

1 The opinion in support of the decision being entered today was *not* written for
2 publication and is *not* binding precedent of the Board.
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6 UNITED STATES PATENT AND TRADEMARK OFFICE
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9 BEFORE THE BOARD OF PATENT APPEALS
10 AND INTERFERENCES
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13 *Ex parte* RAVINDRA R. MANTENA, CHRISTINA L. MATTOON,
14 BIJAY SATPATHY and JULIE A. WHEELER-CYRAN
15

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17 Appeal No. 2007-0770
18 Application No. 09/752,330
19 Technology Center 3600
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22 Decided: April 23, 2007
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25 Before TERRY J. OWENS, HUBERT C. LORIN, and ROBERT E. NAPPI
26 *Administrative Patent Judges.*

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28 NAPPI, *Administrative Patent Judge.*
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31 DECISION ON APPEAL
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33 This is a decision on appeal under 35 U.S.C. § 134 of the final rejection of
34 claims 1 through 48. For the reasons stated *infra* we affirm the Examiner's
35 rejection of these claims.
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INVENTION

The invention is directed to a method for facilitating electronic transactions over the internet. Often purchasers will have contractual agreements with sellers to purchase goods or services at special prices (entitled prices). These prices are often not made public, however agents of the purchasers need to be able to ascertain the entitled price over a public network, the internet. The invention provides a method for the entitled price to be obtained over a public network. See pages 2 through 4 of Appellants' Specification. Claim 1 is representative of the invention and reproduced below:

1. A method of providing an entitled price in an electronic transaction, comprising:
electronically sending by a requestor a request for an entitled price based on a preexisting entitlement from a public electronic environment;
automatically routing the request to a private electronic environment;
obtaining the entitled price within the private electronic environment in real time while the requestor waits; and
automatically returning the entitled price from the private electronic environment to the public electronic environment for providing to the requestor.

REFERENCES

The references relied upon by the Examiner are:

Lidow US 6,889,197 B2 May 3, 2005

Mantena US 6,999,949 B2 Feb. 14, 2006

Roberto Michel, "Multiplatform Pursuits" Manufacturing Systems, Nov. 1998, Vol. 16, Iss. 11, p. 44. (Multiplatform)

REJECTIONS AT ISSUE

Claims 1 through 48 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 through 45 of Mantena. The Examiner's rejection is set forth on pages 4 and 5 of the Answer.¹ Claims 1 through 3, 9 through 11, 13 through 15, 21 through 23, 25 through 27, 33 through 35, 37 through 39, and 45 through 47 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lidow. The Examiner's rejection is set forth on pages 5 through 7 of the Answer.

Claims 4 through 8, 16 through 20, 28 through 32, and 40 through 44 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lidow in view of Multiplatform. The Examiner's rejection is set forth on pages 7 and 8 of the Answer.

Claims 12, 24, 36, and 48 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lidow in view of Official Notice. The Examiner's rejection is set forth on page 8 of the Answer.

Throughout the opinion we make reference to the Brief and Reply Brief (filed June 22, 2006 and November 8, 2006 respectively), and the Answer (mailed September 8, 2006) for the respective details thereof.

¹ We note that the statement of the rejection identifies this as a provisional rejection and relies upon the published application 2002/0087477 which matured into the patent to Mantena. The Appellants' arguments and the Examiner's response to arguments both refer to the rejection as being non-provisional and directed to the patent claims. Accordingly, we treat this rejection as a non-provisional rejection and consider it as applied using the Mantena patent.

1 a) Double Patenting Rejection

2 ISSUES

3 Appellants contend that the Examiner's rejection based upon obviousness-
4 type double patenting is in error. Appellants assert that the Examiner has
5 improperly applied the printed matter doctrine and as such ignored the limitation of
6 an entitled price which is not taught by the claims of the Mantena patent.
7 Appellants argue that the "printed matter case law is inapplicable to computer-
8 based inventions." (Br. P. 12). Further, Appellants argue that Mantena does not
9 teach obtaining the entitled price in "real time."

10 The Examiner contends that the rejection based upon obviousness-type
11 double patenting is proper. The Examiner states, that there is no functional
12 relationship between the claimed "entitled price" and the method. Further, the
13 Examiner interprets the term real time as being a relative term that includes some
14 delay, and concludes any the response of Mantena's system to be in real time.

15 Initially we note that Appellants' arguments directed to the obviousness-type
16 double patenting rejection, group claims 1 through 48 together. Thus, we group
17 claims 1 through 48 together and select claim 1 as the representative claim.
18 Appellants' contentions present us with three issues, first whether the printed
19 matter doctrine applies to computer based inventions such as claimed, second
20 whether the claims of the Mantena patent teach or make obvious the claim
21 limitation of an "entitled price" and third whether the claims of Mantena teach
22 providing the "entitled price" in real time.

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FINDINGS OF FACT

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2 Claim 1 of the Mantena patent recites “electronically receiving a sales order
3 ... obtaining an entitled price..... while the purchaser waits ... automatically
4 returning the electronic order confirmation ... wherein the order confirmation
5 comprises the entitled price.” Implicit, if not obvious, in claim 1 is that if the
6 order is received electronically it was sent electronically. Further, the claim recites
7 that the response to the sales order is an “order confirmation”, thus the sales order
8 is in among other things a request for an order confirmation. The claim further
9 recites that the order confirmation comprises the entitled price. Thus, we find that
10 claim 1 of Mantena patent implies that the sales order is a request for entitled price.
11

PRINCIPLES OF LAW

12
13 Although no issue under 35 U.S.C. § 101 is before this Board, the decisions
14 of our reviewing courts on this issue do provide useful guidance with respect to (a)
15 distinctions between “functional” and “non-functional” descriptive material, and
16 (b) how the distinctions impact the courts’ treatment of each type of descriptive
17 material.

18 When functional descriptive material is recorded on some computer-
19 readable medium, it becomes structurally and functionally interrelated to the
20 medium and will be statutory in most cases since use of technology permits the
21 function of the descriptive material to be realized. *Compare In re Lowry*, 32 F.3d
22 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994) (claim to data structure
23 stored on a computer readable medium that increases computer efficiency held
24 statutory) and *In re Warmerdam*, 33 F.3d 1354, 1360-61, 31 USPQ2d 1574, 1759
25 (claim to computer having a specific data structure stored in memory held statutory
26 product-by-process claim) with *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760

1 (claim to a data structure per se held nonstatutory).

2 When non-functional descriptive material is recorded on some computer-
3 readable medium, in a computer or on an electromagnetic carrier signal, it is not
4 statutory since no requisite functionality is present to satisfy the practical
5 application requirement. Merely claiming non-functional descriptive material, *i.e.*,
6 abstract ideas, stored in a computer-readable medium, in a computer, on an
7 electromagnetic carrier signal does not make it statutory. *See Diamond v. Diehr*,
8 450 U.S. 175, 185-86, 209 USPQ 1, 7-8 (1981) (noting that the claims for an
9 algorithm in *Benson* were unpatentable as abstract ideas because “[t]he sole
10 practical application of the algorithm was in connection with the programming of a
11 general purpose computer.”). Such a result would exalt form over substance. *In re*
12 *Sarkar*, 588 F.2d 1330, 1333, 200 USPQ 132, 137 (CCPA 1978) (“[E]ach
13 invention must be evaluated as claimed; yet semantogenic considerations preclude
14 a determination based solely on words appearing in the claims. In the final analysis
15 under 101, the claimed invention, as a whole, must be evaluated for what it is.”)
16 (quoted with approval in *Abele*, 684 F.2d 902, 907, 214 USPQ 682, 687 (CCPA
17 1982)). See also *In re Johnson*, 589 F.2d 1070, 1077, 200 USPQ 199, 206 (CCPA
18 1978) (“form of the claim is often an exercise in drafting”). Thus, nonstatutory
19 music is not a computer component and it does not become statutory by merely
20 recording it on a compact disk. Protection for this type of work is provided under
21 copyright law.

22 When presented with a claim comprising descriptive material, an Examiner
23 must determine whether the claimed nonfunctional descriptive material should be
24 given patentable weight. The Patent and Trademark Office (PTO) must consider
25 all claim limitations when determining patentability of an invention over the prior
26 art. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983). The

1 PTO may not disregard claim limitations comprised of printed matter. *See*
2 *Gulack*, 703 F.2d at 1384, 217 USPQ at 403; *see also Diamond v. Diehr*, 450 U.S.
3 at 191, 209 USPQ at 10. However, the Examiner need not give patentable weight
4 to descriptive material absent a new and unobvious functional relationship between
5 the descriptive material and the substrate. *See In re Lowry*, 32 F.3d 1579, 1583-
6 84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338, 70
7 USPQ2d 1862, 1863-64 (Fed. Cir. 2004) and or recent final decision in *Ex parte*
8 *Curry* 2005-0509 (Board. Pat. App. Inter. 2007, available at
9 <http://des.uspto.gov/Foia/ReterivePdf?flNm=fd050509.pdf>) (Affirmed, Rule 36,
10 CAFC 06-1003, June 2006).

11 ANALYSIS

12 As discussed above in the principles of law section we hold that the “non-
13 functional descriptive material” doctrine applies to computer implemented
14 inventions. Further, we note that Appellants have not presented any argument or
15 analysis functionally relating the limitation “entitled price” to the method, nor do
16 we find any. For this reason alone, Appellants’ arguments have not persuaded us
17 of error in the Examiner’s obviousness double patenting rejection of claims 1
18 through 48. Nonetheless, as discussed above we find that claim 1 of Mantena
19 patent does make obvious sending a request for an entitled price.

20 Appellants’ reply brief does not address the claim limitation of “real time”
21 with respect to the obviousness-type double patenting rejection, but rather
22 addresses it only with respect to the rejections under 35 U.S.C. § 103(a).
23 Nonetheless, as it was argued in the Brief we will address the issue as it applies to
24 both rejections. Appellants present an extrinsic definition of the term as “a level of
25 computer responsiveness that a user senses as sufficiently immediate or that
26 enables the computer to keep up with some external process.” Further, Appellants

1 point to pages 8 and 9 of the Appellants' specification which describe operation of
2 the claimed invention wherein an operator waits for a response. We agree with
3 Appellants. One of ordinary skill in the art, given the Appellants' disclosure,
4 would understand the term "real time" to not be instantaneous, but rather involve
5 some delay, but nonetheless require the time to be sufficiently immediate to a users
6 input or that enables a computer to keep up with some external process. However,
7 we note that the passages of Appellants' specification which support the above
8 determination of "real time" are also present in the Mantena patent (i.e., the
9 disclosure on pages 8 and 9 of Appellants specification are virtually identical to the
10 disclosure in column 9 of the Mantena patent). Thus, we find that one skilled in
11 the art would also recognize that the limitation of "while the purchaser waits" in
12 claim 1 of Mantena patent is similarly referring to providing the entitled price in
13 real time. Accordingly, we find for the Examiner and sustain the Examiner's
14 rejection of claims 1 through 48 under the judicially created doctrine of
15 obviousness-type double patenting.

16
17 b) Rejections under 35 U.S.C. § 103(a) as being unpatentable over Lidow

18 ISSUES

19 Appellants contend that Lidow does not teach that the price is obtained by the
20 customer in real time while the customer waits as recited in the claims. (Br. 14).
21 Appellants assert that Lidow teaches calculating pricing after delivery of goods,
22 thus the pricing is not provided real time to when the purchaser ordered the goods.
23 (Reply Br. 5). Further, Appellants argue that the Examiner improperly relied upon
24 the non-function descriptive material doctrine and ignored the limitation of
25 "entitled price" a feature not taught by Lidow. (Br. 14, 15)

1 the user in response to an order request (the request which the Examiner equates to
2 the request for an entitled price).

3 ANALYSIS
4

5 Claim 1 recites “obtaining the entitled price within the private electronic
6 environment in real time while the requestor waits.” Independent claims 13, 25,
7 and 37 recite similar limitations. As discussed above we consider the term
8 “entitled price” to be a reference to non-functional descriptive material and as such
9 will not differentiate the claimed invention from the prior art. Nonetheless, the
10 independent claims do recite that the “entitled price” is requested by a user and
11 returned to the user in real time, after routing the request between a public and
12 private environment, while the user waits. As discussed *supra* we do not find that
13 Lidow teaches or suggests that any of the real time reports are returned to the user
14 in response to an order request, the request which the Examiner equates to the
15 request for an entitled price. Thus, we do not find sufficient evidence to support
16 the Examiner’s rejection of independent claims 1, 13, 25, and 37.

17 We recognize that dependent claims 4 through 8, 12, 16 through 20, 24, 28
18 through 32, 36, 40 through 44, and 48 stand rejected under 35 U.S.C. § 103(a) as
19 being unpatentable over Lidow and additional evidence. Although Appellants have
20 presented no arguments directed to these claims, the Examiner’s rejection of these
21 claims builds upon the rejection of independent claims 1, 13, 25, and 37. The
22 Examiner has not asserted nor do we find that that the additional evidence makes
23 up for the above noted deficiency in the rejection of independent claims 1, 13, 25,
24 and 37. Accordingly, we do not sustain the rejection of claims 4 through 8, 12, 16
25 through 20, 24, 28 through 32, 36, 40 through 44, and 48, for the reasons discussed
26 with respect to claims 1, 13, 25, and 37.

1 CONCLUSION

2 We sustain the Examiner's rejection of claims 1 through 48 under the
3 judicially created doctrine of obviousness-type double patenting. However, we do
4 not sustain the Examiner's rejections of claims 1 through 48 under 35 U.S.C.
5 § 103(a) as we do not find that sufficient evidence to support the Examiner's
6 rejection of independent claims 1, 13, 25, and 37. The decision of the Examiner
7 is affirmed.

8 No time period for taking any subsequent action in connection with this
9 appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2006).

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11 AFFIRMED

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20 HESLIN, ROTHENBERG, FARLEY & MESITI PC
21 5 COLUMBIA CIRCLE
22 ALBANY NY 12203