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. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ZEEV BARZILAI, SERGEI SHMULYIAN and ONN SHEHORY

Appeal No. 2005-0131
Application 09/731,388

HEARD: May 5, 2005

Before HAIRSTON, LEVY, and MACDONALD, **Administrative Patent Judges.**

MACDONALD, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-43.

Invention

Appellants' invention relates to a method, apparatus, system, and product to provide a flexible framework in which parties doing business in an electronic commerce setting can automatically negotiate the terms of privacy protection to be provided, by matching privacy criteria that the parties have defined in advance. This framework is useful particularly in business-to-business (B2B) interactions, and especially in interactions carried out through an intermediary electronic marketplace or portal. More generally, however, the principles of the present invention are applicable to substantially any type of electronic commerce setting, including business-to-consumer (B2C) and mixed B2C/B2B settings. Appellants' specification at page 4, line 30, through page 5, line 11.

Claim 1 is representative of the claimed invention and is reproduced as follows:

1. A method for controlling an exchange of information between a first party and a second party, comprising:

receiving from the first party a set of one or more privacy preferences, indicating restrictions to be placed on use of specified items of the information to be disclosed by the first party;

receiving from the second party a description of a privacy policy, indicating undertakings by the second party with regard to restricting the use of the specified items of the information;

assessing compatibility of the privacy preferences with the privacy policy;

if the privacy preferences and the privacy policy are found to be incompatible, brokering a negotiation with at least one of the first and the second parties so as to bring the privacy preferences and the privacy policy into mutual compatibility; and

providing the information from the first party to the second party only when the privacy preferences and the privacy policy are found to be compatible.

References

The references relied on by the Examiner are as follows:

Eisenhart US2001/0047276 Nov. 29, 2001
(non-provisional of provisional app. No. 60/192,600 filed March 27, 2000).

Breed et al (Breed) 6,067,528 May 23, 2000

Smith; Net Worth: Shaping Markets When Customers Make the Rules; Journal of Public Policy & Marketing; vol. 18, no. 2; Ann Arbor; Fall 1999; pp. 275-277.

Rejections At Issue

Claims 1-2, 4-12, 14-16, 21-22, 24-31, 33-35, and 40-43 stand rejected under 35 U.S.C. § 102 as being anticipated by Eisenhart.

Claims 3, 13, 23, and 32 stand rejected under 35 U.S.C. § 103 as being obvious over Eisenhart.

Claims 17-19 and 36-38 stand rejected under 35 U.S.C. § 103 as being obvious over the combination of Eisenhart and Breed.

Claims 20 and 39 stand rejected under 35 U.S.C. § 103 as being obvious over the combination of Eisenhart and Smith.

Throughout our opinion, we make references to the Appellants' briefs, and to the Examiner's Answer for the respective details thereof.[1]

OPINION

With full consideration being given to the subject matter on appeal, the Examiner's rejections and the arguments of the Appellants and the Examiner, for the reasons stated **infra**, we affirm the Examiner's rejection of claims 1-2, 4-12, 14-16,

[1] Appellants filed an appeal brief on January 12, 2004. Appellants filed a reply brief on May 7, 2004. The Examiner mailed an Examiner's Answer on March 9, 2004.

21-22, 24-31, 33-35, and 40-43 under 35 U.S.C. § 102, and we affirm the Examiner's rejection of claims 3, 13, 17-20, 23, 32, and 36-39 under 35 U.S.C. § 103.

Only those arguments actually made by Appellants have been considered in this decision. Arguments that Appellants could have made but chose not to make in the brief have not been considered. We deem such arguments to be waived by Appellants [see 37 CFR § 41.37(c)(1)(vii) effective September 13, 2004 replacing 37 CFR § 1.192(a)].

Appellants have indicated that for purposes of this appeal the claims stand or fall together in two groupings:

> Claims 1-13, 21-32, 40, and 42 as Group I; and
>
> Claims 14-20, 33-39, 41, and 43, as Group II.

See page 5 of the brief. Furthermore, Appellants argue each group of claims separately and explain why the claims of each group are believed to be separately patentable. See pages 5-10 of the brief and pages 1-5 of the reply brief. Appellants have fully met the requirements of 37 CFR § 1.192 (c)(7) (July 1, 2002) as amended at 62 Fed. Reg. 53169 (October 10, 1997), which was controlling at the time of Appellants' filing of the brief. 37 CFR § 1.192 (c)(7) states:

> *Grouping of claims.* For each ground of

> rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together and, in the argument under paragraph (c)(8) of this section, appellant explains why the claims of the group are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable.

We will, thereby, consider Appellants' claims as standing or falling together in the two groups noted above, and we will treat:

Claim 1 as a representative claim of Group I; and

Claim 14 as a representative claim of Group II.

I. Whether the Rejections of Claims 1-13, 21-32, 40, and 42 Under 35 U.S.C. § 102 or 35 U.S.C. § 103 are proper?

It is our view, after consideration of the record before us, that the disclosure of Eisenhart does fully meet the invention as recited in claims 1-2, 4-12, 21-22, 24-31, 40, and 42, and that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the invention as set forth in claims 3, 13, 23, and 32. Accordingly, we affirm.

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. **See In re King**, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986) and **Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.**, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984).

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a **prima facie** case of obviousness. **In re Oetiker**, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). **See also In re Piasecki**, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The Examiner can satisfy this burden by showing that some objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art suggests the claimed subject matter. **In re Fine**, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the Appellants. **Oetiker**, 977 F.2d at 1445, 24 USPQ2d at 1444. **See also Piasecki**, 745 F.2d at 1472, 223 USPQ at 788.

An obviousness analysis commences with a review and

consideration of all the pertinent evidence and arguments. "In reviewing the [E]xaminer's decision on appeal, the Board must necessarily weigh all of the evidence and argument." **Oetiker**, 977 F.2d at 1445, 24 USPQ2d at 1444. "[T]he Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion." **In re Lee**, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

With respect to independent claim 1, Appellants argue at page 6 of the brief, "Eisenhart [US2001/0047276] is effective as prior art . . . only to the extent that the Eisenhart Provisional [60/192,600] discloses the subject matter of the claims." On this point we agree.

Appellants then go on to argue at page 8 of the brief, that with regard to the non-disclosure agreement (NDA), Eisenhart '600 only teaches "binary choices" where one of the parties presents a "take-it-or-leave-it" choice to the other party. Further, Appellants argue that Eisenhart '600 "provides no assessment of

the compatibility of one party's privacy preferences with the other party's privacy policy." We find these arguments unpersuasive.

We find that contrary to Appellants' arguments, page 23 of Eisenhart '600 clearly teaches that with respect to an Evaluation Request that includes an NDA there are three choices "Accept the Request", "Reject the Request", "Discuss the Request." Further, we note that the third choice (discuss) is a negotiation, and evaluation of the request inherently includes assessing compatibility in order to choose among the three choices (page 22, "Supplier has the choice").

Therefore, we will sustain the Examiner's rejection under 35 U.S.C. § 102 and 35 U.S.C. § 103.

II. Whether the Rejections of Claims 14-20, 33-39, 41, and 43 Under 35 U.S.C. § 102 and 35 U.S.C. § 103 are proper?

It is our view, after consideration of the record before us, that the disclosure of Eisenhart does fully meet the invention as recited in claims 14-16, 33-35, 41, and 43, and that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the invention as set forth in claims 17-20 and 36-39. Accordingly, we affirm.

With respect to independent claim 14, Appellants argue at page 9 of the brief, "Eisenhart ['600], however neither teaches nor suggests the functionality of the electronic marketplace recited in claim 14" and "[the hub of Eisenhart] has no privacy policy of its own." We find Appellants' argument unpersuasive.

We have reviewed claim 14 and find no functionality recited for the marketplace. We note that all of the method steps in claim 14 are silent as to the party performing a given step. Contrary to Appellants assertion that the claim requires the marketplace (hub) to establish a privacy policy with the buyer as to information the buyer will reveal to the marketplace in connection with a transaction, the claim language merely requires that a first party establish a privacy policy with a second party as to information the buyer will reveal to the marketplace in

connection with a transaction. We find that Eisenhart '600 teaches this feature in the form of a buyer (first party) establishing a privacy policy with a seller (second party) as to information the buyer will reveal to the marketplace in connection with a transaction.

Therefore, we will sustain the Examiner's rejection under 35 U.S.C. § 102 and 35 U.S.C. § 103.

Conclusion

In view of the foregoing discussion, we have sustained the rejection under 35 U.S.C. § 102 of claims 1-2, 4-12, 14-16, 21-22, 24-31, 33-35, and 40-43; and we have sustained the rejection under 35 U.S.C. § 103 of claims 3, 13, 17-20, 23, 32, and 36-39.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

AFFIRMED

KENNETH W. HAIRSTON Administrative Patent Judge	)	
STUART S. LEVY Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
ALLEN R. MACDONALD Administrative Patent Judge	)	

RAM:pgc

Darby & Darby P.C.
805 Third Avenue
New York, NY 10022