

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

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Paper No. 33

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte AMY LAM

Appeal No. 2005-0494  
Application 09/536,531<sup>1</sup>

ON BRIEF

Before BARRETT, DIXON, and GROSS, Administrative Patent Judges.  
BARRETT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the final rejection of claims 1-22.

We affirm.

BACKGROUND

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<sup>1</sup> Application for patent filed March 28, 2000, entitled "Computer Auction Processing System and Methods of Managing Such System."

This invention relates to a computer-based interactive auction processing system. The system generates currency in exchange for user information and allows the user to acquire merchandise in exchange for the generated currency via an interactive auction. The system includes a host computer and at least one remote terminal.

Claim 1 is reproduced below.

1. An auction processing system comprising:

- (a) a host computer which is capable of communication with at least one remote computer;
- (b) means for generating currency, wherein the currency is generated in exchange for information from a user of the remote computer by interaction with the host computer; and
- (c) means for enabling acquisition of one or more lots of merchandise through an auction format whereby such acquisition is through use of the generated currency.

THE REFERENCES

The examiner relies on the following references:

Godin et al. (Godin)	5,890,138	March 30, 1999
Ng	6,405,175	June 11, 2002
		(filed July 27, 1999)

THE REJECTION

Claims 1-22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ng in view of Godin.

We refer to the final rejection (Paper No. 21) (pages referred to as "FR\_\_") and the second examiner's answer (Paper

No. 30) (pages referred to as "EA") for a statement of the examiner's rejection, and to the brief (Paper No. 24) (pages referred to as "Br") and reply brief (Paper No. 27) (pages referred to as "RBr") for a statement of the appellant's arguments thereagainst.

OPINION

The claims are grouped to stand or fall together (Br3).  
Claim 1 is taken as representative.

There are two issues on appeal. The first issue is appellant's claim that the examiner's answer raises a new ground of rejection (RBr2). The second issue deals with the obviousness rejection of Ng in view of Godin.

No New Ground of Rejection

The question of whether the examiner's answer raises a new ground of rejection is not within our jurisdiction. The Board's jurisdiction is limited to rejections of claims. Nevertheless, the examiner's answer does not raise a new ground of rejection because it merely clarifies that the examiner used the prior art disclosed in Godin, and not the actual Godin invention; note that both the final rejection and the examiner's answer cite to column 1, lines 10-17.

Rejection under 35 U.S.C. § 103(a)

The examiner finds that Ng discloses the claimed subject matter of claim 1 except for acquiring merchandise through an auction system (FR2). The examiner finds that Godin teaches a computer auction system and teaches at column 1, lines 10-17, that auctions provide a way to obtain products at reasonable prices and, in addition, there is the excitement and skill of the buyer. The examiner concludes that it would have been obvious to one having ordinary skill in the art to modify the Ng reference with the Godin teaching by "replacing the mere converting points for prizes or gifts with an auction in order to provide a more exciting means of acquiring the prizes or gifts." (FR4)

First, appellant argues that there is no motivation to combine the references. Appellant argues that "Godin does not teach or suggest that the auctions are substitutes for other methods of selling things over the internet, rather Godin teaches only that its claimed auction method is superior to other auction methods" (Br5). It is also argued that "Godin does not teach the desirability of the modification proposed by the Examiner" (Br5) and the sparse reference to the redemption process in Ng does not suggest the desirability of the combination (Br6).

The issue is whether it would have been obvious to use the generated points disclosed in Ng to acquire merchandise via a computerized auction system, as taught by Godin. Ng discloses that points can be "converted into prizes, such as bonus online

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time, special offers, telephone calling card minutes, hotel nights or frequent-flyer miles, other discounts, or even cash or stock in the database company" (col. 9, lines 25-29). Ng teaches using the points for many things and does not restrict how a user spends his or her points to acquire merchandise. In our opinion, this would have suggested to one of ordinary skill in the art that the generated points in Ng could be spent in any way that regular currency is spent, including to bid in an auction system as taught by Godin. Godin simply shows that computer-based auctions were well known in the art.

Second, appellant argues that Ng and Godin do not teach the limitation of "generating currency" because the "reward system of Ng is largely dependent on the actions of others, while the system of generating currency in the present claims is entirely dependent on the actions of one person, the reward recipient" (Br6). That is, "the systems and methods of the present invention allow the initial person to generate their own currency by simply providing more information, answering more questions, evaluating more product information and the like" (Br6).

Appellant does not point out what language of claim 1 is not met by Ng and we do not find any differences. Ng discloses generating points, which is a form of currency, in exchange for information from a user. Appellant's method of generating currency is not claimed. If the method had been claimed in more

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detail the examiner might have applied an additional reference, such as Goldhaber et al., U.S. Patent 5,794,210 (copy attached), which shows that users can earn digital cash based on consumer interaction (e.g., cols. 9-11), where "the compensation (e.g., direct cash payment) represented by a CyberCoin has generic usefulness" (col. 11, lines 25-27).

For the reasons stated above, the rejection of claims 1-22 is sustained.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). See 37 C.F.R. § 1.136(a)(1)(iv) (2004).

AFFIRMED

LEE E. BARRETT	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
JOSEPH L. DIXON	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
ANITA PELLMAN GROSS	)	
Administrative Patent Judge	)	

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