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 DWIGHT ALLEN MERRIMAN and KEVIN JOSEPH O'CONNOR

Appeal 2007-2126
Application 10/798,342
Technology Center 3700

Decided: October 26, 2007

Before ANITA PELLMAN GROSS, MAHSHID D. SAADAT, and ALLEN R. MACDONALD, *Administrative Patent Judges*.

SAADAT, *Administrative Patent Judge*.

ORDER REMANDING TO THE EXAMINER

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1-22, which are all of the claims pending in this application. We have jurisdiction under 35 U.S.C. § 6(b).

Pursuant to our authority under 37 C.F.R. § 41.50(a)(1), we remand this application to the Examiner to reconsider the reasoning for rejecting claims 1-22 over Wexler. Accordingly, 37 C.F.R. § 41.50(a)(2) applies if a supplemental Examiner's Answer is written in response to this remand by the Board.

It is difficult to understand the Examiner's claim interpretation and how Appellants' arguments with respect to the user selection of an advertisement are relevant. In particular, with respect to the claimed limitations related to the step of "selecting, in response to said advertisement request, an advertisement based upon stored information about said user node" and Appellants' assertion that the user in Wexler does not select an advertisement, we note that nothing in the claims specifies who or which entity selects the advertisement. The Examiner considers the step of selecting an advertisement to be performed by the user and argues that Wexler discloses such step by the user clicking on the banner, which eventually results in sending the information to the user's web browser (Answer 6).

The Examiner is reminded that analysis of whether a claim is patentable over the prior art under 35 U.S.C. §§ 102 and 103 begins with a determination of the scope of the claim. The properly interpreted claim must then be compared with the prior art. Claim interpretation must begin with the language of the claim itself. *See Smithkline Diagnostics, Inc. v. Helena*

Laboratories Corp., 859 F.2d 878, 882, 8 USPQ2d 1468, 1472 (Fed. Cir. 1988). Claims will be given their broadest reasonable interpretation consistent with the specification, and limitations appearing in the specification are not to be read into the claims. *In re Etter*, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985). Giving the claims their broadest reasonable interpretation, attributing such limited scope to the claimed step of "selecting ... an advertisement" is improper.

Wexler receives an advertisement request 11a from a user node 3, wherein the request 11a is based upon a link 7 having a banner 9 sent from an affiliate node 13 in response to a content request 15a from the user node 3 (Figure 2; col. 4, ll. 28-36, 37-40, and 54-57). Wexler further redirects the request to the advertiser 17 to obtain the advertisement to be sent to the user (col. 5, ll. 1-12) by providing useful information about the user to the advertiser (col. 4, ll. 61-67).

As such, the Examiner is required to reconsider the rejections in light of the broadest reasonable interpretation of claim 1. Based on the mapping of the claimed limitations to the process disclosed by Wexler, the Examiner is also required to provide arguments in response to Appellants' Briefs and explain why the claimed subject matter is anticipated by the reference.

With respect to the rejection of claims 16-18, the Examiner is also required to respond to Appellants' arguments (Br. 6) as to whether "to utilize a lookup table" would have been relevant to the claimed "performing a reverse domain name lookup" and/or obvious to one of ordinary skill in the art. As a general principle, the conclusion that the claimed subject matter is obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of

ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. *See In re Fine,* 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Additionally, it is the Examiner and not this panel who has the burden of providing detailed fact finding with respect to the applied prior art and/or additional evidence as well as the proper rationale in support of obviousness of the claimed subject matter.

Our comments are not to be construed as meaning that we consider these claims to be patentable over Wexler. In fact, the Examiner is advised to properly determine the scope of the claims in view of our discussion above and address each limitation with respect to the teachings of Wexler and any other evidence, if deemed appropriate. If the Examiner finds that there is a difference between the applied prior art and the claimed subject matter, the Examiner should consider reopening the prosecution for revising the rejection over Wexler and/or additional prior art. In any event, it is recommended that the Examiner make the findings required under *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966) and provide the appropriate reasoning with respect to Wexler, as well as any other reference that may be necessary. See also MPEP § 706.02 (j) [8th ed., Rev. 2, May 2004].

We also observe that Appellants' claims 2-7 recite limitations that are directed to the content of the stored information, which constitutes non-functional descriptive material. It is not clear why any weight should be given to the content of the stored information, as recited in these claims.

We further observe that an Information Disclosure Statement (IDS) (filed January 13, 2005) was apparently not considered by the Examiner.

Upon remand, the Examiner is required to consider the references cited by Appellants in the IDS or provide evidence indicating its prior consideration.

Accordingly, this application is remanded to the Examiner for further action consistent with the views expressed herein.

ORDER

For the aforementioned reasons and pursuant to our authority under 37 C.F.R. § 41.50(a)(1), we remand the application to the Examiner for further action not inconsistent with the views expressed herein. More specifically, the Examiner is required to:

1. Reconsider the rejections in light of the broadest reasonable interpretation of independent claim 1 and dependent claims 2-7 and to provide arguments in response to Appellants' Briefs and explain why the claimed subject matter is anticipated by Wexler.

2. Respond to Appellants' arguments regarding the claimed "performing a reverse domain name lookup."

3. Provide evidence indicating the consideration of the IDS of July 13, 2005.

Any subsequent Examiner's Answer submitted by the Examiner should be self-contained with respect to all rejections and arguments; no prior Answer or Office action should be referenced or incorporated therein. Similarly, any additional Brief submitted by the Appellants should be self-contained with respect to all arguments. No prior Briefs should be referenced or incorporated therein.

Because it is being remanded for further action, the application has "special" status and requires immediate action. M.P.E.P. § 708.01(D). Furthermore, it is important that the Board be informed promptly of any action affecting the appeal in this case.

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).

REMANDED

tdl/gw

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