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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/108,348	03/29/2002	A.C. McQuaide JR.	BS01391	2143
38516	7590	02/04/2013	EXAMINER	
AT&T Legal Department - SZ			BARQADLE, YASIN M	
Attn: Patent Docketing			ART UNIT	
Room 2A-207			PAPER NUMBER	
One AT&T Way			2456	
Bedminster, NJ 07921			MAIL DATE	
			DELIVERY MODE	
			02/04/2013	
			PAPER	

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte A.C. McQUAIDE JR., DAVID SCOTT,
and XIAOFENG GAO

Appeal 2010-005127
Application 10/108,348
Technology Center 2400

Before DEBRA K. STEPHENS, JOHNNY A. KUMAR, and
TREVOR M. JEFFERSON, *Administrative Patent Judges*.

KUMAR, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from a final rejection of claims 1-5, 11, and 13-21. Claims 6-10 and 12 have been cancelled. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

STATEMENT OF THE CASE

Independent claim 11, reproduced below with disputed subject matter highlighted, is representative of the subject matter on appeal.

11. A method for conducting multiple communications, comprising:

registering a called party as a subscriber with *a third party service provider*;

terminating a call from a caller to the called party;

during the call, prompting the caller with options to receive electronic documents associated with the called party;

during the call, receiving a response to the prompt that indicates which electronic document the caller desires;

sending, during the call between the caller and the called party, a data message from the called party to the service provider, the data message including information identifying the caller and profile information describing the called party's profile;

receiving, at the called party during the call, a response message from the service provider that indicates whether the caller has registered to receive the additional information related to the called party;

when the caller is registered, then, during the call, sending the electronic document from the called party to the service provider; and

forwarding the electronic document from the service provider to an Internet Protocol address associated with the caller, such that the caller's Internet Protocol address remains unknown to the called party.

Rejections on Appeal

The Examiner rejected claims 1, 11, and 18 rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Ans. 3.

The Examiner rejected claims 1-5, 11, and 13-21 under 35 U.S.C. § 103(a) as being unpatentable over Chack (US 6, 751,211 B1, Jun. 15, 2004). Ans. 3-6.

The Examiner alternatively rejected claims 1-5, 11, and 13-21 under 35 U.S.C. § 103(a) as being unpatentable over Brown (US 2003/0112931 A1, Jun. 19, 2003) in view of Chack. Ans. 6-9.

ISSUE 1

Indefiniteness - Claims 1, 11, and 18

As Appellants do not address the indefiniteness rejection, Appellants have waived any argument of error and we summarily sustain the rejection of claims 1, 11, and 18 under 35 U.S.C. § 112, second paragraph, as indefinite. *See* 37 C.F.R. § 41.37(c)(1)(vii).

ISSUE 2

35 U.S.C. § 103(a) – Claims 1-5, 11, and 13-21

Appellants' Contention

1. Appellants contend that the Examiner erred in rejecting independent claim 11¹ under 35 U.S.C. § 103(a) because Brown and Chack do not teach or suggest “*during the call*, prompting the *caller* with options to

¹ Independent claims 1 and 18 recite similar subject matter. Separate patentability is not argued for dependent claims 2-5, 13-17, and 19-21. Therefore, we treat claim 11 as representative for purposes of this appeal.

receive electronic documents associated with the *called party*.” App. Br. 10-14. Appellants further contend the Examiner erred in rejecting independent claim 11 under 35 U.S.C. § 103(a) because Brown and Chack do not teach or suggest “*during the call*, receiving a response to the prompt that indicates which electronic document the *caller* desires.” App. Br. 15-16.

2. Appellants further contend that Brown and Chack do not teach or suggest “a third party service provider” because Chack’s “information provider” and the “transaction processing system” describe an “agent and the caller” and where “the agent sends web pages to the caller’s computer.” App. Br. 11-12.

3. Appellants also contend that the Examiner erred in rejecting claim 11 under 35 U.S.C. § 103(a) because Chack does not teach “receiving, *at the called party during the call*, a response message *from the service provider* that indicates whether the *caller* has registered to receive the additional information related to the called party.” App. Br. 9-10; Reply Br. 5.

Issue on Appeal

Whether the Examiner erred in rejecting claims 1-5, 11, and 13-21 as being obvious over Chack or alternatively over Chack and Brown?

ANALYSIS

35 U.S.C. § 103(a) – Brown and Chack

We have reviewed the Examiner’s rejections in light of Appellants’ arguments (Appeal Brief) that the Examiner has erred. We disagree with Appellants’ conclusions. We adopt as our own (1) the findings and reasons

set forth by the Examiner in the action from which this appeal is taken and (2) the reasons set forth by the Examiner in the Examiner's Answer (Ans. 11-16) in response to Appellants' Appeal Brief. We concur with the conclusions reached by the Examiner. We highlight and address specific findings and arguments for emphasis as follows.

As to Appellants' contention 1, we note that the Examiner has identified the relevant portions of Brown and Chack and has provided sufficient explanation with corresponding citations to various parts of the reference for teaching the feature disputed in Appellants' contention (Ans. 11-14). For emphasis, we note that the Examiner cites to portions of Brown that describe an Interactive Voice Response (IVR) Navigation (Fig. 6) that provides:

audio announcements to a caller directing the caller to press certain telephone keys to navigate the system. At each level of the overall IVR menu, the caller may be presented with one or more options. *Selecting a particular option may bring up yet another level of choices*, connect the caller to a party (e.g., a human) or *information source (e.g., an automated system) matching the caller's choices*, or place the caller in a wait queue for such a party.

In one implementation of this embodiment, the options presented by an IVR system are presented to a caller *graphically* and/or audibly (e.g., on a computing or communication device), in *real-time* or off-line.

Brown, ¶¶ [0154] – [0157], (emphasis ours).

Additionally, Brown discloses that:

one level of the audio menu may be presented at a time, with each choice yielding the suitable options at the *next level (e.g., through a hyperlink)*. Alternatively, multiple levels may be presented together or multiple levels may be condensed to

allow direct selection of a destination rather than being limited to the serial mode of operation of an IVR. In addition, a search tool may be provided so that the caller may search for possible destinations (e.g., ‘technical support,’ ‘reservations’).

Brown, ¶ [0161] (emphasis ours).

Thus, Brown’ IVR system teaches prompting a caller in real-time to select particular options, such as technical support or reservations, or to receive hyper linked information (Brown, ¶¶ 0154] – [0157], [0161]). In other words, we agree with the Examiner that Brown teaches “during a real-time conversation between a caller and an IVR system (500 or 600), providing the caller desired hyper linked information and a search tool (electronic document) for possible desired services such ‘technical support,’ ‘reservations’.” Ans. 12-13. Furthermore, Appellants do not make any substantive arguments to distinguish the disputed limitation from the portions of the reference (Brown ¶¶ [0154] – [0157], and [0161]) relied on by Examiner. As such, we agree with the Examiner that the recited feature “during the call, prompting the caller with options to receive electronic documents associated with the called party,” and “during the call, receiving a response to the prompt that indicates which electronic document the caller desires,” as required by claim 11 is met by the IVR system in Brown.

As to contention 2, we disagree with Appellants’ arguments. Appellants have not provided an explicit definition of “service provider” in their Specification. Appellants’ Specification indicates that the service provider is “capable of receiving registration information from a subscriber and a caller,” (Spec. ¶0006), “interact[s] with the subscriber” using a data network (Spec. ¶0028), the callers register with the service provider using online registration process (Spec. ¶0031), and collects and stores

information in a customer profile database (Spec. ¶0032). Furthermore, the service provider uses information contained in a message to determine whether the caller has registered and agreed to receive content. (Spec. ¶0042). Thus, according to Appellants' Specification, the service provider handles the registration process. Although this disclosure is not limiting to the claimed invention, it provides context for which the term "service provider" is interpreted. Thus, we interpret the claim language "service provider" using the broadest reasonable interpretation consistent with Appellants' disclosure – to include Chack's information provider teaching. Ans. 14. *See In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997). Chack discloses (col. 12, ll. 14-15) that information provider 194 is the "system that handles the registration process." In addition, we agree with the Examiner (Ans. 14) that Chack's information provider 194 (Fig. 8) corresponds to the "third party service provider." Ans. 10-11, 14 (citing Chack, col. 12, ll. 5-12 and ll. 25-59). Specifically, we agree with the Examiner's finding that Chack teaches or at least suggests an information provider 194 for maintaining registry information (unique identifier and IP address) of transaction initiators (callers) that is used to determine whether a user (transaction initiator/caller) is associated with the unique identifier and notifying the determination results to the transaction processing system. Ans. 14.

Accordingly, we agree with the Examiner that the combination of Brown and Chack teaches or at least suggests the invention as recited in independent claim 1 and commensurately recited independent claims 11 and 18. Appellants did not separately argue dependent claims 2-5, 13-17, and 21 and thus, these claims fall with their respective independent claims.

35 U.S.C. § 103(a) – Chack

Regarding contention 3, as noted above, we sustain the Examiner's rejections under 35 U.S.C. § 103(a) as being unpatentable over Brown and Chack. Therefore, Appellants' arguments (App. Br. 9-10; Reply Br. 5) with respect to the Examiner's alternative rejection under 35 U.S.C. § 103(a) as being unpatentable over Chack is moot.

Accordingly, the Examiner did not err in finding the combination of Brown and Chack teaches or suggests the invention as recited in independent claims 1, 11, and 18 and claims 2-5, 13-17, and 19-21, not separately argued.

CONCLUSIONS

The Examiner did not err in rejecting claims 1, 11, and 18 under 35 U.S.C. § 112, second paragraph, as being indefinite.

The Examiner did not err in finding that claims 1-5, 11, and 13-21 are unpatentable over Brown and Chack.

DECISION

The Examiner's rejections of claims 1-5, 11, and 13-21 is affirmed.

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

AFFIRMED

msc