

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LOTFI BELKHIR

Appeal 2007-1778
Application 10/249,645
Technology Center 2100

Decided: November 28, 2007

Before: KENNETH W. HAIRSTON, MAHSHID D. SAADAT, and
ALLEN R. MACDONALD, *Administrative Patent Judges.*

MACDONALD, *Administrative Patent Judge.*

DECISION ON APPEAL
STATEMENT OF THE CASE

Appellant appeals a Final Rejection of claims 27-50 under 35 U.S.C. § 134. We have jurisdiction under 35 U.S.C. § 6(b).

Appellant invented a computerized method and system for creating a customized document having content elements from a plurality of content providers and having user-specified physical features. (Spec., p. 3, ¶¶[0010]-[0014].) The method and system display partial tokens that

represent at least the cost of each content element as well as a final token that represents the total cost of the customized document. (Spec., p. 3, ¶¶[0015]-[0016].) The method and system also accept payment from the customer and distribute payments to the content providers. (Spec., p. 3, ¶[0017].)

Claim 27 is exemplary and is reproduced below:

27. A computerized method for creating a customized document, comprising:

providing access to a plurality of document content elements in electronic format from a plurality of content portion providers;

receiving a user selection of at least two document content elements from at least two different content portion providers, each document contact¹ element having at least a portion of the document content selected;

obtaining and displaying a partial token for each selected content element, each partial token including information related to a respective content element or portion thereof selected including cost;

receiving physical parameter information from the user;

organizing and forming a final customized document from a compilation of the selected content elements based on the physical parameter information;

compiling and displaying a final composite token, the final composite token including at least a total cost for the final customized document;

¹ We have analyzed this claim by considering “contact” to be “content.” Should there be further prosecution, this term should be changed to “content.”

receiving payment information for the customized document;
authorizing distribution of the customized document to the user;
and

distributing payment to each of several content portion
providers in accordance with the partial token cost information.

The prior art relied upon by the Examiner in rejecting the claims on
appeal is:

Tharaken	US 2003/0144961 A1	Jul. 31, 2003
Ginter	US 2002/0048369 A1 ²	Apr. 25, 2002

Claims 27-50 are rejected under 35 U.S.C. § 103(a) as being
unpatentable over the combined teachings and suggestions of Tharaken and
Ginter.

Rather than repeat the arguments of Appellant or the Examiner, we
make reference to the Briefs and the Answer for their respective details.
Only those arguments actually made by Appellant have been considered in
this decision. Arguments which Appellant could have made but chose not to
make in the Briefs have not been considered and are deemed to be waived.
See 37 C.F.R. § 41.37(c)(1)(vii) (2004).

We AFFIRM.

² Now U.S. Patent No. 7,124,302.

FINDINGS OF FACT

The following Findings of Fact (FF) are shown by a preponderance of the evidence.

Tharaken

1. Tharaken teaches a system for the creation, packaging, and distribution of books customized from content obtained from one or more sources. (¶[0025].)
2. Tharaken teaches that content made available to the user from several distinct types of sources may include content that is proprietary or may be provided by or licensed from third party vendors. (¶¶[0046]-[0048].)
3. Tharaken teaches a shopping cart that contains all of the meta-data required to uniquely identify content from a given source. (¶[0051].)
4. Tharaken teaches that a user is asked to provide various identifying information about the new book to be created such as a client name and/or billing code if the book is being created for a third party client. (¶[0044].)

Ginter

5. Ginter teaches a system for distributing digital content from owners of the content to users and ensuring that information is accessed and/or otherwise used only in authorized ways. (¶¶[0002] and [0008].) The system manages the payment for each piece of content by the users to the owners. (¶¶[0092] and [0426].)

6. Ginter teaches a “pop-up” user interface 686 that allows flexible browsing through libraries of properties or objects available for licensing or purchase. (¶[2070].) Figure 72D of Ginter shows multiple digital content properties (e.g., CHUCK JONES BIOGRAPHY and TEX AVERY BIOGRAPHY) along with the size, the publisher, and *cost* of *each* property. (Fig. 72D.)
7. Ginter teaches generating and reporting a bill to a content user 112 and providing usage and payment reports. (¶¶[0092] and [0426].) Ginter teaches transferring payments of money to each content creator 102. (*Id.*)

PRINCIPLES OF LAW

Appellant has the burden on appeal to the Board to demonstrate error in the Examiner’s position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) (“On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.”) (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be 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.’” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the

prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 127 S. Ct. at 1734 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”). The Court in *Graham* further noted that evidence of secondary considerations, such as commercial success, long felt but unsolved needs, failure of others, etc., “might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” 383 U.S. at 18. “If a court, or patent examiner, conducts this analysis and concludes the claimed subject matter was obvious, the claim is invalid under § 103.” *KSR*, 127 S. Ct. at 1734.

In *KSR*, the Supreme Court emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” *Id.* at 1739, and discussed circumstances in which a patent might be determined to be obvious. In particular, the Supreme Court emphasized that “the principles laid down in *Graham* reaffirmed the ‘functional approach’ of *Hotchkiss*, 11 How. 248 [(1850)].” *KSR*, 127 S. Ct. at 1739 (citing *Graham v. John Deere Co.*, 383 U.S. 1, 12 (1966)), and reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* The operative question in this “functional approach” is thus “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id.* at 1740.

“Under the correct analysis, any need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed.” *Id.* at 1742, 82 USPQ2d at 1397. The Court noted that “[c]ommon sense teaches . . . that familiar items may have obvious uses beyond their primary purposes, and in many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle.” *KSR*, 127 S. Ct. at 1742, 82 USPQ2d at 1397. “A person of ordinary skill is also a person of ordinary creativity, not an automaton.” *Id.*

The Federal Circuit recently concluded that it would have been obvious to combine (1) a device for actuating a phonograph to play back sounds associated with a letter in a word on a puzzle piece with (2) a processor-driven device capable of playing the sound associated with a first letter of a word in a book. *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007). In reaching that conclusion, the Federal Circuit recognized that “[a]n obviousness [determination] is not the result of a rigid formula disassociated from the consideration of the facts of a case. Indeed, the common sense of those skilled in the art demonstrates why some combinations would have been obvious where others would not.” *Id.* at 1161 (citing *KSR*, 127 S. Ct. 1727, 1739 (2007)).

Although the combination of prior art references lacked a “reader” to automatically identify the book inserted in the device, the Federal Circuit found no error in the District Court’s determination that readers were well known in the art at the time of the invention. *Id.* at 1162. In addition, the Court found that the reasons for adding a reader to the combination of prior

art references “are the same as those for using readers in other children’s toys-namely, providing an added benefit and simplified use of the toy for the child in order to increase its marketability.” *Id.* at 1162. The Federal Circuit relied in part on the fact that Leapfrog had presented no evidence that the inclusion of a reader in the combined device was “uniquely challenging or difficult for one of ordinary skill in the art” or “represented an unobvious step over the prior art.” *Id.* (citing *KSR*, 127 S. Ct. at 1740-41).

ANALYSIS

Appellant separately alleges the patentability of independent claim 27. Appellant has not presented any substantive arguments directed to the separate patentability of dependent claims 28-38, independent claim 39, and dependent claims 40-50, but relies instead on his arguments for patentability of independent claim 27. In the absence of a separate argument with respect to the dependent claims, those claims stand or fall with the representative independent claims. *See In re Young*, 927 F.2d 588, 590 (Fed. Cir. 1991). *See also* 37 C.F.R. § 41.37(c)(1)(vii)(2004). Accordingly, we select claim 27 as the sole claim on which to decide the appeal of claims 27-50.

35 U.S.C. § 103(a)

All elements are taught

The Examiner found that a combination of Tharaken and Ginter renders claims 27-50 obvious. (Answer 5.) Appellant alleges that neither Tharaken nor Ginter teaches or suggests the element “obtaining and displaying a partial token for each selected content element ... including cost” required by claim 27 and that the modification of Tharaken to include such element is improper. (App. Br. 10-14 and Reply Br. 1-4.)

Therefore an issue is whether a combination of Tharaken and Ginter teaches “obtaining and displaying a partial token for each selected content element ... including cost.”

Figure 72D of Ginter teaches a display of a “pop-up” user interface 686 that allows flexible browsing through libraries of properties or objects available for licensing or purchase. (FF 6.) Figure 72D of Ginter shows that the user interface displays multiple digital content properties (e.g., CHUCK JONES BIOGRAPHY and TEX AVERY BIOGRAPHY) along with the size, the publisher, and *cost of each* property. (FF 6.) Accordingly, we find that Ginter teaches obtaining and displaying a partial token for each selected content element including cost.

Appellant does not allege that the combination of Tharaken and Ginter fails to teach or suggest any other element of claim 27 besides “obtaining and displaying a partial token for each selected content element . . . including cost.” Thus, we deem those arguments waived. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2004).

Adequate reason to combine

The Examiner finds reason to combine the teachings of Tharaken and Ginter. The Examiner states:

Tharaken and Ginter are analogous art because they are from the same field of endeavor of collecting and distributing electronic content. At the time of the invention it would have been obvious to one of ordinary skill in the art to include the collection and distribution of payment information of Ginter with the delivery of a customized electronic book of Tharaken. The motivation for doing so would have been to ensure that commercial content providers are properly compensated for the electronic information they provide, resulting in lower usage costs, decreased transaction costs, and more efficient

access to electronic information (See Ginter, Pages 1-2, paragraph 0013, and Page 2, paragraph 0017). Therefore, it would have been obvious to combine Ginter with Tharaken for the benefit of ensuring that commercial content providers are properly compensated for the electronic information they provide, resulting in lower usage costs, decreased transaction costs, and more efficient access to electronic information to obtain the invention as specified in claims 27 and 39.

(Answer 6-7.)

In a pre-*KSR* brief, Appellant alleges that the combination of teachings of Tharaken with those of Ginter is improper because: the Examiner engaged in impermissible hindsight, Tharaken teaches against use of partial tokens, none of the prior art suggests the desirability of the combination, and displaying partial cost information would change the principle of operation of Tharaken. (App. Br. 11-14 and Reply Br. 1-4.)

Therefore another issue is whether there is adequate reason to combine the teachings and suggestions of Tharaken with those of Ginter.

“[W]hen a patent ‘simply arranges old elements with each performing the same function it had been known to perform’ and yields no more than one would expect from such an arrangement, the combination is obvious.” *KSR*, 127 S. Ct. at 1739 (citing *Sakraida v. AG Pro, Inc.*, 425 U. S. 273, 282 (1976)). Both Tharaken and Ginter allow users to aggregate content that could be proprietary and licensed from third party vendors (as opposed to free material) (FF 1, 2, and 5). Tharaken teaches that the cost of items is a concern by giving the user the ability to specify a billing code for the book. (FF 4.) Tharaken teaches a shopping cart that identifies a source for each piece of content. (FF 3.) Similarly, Ginter teaches display of a pop-up user interface that discloses the cost information for each piece of content. (FF

6.) Incorporating Ginter's display of cost information for each piece of content in a pop-up user interface into Tharaken's shopping cart that uniquely identifies a source for each piece of content does not change the function of either Ginter's display of cost information or Tharaken's shopping cart. Rather, Tharaken's shopping cart feature is merely extended to display cost information for each piece of content. The combination yields an expected result of displaying per-content cost information in a "shopping cart."

Appellant has provided no evidence that incorporating Ginter's display of cost information in a pop-up user interface into Tharaken's shopping cart that uniquely identifies content from a given source was "uniquely challenging or difficult for one of ordinary skill in the art," *Leapfrog*, 485 F.3d at 1162, nor has Appellant presented evidence that this incorporation yielded more than expected results.

Accordingly, we conclude that the Appellant has not shown that the Examiner erred in rejecting claim 27 under 35 U.S.C. § 103(a). Because claims 28-50 fall with claim 27, we conclude that Appellant has not shown that the Examiner erred in rejecting claims 28-50 under 35 U.S.C. § 103(a).

OTHER ISSUES

We bring to the attention of the Examiner the following U.S. Patent references: 6,418,421 to Hurtado et al. and 5,986,690 to Hendricks for consideration by the Examiner should there be further prosecution.

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CONCLUSION OF LAW

On the record before us, we conclude that Appellant has not shown that the Examiner erred in finding claims 27-50 unpatentable over the combined teachings and suggestions of Tharaken and Ginter under 35 U.S.C. § 103(a).

The rejection of those claims is affirmed.

DECISION

The Examiner's rejection of claims 27-50 under 35 U.S.C. § 103(a) 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)(1)(iv).

AFFIRMED

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