

**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(2) is not binding precedent of the Board.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. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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***Ex parte*** LEWIS B. OBERLANDER

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Appeal No. 95-0340  
Application 07/771,685<sup>1</sup>

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ON BRIEF

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Before, FLEMING, BARRETT, THOMAS ***Administrative Patent Judges***.  
FLEMING, ***Administrative Patent Judge***.

**DECISION ON APPEAL**

This is a decision on appeal from the final rejection of  
claims 1 through 20, all of the claims present in the appli-  
cation. The invention relates to a communication network  
including a method for the temporary routing and destination

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<sup>1</sup>Application for patent filed October 4, 1991.

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selection of incoming messages.

The independent claim 1 is reproduced as follows:

1. A method for use with a communication system, which communication system includes an information profile for at least one user, which information profile includes at least some user preferences regarding a plurality of different user destinations for the user, such that the communication system will automatically select a destination from amongst a plurality of candidate destinations for a message intended for the user as a function, at least in part, of the information profile, the method comprising the steps of:

A) accessing the communication system via a communication link using a communication device;

B) transmitting from the communication device via the communication link a temporary over-ride instruction to the communication system to temporarily over-ride at least one element in the information profile while retaining the at least one element from the communication system, such that the temporary over-ride instruction can later be automatically replaced by the at least one element.

The Examiner relies on the following reference:

Riskin                    4,757,267                    Jul. 12, 1988

Claims 1 through 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Riskin.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the brief and answer for the respective details thereof.

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**OPINION**

We will not sustain the rejection of claims 1 through 20 under 35 U.S.C. § 103.

The Examiner has failed to set forth a *prima facie* case. It is the burden of the Examiner to establish why one having ordinary skill in the art would have been led to the claimed invention by the express teachings or suggestions found in the prior art, or by implications contained in such teachings or suggestions. *In re Sernaker*, 702 F.2d 989, 995, 217 USPQ 1, 6 (Fed. Cir. 1983). "Additionally, when determining obviousness, the claimed invention should be considered as a whole; there is no legally recognizable 'heart' of the invention." *Para-Ordnance Mfg. v. SGS Importers Int'l, Inc.*, 73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995), *cert. denied*, 117 S.Ct. 80 (1996) *citing W. L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1548, 220 USPQ 303, 309 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

Appellants argue on pages 4 and 5 of the brief that Appellants' claims are readily distinguishable from Riskin. In particular, Appellants argue that Riskin fails to teach or

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suggest a method for use with a communication system comprising the step of transmitting a temporary over-ride instruction to the communication system to temporarily over-ride at least one element in the information profile without removing at least one element from the communication system, such that the temporary over-ride instruction can later be automatically replaced by the at least one element as recited in Appellants' claims.

The Examiner argues on page 4 of the answer that Riskin in column 28, lines 1-10, teaches transmitting a temporary over-ride instruction to the communication system to temporarily over-ride at least one element in the information profile. The Examiner further states on page 4 of the answer that while Riskin did not specifically teach that the over-ride was to be done without removing the element from the system, such that the over-ride instruction can later be replaced by that element automatically, it would have been obvious to one of ordinary skill in the art at the time of the invention to prevent any deletions of destination number of Product-Dealers from the system because of the increase in integrity of the system gained by preventing persons accessing the system from indiscriminately deleting numbers of vendors and/or vendors from deleting the numbers of their competitors.

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Appellants argue on page 5 of the brief that the Examiner's assertion that column 28, lines 1-10, of Riskin suggests the temporary over-ride of a user destination within the data base is misguided in that the cited passage only teaches that if a certain user (a distributor) is not reachable at their corresponding user destination, the system can continue to route the caller to another user (another distributor) until a connection is made. Appellants argue that because Riskin is only concerned with specifying one user destination for each user, it is not obvious that one would even want to temporarily replace a user destination, let alone retain any temporarily replaced elements.

Upon a closer reading, we find that Riskin teaches a telephone system that automatically connects a potential customer with a nearby dealer who can provide the goods or services desired by the potential customer. The potential customer dials an "800" number which includes digits which uniquely identify the product or services desired. The system identifies the telephone number of the potential customer and a computer routes the call to a dealer in the general vicinity of the potential customer.

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If the dealer's telephone number is busy or does not answer, the system can attempt to call another nearby dealer if one exists.

We note that the Examiner argues that the user is an advertised product or service and the information profile of the user preferences is the database of dealers which can provide the advertised product or service. See the answer pages 3 and 4. However, Appellants' claim 1 recites "transmitting from the communication device via the communication link a temporary over-ride instruction to the communication system to temporarily over-ride the at least one element in the information profile without removing the at least one element from the communication system, such that the temporary over-ride instruction can later be automatically replaced by the at least one element." We note Appellants' remaining claims recite similar limitations. However, we fail to find that Riskin's teaching of a telephone system that can attempt to call another nearby dealer, if the first called dealer's telephone number is busy or does not answer, teaches a temporary over-ride instruction to temporarily over-ride at least one element, the first dealer, in the

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information profile without removing the at least one element

from the communication system, such that the temporary over-ride instruction can later be automatically replaced by the at least one element as recited in Appellant's claims. The Examiner has failed to show that Riskin teaches that the dealer is removed from the information profile much less an a teaching of an over-ride instruction as claimed by Appellants. In fact, in column 28, lines 1-10, Riskin teaches that if first dealer is busy, the system simply calls another dealer. Riskin fails to teach that the dealer number is removed from the information profile and later replaced.

Furthermore, we fail to find any suggestion of modifying Riskin to provide temporary over-ride instruction to temporarily over-ride at least one element in the information profile without removing the at least one element from the communication system, such that the temporary over-ride instruction can later be automatically replaced by the at least one element as recited in Appellant's claims. The Federal Circuit states that "[t]he

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mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the

modification." ***In re Fritch***, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992), ***citing In re Gordon***, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

"Obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor." ***Para-Ordnance Mfg.***, 73 F.3d at 1087, 37 USPQ2d at 1239, ***citing W. L. Gore***, 721 F.2d at 1551, 1553, 220 USPQ at 311, 312-13.

We have not sustained the rejection of claims 1 through 20 under 35 U.S.C. § 103. Accordingly, the Examiner's decision is reversed.

**REVERSED**

JAMES D. THOMAS )  
Administrative Patent Judge )  
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