

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte VIKTORS BERSTIS  
and LINDA ARNOLD LISLE

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Appeal No. 2002-1785  
Application No. 09/239,338

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ON BRIEF

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Before HAIRSTON, BARRETT, and LEVY, Administrative Patent Judges.  
LEVY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-19, which are all of the claims pending in this application.

BACKGROUND

Appellants' invention relates to a store employee locator system. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced as follows:

1. A method for locating store employees, comprising the steps of:

receiving a set of unique signature transmissions by a set of receivers on the store, each transmission emanating from a respective transmitter worn by a store employee;

associating each unique signature with employee biographical information, including an expertise of an employee;

using the transmissions to locate employees in the store;  
and

responsive to a user request for employees having a given expertise, displaying a store map on an informational kiosk display wherein a representation of the location of the employees having the given expertise is shown therein.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Christ	5,977,913	Nov. 2, 1999 (filed: Feb. 5, 1998)
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Claims 1-19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Christ. Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejection, we make reference to the examiner's answer (Paper No. 12, mailed January 23, 2002) for the examiner's complete reasoning in support of the rejection, and to appellants' brief (Paper No. 11, filed November 19, 2001) for appellants' arguments thereagainst. Only those arguments actually made by appellants have been considered in this

decision. Arguments which appellants could have made but chose not to make in the brief have not been considered. See 37 CFR 1.192(a).

OPINION

In reaching our decision in this appeal, we have carefully considered the subject matter on appeal, the rejection advanced by the examiner, and the evidence of obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, appellants' arguments set forth in the brief along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer. Upon consideration of the record before us, we reverse, for the reasons set forth by appellants.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467

(1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole. See id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

We begin with claim 1. As noted by the examiner (Paper No. 3, mailed January 4, 2001), Christ does not specifically show that responsive to a user request for employees having a given expertise, the system displays a map on an informational kiosk wherein a representation of the location of the employees having the given expertise is shown. The examiner's position is that Christ shows that the system displays a map of the facility with the location of a specific transmission highlighted. According to the examiner (id.), since the method of Christ is applicable to storage sites and hospitals, one of ordinary skill in the art would have been motivated to apply the method of locating employees in a store to include the step of displaying a store map on an informational kiosk to show the location of the employee who is an expert in a field in which a customer needs assistance.

Appellants concede (brief, page 4) that Christ shows a prior art method for using the unique signature submitted by a respective transmitter to locate an individual. However, appellants assert (id.) that Christ fails to provide any suggestion or incentive to apply this technology to finding subject matter experts.

Appellants assert (brief, page 5) that Christ fails to teach or suggest the associating and displaying steps of claim 1. It is argued (brief, page 6) that in Christ, it does not matter what the subject matter expertise of the individual might be, and (brief, page 8) that there is no teaching or suggestion in Christ to modify the system to track personnel with a given expertise, because in Christ, emergency is relevant whereas expertise is irrelevant. Appellants further assert (id.) that the examiner is using appellants' own teachings as a blueprint for the rejection, which is impermissible hindsight.

From our review of Christ, we find that Christ is directed to a personal security system employing a locating and tracking device (col. 1, lines 12-14). Christ discloses that security personnel often place their lives at risk merely by showing up for work, and that individuals are unable to notify the main control center that they are in trouble or where they are when trouble arises. Christ discloses that many organizations would benefit from the ability to continuously locate the position of individuals as they move about a facility, such correctional facilities, hospitals, nuclear power plants, and amusement parks, as the frequency of violent crime increases (col. 1, lines 15-32). Christ solves this problem by providing a system of sensors

for locating within a facility, so that upon activation of an alarm, the feedback enables differentiation of the location of the alarm (col. 7, lines 19-23). The system includes a personal alarm transmitter, central monitoring system, and an array of sensors. The central monitoring system locates a person carrying the personal alarm transmitter (col. 7, lines 55-59). If an alarm occurs, a central mapping computer displays the location and identification of each active personal alarm (col. 9, lines 54-62). A map of the facility is presented on the display with the location of the alarm transmission highlighted (col. 12, lines 7 and 8). In one embodiment of the invention, a map of the facility is presented on a PC, upon which alarm conditions are superimposed, and from which an acoustic alarm emits under alarm/system warning conditions (col. 13, lines 50-52).

From the disclosure of Christ, we find that Christ is directed to a personal security system for identifying the location of an individual needing emergency assistance. If applied to a hospital environment, we find that Christ would provide a security system that enables determination of the location of an individual in need of assistance. We find no teaching or suggestion in Christ, and none has been pointed to by the examiner, that would suggest associating an identified

individual with biographical information including an area of expertise of the individual. Nor do we find any teaching or suggestion of "responsive to a user request for employees having a given expertise, displaying a store map on an informational kiosk display wherein a representation of the location of the employees having the given expertise is shown therein" as recited in claim 1. Thus, we agree with appellants (brief, page 9) that "the Christ system locates the position of an emergency, rather than locating various personnel to deal with an emergency," and find that the examiner is using appellants' own teachings as a blueprint for the rejection. "Obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor." Para-Ordnance Mfg. v. SGS Importers Int'l, 73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995) (citing W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1551, 1553, 220 USPQ 303, 311, 312-13 (Fed. Cir. 1983)). "It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992) (citing In re Gorman, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991)).

In sum, because Christ does not address the issues of: associating an individual's signature transmission with the individual's biographical information including the individual's expertise; nor of "responsive to a user request for employees having a given expertise, displaying a store map on an informational kiosk display wherein a representation of the location of the employees having the given expertise is shown therein", we do not agree with the examiner that teachings of Christ would have suggested the claimed associating and displaying limitations. We therefore find that the examiner has failed to establish a prima facie case of obviousness of claim 1. Accordingly, the rejection of claim 1 under 35 U.S.C. § 103(a) is reversed. In addition, because Christ does not teach or suggest the associating and displaying limitations of independent claims 2, 7, and 15, the rejection of claims 2, 7, and 15, along with claims 3-6, 8-14, and 16-19, which depend therefrom, under 35 U.S.C. § 103(a), is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-19 under 35 U.S.C. § 103(a) is reversed.

REVERSED

KENNETH W. HAIRSTON	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
LEE E. BARRETT	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
STUART S. LEVY	)	
Administrative Patent Judge	)	

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