

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

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Ex parte VIKTORS BERSTIS and HERMAN RODRIGUEZ

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Appeal No. 2005-2662  
Application No. 09/335,287

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ON BRIEF

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Before GROSS, SAADAT , and NAPPI , Administrative Patent Judges.  
SAADAT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the Examiner's final rejection of claims 5-7, 10, 13-16, 21, 23, 28-30, 33, 36-39, 44, 46, 51-53, 56, 59-62, 67 and 69. Claims 1-4, 8, 22, 24-27, 31, 45, 47-50, 54 and 68 have been canceled and claims 9, 11, 12, 17-20, 32, 34, 35, 40-43, 55, 57, 58 and 63-66 have been withdrawn from consideration as drawn to a non-elected invention.

We reverse.

BACKGROUND

Appellants' invention is directed to a method and system for adaptively targeting advertisements to a specific client computer from a server based on a generated list of keywords representing the content that appears to be the focus of the client's interest (specification, page 6). The keywords are compared with a database of advertisements in order to select matching advertisements to be inserted into the datastream routed to the client (*id.*). An understanding of the invention can be derived from a reading of exemplary independent claim 5, which is reproduced below:

5. A method for sending advertisements from a server to a client in a distributed data processing system, the method comprising the computer-implemented steps of:  
scanning, on the server, a datastream electronically for a session connecting the server with the client, wherein the datastream comprises HTML tags and ASCII text;  
generating a list of keywords from content within the datastream;  
selecting advertisements based on the generated keyword list; and  
inserting the selected advertisements into the datastream, wherein the step of generating a list of keywords comprises deriving a list of keywords from a moving window of content within the datastream.

The Examiner relies on the following prior art references:

Logan et al. (Logan)	5,721,827	Feb. 24, 1998
Hilsenrath et al. (Hilsenrath)	5,926,812	Jul. 20, 1999

Claims 5-7, 10, 16, 21, 23, 28-30, 33, 39, 44, 46, 51-53, 56, 62, 67 and 69 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Logan.

Claims 13-15, 36-38 and 59-61 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Logan and Hilsenrath.

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We make reference to the briefs and answer for the respective positions of Appellants and the Examiner. 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 briefs have not been considered (37 CFR § 41.37(c)(1)(vii)).

### OPINION

With respect to the rejection of claims 5-7, 10, 16, 28-30, 33, 39, 51-53, 56 and 62 over Logan, the Examiner has indicated how the claimed invention is deemed to be obvious over the modified teachings of Logan to include the step of generating a list of keywords comprising deriving a list from a moving window of content within the datastream (answer, pages 3-4). The Examiner argues that a “moving window of content” is understood by one of ordinary skill in the art as a sample or subset of the total data and concludes that using a moving window in Logan would have been obvious to one of ordinary skill in the art since “sampling saves time and money” (answer, page 4). With respect to claims 21, 23, 44, 46, 67 and 69, the Examiner asserts that caching the datastream prior to scanning and “caching hidden HTML ads” would have been obvious since the datastream may be easily manipulated from a cache while the user may adjust the amount of accepted advertisement (answer, page 5).

Appellants argue that because Logan merely identifies the program data source and divides access program data into segments, the datastream is not dynamically operated on as the datastream is streamed from a server to a client (brief, pages 13-

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14). Appellants further contend that the teachings of Logan as relied on by the Examiner, in fact, refer to scanning of data source (col. 35, lines 14-16) and lack any indication that the data is scanned or converted into a datastream (brief, page 15).

The Examiner responds that the term “datastream” was interpreted, according to a dictionary definition, as “byte-by-byte flow of data” (answer, page 6). The examiner concludes that the claimed use of a moving window of content within a datastream is therefore, the same as the usage/session log of Logan (id.).

Appellants respond that a narrow interpretation of a datastream is the only way the Examiner may equate scanning a static file with the claimed dynamically scanning a datastream (reply brief, page 8). Appellants point out that Logan merely scans data sources (col. 35, lines 14-15) and does not even teach or suggest scanning a file, let alone a datastream (id.). Appellants further argue that using a moving window would not have been obvious since it is not necessarily required for sampling the datastream (reply brief, page 9).

As a general proposition, in rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993) and In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). A prima facie case of obviousness is established when the teachings of the prior art itself would appear to have suggested the claimed subject matter to one of ordinary skill in the art. See In re Bell, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993); In re Fritch, 972 F.2d

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1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992); Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985). In considering the question of the obviousness of the claimed invention in view of the prior art relied upon, the Examiner is expected to make the factual determination 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. See also In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000), citing B.F. Goodrich Co. v. Aircraft Breaking Sys. Corp., 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996).

After a review of Logan, we will not sustain the Examiner's rejection of claims 5-7, 10, 16, 28-30, 33, 39, 51-53, 56 and 62 for essentially the reasons argued by Appellants in the briefs. In particular, we disagree with the Examiner that the usage log 143 in Logan or the scanning of any data source is the same as the claimed datastream for a session connecting the server with the client. Therefore, the Examiner's attempt to modify the content selection of Logan, which is based on scanning the data source, to

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arrive at the claimed deriving a list of keywords from a moving window of content within the datastream is not based on any teachings within the applied reference.

Similarly, with respect to the rejection of claims 21, 23, 44, 46, 67 and 69, we agree with Appellants (brief, page 17) that nowhere does Logan teach or suggest hidden advertisements or caching hidden advertisement content that is not displayed when the document is displayed. We are also convinced by Appellants' arguments that a user selected advertisement is not a hidden advertisement in the sense of imbedding them in the datastream sent to the client (reply brief, pages 12-13). Accordingly, as the Examiner has failed to establish a prima facie case of obviousness, we do not sustain the 35 U.S.C. § 103(a) rejection of claims 5-7, 10, 16, 21, 23, 28-30, 33, 39, 44, 46, 51-53, 56, 62, 67 and 69 over Logan.

Turning now to the 35 U.S.C. § 103(a) rejection of claims 13-15, 36-38 and 59-61 over Logan and Hilsenrath, we note that the examiner has not pointed to any teaching in Hilsenrath that would have overcome the deficiency of Logan discussed above with respect to independent claims 5, 28 and 51. Thus, the 35 U.S.C. § 103(a) rejection of claims 13-15, 36-38 and 59-61 over Logan and Hilsenrath cannot be sustained.

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### CONCLUSION

In view of the foregoing, the decision of the Examiner rejecting claims 5-7, 10, 13-16, 21, 23, 28-30, 33, 36-39, 44, 46, 51-53, 56, 59-62, 67 and 69 under 35 U.S.C. § 103 is reversed.

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

REVERSED

ANITA PELLMAN GROSS	)	
Administrative Patent Judge	)	
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	)	BOARD OF PATENT
MAHSHID D. SAADAT	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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ROBERT NAPPI	)	
Administrative Patent Judge	)	

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