

The opinion in support of the decision being entered today is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JULES S. COHEN, PAUL K. KROMANN, and
THOMAS S. REEVE

Appeal 2007-1539
Application 09/741,362
Technology Center 2100

Decided: June 28, 2007

Before JOSEPH F. RUGGIERO, ANITA PELLMAN GROSS, and
JEAN R. HOMERE, *Administrative Patent Judges*.

RUGGIERO, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134 from the Final Rejection of claims 1-4, 6-12, 14-16, 18-21, 24-26, and 28. Claims 5, 13, 17, 22, 23, and 27 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

Appellants' invention relates to a system and method for execution of live content usage experiments in which an assigned unique identification

tag is retrieved from a content requesting client. The unique identification tag is processed to determine if the requesting user is part of a test subject group or a non-test subject group. Based upon the determination, the requesting user is provided with either experimental content or non-experimental content. Content usage data is then analyzed to compare usage of experimental content versus non-experimental content to thereby determine the effectiveness of the experimental content. (Specification 3-4).

Claim 1 is illustrative of the invention and reads as follows:

1. A method of executing a plurality of live content usage experiments comprising the acts of:

providing a unique identification tag to a content requesting client computing device by a content server;

processing said unique identification tag upon receiving a request for content from said client computing device by said content server to verify if said client computing device is a test subject;

offering experiment content to said client computing device if said client computing device is verified as a test subject;

tracking content usage at said content server of experiment content and non-experiment content offered to said client computing device to produce content usage data; and

analyzing said content usage data to compare usage of experiment content versus non-experiment content to determine if experiment content was used more often than non-experiment content.

The Examiner relies on the following prior art reference to show unpatentability:

Liu	US 6,839,680 B1	Jan. 4, 2005 (filed Sep. 30, 1999)
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Claims 1-4, 6-12, 14-16, 18-21, 24-26, and 28, all of the appealed claims, stand rejected under 35 U.S.C. § 102(e) as being anticipated by Liu.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Briefs and Answer for the respective details. 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 and are deemed waived [see 37 C.F.R. § 41.37(c)(1)(vii)].

ISSUE

Under 35 U.S.C § 102(e), does Liu have a disclosure which anticipates the invention set forth in claims 1-4, 6-12, 14-16, 18-21, 24-26, and 28?

PRINCIPLES OF LAW

It is axiomatic that anticipation of a claim under § 102 can be found if the prior art reference discloses every element of the claim. *See In re King*, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986) and *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984).

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).

ANALYSIS

With respect to the 35 U.S.C. § 102(e) rejection of independent claims 1, 10, 16, and 26 based on the teachings of Liu, the Examiner indicates (Answer 3-4) how the various limitations are read on the disclosure of Liu. In particular, the Examiner directs attention to the illustration in Figure 6 of Liu, as well as the disclosure at column 2, lines 15-25, column 5, lines 30-67, and column 17, lines 15-55 of Liu.

Appellants’ arguments in response assert that the Examiner has not shown how each of the claimed features is present in the disclosure of Liu so as to establish a *prima facie* case of anticipation. Appellants’ arguments (Br. 6-7; Reply Br. 5) initially focus on the contention that, in contrast to the requirements of the appealed claims, Liu never makes any determination or verification that identified users are part of a test group.

After reviewing the disclosure of Liu in light of the arguments of record, we are in general agreement with Appellants’ position as stated in the Briefs. We find no support in the portion of Liu (column 4, lines 36-41), or elsewhere in Liu, for the Examiner’s finding that the users in Liu are “test subjects” since they have been selected out of a larger group. To the contrary, our interpretation of the disclosure of Liu coincides with that of Appellants, i.e., all users in Liu are provided with an identification and their web activity is observed and tracked with no indication that any particular

user might be identified as part of a test group. (Liu, col. 11, l. 59 through col. 13, l. 21).

We further agree with Appellants (Br. 8; Reply Br. 6) that, the Examiner's arguments to the contrary notwithstanding, Liu has no disclosure of what might be reasonably interpreted as experimental content and non-experimental content, let alone any disclosure of the determination of how such information might be used by a verified member of test and non-test subject groups as claimed. Although the Examiner cited Liu's "SportWorld" example (column 28, lines 29-52) in support of the stated position, we agree with Appellants that, in Liu's example, no verification as to whether the requesting user is a test subject ever takes place. Further, there is no indication that a requesting user might receive experimental or non-experimental content depending on whether a requesting user is verified as being a member of a test group.

In view of the above discussion, since all of the claim limitations are not present in the disclosure of Liu, we do not sustain the Examiner's 35 U.S.C. § 102(e) rejection of independent claims 1, 10, 16, and 26, nor of claims 2-4, 6-9, 11, 12, 14, 15, 18-21, 24, 25, and 28 dependent thereon.¹

¹ We make the observation that the language of claim 1 lacks clarity and precision. While the claim recites "offering experiment content..." to a client device upon verification that the client computing device is a test subject, the succeeding clause recites that both experiment and non-experiment content is offered to the client computing device. We leave it to the Examiner and Appellants to address this matter in any further prosecution on this application.

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CONCLUSION

In summary, we have not sustained the Examiner's 35 U.S.C. § 102(e) rejection of any of the claims on appeal. Therefore, the decision of the Examiner rejecting claims 1-4, 6-12, 14-16, 18-21, 24-26, and 28 is reversed.

REVERSED

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