

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* MICHAEL L. GAILEY, ERIC A. PORTMAN,  
and MICHAEL J. BURGISS

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Appeal 2007-3044  
Application 10/263,566<sup>1</sup>  
Technology Center 2100

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Decided: March 14, 2008

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Before JAMES D. THOMAS, JAY P. LUCAS, and  
ST. JOHN COURtenay III, *Administrative Patent Judges*.

LUCAS, *Administrative Patent Judge*

DECISION ON APPEAL

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<sup>1</sup> Application filed October 3, 2002. Appellants claim the benefit under 35 U.S.C. § 119 of Provisional Application 60/326,826, filed 10/3/2001. The real party in interest is Accenture Global Services, GmbH.

## **STATEMENT OF CASE**

Appellants appeal from a final rejection of claims 1 to 6, 12 to 15, and 24 to 31 under authority of 35 U.S.C. § 134. The Board of Patent Appeals and Interferences (BPAI) has jurisdiction under 35 U.S.C. § 6(b).

Appellants' invention relates to a method for obtaining authorization to enlist qualified users to subscribe to various data services. In the words of the Appellants:

A preferred embodiment of the present invention discloses a method of pushing data service authorization over a wireless access network. In this embodiment, a data service list associated with a respective user of a wireless terminal is generated with a service authorization server. A multi-modal request for authorization for at least one data service contained in the data service list is then created by the service authorization server. After being created, the multi-modal request for authorization is transmitted to the wireless terminal. A response to the multi-modal request for authorization is then generated with the wireless terminal. A user profile in a customer database is then updated based on the response to the multi-modal request for authorization. If the user accepts, the user will be able to receive the data service and if the user rejects, the user will not receive the data service and will no longer receive messages related to the data service.

(Spec. 2-3).

Claim 1 is exemplary:

1. A method of pushing data service authorization over a wireless access network, comprising the steps of:

generating a data service list associated with a respective user of a wireless terminal;

creating a multi-modal request for authorization for at least one data service contained in said data service list;

transmitting said multi-modal request for authorization to said wireless terminal;

generating a response to said multi-modal request for authorization with said wireless terminal; and

updating a user profile in a customer database based on said response to said multimodal request for authorization.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Luzeski	US 6,301,245 B1	Oct. 9, 2001
Tobita	US 6,782,419 B2	Aug. 24, 2004

Rejection:

Claims 1 to 6, 12 to 15, and 24 to 31 stand rejected under 35 U.S.C. 103(a) for being obvious over Luzeski and Tobita.

Appellants contend that the claimed subject matter is not rendered obvious by Luzeski alone, or in combination with Tobita, for failure of the references to teach claimed limitations. The Examiner contends that each of the claims is properly rejected.

We reverse the rejection.

## ISSUE

The issue is whether Appellants have shown that the Examiner erred in rejecting the claims under 35 U.S.C. § 103(a). The issue turns on whether the references teach all of the claimed elements, most particularly, a multi-modal request for authorization for a data service, as claimed.

## FINDINGS OF FACT

The record supports the following findings of fact (FF) by a preponderance of the evidence.

1. Appellants teach a method for encouraging subscribers to authorize acceptance of data services. (Spec., page 1.) A request for authorization is presented to users with various data services for which the user is qualified, but for which they have not yet authorized the activation. (Spec. 10:5-15).
2. Multi-modal messaging is defined in this application as “allows users of wireless terminals to send and receive messages in several data formats at the same time.” (Spec. 2:11.) A “multi-modal request for authorization of data services is preferentially sent to the wireless terminal 14 using a voice-based message and a text-based message.” (Spec. 11:13).

## PRINCIPLES OF LAW

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner’s position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) (“On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.”) (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

“Shortly after the creation of this court, Judge Rich wrote that “[t]he descriptive part of the specification aids in ascertaining the scope and

meaning of the claims inasmuch as the words of the claims must be based on the description. The specification is, thus, the primary basis for construing the claims.” *Standard Oil Co. v. Am. Cyanamid Co.*, 774 F.2d 448, 452 (Fed. Cir. 1985). On numerous occasions since then, we have reaffirmed that point...” *Phillips v. AWH Corp.*, 415 F3d 1303, 1315 (Fed. Cir. 2005).

## **ANALYSIS**

Appellants have invented a method for acquiring from various Company servers a list of data services for which a certain user of a wireless terminal is qualified, but has not accepted service. (Spec. 11:12.) That user is contacted and asked if he would like to sign up for that service. If he says “yes,” then that user’s profile in a customer database is updated to reflect his being subscribed to the service. (*Id.*) A claimed aspect of the contact to that user is that he is approached with a multi-modal request for authorization. “Multi-modal” and “multi-modal request for authorization” are carefully defined in the Specification. (*See* FF2 above.)

The Examiner presents the Luzeski reference to teach the elements of the claim, except for the wireless terminals which are taught by Tobita. (Answer 5, top.) Luzeski teaches a messaging system in which two forms of messages are presented to the user: both (1) e-mail messages and (2) fax or voice messages are presented to the user in a single interface. (Col. 3, ll. 42 to 55). The user signs on to a Web interface 22 (col. 7, l. 7 *et seq.*) presenting his ID and password. The Session Manager then presents the two types of messages to the user on the Web page. (Col. 6., l. 20.)

The Examiner has equated the presentation of the two types of information to the user as “creating a multi-modal request for authorization” as claimed. (Answer 13, middle). He equates sending the login ID and password as transmitting the multi-modal request for authorization. (Answer 15, top). Neither of these interpretations of Luzeski is accepted by the Appellants, and we must agree. Even if we read the request for a log-in as a request for authorization for a data service contained in a list, the request for a log-in is not multi-modal. A single web page, presented in a single mode, is used to request the ID and password and to convey them to the system. That single mode of communications will authorize the data being sent to the user. The Appellants were careful to define multi-modal in the specification, and the term must be considered in view of the definition in the specification. (*See Phillips v. AWH Corp.*, cited above.)

As the Luzeski reference fails to teach a multi-modal request for authorization, or the multi-modal response to said request as recited in claim 26, we do not find it a competent reference to support the rejection under 35 U.S.C. § 103. We also find that Tobita does not supply the missing teachings.

## **CONCLUSION OF LAW**

Based on the findings of facts and analysis above, we conclude that the Examiner erred in rejecting claims 1 to 6, 12 to 15, and 24 to 31.

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Application 10-263566

**DECISION**

The Examiner's rejection of claims 1 to 6, 12 to 15, and 24 to 31 is reversed.

REVERSED

clj

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