The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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 ROBERT M. SZABO, KEITH N. FORTENBERRY, and JAMES J. TOOHEY

Appeal No. 2005-2457
Application No. 09/604,189

ON BRIEF

Before GROSS, LEVY, and BLANKENSHIP, Administrative Patent Judges.

BLANKENSHIP, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-8 and 10-37, which are all the claims remaining in the application.

We reverse, and enter a new ground of rejection in accordance with 37 CFR § 41.50(b).

BACKGROUND

The invention relates to an e-commerce site capable of storing shopping lists, the purchase history of items purchased by consumers, and the periodicity of previous purchases. The stored information may be used in determining whether to prompt a particular customer to add items to a shopping list. Claim 1 is reproduced below.

> 1. A method to automate the replenishment of one or more items on a shopping list, comprising the steps of:
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> storing one or more consumer shopping lists of respective consumers at an e-commerce site;
>
> storing a list of items previously purchased by one or more consumers from the e-commerce site, wherein the list of items previously purchased comprises a time of delivery for at least some of the items of the one or more consumers;
>
> receiving a request from a consumer for at least one consumer shopping list; and
>
> determining if the request from the consumer is from a consumer that has previously purchased one or more items from the e-commerce site, and if the user has previously purchased, one or more items from the e-commerce site, then performing the sub-steps of:
>
> calculating a periodicity of previous purchases of one or more items previously purchased from the e-commerce site by looking at a pattern of past purchase histories for one or more items, wherein the past purchase histories specify a time and a location where the items are fulfilled for delivery, which is independent of a time when the items are ordered for purchase, and wherein the periodicity is based upon the time the items are fulfilled for delivery; and
>
> adding to the at least one consumer shopping list one or more items that have exceeded the periodicity, wherein
>
> the sub-step of calculating includes calculating if at least one item has a periodicity based on a quantity associated with the item and calculating the

periodicity based upon a consumer's frequency of purchase and time of delivery of that quantity of the item.

The examiner relies on the following references:

Kenney	6,026,376	Feb. 15, 2000 (filed Apr. 15, 1997)
Suzuki et al. (Suzuki)	US 6,470,323 B1	Oct. 22, 2002 (filed Jun. 27, 1996)

Rob Grimes (Grimes), Digital appliance age dawns, Nation's Restaurant News, vol. 34, no. 4, p. 52 (Jan. 24, 2000).

Claims 1-8 and 10-37 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kenny, Suzuki, and Grimes.

We refer to the Final Rejection (mailed Nov. 19, 2003) and the Examiner's Answer (mailed Jun. 4, 2004) for a statement of the examiner's position and to the Brief (filed Apr. 21, 2004) and the Reply Brief (filed Aug. 3, 2004) for appellants' position with respect to the claims which stand rejected.

OPINION

The § 103 rejection of claims 1-8 and 10-37 over Kenny, Suzuki, and Grimes

Instant claim 1 recites the step of calculating a periodicity of previous purchases of one or more items previously purchased from the e-commerce site by looking at a pattern of past purchase histories for one or more items, "wherein the past purchase histories specify a time and a location where the items are fulfilled for delivery, which is independent of a time when the items are ordered for purchase, and wherein the

periodicity is based upon the time the items are fulfilled for delivery. . . ." Appellants submit, in the Reply Brief, that a place and time for "fulfillment" of delivery is different from a place and time for which items are delivered to the consumer. We note that the rejection appears to take "a time and a location where the items are fulfilled for delivery" to be synonymous with "a time and a location where the items are delivered [to the consumer]." For example, the rejection relies on Grimes for teaching the step of recording items at a time and place of delivery, and submits that it would have been obvious to combine the teachings of Grimes with Kenney "to store the time and location of delivery. . . ." (Answer at 3.)

Appellants contend (Reply Brief at 2) that "fulfilled for delivery" means the time (and location) that items are shipped from the retailer or distributor, and not the time at which the items are delivered to the consumer, referring to Figure 8 and page 18, first full paragraph of the originally filed application. We do not find any expression of "fulfillment" in the first full paragraph of page 18 of the specification, but box 814 of Figure 8 refers to a product "available for fulfillment" and box 818 reveals that a product is "scanned during fulfillment." Page 10 of the specification refers to a "fulfillment center," not shown in the drawings, that arranges for the physical pickup or delivery of an item or items. The text bridging pages 18 and 19 of the specification reveals that when an item is delivered through "fulfillment system 410" (Fig. 4), product expiration bar code labels (Figs. 9 and 10) are read and stored along with the product in the

purchase history database 406. Expiration dates for perishable items may be recorded manually or in other ways "at the time of order fulfillment."

Appellants' specification is consistent with appellants' argument to the extent that the time and location that an item is "fulfilled for delivery" does not refer to the time and location that the customer receives delivery of the item. The rejection fails because claim 1, and each of the other independent claims, recites limitations concerning storage of information relating to a time and a location where items are fulfilled for delivery, or concerning capture of information at a time and location where the items are fulfilled for delivery (e.g., claim 10). The examiner has not provided any evidence tending to show that the artisan would interpret the time or location that an item is "fulfilled for delivery" to include the time or location that the item is delivered to (i.e., received by) the consumer.

Grimes teaches that when an order is delivered, the user scans (into the refrigerating unit) the bar code that is found on most grocery items, which is data capture (and storage) at the time and location that the item is received by the consumer. Suzuki teaches (col. 5, l. 66 - col. 6, l. 9) storing and using information regarding the date of purchase of goods by consumers. We agree with appellants that the isolated reference to "delivery history" at column 1, lines 49 through 54 of Suzuki is insufficient to teach data capture or storage relating to when or where an item is fulfilled for delivery as claimed. The rejection thus fails to show disclosure or suggestion of all limitations of the claims.

New ground of rejection

We enter the following new ground of rejection against the claims in accordance with 37 CFR § 41.50(b): Claims 1-8, 14, 17, 28, 30, 33, 35, and 36 are rejected under 35 U.S.C. § 112, first paragraph, as the disclosure fails to provide written description for the invention now claimed.

To comply with the "written description" requirement of 35 U.S.C. § 112, first paragraph, an applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention. The invention is, for purposes of the "written description" inquiry, whatever is now claimed. Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). To "convey with reasonable clarity to those skilled in the art" may also be expressed in terms of whether the "necessary and only reasonable construction" to be given the disclosure by one skilled in the art clearly supports the limitation now claimed. See Hyatt v. Boone, 146 F.3d 1348, 1354, 47 USPQ2d 1128, 1132 (Fed. Cir. 1998) ("We do not view these various expressions as setting divergent standards for compliance with § 112. In all cases, the purpose of the description requirement is 'to ensure that the inventor had possession, as of the filing date of the application relied on, of the specific subject matter later claimed by him.'") (quoting In re Edwards, 568 F.2d 1349, 1351-52, 196 USPQ 465, 467 (CCPA 1978)).

The invention claimed does not have to be described in ipsis verbis in order to satisfy the written description requirement. Union Oil Co. v. Atlantic Richfield Co., 208

F.3d 989, 1000, 54 USPQ2d 1227, 1235 (Fed. Cir. 2000). However, one skilled in the art, reading the original disclosure, must be able to immediately discern the limitations now claimed. See Waldemar Link GmbH & Co. v. Osteonics Corp., 32 F.3d 556, 558, 31 USPQ2d 1855, 1857 (Fed. Cir. 1994) ("The fact finder must determine if one skilled in the art, reading the original specification, would immediately discern the limitation at issue in the parent.").

We are mindful, however, that the question of written description support should not be confused with the question of what would have been obvious to the artisan. Whether one skilled in the art would find the instantly claimed invention obvious in view of the disclosure is not an issue in the "written description" inquiry. In re Barker, 559 F.2d 588, 593, 194 USPQ 470, 474 (CCPA 1977). A description which renders obvious the invention for which the benefit of an earlier date is sought is not sufficient. Lockwood v. American Airlines, Inc., 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997).

When a claimed limitation is not present in the written description, it must be shown that a person of ordinary skill would have understood, at the time the application was filed, that the description requires that limitation. See Hyatt v. Boone, 146 F.3d at 1353, 47 USPQ2d at 1131 ("[W]hen an explicit limitation in an interference count is not present in the written description whose benefit is sought it must be shown that a person of ordinary skill would have understood, at the time the patent application was filed, that the description requires that limitation.").

One shows "possession" by descriptive means such as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention. Lockwood, 107 F.3d at 1572, 41 USPQ2d at 1966. It is not sufficient for purposes of the written description requirement that the disclosure, when combined with the knowledge in the art, would lead one to speculate as to modifications that the inventor might have envisioned, but failed to disclose. Id.

Instant claim 1 recites that "the past purchase histories specify a time and a location where the items are fulfilled for delivery. . . ." Page 10, line 6 of the specification states that purchase history database 406 contains the history of the user's previous purchases. When an item is purchased (online), a record of the items purchased is added to the person's purchase history database 406, along with a time visit stamp. (Spec. at 12, ll. 13-15.) The purchase history database may also contain the expiration dates of perishable items. (Id. at 15, ll. 6-7) We find no description of past purchase histories that specify a time and a location where items are fulfilled for delivery.[1]

[1] We compare the claim 1 limitation with, for example, the language of claim 10, which specifies that "the previous purchases of the items and the predetermined shelf life are captured at a time and a location where the items are fulfilled for delivery " (emphasis added), which is consistent with the original disclosure.

Claim 1 also recites, in a related limitation, calculating a periodicity of previous purchases of one or more items previously purchased from the e-commerce site by looking at a pattern of past purchase histories for one or more items, "wherein the periodicity is based upon the time the items are fulfilled for delivery. . . ." The original disclosure made clear, however, that periodicity is based on purchase history (e.g., spec. at 11, ll. 11-12; at 24, ll. 16-22; original claims 1 and 15). We find no description of purchase history information that includes the time the items are fulfilled for delivery, nor of a periodicity based upon the time the items are fulfilled for delivery. Further, we find no description of storing a list of items previously purchased, wherein the list of items "comprises a time of delivery" for at least some of the items, as required by the second step of claim 1, nor of calculating a periodicity based a "time of delivery" of an item, as required by the final line of claim 1.

Instant claim 14 recites similar limitations regarding periodicity and purchase histories that specify a time and a location where the items are fulfilled for delivery, and periodicity based upon the time the items are fulfilled for delivery. Further, in regard to claim 14, we find no description of an interface for storing a list of items previously purchased, wherein the list of items previously purchased "comprises a time of delivery" for at least some of the items.

Finally, with respect to claim 17, we find no description of calculating a shelf-life with a date in the calculation of periodicity. With respect to instant claims 28 and 30, we find no description of calculating a periodicity that is based, in part, on capturing the

past purchase histories by reading a product expiration bar code that indicates the predetermined shelf life for the item. Although, as originally disclosed, such captured information may be used in suggesting replacement of an item with a predetermined shelf life, there is no description of calculating periodicity as claimed.

Claims 1-8, 14, 17, 28, 30, 33, 35, and 36 are thus rejected under 35 U.S.C. § 112, first paragraph, as dependent claims 2-8, 28, 30, 33, 35, and 36 incorporate the limitations of claim 1 or claim 14. Claims 28 and 30 are also rejected for the lack of written description, for additional reasons, as noted.

CONCLUSION

The rejection of claims 1-8 and 10-37 under 35 U.S.C. § 103 as being unpatentable over Kenny, Suzuki, and Grimes is reversed.

A new rejection of claims 1-8, 14, 17, 28, 30, 33, 35, and 36 under 35 U.S.C. § 112, first paragraph, as the disclosure fails to provide written description for the invention now claimed, is set forth herein.

This decision contains a new ground of rejection pursuant to 37 CFR § 41.50(b). 37 CFR § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 CFR § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

> (1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .
>
> (2) *Request rehearing*. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

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

REVERSED -- 37 CFR § 41.50(b)

ANITA PELLMAN GROSS Administrative Patent Judge	)	
STUART S. LEVY Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
HOWARD B. BLANKENSHIP Administrative Patent Judge	)	

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