

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN DERYK WATERS

Appeal 2008-3196
Application 09/862,185
Technology Center 2600

Decided: September 30, 2008

Before KENNETH W. HAIRSTON, JOHN A. JEFFERY,
and R. EUGENE VARNDELL, JR., *Administrative Patent Judges*.

VARNDELL, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant appeals the Examiner's rejections of claims 1-21 under 35 U.S.C. § 134. We have jurisdiction under 35 U.S.C. § 6(b). We REVERSE.

STATEMENT OF THE CASE

The invention claimed on appeal is directed to a method and system for finding locally-relevant information in a physical or electronic document (71) already possessed by a user (70), which includes sending a query message from a mobile entity (20) associated with the user via a mobile radio infrastructure (10) to a service system (40) (Spec. 12, Fig. 6). The query message identifies the document to the system and provides location data regarding the location of the mobile entity to the service system (Spec. 12, Fig. 6). The service system obtains a document reference indicating where, in the document, information can be found that is relevant to the locality of the mobile entity as indicated by said location data and returns the document reference to the mobile entity (Spec. 12, Fig. 6).

Claim 1, which further illustrates the invention, follows:

1. A method of finding locally-relevant information in a physical or electronic document already possessed by a user, the method comprising the steps of:
 - (a) sending a query message from a mobile entity associated with the user via a mobile radio infrastructure to a service system, the query message identifying the document to the system;
 - (b) providing location data regarding the location of the mobile entity to the service system;
 - (c) under the control of the service system, obtaining a document reference indicating where, in the document, information can be found that is relevant to the locality of the mobile entity as indicated by said location data;
 - (d) returning the document reference to the mobile entity.

The Examiner relies on the following prior art references to show unpatentability:

Huttunen	US 6,356,761 B1	Mar. 12, 2002
Saigh	US 6,633,877 B1	Oct. 14, 2003
Short	US 6,636,894 B1	Oct. 21, 2003

The Final Rejection mailed on July 14, 2004 set forth the following rejections of claims 1-21 on appeal:

1. Claims 1, 3-9, 11, 12, and 14-19 stand rejected as being unpatentable under 35 U.S.C. § 102(e) as being anticipated by Huttunen.
2. Claims 2, 7-9, 15-17, 20, and 21¹ stand rejected as being unpatentable under 35 U.S.C. § 103(a) over Huttunen in view of Saigh.
3. Claims 10 and 13 stand rejected as being unpatentable under 35 U.S.C. § 103(a) over Huttunen in view of Short.

Throughout this opinion, we refer to the most recent Appeal Brief filed August 20, 2007 and the Examiner's Answer mailed October 1, 2007.

GROUPING OF CLAIMS

Only those arguments actually made by Appellant have been considered in this decision. Arguments that Appellant could have made but

¹ Although the statement of the rejection indicates that only claim 2 was rejected, the body of the rejection nonetheless includes claims 7-9, 15-17, 20, and 21 (Ans. 7-8). Accordingly, we presume that the Examiner intended to include these claims in this rejection.

chose not to make in the Brief have not been considered. For purposes of this appeal, claims 2-21 stand or fall with the patentability of independent claim 1. *See* 37 C.F.R. § 41.37(c)(1)(vii).

ISSUE

Has Appellant shown that the Examiner erred in finding that Huttunen teaches all limitations of claim 1 on appeal within the meaning of 35 U.S.C. § 102(e)?

We answer this question in the affirmative.

OPINON

Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. *RCA Corp. v. Appl. Dig. Data Sys., Inc.*, 730 F.2d 1440, 1444 (Fed. Cir. 1984); *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554 (Fed. Cir. 1983).

The Examiner indicates how the claimed invention is fully met by the disclosure of Huttunen (Ans. 3-4, 8). Appellant argues that Huttunen does not teach finding locally-relevant information “in a document already possessed by the user” where the query message identifies the document to the system, as required in the claims on appeal (Br. 4). The Examiner asserts that the disclosure at Fig. 9 and column 8, line 54 to column 9, line 35 of Huttunen teaches sending a query message from a mobile entity associated with the user via a mobile radio infrastructure to a service system,

the query message identifying the document to the system (Ans. 4). The Examiner also asserts that an electronic document stored on the World Wide Web (WWW) is considered a document possessed by the user since the user has access to this document at any time (Ans. 8).

In addition, Appellant argues that Huttunen does not disclose obtaining a document reference indicating where, in the document, information can be found that is relevant to the locality of the mobile entity, as required in the claim on appeal. The Examiner cites Fig. 9 and column 8, line 54 to column 9, line 35 of Huttunen as disclosing such a limitation.

We do not agree with the Examiner's position that a document stored on the WWW is considered a document "already" possessed by the user as required in claim 1 on appeal, because the term "already" in claim 1 on appeal requires or implies that the document is in the user's possession prior to sending the query message. In contrast, a document stored on the WWW as proposed by the Examiner would be present on the user's mobile entity only after sending some type of query message or request to the WWW.

In addition, we do not agree with the Examiner's interpretation of Fig. 9 and column 8, line 54 to column 9, line 35 of Huttunen. These portions of Huttunen are directed to finding information on the WWW or other such network, based on the geographical location of the user, as explained by Appellant (Br. 4). This teaching in Huttunen is different from and not identical to the interrelated limitations in the claims on appeal, which require, among other things, (1) finding a document reference in a document already in the possession of the user that is sent in a query from a mobile entity to a service system and (2) that is based on the locality of the mobile

entity as indicated by location data provided to the service system, and (3) returning the document reference to the mobile entity.

Since the teachings of Huttunen do not teach the previously-mentioned interrelated claim limitations on appeal, the Examiner failed to establish a factual basis for the previously-mentioned interrelated claim limitations on appeal. Accordingly, we will not sustain the Examiner's §102(e) rejection of claims 1, 3-9, 11, 12, and 14-19 as anticipated by Huttunen.

The missing factual basis for the previously-mentioned interrelated claim limitations of appeal is also required to support the legal conclusion of obviousness under § 103(a). *See In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). Accordingly, since the references to Saigh and Short do not cure the deficiencies noted above with respect to independent claims 1 and 14, we will also not sustain the Examiner's obviousness rejections of dependent claims 2, 7-10, 13, 15-17, 20, and 21 based on those references for similar reasons.

CONCLUSION

1. The Examiner's decision rejecting claims 1, 3-9, 11, 12, and 14-19 under 35 U.S.C. § 102(e) over Huttunen is reversed.
2. The Examiner's decision rejecting claim 2, 7-9, 15-17, 20, and 21 under 35 U.S.C. § 103(a) over Huttunen and Saigh is reversed.

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3. The Examiner's decision rejecting claims 10 and 13 under 35 U.S.C. § 103(a) over Huttunen and Short is reversed.

REVERSED

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