

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STACY HAITSUKA, RONALD BURR,
HAROLD MACKENZIE, MARWAN ZEBIAN,
TERRY WARREN and SHANE BLASER

Appeal No. 2004-0228
Application No. 09/348,411

ON BRIEF

Before KRASS, GROSS, and SAADAT, Administrative Patent Judges.
KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-29.

The invention pertains to ad displays on the internet. In particular, a client application enables access to an online service and causes the display of advertisements while the user uses the client application to access the online service. The client application establishes a communication channel from a

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local device to the online service and the client application receives play lists from the online service provider. The play lists include information about advertisements to be played and the order of play.

Representative independent claim 1 is reproduced as follows:

1. A method of displaying advertisements to a user of an online service using a client application on a local device, the local device including an input device and an output device, the local device accessing the online service and providing interaction with the online service, the method comprising the steps of:

the client application becoming active;

the client application establishing a communication channel from the local device to the online service;

the client application receiving a first play list;

the client application displaying a client window on the output device of the local device, wherein the client window displays continuously so long as the communication channel from the local device to the online service is maintained;

the client application causing advertisements to be displayed in an ad pane of the client window, wherein the display of advertisements operates in accordance with the first play list, the first play list comprising plural ad objects, each ad object comprising a resource locator for a given advertisement and a resource locator for a click-through associated with the given advertisement, the first play list further specifying an order in which the advertisements identified in the first play list are to be displayed.

The examiner relies on the following reference:

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In the examiner's explanation of the rejection, at pages 3-4 of the answer, the examiner contends, with regard to independent claims 1, 8 and 26, that Hoyle teaches the claimed subject matter but for a client window that is displayed continuously as long as the communication channel is maintained. But, the examiner finds that it would have been obvious to implement the continuous displaying of the client window as long as the communication channel is maintained. "Motivation of the implementation is for continuously maintaining the communication interface window for communicating with the client" (answer-page 3).

Appellants assert that Hoyle fails to teach the claimed "client application establishing a communication channel from the local device to the online service" recited in claim 1 and, analogously, in claims 8 and 26.

In particular, appellants point to column 8, lines 53-63, of the reference to show that Hoyle teaches that a client application may be used to download and install software but that this "in no way teaches or suggests establishing a connection with a server." It is appellants' position that this portion of Hoyle implies the prior existence of a connection, so that it cannot suggest that a client application establishes a communication channel from the local device to the online

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service, as claimed. Similarly, with regard to column 8, lines 30-35, column 13, lines 56-58, and column 16, lines 24, through 56-58, reciting access to a server, appellants argue that this implies a prior connection so that it cannot suggest the client application establishing the communication channel.

We agree with appellants.

There are many references in Hoyle to accessing the Internet via an existing TCP/IP connection to obtain advertising (see, for example, column 7, lines 38-41), but we find nothing in Hoyle, and the examiner has not convincingly pointed to anything therein, indicating, or suggesting, that a client application performs the establishment of a communication channel from a local device to an online server (as required by independent claims 1, 8 and 26), and that the client application displays a client window continuously so long as the communication channel from the local device to the online service is maintained (as required by independent claims 1 and 26).

Accordingly, we will not sustain the rejection of claims 1, 8 and 26, or of claims 2-7, 9-14 and 27-29, dependent thereon, under 35 U.S.C. § 103.

With regard to independent claim 15, appellants assert that the limitation, "each ad object comprising a resource locator for

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a given advertisement, a resource locator for a click-through associated with the given advertisement, and display attributes for the given advertisement" distinguishes over Hoyle because Hoyle does not suggest or teach ad objects including these three components or that display attributes are included in an ad object.

The examiner's response is that Hoyle discloses each ad object comprising a resource locator for a given advertisement (citing the URL of the destination link when a user clicks on a banner, at column 14, line 67 through column 15, line 6, and column 19, lines 13-18); that Hoyle discloses a resource locator for the click-through associated with a given advertisement embedded in a web page and associated links for additional information (citing column 1, lines 55-65, and column 15, lines 1-2); and that Hoyle suggests attributes such as the priority level or the maximum number of permitted displays (citing column 15, lines 54 through column 16, line 8).

The examiner also dismisses appellants' argument re Hoyle not teaching the display attributes of the kind which contains instruction, as being directed to limitations forming no part of the *claimed* subject matter.

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We will sustain the rejection of claim 15, and of claims 17-20, dependent thereon, under 35 U.S.C. § 103, in accordance with appellants' grouping at page 3 of the principal brief.

While appellants argue the lack of a showing of the three components of the ad objects in Hoyle, the examiner has reasonably pointed out where each component is to be found or suggested in Hoyle's disclosure and appellants' only response to the examiner's rationale is that the third component, i.e., the "display attributes" is not taught or suggested. However, the examiner has clearly and reasonably pointed to "attributes" such as priority level and the maximum number of permitted displays in Hoyle. Appellants do not deny that Hoyle shows certain display attributes in Figure 5, but, rather, they argue that the attributes in Hoyle are not "attributes," as claimed, but, rather "perceived characteristics" because the claimed "display attributes" include "controlling instructions such as, for example, 'fade, wash, sweep, fly, blinds, box, checkerboard, crawl, dissolve, peak, spiral, split, stretch, strips, swivel, wipe, zoom'."

We agree with the examiner that Hoyle clearly shows "display attributes" and that the specific display attributes now cited by

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appellants form no part of the claimed subject matter. As such, appellants' argument in this regard is not persuasive.

Since appellants have not convinced us of any error in the examiner's rationale with regard to claims 15 and 17-20, we will sustain the rejection of these claims under 35 U.S.C. § 103.

We also will sustain the rejection of claim 16, dependent on claim 15, under 35 U.S.C. § 103. Appellants separately argue the limitations of claim 16, specifically arguing that Hoyle does not teach the limitation of an "ad object includes a length of time to display the given advertisement." The examiner's response was to point to column 2, line 13, of Hoyle, wherein Hoyle specifically mentions "the duration of display" as one of the parameters relating to the presentation of the advertising. We agree with the examiner that this disclosure by Hoyle, albeit in the background section of the patent disclosure, is clearly suggestive of displaying a given advertisement for a "length of time."

Appellants argue, in the reply brief, that the examiner never before pointed to this section of Hoyle for a teaching of displaying an advertisement for a "length of time." The argument is not persuasive as this disclosure has always been a part of Hoyle and was readily ascertainable by appellants from a thorough

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reading of the applied reference. Moreover, appellants were not prejudiced in any manner by the examiner pointing out this portion of Hoyle in the answer since appellants had the opportunity and, in fact, took that opportunity, to file a reply brief. Appellants had a chance in the reply brief to refute the examiner's assertion that Hoyle suggested displaying advertisements for a length of time.

With regard to independent claim 21, appellants assert that Hoyle fails to disclose or suggest the claimed "match list" and, specifically, "the client application receiving a match list from an ad server after establishment of the first communication channel, the match list comprising plural match objects comprising an activity identifier and an ad object, the ad object comprising a resource locator for a given advertisement and a resource locator for a click-through associated with the given advertisement."

The examiner points to the two-tiered approach to target advertisement in Hoyle's client software application 10. The examiner contends that the first tier is the initial selection of ad objects based on a user's demographic information and that the second tier is the reactive targeting of the advertisement based on user interaction with a particular application or on a link to

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information resource, citing column 16, lines 9-16, and column 4, lines 5-7, of Hoyle. The examiner explains that the reactive targeting permits the displaying of advertising that is relevant to what the user is doing at any particular time, citing column 16, lines 24-37, for a "match list," i.e., a list of target advertisements that match with the user's activities. The examiner further explains that each of the target advertisements, i.e., the match object, "implicitly includes an identifier (identified by the web site being accessed, the keywords used, the program being executed, etc . . .) Such that the relevant ads can be identified and displayed to the user" (answer-page 7).

Appellants' response is that Hoyle teaches real-time, reactive targeting of ads to users based on a user's actions, but that no mention is made of a match object comprising an activity identifier and an ad object.

We will not sustain the rejection of claims 21-25 under 35 U.S.C. § 103 because, while appellants have not convinced us of any error in the examiner's position regarding the claimed "match list" and "the client application receiving a match list from an ad server after establishment of the first communication channel, the match list comprising plural match objects comprising an activity identifier and an ad object, the ad object

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comprising a resource locator for a given advertisement and a resource locator for a click-through associated with the given advertisement," claim 21 includes the limitation of "the client application establishing a first communication channel to the network" and, for reasons supra, we do not find such limitation taught or suggested by Hoyle.

We have sustained the rejection of claims 15-20 under 35 U.S.C. §103 but we have not sustained the rejection of claims 1-14 and 21-29 under 35 U.S.C. § 103.

Accordingly, the examiner's decision is affirmed-in-part.

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

AFFIRMED-IN-PART

ERROL A. KRASS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
ANITA PELLMAN GROSS)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
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