

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PAUL GREER
and ANAND PASHUPATHY

Appeal No. 2005-1804
Application No. 08/882,197

ON BRIEF

Before KRASS, JERRY SMITH, and NAPPI, Administrative Patent Judges.
JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 3-5, 17, 18, 22-25, 27-29, 32, 36, 40, 41, 45-49 and 54-57.

The disclosed invention pertains to controlling advertisements provided from a content provider to a target computer over a network.

Representative claim 3 is reproduced as follows:

3. A system comprising:
a target computer to receive a content including an advertisement; and
a content provider coupled to the target computer via a network to transmit the content, the content provider comprising:

a user rule page containing information automatically obtained from the target computer by a first agent, the first agent having a trigger program to filter information and to determine whether the information is relevant to the user rule page;

a rulebook to provide a rule based on the user rule page, the rule controlling the content to be transmitted from a database to the target computer, the rule stored in form of a condition-action pair, the user rule page including at least one of a hardware profile indicating hardware capabilities of the target computer, a software profile indicating software used by the target computer, and a user profile including dynamic information related to a user using the target computer, the dynamic information including information on web sites visited and time spent by the user on the websites; and

wherein a second agent updates information in the user rule page based upon information received from the target computer and based upon the updated user rule page finds new appropriate content including a second advertisement that is transmitted to the target computer.

The examiner relies on the following references:

Davis et al. (Davis)	5,796,952	Aug. 18, 1998 (filed Mar. 21, 1997)
O'Toole, Jr. et al. (O'Toole)	6,279,112	Aug. 21, 2001 (filed Oct. 29, 1996)

Claims 3-5, 17, 18, 22-25, 27-29, 32, 36, 40, 41, 45-49 and 54-57 stand rejected under 35 U.S.C. § 103(a). As evidence of obviousness the examiner offers O'Toole in view of Davis.

Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, 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 obviousness of the invention as set forth in the claims on appeal. Accordingly, we affirm.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in

the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d

1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered and are deemed to be waived [see 37 CFR § 41.37(c)(1)(vii)(2004)].

The examiner has indicated how the claimed invention is rendered obvious by the teachings of O'Toole and Davis [answer, pages 3-9]. Appellants have indicated that all the appealed claims stand or fall together as a single group [brief, page 5], so we will consider independent claim 3 as representative of all the claims on appeal. With respect to representative claim 3, appellants argue that O'Toole fails to teach a first agent or a user rule page containing information automatically obtained from the target computer by a first agent having a trigger program to filter information and to determine whether the information is relevant to the user rule page. Appellants argue that the portions of O'Toole cited by the examiner fail to teach the claimed user rule page. Appellants also argue that O'Toole fails to teach the claim limitations related to the claimed rule book based on the user rule page. On this point, appellants argue that the client avatar 210 and the client personal profile are

both located at the client computer rather than at the content provider as claimed. Appellants also argue that there is no motivation to modify O'Toole with Davis except to recreate the claimed invention in hindsight. Appellants also contend that the examiner has improperly relied on what is old and well known in the art to support the rejection [brief, pages 5-13].

The examiner responds that the smart digital offer object of O'Toole corresponds to the claimed first agent and that profile information, the user rule page, is received from the client computer and sent to trusted servers. The examiner asserts that since the profile information is information deemed significant to the trusted servers, then the smart digital offer object functions as the first agent having a triggering program to filter information and to determine whether the information is significant. The examiner also responds that the smart digital object in O'Toole conforms to certain rules regarding how customization is to occur depending on profile details. The examiner also asserts that the content provider or server in O'Toole comprises a user rule page, released profile information, and a rule book, that is, rules governing how to target content to a user based on his/her profile. Finally, the examiner notes

that claim 3 only requires that the user rule page recite one of a hardware profile, a software profile and a user profile [answer, pages 9-15].

Appellants respond that there is no teaching or suggestion in O'Toole of the automatic gathering of information from a target computer, but instead, only a query session to determine whether the user accepts an offer. Appellants also respond that O'Toole does not teach or suggest the claimed second agent that updates information in a user rule page and based on this updated content, finds new content including a second advertisement that is transmitted to the computer [reply brief].

We will sustain the examiner's rejection of all the claims on appeal for essentially the reasons argued by the examiner in the answer. Regarding appellants' argument that information is not automatically obtained by a first agent in O'Toole, we do not agree. O'Toole teaches that a user can control the release of information by way of a security profile. Even though the user may be queried to approve the transfer of information in some instances, O'Toole also teaches that user information will be automatically released to trusted servers [column 9, line 67 to column 10, line 1]. Davis also teaches that it was well known to

the artisan to acquire information about the user's computer automatically [column 9, lines 41-45]. As noted by the examiner, claim 3 recites that the user rule page includes at least one of a hardware profile, a software profile, and a user profile. As also noted by the examiner, such recitation only requires a prior art teaching of any one or more of these three profiles. O'Toole teaches the user rule page which is stored at the server as including user profile information. Davis teaches the user rule page containing at least user profile information as well as a hardware profile of the user's computer. With respect to appellants' arguments regarding the claimed second agent, we agree with the examiner that O'Toole [column 10, lines 18-21] and Davis [column 14, lines 41-52] each teaches that information at the content provider is updated so that new content sent to the client computer can be intelligently selected for each client computer.

In summary, we have sustained the examiner's rejection of the claims on appeal. Therefore, the decision of the examiner rejecting claims 3-5, 17, 18, 22-25, 27-29, 32, 36, 40, 41, 45-49 and 54-57 is affirmed.

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

ERROL A. KRASS)	
Administrative Patent Judge)	
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