

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 JEFFREY P. BEZOS, PAUL HAM, MICHAEL McDANIEL,
NEIL ROSEMAN, JOSH PETERSEN, and JOEL R. SPIEGEL

Appeal No. 2005-2570
Application No. 09/280,867

HEARD: January 12, 2006

Before KRASS, DIXON, and BARRY, *Administrative Patent Judges*.
BARRY, *Administrative Patent Judge*.

A patent examiner rejected claims 1-43. The appellants appeal therefrom under 35 U.S.C. § 134(a). We reverse.

I. BACKGROUND

The invention at issue on appeal relates to electronic commerce ("e-commerce"). According to the appellants, e-commerce refers to commercial transactions conducted at least partially via computers. (Spec. at 1.) For its part, the World Wide Web ("Web") of the Internet facilitates e-commerce by enabling vendors to advertise and sell

products. (*Id.* at 2.) The Web also enables vendors to auction products electronically.
(*Id.* at 3.)

Unfortunately, the myriad computer systems that support e-commerce make it difficult for a user to locate all the information needed to make an informed decision to buy or sell. For example, a buyer may want to purchase an item that is being sold or auctioned via several computer servers. (*Id.* at 3.)

Accordingly, the appellants' invention publicizes commercial transactions on a computer network. (*Id.* at 1.) More specifically, when a buyer opts to buy a first item via a computer, the invention identifies at least one auction for an item related to the first item. For example, the first item may be a kayak, and the related item may be a cover therefor. The invention then generates a Web page that includes information for buying the first item and information relating to the auction of the related item. (*Id.* at 30.)

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

1. A method in a computer system for publicizing commercial transactions, the method comprising:

receiving a selection of a purchase transaction for a first item;

identifying an auction for a second item that is related to the first item; and

generating a display description that includes information for conducting the purchase transaction for the first item and that includes information relating to the identified auction for the second item so that a user who may view information relating to a purchase transaction for the first item can view information relating to the identified auction for the second item.

27. A method in a computer system for identifying auctions to recommend to a user, the method comprising:

analyzing access patterns of the user to information describing items that are for sale for a fixed price;

identifying items that may be of interest to the user based on the analysis of the access pattern; and

identifying auctions that are related to those identified items so that the identified auctions can be recommended to the user.

Claims 1-4, 7-9,¹ 11-13, 15-26, and 36-42 stand rejected under 35 U.S.C.

§ 103(a) as obvious over U.S. Patent No. 5,890,138 ("Godin"). Claims 5, 6, 10, 14, 27-

¹ Although the examiner's statement of the rejection and his explanation thereof, (Examiner's Answer, 10.A), omit claim 9, the examiner explains that the claim is rejected. (Final Rej., Office Action Summary.) Claim 9 depends from claim 1, which is rejected as obvious over Godin. Therefore, we treat claim 9 as rejected under the same grounds as claim 1.

33-35,² and 43 stand rejected under § 103(a) as obvious over Godin and Deborah Lynne Wiley ("Wiley"), *Beyond Information Retrieval* (Aug./Sep. 1998).

II. OPINION

Our opinion addresses the claims in the following order:

- claims 1-26 and 30-43
- claims 27-29.

A. CLAIMS 1-26 AND 30-43

Rather than reiterate the positions of the examiner or the appellants *in toto*, we focus on the main point of contention therebetween. The examiner asserts, "Godin teaches advertising both a purchase transaction for an item and an auction for a related

² Although the examiner's statement of the rejection and his explanation thereof, (Examiner's Answer, 10.B), omit claim 34, the examiner explains that the claim is rejected. (Final Rej., Office Action Summary.) Claim 34 depends from claim 30, which is rejected as obvious over Godin and Wiley. Therefore, we treat claim 34 as rejected under the same grounds as claim 30.

Although the examiner's statement of the rejection, (Examiner's Answer, 10.B), also omits claim 35, his explanation of the obviousness rejection over Godin and Wiley refers thereto. (*Id.*, 10.B.iii.) Therefore, we treat claim 35 as also rejected as obvious over Godin and Wiley.

item on a display description (see Godin, Fig. 10). . . ." (Examiner's Answer, ¶ 11.³) He explains that the "reference includes a situation when both purchasing item and auction item are identical. . . ." (*Id.*, ¶ 10.A.i) The appellants argue, "Godin's Figure 10 shows a web page that contains information about the item that is currently being auctioned (e.g., toy Porsche 911 Turbo). Godin's web page, however, is not for conducting the purchase transaction . . . ; rather, it is a web page for conducting an auction." (2d Reply Br. at 5.)

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

1. 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). In answering the question, "[c]laims must be read in view of the

³As noted by the appellants, "[t]he Examiner's Answer does not include page numbers." (Reply Br. at 2 n.1.) In the future, the examiner should number the pages of his Answers to facilitate citation thereto.

specification, of which they are a part." *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979, 34 USPQ2d 1321, 1329 (Fed. Cir. 1995).

Here, independent claim 1 recites in pertinent part the following limitations:
"generating a display description that includes information for conducting the **purchase transaction** for the first item and that includes information relating to the identified auction for the second item. . . ." (Emphasis added.) Independent claims 15, 30, 36, 42, and 43 include similar limitations. During oral hearing, the appellants' attorney emphasized that the appellants' specification defines "purchase transaction" as a fixed price sale. See Spec. at 15 (disclosing "retail purchase transaction of a Whitewater kayak cover at the price of \$75".) Reading the limitations in view of the specification, therefore, the limitations require simultaneously displaying information about an auction and information for buying an item at a fixed price outside of the auction.

2. Obviousness Determination

Having determined what subject matter is being claimed, the next inquiry is whether the subject matter would have been obvious. "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, Godin "is directed to . . . auctioning products on-line where participants use computer terminals to access a computer site and participate." Col. 1, ll. 58-60. As such, the reference displays information about an auction. Specifically, Figure 10 shows a "screen[] that the computer system provides to the user . . . during the auction process." Col. 3, ll. 9-11. "The auction process and the really dynamic variables of the auction process are shown at the bottom portion of the screen indicated as 140. The first column 142, shows the number of units remaining to be auctioned." Col. 6, ll. 27-31. "The price of the unit, at the current time, is shown at 144. . . . The last column 146 identifies the time remaining in the auction. . . ." *Id.* at ll. 32-35.

We are unpersuaded that, along with the information about the auction, Godin simultaneously displays information for buying an item at a fixed price outside of the auction. Also shown in the reference's aforementioned screen, is a "trigger 150

indicating the desire to buy the product at the particular price." *Id.* at ll. 35-36.

The price indicated by the trigger ("the trigger price"), however, is not a price for buying the product outside the auction. To the contrary, the reference explains "[o]nce this trigger is actuated, the user is removed from the auction process and he is asked to complete the screen shown in FIG. 11." *Id.* at ll. 58-60. In other words, the trigger price is part of the auction process.

The examiner does not allege, let alone show, that the addition of Wiley cures the aforementioned deficiency of Godin. Absent a teaching or suggestion of simultaneously displaying information about an auction and information for buying an item at a fixed price outside of the auction, we are unpersuaded of a *prima facie* case of obviousness. Therefore, we reverse the obviousness rejections of claims 1, 15, 30, 36, 42, and 43 and of claims 2-14, 16-26, 31-35, and 37-41, which depend therefrom.

B. CLAIMS 27-29

The examiner admits, "Godin et al. do not mention . . . user's access pattern. . . ." (Examiner's Answer, ¶ 11.) He asserts, however, "Wiley teaches about using a well-known technology of 'collaborative filtering' in computer to identify a user's pattern to come up with the idea of 'a related item'." (*Id.*) The appellants argue, "neither Wiley

nor Godin describes that auctions are identified for recommendations based on the access pattern of the user. . . ." (2d Reply Br. at 7.)

1. Claim Construction

"The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art." *In re Lowry*, 32 F.3d 1579, 1582, 32 USPQ2d 1031, 1034 (Fed. Cir. 1994) (citing *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 403-04 (Fed. Cir. 1983)). Here, independent claim 27 recites in pertinent part the following limitations: "analyzing access patterns of the user to information describing items that are for sale for a fixed price; [and] identifying items that may be of interest to the user based on the analysis of the access pattern. . . ."

Considering all the limitations, claim 27 requires identifying items that may be of interest to a user based on that user's access patterns.

2. Obviousness Determination

For its part, although Wiley identifies items that may be of interest to a user based on access patterns, these access patterns are not access patterns of that user. To the contrary, these are access patterns of other users. Specifically, the reference explains that "[c]ollaborative filtering has been effectively used by a number of sites to

offer recommendations to a user **based on what other users have done.**" P. 4

(Emphasis added.)

Absent a teaching or suggestion of identifying items that may be of interest to a user based on that user's access patterns, we are unpersuaded of a *prima facie* case of obviousness. Therefore, we reverse the obviousness rejection of claim 27 and of claims 28 and 29, which depend therefrom.

III. CONCLUSION

In summary, the rejections of claims 1-43 under § 103(a) are reversed.

REVERSED

ERROL A. KRASS
Administrative Patent Judge

JOSEPH L. DIXON
Administrative Patent Judge

LANCE LEONARD BARRY
Administrative Patent Judge

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