

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 34

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte WILLIAM GIRARD MCCOLLOM et al.

Appeal No. 2004-0528
Application No. 09/204,018

ON BRIEF

Before FRANKFORT, FLEMING, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 61 to 90, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellants' invention generally relates to computers and software, and more particularly, to a system and method for creating and sharing purchasing lists in a network system (specification, p. 2). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

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

LeRoy et al. (LeRoy)	5,970,474	Oct. 19, 1999
2Market, Too Cool (2Market)	ISSN: 1082-0310	March 6, 1995

Claims 61 to 90 stand rejected under 35 U.S.C. § 103 as being unpatentable over LeRoy in view of 2Market.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the answer (Paper No. 30, mailed July 29, 2003) for the examiner's complete reasoning in support of the rejection, and to the brief (Paper No. 29, filed June 30, 2003) and reply brief (Paper No. 31, filed September 11, 2003) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 61 to 90 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Claims 61, 71 and 81, the only independent claims on appeal, read as follows:

61. A method comprising:
creating a plurality of purchase lists on a consumer device connected to a network, each purchase list comprising a wish list of items that a consumer desires;

receiving on the consumer device an item advertisement from a non-merchant provider connected to the network, the item advertisement comprising a description of at least one item;

receiving an input from a consumer to select an item desired for purchase, wherein the item desired for purchase is selected from the at least one item described in the item advertisement received from the nonmerchant provider;

identifying one purchase list from the plurality of purchase lists;

saving the item desired for purchase on the identified purchase list;

allowing the consumer to identify a third party consumer with whom the identified purchase list is to be shared; and

transmitting the identified purchase list from the consumer device to the identified third party consumer.

71. A consumer system connected to a network, the consumer system comprising:

means for receiving input from a consumer to create a plurality of purchase lists on the consumer system, each purchase list comprising a list of items that a consumer desires for purchase;

means for receiving via the network an item advertisement from a non-merchant provider, the item advertisement comprising a description of at least one item;

means for selecting an item desired for purchase, wherein the item desired for purchase is selected from the at least one item described in the item advertisement received from the non-merchant provider;

means for identifying, from the plurality of purchase lists, a purchase list on which to save the selected item;

means for receiving an input from the consumer to identify a third party consumer with whom the identified purchase list is to be shared; and

means for receiving an initiation input from a consumer to transmit the identified purchase list from the consumer system to the identified third party consumer.

81. A network-connected consumer device comprising:

a plurality of purchase lists, each purchase list comprising a list of items that a consumer desires;

a first consumer mechanism that receives an item advertisement from a network-connected non-merchant provider, the item advertisement comprising a description of at least one item;

a second consumer mechanism that receives an input from a consumer to select an item desired for purchase, wherein the item desired for purchase is

selected from the at least one item described in the item advertisement received from the network-connected nonmerchant provider;

a third consumer mechanism that receives an input from the consumer to identify from the plurality of purchase lists a purchase list on which the selected item is to be saved;

a fourth consumer mechanism that receives a consumer input identifying a third party consumer with whom the identified purchase list is to be shared; and

a fifth consumer mechanism that transmits the identified purchase list to the identified third party consumer.

LeRoy's invention relates generally to a product information system for selecting, monitoring and purchasing of products in a retail establishment, and more particularly, to a system for registering gift requests in a national database which is updatable to reflect customer purchases so that other customers can search the database and retrieve a current list to avoid making duplicate purchases. LeRoy teaches (column 2, lines 16-67) that:

The system includes a product selection device, a data processor, a registry retrieval device, a point-of-sale data input device, and a host computer. The product selection device identifies desired items selected by a registrant, such as wedding or birthday gifts, and routes the desired items to a registry database on a host computer. The data processor is adapted to communicate with the product selection device to thereby collect the desired items selected by the registrant and route the desired items to the host computer. The registry retrieval device is configured to retrieve updated registry data from the host computer in response to a request from a purchasing customer. The retrieval device has an output unit for displaying an updated list of items in the registry database. Once a customer has chosen a desired item for the registrant (i.e. a registered gift), the customer typically goes to a checkout counter where the point-of-sale data input device identifies the desired item for routing to the host computer. The host computer has a storage unit for maintaining the registry database and a data processor for processing selection and purchasing transactions. Thus, desired items consecutively selected by the registrant are added to the registry database to

create a registry list, and desired items purchased by the customer are associated with the registry database to create an updated list reflecting the purchase of said desired items. The registry database is thereby automatically updated so that one customer does not purchase items that have already been purchased by another customer.

In another aspect of the invention, an inter-site product information system is provided for use in a plurality of retail establishments. A product selection device and a data processor are located at a registry enrollment site for identifying desired items selected by a registrant and routing the desired items to the registry database on a host computer. A registry retrieval device, a point-of-sale data input device, and another data processor are located at a separate customer purchase site for allowing a customer to retrieve updated registry information. A host computer is also provided to maintain the registry database and process selection and purchasing transactions. Thus, desired items consecutively selected by the registrant at the registry enrollment site are added to the registry database to create a registry count, and desired items subsequently purchased by the customer at the customer purchase site are associated with the registry database to create an updated list reflecting the purchase of the desired items. Preferably, a registry retrieval device and a point-of-sale input device are also provided at the registry enrollment site to allow customers to purchase items at that site as well as the customer purchase site. Furthermore, a product selection device is preferably provided at the registry enrollment site to allow the registrants to update the registry database at that site if desired.

LeRoy further teaches (column 5, lines 47-51) that "a registrant may be able to enroll at home over a public access system such as the Internet, and purchasing customers can retrieve updated registry lists and make purchases with credit cards at home over such a public access system." LeRoy instructs (column 6, lines 27-33) that devices other than a handheld scanner could be utilized so that a registrant can identify

desired items for creating a registry. For example, a sponsoring store can post a Web page on the Internet listing many or all of the products offered within a nationwide chain of stores, and the registrant may be able to click on the desired items from a personal computer in the registrant's home.

2Market describes an interactive shopping service in which an electronic catalog (e.g., CD-ROM catalog mailed to the consumer) is used to browse products and learn about them. With the service, consumers can create order lists that identify the products they would like to purchase. Included in the shopping service is a "Gift Finder" service that creates a special gift list based upon information the consumer provides such as the age of the recipient, the recipient's interests, an occasion for which the gift is being purchased, and a gift price range.

After the scope and content of the prior art are determined, the differences between the prior art and the claims at issue are to be ascertained. Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

Based on our analysis and review of LeRoy and claim 61, it is our opinion that the differences include the following limitations: (1) receiving on the consumer device an item advertisement from a non-merchant provider connected to the network, the item

advertisement comprising a description of at least one item; (2) receiving an input from a consumer to select an item desired for purchase, wherein the item desired for purchase is selected from the at least one item described in the item advertisement received from the nonmerchant provider; (3) saving the item desired for purchase on the identified purchase list; (4) allowing the consumer to identify a third party consumer with whom the identified purchase list is to be shared; and (5) transmitting the identified purchase list from the consumer device to the identified third party consumer.

Based on our analysis and review of LeRoy and claim 71, it is our opinion that the differences include the following limitations: (1) means for receiving via the network an item advertisement from a non-merchant provider, the item advertisement comprising a description of at least one item; (2) means for selecting an item desired for purchase, wherein the item desired for purchase is selected from the at least one item described in the item advertisement received from the non-merchant provider; (3) means for identifying, from the plurality of purchase lists, a purchase list on which to save the selected item; (4) means for receiving an input from the consumer to identify a third party consumer with whom the identified purchase list is to be shared; and (5) means for receiving an initiation input from a consumer to transmit the identified purchase list from the consumer system to the identified third party consumer.

Based on our analysis and review of LeRoy and claim 81, it is our opinion that the differences include the following limitations: (1) a first consumer mechanism that receives an item advertisement from a network-connected non-merchant provider, the item advertisement comprising a description of at least one item; (2) a second consumer mechanism that receives an input from a consumer to select an item desired for purchase, wherein the item desired for purchase is selected from the at least one item described in the item advertisement received from the network-connected nonmerchant provider; (3) a third consumer mechanism that receives an input from the consumer to identify from the plurality of purchase lists a purchase list on which the selected item is to be saved; (4) a fourth consumer mechanism that receives a consumer input identifying a third party consumer with whom the identified purchase list is to be shared; and (5) a fifth consumer mechanism that transmits the identified purchase list to the identified third party consumer.

With regard to these differences, it is our conclusion that the combined teachings of LeRoy and 2Market would not have made it obvious at the time the invention was made to a person of ordinary skill in the art to have modified LeRoy to arrive at the subject matter under appeal. Accordingly, a prima facie case of obviousness has not been established since the evidence presented would not have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed

invention. In that regard, the combined teachings of LeRoy and 2Market would only have suggested utilizing 2Market's interactive shopping service to identify desired items for LeRoy's gift registry. As such, the combined teachings of LeRoy and 2Market would not have suggested the claimed invention (e.g., the limitations of claims 61, 71 and 81 not taught by LeRoy).

For the reasons set forth above, the decision of the examiner to reject claims 61 to 90 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 61 to 90 under 35 U.S.C. § 103 is reversed.

REVERSED

CHARLES E. FRANKFORT
Administrative Patent Judge

MICHAEL R. FLEMING
Administrative Patent Judge

JEFFREY V. NASE
Administrative Patent Judge

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