

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BRUCE JACKSON
and
NIGEL ROBERT BROOKES

Appeal No. 2003-1726
Application No. 09/460,450

ON BRIEF

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

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 24, which are all of the claims pending in this application.

Appellants' invention relates to a method and system of managing distribution of content to a device. Claim 22 is illustrative of the claimed invention, and it reads as follows:

22. A method of managing distribution of content to a device, comprising the steps of:

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storing in a database a number of elements as a hierarchical structure, content identifiers being able to be associated with elements in the hierarchical structure, and one of the elements representing the device;

referencing the hierarchical structure in the database to generate a profile for the device, the profile containing a number of content identifiers indicating content to be provided to the device;

with reference to the content identifiers in the profile, causing the content indicated by the profile to be provided to the device;

maintaining a record identifying the content provided to the device in accordance with the profile;

upon receipt of a subsequent profile, comparing the content identifiers in the subsequent profile with the record to determine new content not yet provided on the device and old content no longer to be provided on the device, and using the relevant content identifiers to cause the new content to be provided to the device, and to cause the old content to be removed.

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Perlman et al. (Perlman) 5,742,820 Apr. 21, 1998

Claims 1 through 24 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Perlman.

Reference is made to the Examiner's Answer (Paper No. 16, mailed March 20, 2003) for the examiner's complete reasoning in support of the rejection, and to appellants' Brief (Paper No. 15, filed January 10, 2003) for appellants' arguments thereagainst.

OPINION

We have carefully considered the claims, the applied prior art reference, and the respective positions articulated by appellants and the examiner. As a consequence of our review, we will reverse the anticipation rejection of claims 1 through 24.

"It is axiomatic that anticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim." *In re King*, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986). *See also Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick*, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984). Thus, if any limitation is not disclosed by Perlman, the claims cannot be anticipated.

The examiner states (Answer, page 3) that claims 1-22¹ are rejected as being anticipated by Perlman, but fails to provide an explanation of the rejection or a reference to a prior paper for such an explanation. The final rejection, Paper No. 12, likewise provides no explanation of the rejection, but does refer to the previous action, which was the examiner's First Action, Paper No. 8.

¹ We assume that the examiner meant claims 1 through 24, since the examiner states on page 2 of the Answer that the issue presented by appellants on page 12 of the Brief (whether claims **1 through 24** are unpatentable under 35 U.S.C. § 102(e) over Perlman) is correct.

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Turning to the First Action, we find that the examiner appears to equate Perlman's hierarchical arrangement of database identifiers with the claimed hierarchical structure of elements. However, claim 22 requires that one of the elements that are arranged in the hierarchical structure is the device to which content is distributed. None of the database identifiers qualifies as a device to which content is distributed. Furthermore, claim 22 recites content identifiers which indicate content to be provided to the device. Since none of the identifiers of Perlman has an identifier which indicates content to be provided thereto, Perlman's identifiers cannot be the claimed elements, one of which is the device. Last, since Perlman discloses no other hierarchical arrangement, the claimed step of storing in a database a number of elements as a hierarchical structure is not disclosed by Perlman. Also, as Perlman fails to disclose the content identifiers as claimed, the steps of referencing the hierarchical structure to generate a profile, the profile containing content identifiers indicating content to be provided to the device, and causing the content indicated by the profile to be provided to the device, are not disclosed by Perlman.

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Since the remainder of the claim depends upon the limitations already found lacking in Perlman, clearly those limitations are likewise lacking. Since Perlman fails to disclose each and every limitation of the claim, claim 22 is not anticipated by Perlman. Furthermore, since independent claim 24 includes the same limitations found lacking and independent claims 1 and 23 recite corresponding structure limitations for those found lacking, none of the independent claims are anticipated by Perlman. Accordingly, we cannot sustain the rejection of claims 1 and 22 through 24, nor of their dependents, claims 2 through 21.

CONCLUSION

The decision of the examiner rejecting claims 1 through 24 under 35 U.S.C. § 102(e) is reversed.

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

REVERSED

JOSEPH L. DIXON)	
Administrative Patent Judge)	
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)	
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)	BOARD OF PATENT
ANITA PELLMAN GROSS)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
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LANCE LEONARD BARRY)	
Administrative Patent Judge)	

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