

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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

Appeal 2007-0220
Application 09/982,640
Technology Center 2100

Decided: May 31, 2007

Before JAMES D. THOMAS, JOSEPH F. RUGGIERO, and
ALLEN R. MACDONALD, *Administrative Patent Judges*.

THOMAS, *Administrative Patent Judge*.

DECISION ON APPEAL

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Application No. 09/982,640

This appeal involves claims 1 through 42 and 44, which constitute all the claims pending in this application. We have jurisdiction under 35 U.S.C. § 6(b) and § 134(a). An oral hearing regarding this appeal was conducted on May 23, 2007.

As best representative of the broadest disclosed and claimed invention, independent claim 1 is reproduced below:

1. A method of supplying advertisement information to a user searching for said information within a data network, comprising the steps of: receiving from the user, a series of search rules comprising facts about an advertisement; accessing a database comprising details of a plurality of advertisements; using a search engine to apply said search rules to said database; and reporting, to the user, results comprising a subset of the contents of said database.

The following references are relied on by the Examiner:

Loeb	US 6,421,652 B2	Jul. 16, 2002 (filed Jul. 27, 1999)
Skillen	US 6,098,065	Aug. 1, 2000

In a first stated rejection, the Examiner has rejected all claims on appeal, claims 1 through 42 and 44 under 35 U.S.C. § 102(b) as being anticipated by Skillen. Secondly, claims 1 through 10, 39 through 42, and 44 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Loeb. Lastly, claims 11 through 38 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the Examiner relies upon Loeb alone.

Rather than repeat the positions of the Appellant and the Examiner, reference is made to the Brief and Reply Brief for Appellant's positions, and to the Answer for the Examiner's positions.

OPINION

For the reasons set forth by the Examiner in the Answer, as amplified here, we sustain each of the three separately stated rejections of the claims on appeal. The Examiner has correlated each of the respective independent claims to specific teachings of Skillen and Loeb as well as grouped common subject matter of grouped dependent claims in the same manner. In like manner, the Examiner's responsive arguments beginning at the bottom of page 8 of the Answer address specifically numbered points of the Appellant's arguments in the principal Brief on appeal. The following remarks buttress the Examiner's positions by expanding upon the analysis as well as the consideration of the teachings of the respective references, further in view of the extensive arguments in the Brief and Reply Brief.

At the outset, it appears to us that the subject matter presented in all claims on appeal relates to features that may differ from the prior art solely on the basis of "non-functional descriptive material," which is generally not given patentable weight when determining patentability of an invention over the prior art. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983). The PTO may not disregard claim limitations comprised of printed matter. *See Gulack*, 703 F.2d at 1384, 217 USPQ at 403; *see also Diamond v. Diehr*, 450 U.S. 175, 191, 209 USPQ 1, 10 (1981). However, the Examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. *See In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338, 70 USPQ 1862, 1864 (Fed. Cir. 2004). We conclude that when the prior art describes all the claimed structural and functional relationships between the

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descriptive material and the substrate, but the prior art describes a different descriptive material than the claim, and then the descriptive material is non-functional and will not be given any patentable weight. That is, we conclude that such a scenario presents no new and unobvious functional relationship between the descriptive material and the substrate. In the instant case on appeal, we find that the invention of all claims on appeal recites non-functional descriptive material which does not provide a patentable distinction to the data or to the process of the claimed methods. In other words, we find that the meaning relating to facts about an advertisement and/or details of a plurality of advertisements cannot be used to distinguish the claimed invention from prior art data/facts/details. Therefore, we conclude that the invention of claims 1 through 42 and 44 is not patentably distinguishable from the teachings of the applied prior art.

In accordance with the hearing panel's questioning of Appellant's representative at oral hearing, patentability of the claimed subject matter of the claims on appeal was said to be dependent on the nature of the information recited. Consistent with those arguments in the Brief and Reply Brief, patentability was predicated to be based upon the characterization or labels attributed to the information content *per se* not to any variations or improvements or novelty associated with the actual processes set forth in the method claims on appeal. We will add our correlations here to those the Examiner already did in the Answer to correlate some teachings of the references to the particular characterizations of the information of the claims on appeal. The two references relied upon convey to the artisan the same teaching concepts of the processes that are recited.

Skillen's Abstract and the initial paragraphs of the Summary of the Invention at column 1 indicate that the user is searching for "desired information." The scope of search of the user by means of search rules, search arguments, search terms, search statements, or search criteria in Skillen is not limited to the nature/topic of the information searched for or the intent of the user (such as in claims 2, 7, 12, 19, 26, and 33). The process itself of representative independent claim 1, for example, is not different; the claim is only allegedly different in the nature of the information or the characterization of it to which no patentable weight will be given. Corresponding observations are appropriate as to Loeb as well.

Skillen's advertising machine 10 in Figure 1 is also characterized as a selling system at column 2, lines 11 through 32. Customers and advertisers exercising buying and selling capabilities are taught generally at column 3, lines 9 through 19; column 4, lines 64 through column 5, line 6, and column 6, lines 28 through 45.

According to the teachings of Skillen, the user is taught to be able to enter information in various forms which may be considered a search argument for use by various search engines in both figures of Skillen. There are repeated teachings in Skillen of the user's ability to do this in addition to a feature taught associated with Figure 1 but explicitly shown in Figure 2 of Skillen of the system of both figures assessing or otherwise keeping and updating user profiles such as user profile database 48 in Figure 2. Because the teachings of the operation of Figure 1 beginning at the middle of column 4 and the corresponding teachings of the operation of Figure 2 beginning at the bottom of column 5 indicate the user preferences are sought, the user

may be considered to be queried by the system for modifying or otherwise refining the searches that the user initially enters.

According to the operation of Figure 1 beginning at the middle of column 4, the results of the initial pass of a search argument through the database search engine 16 in Figure 1 to the contextual database 22 in that figure yields results for the claimed first search results, which in turn are passed along with the initial search arguments to the associative search engine 18 in that figure for queries with respect to the product database 24 which in turn yields its own search results corresponding to the claimed second search results. For purposes of the single search engine of claim 1, both search engines or the result of the second one or either one of them may yield a search result and correspondingly, the claimed first and second search engines of claims 11 and 25 may correspond to these elements as well. It is significant to note here that the claimed first and second search engines are not recited to be different search engines such that search results derived from either one of them and which is further modified or refined according to the teachings of Skillen may yield a second result effectively from a second search engine. Clearly, from Skillen's teachings, the more refined the search, the smaller the ending subset of results.

Based upon the remarks at oral hearing and the nature of the arguments in the principal Brief and Reply Brief, consistent with the above noted constraints, no patentable significance can be given to the characterization of information content relating to connotations and demographic usages such as in independent claims 39 and 42 on appeal. The mere use of a contextual searchable database 22 in Figure 1 and 46 in Figure 2 relates to connotative information. The intent of Skillen in the use

of an associative search engine 18 in Figure 1 and 40 in Figure 2 relates to the ability of Skillen to retrieve related information to that which may be specifically recited in a search query of a user. Indeed, the Examiner has pointed specifically to the teachings of fuzzy logic to the extent recited in some of the dependent claims on appeal that is taught in Skillen. As to the meanings attributed to the words “connotations” and “demographics,” Skillen teaches related concepts at column 2, lines 44 through 58; column 3, lines 1 through 19; column 4, lines 64 through column 5, line 6; and column 6, lines 28 through 45. As the nature of the search process proceeds from the initial search through and to a refined search, the artisan would appreciate that so-called “targeted” information is sought or searched for.

Skillen even teaches the ability to determine synonyms by use of the logical “OR” at column 1, lines 19 through 25 and the alternate descriptions discussion there in addition to the teachings at column 3, lines 20 through 28 and column 5, lines 7 through 17 as well as the user profiles discussed with respect to the system of Figure 1 and the database associated with these profiles as element 48 in Figure 2.

As grouped by the Examiner at the bottom of page 3 of the Answer, no arguments are presented in the Brief as to dependent claims 3, 8, 13, 20, 27, and 34. As to Appellant’s arguments at page 25 of the principal Brief on appeal relating to dependent claims 6, 18, and 32, we have already pointed out that the nature of the teachings of Skillen includes customers. As to Appellant’s remarks at pages 26 and 27 of the principal Brief on appeal relating to dependent claims 23 and 37, we emphasize again that the two search engines recited in other dependent claims are not recited to be different in the sense of the same associative search engine in Figures 1 and

2 of Skillen. To refine the initially returned search results, they utilize a plurality of times the same set of fuzzy logic of claims 23 and 37. No arguments are presented to us in the principal Brief on appeal as to dependent claims 4, 9, 14 through 16, 21, 22, 28 through 30, 35, 36, 40, 41, and 44.

Although most of these initial remarks in this opinion relate to the rejection of various claims over Skillen, they do apply to each of the three separately stated rejections of the claims on appeal. Likewise, to the extent the Examiner has not addressed Appellant's arguments in the principal Brief on appeal to certain dependent claims relating to Skillen or Loeb, this appears to be either an oversight or the Examiner is relying upon the stated rejection effectively to respond to any additional remarks in the Briefs. We have identified certain dependent claims not argued by Appellant with respect to the rejection of Skillen and have addressed those that have been argued.

As to Loeb, Figures 1 through 3 of this reference show a consumer or customer of representative dependent claim 6 on appeal operating with a central controller 110, the details of which are set forth in Figures 2 and 3 in a query response dialog arrangement. Figures 2 and 3 show consumer databases and a plurality of duplicate, even redundant servers such as the search server and hot swap server as well as a database in a server farm and presentation to a user server farm. Figure 4 relates to a consumer database to which the artisan may attribute various demographics information. Figures 6 and 7 relate to publisher and fulfillment house data structures and their respective databases with respective contact points and address information correlated to respective trade magazines or items to be sold to

qualified users, customers, or consumers. Because Loeb teaches a dialog that may be interactive between the user or consumer to effectively refine by successive usages the nature of the information sought from either party, at least two levels of search results are depicted in Figure 8, shown in Figure 9, and shown in more detail in Figure 10 with examples given in various parts in Figure 11. The ability of the systems to update or refine the searches and qualifications of consumers is depicted in Figures 12 and 13.

The concept of a consumer/customer is discussed in the paragraph at column 1, lines 42 through 57 to the point of even discussing advertisers and sales or fees associated with the process. Of importance here is the ability to target an audience for specific trade publications (also summarized at column 15, lines 21 through 24) such as to elicit various demographics information. Advertising may proceed to various consumers and refinements thereof according to the discussion at column 9 outlined by the Examiner in the Answer. At least according to the teachings at columns 11 and 12, a certain market analysis and demographic approaches to matching a consumer database with magazine databases associated with trade publications are taught. The nature of the algorithmic approaches appears in Loeb to be more deductive than any other approach.

Our earliest remarks in this opinion relate to the features of dependent claims 2 and 7 argued by Appellant with respect to the rejection relying upon Loeb. Likewise, we have addressed the algorithmic recitations of dependent claims 4, 9, 41, and 44. Other than independent claims 11 and 25, no arguments are presented in the Brief and Reply Brief as to any dependent claim depending from these independent claims according to the rejection under Loeb.

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In view of the foregoing, the decision of the Examiner rejecting various claims on appeal under 35 U.S.C. § 102 and 35 U.S.C. § 103 is affirmed.

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

AFFIRMED

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