

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FRANK J. SNOW

Appeal 2006-1773
Application 10/051,000
Technology Center 3600

Decided: March 21, 2007

Before TERRY J. OWENS, ROBERT E. NAPPI and ANTON W. FETTING,
Administrative Patent Judges.

ANTON W. FETTING, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF CASE

This appeal involves claims 17 and 18, the only claims pending in this application. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 134.

We AFFIRM.

The appellant invented a method for compiling planetary land property information. An understanding of the invention can be derived from a reading of exemplary claim 17, which is reproduced in the analysis below.

This appeal arises from the examiner's final rejection, mailed September 16, 2005. The appellant filed a brief in support of the appeal on December 12, 2005, and the examiner mailed an answer to the appeal brief on February 23, 2006. A reply brief was filed on March 21, 2006.

PRIOR ART

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

www.moonshop.com, via www.archive.com, 1998-2000 (moonshop.com)

Galaty, Allaway and Kyle, Modern Real Estate Practice, 15th edition, pp. 131-143 and 355-356, 2000 (Galaty)

REJECTION

Claims 17 and 18 stand rejected under 35 U.S.C. § 103(a) as obvious over moonshop.com and Galaty.

ISSUES

The issues pertinent to this appeal are

- Whether the specific details of a document's contents recited in the claim distinguish the invention over the prior art.

- Whether the claimed lack of the capacity of a claimed deed to convey property distinguishes the invention over the prior art.
- Whether data in the claimed document that characterize the delineation of property subdivisions distinguishes the invention over the prior art.
- Whether the size of land parcels specified in a claimed document distinguishes the invention over the prior art.
- Whether the claimed steps are found in moonshop.com .
- Whether property subdivision described in the claimed document is obvious over Galaty.

In particular, the appellant contends that the claim includes a novel creation of a form and content of a Deed of Claim that does not convey property, that the delineation of property in the Deed of Claim is novel, that the size of parcels described in the Deed of Claim are particularly appealing, and that moonshop does not suggest several of the steps in the claimed method.

FACTS PERTINENT TO THE ISSUES

Claim 17 contains the following limitation elements. We have enumerated the elements for ease of reference within this opinion.

	Limitation
1	17. A method of doing business, comprising operations of:
2	developing, producing, assembling, and offering for sale a documentation package covering a lunar land property parcel;
3	wherein the package includes decorative and educational imagery related to the parcel, and further, includes a document herein defined as a Deed of Claim for the parcel;

4	wherein, the primary function of the deed, and so stated in the deed's contents, is to provide an accurate and detailed description of the location and boundary of the parcel, and not to indicate any legal ownership of the parcel;
5	wherein, the land containing the parcel has been subject to the Apollo Lunar Space Program of exploration and survey conducted by the U.S. Government during the 1960's and 1970's, and
6	wherein, the value of the deed is to be based on the possibility that, at some future time, the U.S. Government may choose to claim some part or all of Earth's Moon, and as a consequence, may choose to encourage lunar development by establishing a land grant program ;
7	wherein, as a further consequence, the government may choose to recognize a land grant claimant's ownership of the Deed of Claim for a specific land parcel as an essential element of the claimants [sic. claimant's] request for the specific land parcel;
8	developing a plan of subdivision of the lunar globe into a decreasing size sequence of regions, sections, blocks and parcels;
9	wherein, subdivision of the lunar globe results in four equally sized mid-latitude regions and two equally sized polar regions, said mid-latitude regions defined as Region 1, Region 2, Region 3 and Region 4, and said polar regions defined as Region 5 and Region 6;
10	wherein, a first mid-latitude Region 1 is centered on the equatorial center of the lunar near side, has longitudinal and latitudinal dimensions of 90 degrees, and the remaining three mid-latitude Regions 2, 3 and 4 are similarly constructed with center longitudinal spacings of 90 degrees; and where Polar Region 5 contains all that land from North 45 Degrees Latitude to the Lunar North Pole; and where Polar Region 6 contains all that land from South 45 Degrees Latitude to the lunar South Pole;
11	wherein, Region 1 has the singular quality of containing the 6 Apollo landing sites within its boundary and is accordingly subdivided into 6 sections, each bounded by pairs of longitude and latitude lines, and containing one of the landing sites, with the result that the sections are not necessarily of equal size;
12	wherein, Regions 2, 3, and 4 are each subdivided into 6 sections, three above and three below the lunar equator, each section equally bounded by pairs of 30 degree-spaced lines of longitude and 45 degree-spaced lines of latitude;
13	wherein, Polar Regions 5 and 6 are each subdivided into 4 radial sections, each section equally bounded by pairs of 90 degree-spaced lines of longitude and 45 degree spaced lines of latitude;
14	wherein, the sections of Regions 1, 2, 3, and 4 are each subdivided into a multiplicity of blocks whose latitude and longitude dimensions are 5 degrees;

15	wherein, the blocks contained in the sections of Regions 1, 2, 3, and 4 are each subdivided into a multiplicity of land property parcels whose latitudinal and longitudinal dimensions are 1/3 degree each, whereby such dimensions correspond to a nominal linear value in the range of about 6 miles by 6 miles in the mid-latitude regions of the moon;
16	wherein, the sections of Polar Regions 5 and 6 are each subdivided into 6 blocks of approximately equal size, each block bounded by pairs of 15 degree-spaced-lines of longitude and 45 degree-spaced-lines of latitude;
17	wherein, the blocks contained in the sections of Polar Regions 5 and 6 are each subdivided into land property parcels whose latitudinal dimension is 1/3 degree, corresponding to a linear value of about 6 miles;
18	wherein, the longitudinal angular dimension of a desirably square parcel will vary with the latitude location of a parcel in order to compensate for the decreasing linear separation of the lines of longitude as they converge towards the lunar poles;
19	wherein, a calculation is made to determine what integer value of parcel longitudinal dimension, in terms of degrees and/or minutes of angle, results in an integer number of parcels having a linear width of the order of 4 to 6 miles;
20	establishing the use of map and photographic imagery, in paper and/or digital electronic form, as part of the documentation package, that have been determined to be publicly available from the U.S. Government;
21	wherein, such imagery is used to develop the imagery content of a documentation package;
22	wherein, such imagery content includes three pairs of map and photograph of similar size and intended to be suitable for framing; with imagery scaled in accordance with a sequence which provides a lunar global view and a large area view indicating the general location of the lunar land parcel, and a local area view indicating, in more detail, the location and boundary of the lunar land parcel;
23	establishing a computer-useable database, herein defined as a Master Map and Chart Set of the Lunar Tract, of all parcel locations, as determined from lunar subdivision into the area sequence of regions, sections, blocks, and parcels;
24	establishing an inventory of individual lunar parcels, to be drawn from the above parcel locations database;
25	wherein, for each parcel, a documentation package containing the Deed of Claim and its associated location-oriented imagery is developed, and assembled in paper or computer disc format;
26	establishing the offering for sale of a documentation package for individual lunar parcels;

27	establishing a computer-useable registry, defined herein as the lunar Claim Registry, whose uses will include that of maintaining a record of original ownership of a Deed of Claim, and any subsequent ownership of the deed where such information is made available to the registry operator;
28	establishing the use of copyright protection of the Lunar Claim Registry, with its Deed of Claim ownership data contents, as a method for achieving data storage in the U.S. Archives;
29	establishing an organization of members, in the form, for example, of a lunar Claim Society, whose focus is the provision of information of common interest to Deed of Claim owners;
30	wherein, the organization functions include periodic generation of a newsletter, primarily internet-based, to provide information of potential interest to society members and other readers.

Moonshop.com describes developing, producing, assembling, and offering for sale a documentation package covering a lunar land property parcel at e.g., p. 5 and 11.

Galaty describes developing a plan of subdivision into a decreasing size sequence of regions, sections, blocks and parcels at 132-133 describing the use of longitudinal and latitudinal based meridian and base lines, incorporating the correction lines at p. 135-136. Moonshop.com suggests this method of parceling subdivisions by its macroscopic partitioning by latitude and longitude on the maps on p. 5.

Moonshop.com describes establishing the use of map and photographic imagery, in paper and/or digital electronic form, as part of the documentation package, that have been determined to be publicly available from the U.S. Government at e.g., p. 11 and 12.

Moonshop.com describes establishing a computer-useable database of all parcel locations, as determined from lunar subdivision into the area sequence of regions, sections, blocks, and parcels at e.g., p. 5 the lunar sight map.

Moonshop.com describes establishing an inventory of individual lunar parcels, to be drawn from the above parcel locations database at e.g., p. 5 the lunar site map.

Moonshop.com describes establishing the offering for sale of a documentation package for individual lunar parcels at e.g., p. 5.

Moonshop.com describes establishing a computer-useable registry maintaining a record of original ownership of a Deed of Claim, and any subsequent ownership of the deed where such information is made available to the registry operator at e.g., p. 9 After Sales service.

Establishing the use of copyright protection of the registry, with its data contents, as a method for achieving data storage in the U.S. Archives is inherent by the operation of the regulations in registering for copyright.

Moonshop.com describes establishing an organization of members whose focus is the provision of information of common interest to Deed of Claim owners is shown by moonshop.com p. 27 extraterrestrial mailing list.

PRINCIPLES OF LAW

In order to determine whether a prima facie case of obviousness has been established, we considered the three factors set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966), viz., (1) the scope and content of the prior art; (2) the differences between the prior art and the claims at issue; and (3) the level of ordinary skill in the art. We also considered the requirement, as recently re-stated in *In re Kahn*, 441 F.3d 977, 78 USPQ2d 1329 (Fed. Cir. 2006), for a showing of a

“teaching, suggestion, or motivation” to modify or combine the prior art teaching.

As to this test, the court explained,

The ‘motivation-suggestion-teaching’ test asks not merely what the references disclose, but whether a person of ordinary skill in the art, possessed with the understandings and knowledge reflected in the prior art, and motivated by the general problem facing the inventor, would have been led to make the combination recited in the claims.... From this it may be determined whether the overall disclosures, teachings, and suggestions of the prior art, and the level of skill in the art – *i.e.*, the understandings and knowledge of persons having ordinary skill in the art at the time of the invention – support the legal conclusion of obviousness.

441 F.3d at 988, 78 USPQ2d at 1337 (internal citations omitted). It is not just the explicit teachings of the art itself, but also the understandings and knowledge of persons having ordinary skill in the art, that play a role in applying the motivation-suggestion-teaching test.

The Federal Circuit has repeatedly recognized that to establish a *prima facie* case of obviousness, the references being combined do not need to explicitly suggest combining their teachings. See e.g., *In re Kahn*, 441 F.3d at 987-88, 78 USPQ2d at 1336 (“the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references”); and *In re Nilssen*, 851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988) (“for the purpose of combining references, those references need not explicitly suggest combining teachings”). The court recently noted,

An explicit teaching that identifies and selects elements from different sources and states that they should be combined in the same way as in the invention at issue, is rarely found in the prior art. As precedent illustrates, many factors are relevant to the motivation-to-combine aspect of the obviousness inquiry, such as the field of the specific invention, the subject matter of the references, the extent to which

they are in the same or related fields of technology, the nature of the advance made by the applicant, and the maturity and congestion of the field.

In re Johnston, 435 F.3d 1381, 1385, 77 USPQ2d 1788, 1790 (Fed. Cir. 2006).

Nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious. *In re Ngai*, 367 F.3d 1336, 1339, 70 USPQ2d 1862, 1864 (Fed. Cir. 2004). Cf. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability).

Differences of spacing in lines drawn on printed paper are generally obvious to a person of ordinary skill in the art (See *In re Cavrich*, 59 CCPA 883, 451 F.2d 1091, 172 USPQ 121 (CCPA 1971) in which the distinctions between the groups of spaced lines recited in the appealed claims and the groups of spaced lines disclosed in the prior art were held to be of minor importance, and that the modifications would have been obvious to one of ordinary skill in the pattern drafting art.)

“[T]he steps comprising the process are the essential features for consideration in determining the right of appellants to a patent – not the particular material to which the process is applied nor the particular substance obtained by its application.” *In re Fahrni*, 41 CCPA 768, 771, 210 F.2d 302, 303, 100 USPQ 388, 390 (CCPA 1954).

ANALYSIS

Claims 17 and 18 rejected under 35 U.S.C. § 103(a) as obvious over moonshop.com and Galaty.

Claim 17 is a method claim. The actual enumerated steps are set forth in elements

2 - developing, producing, assembling, and offering for sale a documentation package covering a lunar land property parcel. As shown in the above facts, moonshop.com has incorporated this step.

8 - developing a plan of subdivision of the lunar globe into a decreasing size sequence of regions, sections, blocks and parcels. As shown in the above facts, moonshop.com has incorporated this step.

20 - establishing the use of map and photographic imagery, in paper and/or digital electronic form, as part of the documentation package, that have been determined to be publicly available from the U.S. Government. As shown in the above facts, moonshop.com has incorporated this step.

23 - establishing a computer-useable database of all parcel locations, as determined from lunar subdivision into the area sequence of regions, sections, blocks, and parcels. As shown in the above facts, moonshop.com has incorporated this step.

24 - establishing an inventory of individual lunar parcels, to be drawn from the above parcel locations database. As shown in the above facts, moonshop.com has incorporated this step.

26 - establishing the offering for sale of a documentation package for individual lunar parcels. As shown in the above facts, moonshop.com has incorporated this step.

27 - establishing a computer-useable registry, defined herein as the lunar Claim Registry, whose uses will include that of maintaining a record of original ownership of a Deed of Claim, and any subsequent ownership of the deed where such information is made available to the registry operator. As shown in the above facts, moonshop.com has incorporated this step.

28 - establishing the use of copyright protection of the Lunar Claim Registry, with its Deed of Claim ownership data contents, as a method for achieving data storage in the U.S. Archives. As shown in the above facts, this is inherent in the operation of copyright law.

29 - establishing an organization of members, in the form, for example, of a lunar Claim Society, whose focus is the provision of information of common interest to Deed of Claim owners. As shown in the above facts, moonshop.com has incorporated this step.

Thus, all of the claimed steps are anticipated by moonshop.com. As shown in the principles of law above, the steps comprising the process are the essential features in determining the rights to a patent.

The additional claim 17 limitations, not reciting steps, but characterizing the package of non-functional descriptive material that is created, include

Element 3 - wherein the package includes decorative and educational imagery related to the parcel, and further, includes a document herein defined as a Deed of Claim for the parcel, all of which are shown by Moonshop.com at p. 5.

Elements 4-7, which describe the purported function and value of the document. However, there is no functional relationship between the contents of the documents and the underlying substrate recited in these limitations. Therefore, these are descriptions of non-functional descriptive material. When descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability. Further, this element is a conjectural and aspirational characterization of the document, and therefore does not limit the actual scope of the claimed document.

Elements 9-19, which describe the convention employed in describing the moon's subdivisions. These elements form the bulk of the claim text, and of the arguments proffered by the Appellant. However, voluminous as this text is, there is no functional relationship between the contents of the documents and the underlying substrate recited in these limitations. Therefore, these claim elements are no more than characterizations of non-functional descriptive material. When descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability. Also, this convention for parceling property is a species of the genus of Galaty's convention of using longitudinal and latitudinal based meridian and base lines. Differences of spacing in lines drawn on printed paper are generally obvious to a person of ordinary skill in the art. Similarly, differences in the spacing of longitudinal and latitudinal based meridian and base lines used to establish borders for property plats drawn on printed paper are generally obvious to a person of ordinary skill in the art. Whether particular purchasers would prefer a particular size or location, as argued by the appellant, is a matter of subjective preference, suggesting a limitation on the intended field of use, but does not

distinguish the invention over the art of record. Therefore, the particular numbers used to segment the longitudinal and latitudinal boundaries in the claims would have been obvious variants of those described by Galaty.

Element 21 - wherein such imagery is used to develop the imagery content of a documentation package, shown by Moonshop.com at p. 5.

Element 22, which describes a global view, intermediate view and local view shown by Moonshop.com at p. 5, 6 and 10. This element describes the intent of the views, and is therefore aspirational rather than functional, thus creating 3 pictures. Such an indication of intent describes a limitation on the intended field of use, but does not distinguish the invention over the art. As to providing 3 views, this is a species of the number of views provided well within the foreseeable range of the number of views suggested by moonshop.com, particularly because it was notoriously well known at the time of the invention to copy whatever views of maps were desired with the then existing map atlases.

Element 25, wherein, for each parcel, a documentation package containing the Deed of Claim and its associated location-oriented imagery is developed, and assembled in paper or computer disc format, is shown by moonshop.com at p. 5.

Element 30 describes the social purpose of the organization recited in element 29. Such an indication of intent describes a limitation on the intended field of use and is aspirational rather than functional, and does not distinguish the invention over the art.

Claim 18 extends the subject matter claimed in claim 17 to documentation of planets, which is, again, a limitation on intended use that does not distinguish the invention over the art.

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Accordingly we sustain the examiner's rejection of claims 17 and 18 under 35 U.S.C. § 103(a) as obvious over moonshop.com and Galaty.

DECISION

To summarize, our decision is as follows:

- The rejection of claims 17 and 18 under 35 U.S.C. § 103(a) as obvious over moonshop.com and Galaty is sustained.

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Application Number: 10/051,000

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

AFFIRMED

TERRY J. OWENS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
ROBERT E. NAPPI)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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ANTON W. FETTING)	
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AWF/jlb

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