called party) has a plurality of individual value-added telephone numbers with  
24 each representing a different billing rate to reflect the services rendered, and

1 further disclose that in addition to time related billing rates, the service provider  
2 (called party) may have numbers which enable a single item charge. The Examiner  
3 concluded that it would have been obvious to one of ordinary skill to modify the  
4 system of Greene with the teachings of Haralambopoulos in order to store the  
5 caller-specified costs and rules in a database associated with the user terminal to  
6 provide the user the convenience to modify or change charges and rules (Answer 7:  
7 ¶ referring to claim 13 and 14).

8 The Appellant contends that Haralambopoulos describes a system which  
9 depends on an action by the called party. Claim 13, on the other hand, describes a  
10 system in which any access costs incurred by the caller are dependent on one or  
11 more specified conditions associated with an incoming call. The Appellant  
12 contends that these conditions are intrinsic to the incoming call and no actions by  
13 the caller during a conversation are required to establish a billing rate. (Br. 10:Last  
14 full ¶ - 10:Top of page).

15 Thus, the issue under contention is whether claim 13 requires that no action by  
16 the caller is required to establish a billing rate. Claim 13 contains the transition  
17 phrase “comprises,” which is open ended in that additional elements might be  
18 included within an embodiment and still be within the scope of the claim. Thus, so  
19 long as the applied art shows one or more access rules specified by the user and  
20 indicating a particular access cost for an incoming call under one or more specified  
21 conditions, as Greene does (FF 08-10), then there is no requirement that no action  
22 by the caller is required to establish a billing rate. Thus, we find the Appellant’s  
23 arguments unpersuasive.

24 As to the Appellant’s argument that the combination would change the  
25 principle of operation (Br. 11, First full ¶), citing *In re Ratti*, 270 F.2d 810, 123

1 USPQ 349 (CCPA 1959), while *Ratti* held that a combination of references that  
2 would require a substantial reconstruction and redesign of the elements shown the  
3 prior art as well as a change in the basic principles under which the prior art was  
4 designed to operate is not a proper ground for an obviousness rejection, 270 F.2d at  
5 813, 123 USPQ at 352, what *Ratti* was referring to was reconstruction and redesign  
6 of how all the elements interrelate in a manner relying on operational principles  
7 unforeseeable to a person of ordinary skill.

8 In *Ratti*, claims were directed to an oil seal comprising a bore engaging portion  
9 with outwardly biased resilient spring fingers inserted in a resilient sealing  
10 member. The primary reference relied upon in a rejection based on a combination  
11 of references disclosed an oil seal wherein the bore engaging portion was  
12 reinforced by a cylindrical sheet metal casing. Its seal was incompressible and the  
13 device required rigidity for operation, whereas the claimed invention required  
14 resiliency.

15 But Haralambopoulos' user actions (FF 16), coupled with Greene's automated  
16 billing rates (FF 08), would not do such violence to the operating principles of  
17 Greene. Modifications by substitution, even if they omit the subject matter portion  
18 which a prior art patentee apparently regarded as his contribution to the art along  
19 with such advantages as it might provide, where the modified apparatus is obvious  
20 in view of the prior art and where the retained portion of the subject matter will  
21 operate on the same principles as before, "are not authority for holding a rejection  
22 improper under such circumstances." *In re Umbarger*, 407 F.2d 425, 430-31, 160  
23 USPQ 734, 738 (CCPA 1959), distinguishing *Ratti*. In this case, modifying  
24 Greene by applying Haralambopoulos' user actions still operates on the principles

1 of both Greene and Haralambopoulos, and the combination produces billing rates,  
2 as needed in Jones, Among, and the claimed invention.

3 Therefore, we find the Appellant's arguments unpersuasive.

4 The Appellant contends that claim 14 is patentable for the same reasons as  
5 claim 13 (Br. 11, Last full ¶), and stands or falls with claim 13.

6 Accordingly we sustain the Examiner's rejection of claims 13 and 14 under  
7 35 U.S.C. § 103(a) as obvious over Greene, Lynch-Aird, Chang, Harrison, and  
8 Haralambopoulos.

#### 9 CONCLUSIONS OF LAW

10 The Appellant has not sustained its burden of showing that the Examiner erred  
11 in rejecting claims 2-6 and 8-19 under 35 U.S.C. § 103(a) as unpatentable over the  
12 prior art.

13 On this record, the Appellant is not entitled to a patent containing claims 2-6  
14 and 8-19.

#### 15 DECISION

16 To summarize, our decision is as follows:

- 17 • The rejection of claims 2-5, 8-12, and 15-19 under 35 U.S.C. § 103(a) as  
18 obvious over Greene, Lynch-Aird, and Chang is sustained.
- 19 • The rejection of claim 6 under 35 U.S.C. § 103(a) as obvious over Greene,  
20 Lynch-Aird, Chang, and Harrison is sustained.
- 21 • The rejection of claims 13 and 14 under 35 U.S.C. § 103(a) as obvious over  
22 Greene, Lynch-Aird, Chang, Harrison, and Haralambopoulos is sustained.

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

3

4

AFFIRMED

5

6

7

8

9

10

11

12 vsh

13

14 RYAN, MASON & LEWIS, LLP

15 90 FOREST AVENUE

16 LOCUST VALLEY NY 11560