

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DOMINIC J. PILEGGI

Appeal No. 98-1528
Application No. 08/374,039¹

ON BRIEF

Before MEISTER, ABRAMS, and FRANKFORT, *Administrative Patent Judges*.

ABRAMS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the decision of the examiner finally rejecting claims 1-6, 9-12 and 22-26, which constitute all of the claims remaining of record in the application.

The appellant's invention is directed to a method of providing acknowledgment from a recipient of an occupant's

¹ Application for patent filed January 18, 1995.

THE REJECTIONS

The following rejections stand under 35 U.S.C. § 103:²

(1) Claims 1-6, 9-12 and 22-26 on the basis of Scragg in view of Sacramento Bee or The Dallas Morning News or The Vancouver Sun.

(2) Claims 1-6, 9-12 and 22-26 on the basis of Official Notice in view of The Vancouver Sun.

The rejections are explained in the Examiner's Answer.

The opposing viewpoints of the appellant are set forth in the Brief and the Reply Brief.

OPINION

We have evaluated the two rejections on the basis that the examiner bears the initial burden of presenting a *prima facie* case of obviousness (see *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993)), which is established when the teachings of the prior art itself would appear to have suggested the claimed subject matter to one of ordinary skill

² Both of these rejections are new, appearing for the first time in the Answer. In view of the fact that the two rejections set forth in Paper No. 5 (the final rejection) were not repeated in the Answer, we shall treat them as having been withdrawn by the examiner.

in the art (see *In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993)).

The first standing rejection of independent claims 1 and 22 is that they are unpatentable over the combined teachings of Scragg and Sacramento Bee, The Dallas Morning News, or The Vancouver Sun. In our view, none of the three combinations advanced by the examiner establish a *prima facie* case of obviousness with regard to the subject matter recited in these two claims, and we therefore will not sustain this rejection.

We begin our analysis by noting that the problem to which the appellant has directed his inventive energies is, as specifically stated in the opening lines of claim 22, reassuring a child that a change of residential address has been received by an ethereal being, as an aid to assisting the child in coping with residential relocation. Claim 1 sets forth the invention in more broad language, in that the preamble does not limit it to a child. The problem of acknowledgment by an ethereal being of an occupant's change of address is not mentioned in any of the applied references. In fact, none of the references are at all concerned with the

acknowledgment of a change of address. In Scragg, the recipient of sent materials acknowledges receipt by returning to the sender a self-addressed post card that the sender has included with the materials. However, whether this is a new address is of no interest or consequence insofar as Scragg is concerned. Scragg also provides no teaching of involving an ethereal being. In the case of the three newspaper references, the sender's letter to an ethereal being at the recipient's address provokes the recipient to respond on behalf of the ethereal being to the address indicated in the sender's letter. While the response is, in effect, an acknowledgment that the sender's letter was received, it is not an acknowledgment that this is a change in address. Therefore, it is our view that the combined teachings of the references, in either of the two rejections, would not have suggested to one of ordinary skill in the art "[a] method for providing acknowledgment from a recipient of an occupant's change of address" wherein the recipient is an ethereal being, which is the invention recited in independent claim 1, or "[a] method of reassuring a child that a change of residential address has been received by an ethereal being," as is the case in independent claim 22.

Nor do any of the references disclose or teach the first step recited in each of the two independent claims, which is "providing a . . . document" to be sent to the ethereal being that identifies the ethereal being as the recipient and is capable of accommodating change of address indicia. Scragg is the only reference in which a document is "provided" to the sender, and while it is capable of accommodating change of address indicia, it does not identify an ethereal being as the intended recipient. As for the other references, while they teach that the sender should create a communication in which the intended recipient is an ethereal being, they do not teach providing such a document to the sender. These same comments apply to the third step in each of the independent claims, which requires "providing" a second document that is returned by the recipient.

In the second rejection of the claims, the examiner begins by proposing that since it is known to configure an e-mail system to acknowledge to a sender receipt by the recipient of a communication (Official Notice), it would have been obvious to one of ordinary skill in the art to send the communication to an ethereal being at an e-mail address, in view of The

Vancouver Sun. Be that as it may, our problem with the rejection resides in the next portion of the examiner's position, which is that it further would have been obvious to include change of address indicia in the sender's communication to notify the recipient of the sender's relocation. No evidentiary basis is provided for this conclusion.

The rationale we expressed above with regard to the first rejection also applies here. Neither of the references is at all concerned with acknowledging a change in address, which is the focus of the appellant's claims, and while their combined teachings might give rise to a method of communicating with an ethereal being, they do not render obvious a method for providing acknowledgment of a change of address from any intended recipient, much less an ethereal being. Moreover, neither teaches "providing" the two documents required by the claims.

SUMMARY

Neither rejection is sustained.

The decision of the examiner is reversed.

REVERSED

JAMES M. MEISTER)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
NEAL E. ABRAMS)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
CHARLES E. FRANKFORT)	
Administrative Patent Judge)	

Hoffmann and Baron
350 Jericho Turnpike
Jericho, NY 11753