

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 JAMES C. COLSON and AJEI GOPAL

Appeal 2007-0278
Application 10/042,047
Technology Center 2100

Decided: May 15, 2007

Before JAMES D. THOMAS, ALLEN R. MACDONALD, and
ST. JOHN COURTENAY III, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1-42.

THE INVENTION

The disclosed invention is generally directed to the field of computer networks, and, in particular, to the display of Internet web page content.

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More particularly, the disclosed invention relates to an improved method and system for allowing a user of a device having a limited size display to pay for receipt of the web page content (Specification 1).

Representative claim 1 is illustrative:

1. A method for receiving on a user device a web page content from a network content server, said method comprising;

requesting, from a user device and via a billing server, a single web page's content from a network content server;

displaying on the user device multiple options from the billing server to a single user of the user device to view the single web page's content for a price, wherein each option has a different price;

selecting, by the single user, at the user device at least one of the options;

receiving at the user device a request content from the single web page according to the selected option, wherein the requested content is less than all of the single web page; and

displaying on the user device the requested content from the single web page.

THE REFERENCES

The Examiner relies upon the following references as evidence of anticipation and unpatentability:

Shamoon	US 2004/0107356 A1	June 3, 2004
Nicolas	US 6,593,944 B1	July 15, 2003
Mitchell	US 6,701,350 B1	Mar. 2, 2004

THE REJECTIONS

The following rejections are on appeal before us:

1. Claims 6, 12, and 18 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.
2. Claims 1-3, 7-9, 13-15, 19-22, 25-30, 33-38, 41, and 42 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Shamoon.
3. Claims 4-6, 10-12, 16-18, 24, 32, and 40 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Shamoon in view of Nicolas.
4. Claims 23, 31, and 39 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Shamoon in view of Mitchell.

Rather than repeat the arguments of Appellants or the Examiner, we make reference to the Brief and the Answer for the respective details thereof.

OPINION

Only those arguments actually made by Appellants have been considered in this decision. It is our view, after consideration of the record before us, that the evidence relied upon supports the Examiner's rejection of claims 1, 2, 4-8, 10-14, 16-20, 22-28, 30-36, and 38-42, but does not support the Examiner's rejection of claims 3, 9, 15, 21, 29, and 37. Accordingly, we affirm-in-part. In addition, we have *sua sponte* set forth new grounds of

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rejection for claims 3, 9, 15, 21, 29, and 37 pursuant to our authority under 37 C.F.R. § 41.50(b).

Claims 6, 12, and 18

We consider first the Examiner's rejection of dependent claims 6, 12, and 18 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

We begin by noting that § 112, first paragraph, of the Patent Act states that the “specification shall contain a written description of the invention.” 35 U.S.C. § 112. We note that the Court of Appeals for the Federal Circuit has held that “[t]o fulfill the written description requirement, the patent specification must describe an invention in sufficient detail that one skilled in the art can clearly conclude that the inventor invented what is claimed.” *Kao Corp. v. Unilever U.S., Inc.*, 441 F.3d 963, 967–968, 78 USPQ2d 1257, 1260 (Fed. Cir. 2006) (quoting *Cordis Corp. v. Medtronic AVE, Inc.*, 339 F.3d 1352, 1364, 67 USPQ2d 1876, 1885 (Fed. Cir. 2003)). Our reviewing court has cautioned, however, that “[t]he disclosure as originally filed does not ... have to provide *in haec verba* support for the claimed subject matter at issue.” *Cordis Corp. v. Medtronic AVE, Inc.*, 339 F.3d at 1364, 67 USPQ2d at 1885 (internal citation omitted). “Although [the applicant] does not have to describe exactly the subject matter claimed, ... the description must clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed.” *In re Gosteli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989) (citations omitted). Put another way, “the 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

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invention.” *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991) (emphasis in original). The written description, although it need not include information that is already known and available to the experienced public, must be in sufficient detail to satisfy the statutory requirements, employing “[w]ords, structures, figures, diagrams, formulas, etc., that fully set forth the claimed invention.” *Space Systems/Loral, Inc. v. Lockheed Martin Corp.*, 405 F.3d 985, 987, 74 USPQ2d 1534, 1535 (Fed. Cir. 2005) (quoting *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997)). “Precisely how close the original description must come to comply with the description requirement of section 112 must be determined on a case-by-case basis.” *Eiselstein v. Frank*, 52 F.3d 1035, 1039, 34 USPQ2d 1467, 1470 (Fed. Cir. 1995) (quoting *Vas-Cath*, 935 F.2d at 1561, 19 USPQ2d at 1116). With respect to negative limitations, our reviewing court has determined that an “express intent to confer on the claim language the novel meaning imparted by [the] negative limitation” is required, such as an “express disclaimer or independent lexicography in the written description.” *Omega Engineering, Inc. v. Raytek Corp.*, 334 F.3d 1314, 1323, 67 USPQ2d 1321, 1327 (Fed. Cir. 2003) (internal citations omitted).

In the instant case, we find Appellants do not disclose an express disclaimer or independent lexicography in the written description that provides support for the recited negative limitation of a “non-text image.” In particular, we note that the disputed negative limitation for claims 6, 12, and 18 (i.e., “non-text image”) was added by an amendment to the claims filed on Oct. 19, 2004. While literal support is not required, we nevertheless find

that Appellants have failed to convey with reasonable clarity to those skilled in the art that Appellants were in possession of the invention as of the filing date sought. We further note that Appellants merely rely upon a dictionary definition for “image” and argue that an “image” is a “non-text image” (*see* Br. 11). We agree with the Examiner that a broad but reasonable interpretation of the term “image” encompasses the set of all images, including images of textual documents. Therefore, we find the weight of the evidence supports the Examiner’s position. Accordingly, we will sustain the Examiner’s rejection under *35 U.S.C. § 112, first paragraph*, of claims 6, 12, and 18.

Claims 1, 2, 7, 8, 13, and 14

We consider next the Examiner’s rejection of claims 1, 2, 7, 8, 13, and 14 as being anticipated by Shamoon. Since Appellants’ arguments with respect to this rejection have treated these claims as a single group which stands or falls together, we will select independent claim 1 as the representative claim for this rejection because we find it is the broadest independent claim in this group. *See 37 C.F.R. § 41.37(c)(1)(vii)(2004)*.

At the outset, we note that Appellants have also argued that dependent claims 4, 5, 10, 11, 16 and 17 are not *anticipated* by Shamoon (*see* Br. 8, ¶ 1). Because dependent claims 4, 5, 10, 11, 16, and 17 were rejected by the Examiner on grounds of being unpatentable over Shamoon in view of Nicolas, we find Appellants’ arguments moot with respect to these claims as being anticipated by Shamoon. We specifically address the Examiner’s rejection of claims 4 and 5 as being unpatentable over Shamoon in view of Nicolas *infra*. Because Appellants have failed to traverse the Examiner’s

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rejection of dependent claims 10, 11, 16, and 17 within the Brief, we will *pro forma* sustain the Examiner's rejection of claims 10, 11, 16, and 17 as being unpatentable over Shamoon in view of Nicolas.

With respect to the Examiner's rejection of claims 1, 2, 7, 8, 13, and 14 as being anticipated by Shamoon, Appellants acknowledge that Shamoon teaches a system for paying a different price for streaming content (MPEG, MP3) according to different features of the content. Appellants point out that such different features include whether an MPEG-4 file includes advertisements (§ 0475), or whether a music file has a predetermined fidelity or quality level (§ 0358). Appellants note that such content may be either streamed or sent as a static data structure (§ 0331). However, Appellants argue that there is no teaching, expressly or implicitly, of displaying a single web page in accordance with the option(s) selected by a requester, as claimed (claim 1). Appellants conclude that a movie MPEG file or an audio MP3 file is not reasonably equivalent to a "single web page," as claimed (Br. 8).

The Examiner disagrees. The Examiner argues that Shamoon discloses selection of a priced option to display a single web page with or without advertisements (§§ 0349-0350). As seen in paragraph 0239, the Examiner argues that the object, or web page, is disclosed to be presented as a whole in accordance with corresponding rules that govern the web page object. The Examiner asserts that each object recited in paragraph 0239 refers to the website. The Examiner concludes that disclosures regarding a MP3 file or streamed file represent alternate embodiments within

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Shamoono. In particular, the Examiner points to Shamoon at paragraph 0248:

[0248] The commerce appliance function is not restricted to streamed channel content but may include various *browser-type applications consisting of aggregated composite content such as still imagery, text*, synthetic and natural video and audio and functional content such as applets, animation models and so on, these devices include *browsers*, set-top boxes, etc. [emphasis added].

In rejecting claims under 35 U.S.C. § 102, a single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation. *Perricone v. Medicis Pharmaceutical Corp.*, 432 F.3d 1368, 1375-76, 77 USPQ2d 1321, 1325-26 (Fed. Cir. 2005) (citing *Minn. Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1565, 24 USPQ2d 1321, 1326 (Fed. Cir. 1992)).

Anticipation of a patent claim requires a finding that the claim at issue “reads on” a prior art reference. *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1346, 51 USPQ2d 1943, 1945 (Fed. Cir. 1999) (“In other words, if granting patent protection on the disputed claim would allow the patentee to exclude the public from practicing the prior art, then that claim is anticipated, regardless of whether it also covers subject matter not in the prior art.”) (internal citations omitted).

We will sustain the Examiner’s rejection of representative claim 1 for essentially the same reasons argued by the Examiner in the Answer. In particular, we note that Shamoon expressly discloses: “*browser-type applications consisting of aggregated composite content such as still*

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imagery, text, ...” (¶ 0248, emphasis added). Shmoon further discloses that content may be streamed or may be received as static data structures (¶ 0331). Even if the work is a video work (e.g., *see* ¶ 0346), we note that Shmoon’s invention supports the Real Networks architecture (¶ 0196) that we find is capable of displaying a video screen embedded within a single web page. Therefore, we find the weight of the evidence supports the Examiner’s position that the argued language of the claim broadly but reasonably reads on Shmoon in the manner indicated in the Answer.

Pursuant to 37 C.F.R. § 41.37(c)(1)(vii), we have decided the appeal with respect to the claims 2, 7, 8, 13, and 14 on the basis of the selected representative claim alone. Therefore, we will sustain the Examiner’s rejection of these claims as being anticipated by Shmoon for the same reasons discussed *supra* with respect to representative claim 1.

Claims 19, 20, 25-28, 35, and 36

We consider next the Examiner’s rejection of claims 19, 20, 25-28, 35, and 36 as being anticipated by Shmoon. Since Appellants’ arguments with respect to this rejection have treated these claims as a single group which stands or falls together, we will select independent claim 19 as the representative claim for this rejection because we find it is the broadest independent claim in this group. *See* 37 C.F.R. § 41.37(c)(1)(vii)(2004).

Appellants argue that “there is no teaching, expressly or implicitly, of sending a ‘single web page’ in accordance with the option(s) selected by a requester,” as claimed (Br. 9, ¶ 1).

In response, we note that a “single web page” is not recited within any of independent claims 19, 27, and 35 (and associated dependent claims). In contrast, independent claims 19, 27, and 35 each recite “web page content.” Because a “single web page” is not equivalent to “web page content” (which could refer to any content within a single web page, such as a discrete image, icon, URL link, or text section), we find that Appellants are arguing limitations that are not claimed. We note that patentability is based upon the claims. “It is the claims that measure the invention.” *SRI Int’l v. Matsushita Elec. Corp. of America*, 775 F.2d 1107, 1121, 227 USPQ 577, 585 (Fed. Cir. 1985) (*en banc*). We further note that arguments which Appellants could have made but chose not to make in the Brief have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii)(2004). *See also In re Watts*, 354 F.3d 1362, 1368, 69 USPQ2d 1453, 1458 (Fed. Cir. 2004). Therefore, we find that Appellants have not shown the Examiner erred in rejecting representative claim 19 based on anticipation. Accordingly, we will sustain the Examiner’s rejection of representative claim 19 as being anticipated by Shamoon.

Pursuant to 37 C.F.R. § 41.37(c)(1)(vii), we have decided the appeal with respect to the claims 20, 25-28, 35, and 36 on the basis of the selected representative claim alone. Therefore, we will sustain the Examiner’s rejection of these claims as being anticipated by Shamoon for the same reasons discussed *supra* with respect to representative claim 19.

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Claims 3, 9, 15, 21, 29, and 37

We consider next the Examiner's rejection of claims 3, 9, 15, 21, 29, and 37 as being anticipated by Shamoon.

Appellants note that Shamoon is cited by the Examiner at paragraph 0287 for teaching the limitation of pricing options based on an age of the web page content. Appellants note that the cited passage of Shamoon teaches that a user may be charged more for watching more streamed programming. Specifically, Shamoon discloses: "based on a pre-payment, the user has the right to watch 12 hours of programming" (Shamoon, ¶ 0287). Appellants argue there is no teaching expressly or implicitly, of adjusting a fee according to an "age" of the content. Appellants assert that Shamoon adjusts a charge according to how much content is presented during 12 hours of programming. In contrast, Appellants argue that exemplary claim 3 adjusts a charge according to staleness ("age") of a single piece of content (Br. 9).

The Examiner disagrees. The Examiner argues that age is a period of existence. The Examiner argues that Shamoon teaches a price option based on how long the programming exists (e.g., 12 hours) (Answer 10).

We will reverse the Examiner's rejection of claims 3, 9, 15, 21, 29, and 37 for essentially the same reasons argued by Appellants. In particular, we find the Examiner has failed to point to a specific disclosure in Shamoon where the prices of the options are based on an age of at least a portion of the single web page content. We agree with Appellants that Shamoon adjusts a charge according to how much content is presented during 12 hours of programming. Because dependent claims 3, 9, 15, 21, 29, and 37 each

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recite equivalent limitations, we find the Examiner has failed to establish a prima facie case of anticipation for these claims. However, we have *sua sponte* set forth new grounds of rejection *infra* for claims 3, 9, 15, 21, 29, and 37 pursuant to our authority under 37 C.F.R. § 41.50(b).

Claim 22

We consider next the Examiner's rejection of dependent claim 22 as being anticipated by Shamoon.

Appellants note that Shamoon is cited by the Examiner at paragraph 0454 et seq. and Figs. 2 and 7, for teaching the feature that "the multiple offers are defined by a non-URL, descriptive portion of a script header to the web page content." Appellants further note that Figs. 2 and 7 relate to control messages for delivery of streamed content (see, e.g., ¶ 0101). Appellants point to Rule 710 that specifies a user who agrees to pay a certain amount may view a Stream 49, but non-paying users may not (*see* Shamoon, ¶ 0102). Appellants argue there is no teaching or suggestion of sending offers to view the content in the non-URL header, as claimed in Claim 22. Appellants further argue that paragraph 0454 appears to teach away from the use of a non-URL descriptive portion of a script header, since the cited paragraph teaches the use of a URL message that references another CMP message ... in keeping with the standard of using URLs to point to streams. (Br. 10).

The Examiner disagrees. The Examiner argues that offers are a part of the rules section of the header and can be seen in Shamoon's Fig. 7 as separate from the URL descriptive portion (Answer 10).

We begin our analysis by noting that the Court of Appeals for the Federal Circuit has determined “[t]eaching away is irrelevant to anticipation.” *Seachange International, Inc., v. C-Cor, Inc.*, 413 F.3d 1361, 1380, 75 USPQ2d 1385, 1398 (Fed. Cir. 2005), *citing Celeritas Tech., Ltd., v. Rockwell Int’l Corp.*, 150 F.3d 1354, 1361, 47 USPQ2d 1516, 1522 (Fed. Cir. 1998); *Bristol-Myers Squibb Co. v. Ben Venue Labs., Inc.*, 246 F.3d 1368, 1378, 58 USPQ2d 1508, 1515 (Fed. Cir. 2001). Therefore, we find Appellants’ argument misplaced that Shmoon teaches away from the use of “a non-URL descriptive portion of a script header” because the Examiner has rejected claim 22 under 35 U.S.C. § 102. We further find that the weight of the evidence supports the Examiner’s position that offers are a part of the rules section of the header (e.g., Rule 710) that is separate from the URL descriptive portion. *See* Fig. 7 and ¶ 0102:

[0102] In this case, Rule 710 specifies that a user who agrees to pay a certain amount (or provide a certain amount of information) may view Stream 49, but all other users are required to view Stream 50, or a combination of Streams 49 and 50. In this case, Stream 49 may represent a movie or television program, while Stream 50 represents advertisements ... When the user initially attempts to access the video encoded in Stream 49, Rule 710 could put up a message asking if the user would prefer to use pay for view mode or advertising mode. If the user selects pay for view mode, Rule 710 could store (or transmit) the payment information, and pass Cryptographic Key 712 to Stream Controller 18. Stream Controller 18 could use Cryptographic Key 712 to decrypt the first stream until receipt of a header indicating that a different key is needed to decrypt the following set of packets. Upon request by Stream Controller 18, Control Block 13 would then check to determine that payment had been made, and then release Cryptographic Key

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713, which would be used to decrypt the following packets, and so on. Rule 710 could additionally release Cryptographic Key 716, corresponding to Organization Stream 52, which corresponds to video without advertisements.

(Shamoon, ¶ 0102).

Therefore, we find that the language of the claim (i.e., wherein multiple offers are defined by a non-URL descriptive portion of a script header to the web page content) broadly but reasonably reads on Shamoon's Rule 710 in the manner argued by the Examiner, i.e., where Rule 710 corresponds to "a non-URL descriptive portion of a script header" and "Controlled Streams 49-53" correspond to "the web page content" (*see* Shamoon Fig. 7, *see also* instant claim 22). Accordingly, we will sustain the Examiner's rejection of dependent claim 22 as being anticipated by Shamoon.

Claims 30, 38, 41, and 42

We consider next the Examiner's rejection of dependent claims 30, 38, 41, and 42 as being anticipated by Shamoon.

Appellants argue that claims 30, 38, 41, and 42 should be allowed for the same reasons previously argued for independent claims 27 and 35, from which these claims depend (Br. 11).

We note that Appellants have not presented any substantive arguments directed separately to the patentability of dependent claims 30, 38, 41, and 42. In the absence of a separate argument with respect to the dependent claims, those claims stand or fall with the representative independent claim. *See In re Young*, 927 F.2d 588, 590, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991). *See also* 37 C.F.R. § 41.37(c)(1)(vii)(2004).

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Therefore, we will sustain the Examiner's rejection of these claims for the same reasons discussed *supra* with respect to independent claims 27 and 35.

Claims 6, 12, and 18

We consider next the Examiner's rejection of dependent claims 6, 12, and 18 as being unpatentable over the teachings of Shamoon in view of Nicolas.

Appellants argue even if Shamoon's multimedia stream (¶ 0349) is considered to be an image, Shamoon and Nicolas nevertheless do not teach or suggest a multimedia image from a "single web page," as claimed (Br. 10-11).

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966). "[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability." *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Furthermore, "there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness' . . . [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *KSR Int'l Co. v. Teleflex Inc.*, 127

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S. Ct. 1727, 82 USPQ2d 1385, 1396 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)).

In the instant case, we have fully addressed the issue of the “single web page” limitation with respect to claim 1 *supra*. Therefore, we will sustain the Examiner’s rejection of claims 6, 12, and 18 as being unpatentable over the teachings of Shamoon in view of Nicolas for the same reasons discussed *supra* with respect to independent claim 1.

Claims 4, 5, 24, 32-34, and 40

We consider next the Examiner’s rejection of dependent claims 4, 5, 24, 32-34, and 40 as being unpatentable over the teachings of Shamoon in view of Nicolas.

Appellants argue that claims 4, 5, 24, 32-34, and 40 should be allowed for the same reasons previously argued for independent claims 1, 19, 27 and 35, from which these claims depend (Br. 11).

We note that Appellants have not presented any substantive arguments directed separately to the patentability of dependent claims 4, 5, 24, 32-34, and 40 . In the absence of a separate argument with respect to the dependent claims, those claims stand or fall with the representative independent claim. *See In re Young*, 927 F.2d at 590, 18 USPQ2d at 1091. *See also* 37 C.F.R. § 41.37(c)(1)(vii)(2004). Therefore, we will sustain the Examiner’s rejection of these claims as being unpatentable over the teachings of Shamoon in view of Nicolas for the same reasons discussed *supra* with respect to independent claims 1, 19, 27 and 35.

Claims 23, 31, and 39

We consider next the Examiner's rejection of dependent claims 23, 31, and 39 as being unpatentable over the teachings of Shamoon in view of Mitchell.

Appellants argue that claims 23, 31, and 39 should be allowed for the same reasons previously argued for independent claims 19, 27 and 35, from which these claims depend (Br. 11).

We note that Appellants have not presented any substantive arguments directed separately to the patentability of dependent claims 23, 31, and 39. In the absence of a separate argument with respect to the dependent claims, those claims stand or fall with the representative independent claim. *See In re Young*, 927 F.2d at 590, 18 USPQ2d at 1091. *See also* 37 C.F.R. § 41.37(c)(1)(vii)(2004). Therefore, we will sustain the Examiner's rejection of these claims as being unpatentable over the teachings of Shamoon in view of Mitchell for the same reasons discussed *supra* with respect to independent claims 19, 27 and 35.

NEW GROUNDS OF REJECTION

Pursuant to our authority under 37 C.F.R. § 41.50(b), we have *sua sponte* set forth new grounds of rejection for claims 3, 9, 15, 21, 29, and 37.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Decision:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be

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patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 9, 15, 21, 29, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shmoon (US 2004/0107356 A1) in view of Dalzell et al. (US 2003/0204447 that is a non-provisional of provisional application 60/336409, filed October 31, 2001).

Claims 3, 9, 15, 21, 29, and 37

Shmoon discloses the invention substantially as claimed (*see* the Examiner's rejections of corresponding independent claims 1, 7, 13, 19, 27, and 35, respectively, as set forth in the Answer (pp. 4-5), and incorporated herein by reference.

However, Shmoon does not *explicitly* teach: "wherein the prices of the options are based on an age of the at least a portion of the single web page content," as claimed (claims 3, 9, 15, 21, 29, and 37).

Dalzell teaches and/or suggests the prices of the options are based on an age of the at least a portion of the single web page content:

See e.g., paragraph 0071:

[0071] In accordance with another aspect of the invention, the online marketplace system may provide a service for suggesting a suitable selling or asking price to the creator of a marketplace or preorder listing, respectively. For example, *the system may use one or more of the following criteria to suggest a selling price to a user who is creating a marketplace listing*: the current retail price for the product, the manufacture's suggested retail price, the condition and/or *age of the product* (as specified by the user, or predicted from the user's purchase history in the

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case of a re-sell item), prices paid by other marketplace users for the same or similar products of like condition. In one embodiment, the user is free to use or ignore the suggested price. In embodiments in which auctions are supported, a seller may use the suggested price to (1) select a minimum price at which bids are to be accepted, and/or (2) select a "buy it now" price at which a buyer can immediately purchase the item. As described below, marketplace system's user interface may support the ability for a user to create a marketplace listing (including specifying the selling price and condition), from a product detail page or a purchase history listing, with a single mouse click or other single selection action (emphasis added).

(Dalzell, ¶ 0071).

See also Dalzell provisional application 60/336409, filed October 31, 2001 at ¶ 0071:

[0071] According to one embodiment, the seller may also enter in a text line adding condition specifics, such as, for example, "Never Been Opened," "Just Like New," "*Showing Age*," or the like (emphasis added).

(Dalzell, ¶ 0071, provisional application 60/336409).

When we take account of the inferences and creative steps that a person of ordinary skill in the art would employ, we conclude it would have been obvious to a person of ordinary skill in the art at the time the invention was made to improve upon the system taught by Shmoon by implementing Dalzell's improvements (as described above) because it would provide Shmoon's system with the enhanced capability of "assist[ing] potential buyers in efficiently locating the marketplace listings for a particular product" (Dalzell, ¶ 0013).

DECISION

We sustain the Examiner's rejection of claims 1, 2, 4-8, 10-14, 16-20, 22-28, 30-36, and 38-42, but we reverse the Examiner's rejection of claims 3, 9, 15, 21, 29, and 37. Therefore, the decision of the Examiner rejecting claims 1-42 is affirmed-in-part.

We have entered a new grounds of rejection against claims 3, 9, 15, 21, 29, and 37 under 37 C.F.R. § 41.50(b).

As indicated *supra*, this decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b) (amended effective September 13, 2004, by final rule notice 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. & Trademark Office 21 (September 7, 2004)). 37 C.F.R. § 41.50(b) provides that "A new ground of rejection . . . shall not be considered final for judicial review."

37 C.F.R. § 41.50(b) also provides that the Appellants, 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) 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 . . .

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- (2) 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 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART
37 C.F.R. § 41.50(b).

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