

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Ex parte IAN TOMLINSON and GREG WINTER

Appeal No. 2005-0100
Application No. 09/962,744

ON BRIEF

Before FLEMING, BARRY, and LEVY, *Administrative Patent Judges*.
BARRY, *Administrative Patent Judge*.

DECISION ON APPEAL

A patent examiner rejected claims 1-18 and 23-38. The appellants appeal therefrom under 35 U.S.C. § 134(a). We reverse.

BACKGROUND

The invention at issue on appeal concerns querying databases. Database queries are common in today's computing world. Many such queries include geographic locations as a searching criterion. For example, a user to may wish to query a database to obtain the people named "Bush" located in "Washington, D.C." A

query may use "Washington" and "D.C." as inputs for city and state fields, respectively. The query will return records of those people living within the city limits of Washington, D.C. (Spec. at 1.)

Nielsen has defined regions known as "direct marketing areas" within the continental United States. These areas are based on television signal areas. (*Id.*) According to the appellants, "[d]irect marketing areas are more useful geographic designations for purposes of advertising and marketing." (*Id.* at 13.)

Consequently, the appellants' invention converts a geographic input (e.g., a city and state, a latitude and longitude) into a direct marketing area. The direct marketing area is substituted for the geographic input, and the requested database query is performed. (*Id.*)

A further understanding of the invention can be achieved by reading the following claim.

1. A method for performing a database query, comprising:
 - (a) receiving a query request, the query request containing a geographic location input parameter,
 - (b) obtaining the direct marketing area corresponding to the geographic location input parameter, if possible; and

(c) replacing the geographic location input parameter with the direct marketing area, if the direct marketing area for the geographic location input parameter was obtained.

Claims 1-18, 23, 24, and 27-38 stands rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,295,526 ("Kreiner"). (Final Rejection¹ at 3.) Claims 25 and 26 stand rejected under 35 U.S.C. § 103(a) as obvious over Kreiner.

OPINION

Rather than reiterate the positions of the examiner or the appellants *in toto*, we focus on the point of contention therebetween. "[I]nterpret[ing] that the location description (i.e. Buckhead) in Kreiner's teaching corresponds to the 'direct marketing area' and the location identifier (i.e. 37) corresponds to the 'geographic location,'" (Examiner's Answer at 3), the examiner asserts, "Kreiner teaches replacing the geographic location with direct marketing area (column 14 lines 15-41 and column 17 lines 8-26)." (*Id.*) The appellants argue, "the integer '37' is not a direct marketing area, as clearly defined in the Current Application, but is instead simply an identifier synonymous with the term 'Buckhead,' as stated by Kreiner. . . ." (Appeal Br. at 6.)

¹"We advise the examiner to copy his rejections into his examiner's answers," *Ex parte Metcalf*, 67 USPQ2d 1633, 1635 n.1 (Bd.Pat.App.& Int. 2003), rather than merely referring to "rejection[s] . . . set forth in prior Office Action. . . ." (Examiner's Answer at 3.)

In addressing the point of contention, the Board conducts a two-step analysis. First, we construe independent claims at issue to determine their scope. Second, we determine whether the construed claims are anticipated or would have been obvious.

A. CLAIM CONSTRUCTION

"Analysis begins with a key legal question — *what is the invention claimed?*" *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1567, 1 USPQ2d 1593, 1597 (Fed. Cir. 1987). "Claims are not interpreted in a vacuum, but are part of and are read in light of the specification." *Slimfold Mfg. Co. v. Kinkead Indus., Inc.*, 810 F.2d 1113, 1116, 1 USPQ2d 1563, 1566 (Fed. Cir. 1987) (citing *Hybritech Inc. v. Monoclonal Anti-bodies, Inc.*, 802 F.2d 1367, 1385, 231 USPQ 81, 94-95 (Fed. Cir. 1986); *In re Mattison*, 509 F.2d 563, 565, 184 USPQ 484, 486 (CCPA 1975)).

Here, claim 1 recites in pertinent part the following limitations: "receiving a query request, the query request containing a geographic location input parameter, . . . obtaining the **direct marketing area** corresponding to the geographic location input parameter, if possible; and . . . replacing the geographic location input parameter with the direct marketing area. . . ." (Emphasis added.) Claims 6, 10, 15, 23, 31, and 35 recite similar limitations.

The appellants' specification describes the claimed "direct marketing area[s]" as "[r]egions . . . defined by Nielsen for the continental United States," (Spec. at 1), which "are based on television signal areas." (*Id.*) Reading the limitations in light of the specification, claims 1, 6, 10, 15, 23, 31, and 35 require replacing a geographic input parameter of a database query with a direct marketing region defined by Nielsen based on television signal areas in the continental United States.

B. ANTICIPATION AND OBVIOUSNESS DETERMINATIONS

"Having construed the claim limitations at issue, we now compare the claims to the prior art to determine if the prior art anticipates those claims." *In re Cruciferous Sprout Litig.*, 301 F.3d 1343, 1349, 64 USPQ2d 1202, 1206 (Fed. Cir. 2002). "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (citing *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 715, 223 USPQ 1264, 1270 (Fed. Cir. 1984); *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983); *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 771, 218 USPQ 781, 789 (Fed. Cir. 1983)). "[A]bsence from the reference of any claimed element negates anticipation." *Kloster Speedsteel AB v. Crucible, Inc.*, 793 F.2d 1565, 1571, 230 USPQ 81, 84 (Fed. Cir. 1986).

Here, Kreiner employs "a memory map to provide listing information representing data within a database." Col. 6, ll. 3-4. "The memory map comprises an index related to the database's data and relationship information about the data-to-data relationships within the database's data." *Id.* at ll. 7-10. "[T]he index 230 may . . . include geographic elements for a listing and display numbers for a listing. Geographic elements associate a listing with a city, county, community, street name, or other geographical feature." Col. 13, ll. 59-62. "[W]here the database 40 contains classified advertising data, the index 230 may include, amongst other things, the categories and identifiers as listed in Table 1," col. 14, ll. 11-13, of the reference. "Referring now to Table 1, 'Attorneys' and 'Buckhead' are each a description of a category by which the information within the database 40 may be organized. Each of these categories is one of a predefined type of category within the Index 230." *Id.* at ll. 23-27. "[E]ach category is referenced by a distinct numeric identifier. For example, the Attorneys category is a LOB (Line of Business) type of category having numeric identifiers of 1730 for the LOB type of category and 105 for Attorneys. The Buckhead category is a community type of category having numeric identifiers of 21274 for the community type of category and 37 for Buckhead." *Id.* at ll. 27-34.

"If [a] user desires to use the [Information Retrieval] system modules 26 to search for attorneys located within the Buckhead community, an exemplary search query would include the above two listed categories and their respective identifiers as target elements of the search query. The elements in such an exemplary search query would be as follows: 1730 105, 21274, 37." *Id.* at ll. 35-41. Although such a search query includes a geographic input parameter, viz., "37," we are unpersuaded that Kreiner teaches a direct marketing region defined by Nielsen based on television signal areas in the continental United States, let alone replaces its geographic input parameter with such a direct marketing region. To the contrary, based on the aforementioned passages of the reference, we agree with the appellants that "the integer '37' is not a direct marketing area . . . but is instead simply an identifier synonymous with the term 'Buckhead,' . . ." (Appeal Br. at 6.)

The absence of replacing a geographic input parameter of a database query with a direct marketing region defined by Nielsen based on television signal areas in the continental United States negates anticipation. Therefore, we reverse the anticipation rejection of claim 1; of claims 2-5, which depend therefrom; of claim 6; of claims 7-9, which depend therefrom; of claim 10; of claims 11-14, which depend therefrom; of claim 15; of claims 16-18, which depend therefrom; of claim 23; of claims 24, and 27-29,

which depend therefrom; of claim 31; of claims 32-34, which depend therefrom; of claim 35; and of claims 36-38, which depend therefrom.

"In rejecting claims under 35 U.S.C. Section 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness." *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993) (citing *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992)). "A *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." *In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) (quoting *In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976)).

Here, the examiner does not show that teachings from the prior art itself would have suggested replacing a geographic target element of Kreiner with a direct marketing region defined by Nielsen based on television signal areas in the continental United States. Therefore, we reverse the obviousness rejection of claims 25 and 26, which indirectly depend from claim 23.

CONCLUSION

In summary, the rejection of claims 1-18, 23, 24, and 27-38 under § 102(e) is reversed. The rejection of claims 25 and 26 under § 103(a) is also reversed.

REVERSED

MICHAEL R. FLEMING
Administrative Patent Judge

LANCE LEONARD BARRY
Administrative Patent Judge

STUART S. LEVY
Administrative Patent Judge

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