

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LIOUDMILA BLANTS and PETTERI SAARINEN

Appeal No. 2000-2238
Application No. 08/826,922

ON BRIEF

Before FLEMING, GROSS, and BARRY, *Administrative Patent Judges*.
BARRY, *Administrative Patent Judge*.

DECISION ON APPEAL

A patent examiner rejected claims 1-4, 6-9, and 11-14. The appellants appeal therefrom under 35 U.S.C. § 134(a). We reverse.

BACKGROUND

The appellants' invention creates a message for transmission via a short message service ("SMS"). The SMS is a method of communication used by digital mobile phones wherein a character string is transmitted through a communication network without establishing a telephone connection therein. (Spec. at 1.)

According to the appellants, when a user created a short message, heretofore, he formed the message one character at a time. (*Id.*) Because digital mobile phones usually do not contain letter keys, they explain, the user entered letters by pressing numbers, special characters, and function keys in a certain order. (*Id.*) Because the selection of a letter required several keystrokes, adding the appellants, forming a textual message by such means was slow. (*Id.*)

In contrast, the appellants' digital mobile phone uses menus to form a message. More specifically, a user selects parts of the message based on questions or options presented by menus of the phone. (*Id.*) The phone compiles responses from the user into a short message for transmission. (*Id.* at 2.)

A further understanding of the invention can be achieved by reading the following claim:

7. A method for creating a short message on an electrical communication device, which short message is a string of characters complying with a predetermined structure, characterized in that the communication device presents to the user data input options according to said structure and, in response to data entered by the user, said communication device compiles said short message in accordance with said structure, wherein the message is in human readable form.

Claims 1-4, 6-9, and 11-14 stand rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 5,887,249 ("Schmid").

OPINION

Rather than reiterate the positions of the examiner or appellants *in toto*, we address the point of contention therebetween. The examiner asserts, "Schmid clearly disclose [sic] . . . presenting a series of questions related to the selected application to the user (figure 4, #65-67), answering the series of presented questions (#68), processing the answers in the microprocessor (#38), forming a message suitable for transmission (#70) and transmitting the message over the cellular communications system (figure 1)." (Examiner's Answer at 3-4.) The appellants argue that Schmid's "mobile telephone is not described as having the capability of generating messages from message components stored and compiled at the mobile phone." (Reply Br. at 2.) They explain, "[t]here are no suggested responses." (Appeal Br. at 3-4.)

"Analysis begins with a key legal question -- *what is the invention claimed?*" *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1567, 1 USPQ2d 1593, 1597 (Fed. Cir. 1987). In answering the question, "the Board must give claims their broadest reasonable construction. . . ." *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1668 (Fed. Cir. 2000).

Here, independent claim 1 specifies in pertinent part the following limitations:
"storing, within the communication device, at least one possible user response for each

input request, selecting a user response to each request. . . ." Similarly, independent claim 7 specifies in pertinent part the following limitations: "the communication device presents to the user data input options according to said structure. . . ." Also similarly, independent claim 13 specifies in pertinent part the following limitations: "storing at least one application in said storage medium, wherein said application includes, a series of questions relating to said application, a series of answers to said questions, and a series of message components, suitable for transmission in the short message service, correlated to said answers; . . . answering said series of presented questions by selecting from the stored series of answers through the use of the input device. . . ." Similarly, independent claim 14 specifies in pertinent part the following limitations: " a memory for storing a separate data input request for each field and at least one input response for each request; a display for presenting the stored input response to the user; a data input device for allowing the user to select a stored input response. . . ." Giving the independent claims their broadest, reasonable construction, the limitations require that a communications device stores, presents to a user, or allows a user to select one or more predetermined answers to at least one question.

"[H]aving ascertained exactly what subject matter is being claimed, the next inquiry must be into whether such subject matter is novel." *In re Wilder*, 429 F2d 447, 450, 166 USPQ 545, 548 (CCPA 1970). "A claim is anticipated only if each and every

element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (citing *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 715, 223 USPQ 1264, 1270 (Fed. Cir. 1984); *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983); *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 771, 218 USPQ 781, 789 (Fed. Cir. 1983)). “[A]bsence from the reference of any claimed element negates anticipation.” *Kloster Speedsteel AB v. Crucible, Inc.*, 793 F.2d 1565, 1571, 230 USPQ 81, 84 (Fed. Cir. 1986).

Here, although Schmid’s “cellular radiotelephone prompts [a] user for input of . . . account information and then accepts the account information input by the user,” col. 6, ll. 38-40, the examiner fails to allege, let alone show, that the radiotelephone stores one or more predetermined answers to the prompts, presents the answers to the user, or allows him to select the answers. The absence of such a showing negates anticipation. Therefore, we reverse the rejection of claim 1 and claims 2-4, 6, and 12, which depend therefrom; of claim 7 and claims 8, 9, and 11, which depend therefrom; and of claims 13 and 14.

CONCLUSION

In summary, the rejection of claims 1-4, 6-9, and 11-14 under § 102(e) is reversed.

REVERSED

MICHAEL R. FLEMING)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
ANITA PELLMAN GROSS)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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Appeal No. 2000-2238
Application No. 08/826,922

Page 7

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APPLICATION NO. 08/826,922

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APJ GROSS

APJ FLEMING

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Prepared By: APJ BARRY

DRAFT SUBMITTED: 21 Jul 03

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For any additional reference provided, please prepare PTO 892 and include copy of references

Thanks, Judge Barry