UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RAYMOND G. GOSS and DONALD RAVENSCROFT

Appeal 2007-2491
Application 10/648,427
Technology Center 2100

Decided: March 20, 2008

Before JOSEPH L. DIXON, LANCE LEONARD BARRY, and CAROLYN D. THOMAS, *Administrative Patent Judges*.

THOMAS, C., *Administrative Patent Judge*.

DECISION ON APPEAL

I. STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 from a Final Rejection of claims 72-112 entered September 21, 2005. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm-in-part.

A. INVENTION

Appellants invented a system and method that enables customers to submit call-back requests to a call center via the Internet. (Spec., Abstract.)

B. ILLUSTRATIVE CLAIM

The appeal contains claims 72-112. Claims 1-71 are cancelled. Claims 72, 80, 88, 99, 111, and 112 are independent claims. Claim 72 is illustrative:

> 72. A method for providing user support for a user accessing a web site, comprising:
>
> providing at least one web page to the user, the at least one web page including software associated with providing user support services;
>
> receiving a request from the user, via the at least one web page, for support; and
>
> identifying a user support party in response to the request.

C. REFERENCE

The single reference relied upon by the Examiner in rejecting the claims on appeal follows:

Saliba	US 6,052,710	Apr. 18, 2000

D. REJECTION

The Examiner entered a Final Rejection with the following rejection, which is before us for review:

Claims 72-112 are rejected under 35 U.S.C. § 103(a) as being obvious over Saliba.

II. PROSECUTION HISTORY

Appellants appealed from the Final Rejection and filed an Appeal Brief (Br.) on January 20, 2006. The Examiner mailed a revised Examiner's Answer (Ans.) on March 8, 2007. No Reply Brief was filed.

III. ISSUE

Whether Appellants have shown that the Examiner erred in rejecting claims 72-112 as being obvious over Saliba.

IV. FINDINGS OF FACT

The following findings of fact (FF) are supported by a preponderance of the evidence.

Claim Construction

1. The Specification does not provide a lexicographic definition for the terms "user support" and "user support party".

2. The ordinary and usual meaning of "support" is to help or assist. *Merriam-Webster's Collegiate Dictionary*, p. 1256 (11th Edition 2005).

Saliba

3. Saliba discloses that "the commerce client includes the functionality of a shopping basket, a wallet, and an address book, and the commerce server includes functionality for performing specialized functions such as retrieving price and inventory information, calculating sales tax due, and calculating shipping and handling costs." (Col. 2, ll. 15-20.)

4. Saliba discloses that "these specialized functions may include various services for facilitating the analysis of merchant offerings and the placement of product orders." (Col. 6, ll. 63-66.)

5. Saliba discloses that "[u]pon receipt of the HTTP POST message, the Web server 116 passes the function calling information to the Shopping server 136, which in-turn makes the specified function call on behalf of the Shopper 132." (Col. 12, ll. 25-28.)

6. Saliba discloses that "this function calling information is embedded within an HTML document such that a specific action by the user (such as clicking on a 'retrieve additional information' button) causes the function calling information to be transmitted to the Web server 116 within an HTTP POST message." (Col. 12, ll. 19-24.)

7. Saliba discloses that "[a]s illustrated by Fig. 4, this function-calling information is provided in the document along with a target URL (of the merchant Web site 100) such that an HTTP POST message containing the information will be sent to the URL if the consumer clicks on the button 512. In this example, the URL would include a definition of the Shopping server 136 to which the function-calling information is directed. Although the target URL in this example corresponds to the Web site 100 that is the source of the HTML document, the target URL could be that of a different Web site." (Col. 13, ll. 50-61.)

8. Saliba discloses that "Fig. 4 is an example HTML sequence which illustrates a preferred format . . . for embedding a function call within an HTML document. In this example, a single function call . . . is linked to the button "Calculate Sales Tax" such that the function calling information (OBJECT, INTERFACE, METHOD and ARGS) will be sent to URL

'http://www.merchant.com/mig.dll" when the user selects the button. (In this example, 'mig.dll' is the file name of the Shopper server 136.)" (Col. 12, ll. 53-62.)

9. Saliba discloses that "the protocol specifies a simple, text-based format for embedding the function calling information of a generic client-to-server function within HTML content such that a user can initiate a call to the function while viewing an HTML document via the standard Web browser." (Col. 2, ll. 25-30.)

Patent Incorporated By Reference: USP 6,125,352

10. USP 6,125,352 discloses address data fields that include the name of the person to receive parcels at address (Type: Cstring), and the first and second phone numbers associated with shipping address. (Col. 18, Table 6.)

V. PRINCIPLES OF LAW

Appellants have 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, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *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.")

VI. ANALYSIS

Grouping of Claims

In the Brief, Appellants set forth their arguments in essentially eleven (11) separate groups. (Br. 8-21.)

In **Group I**, Appellants argue claims 72, 77, 80, 85, and 111 as a group. (Br. 8-11.) For claims 72, 77, 80, 85, and 111, Appellants merely repeat the same argument made for claim 72. Thus, the Board selects representative claim 72 to decide the appeal for this group. Accordingly, the remaining claims in this group stand or fall with claim 72.

In **Group II**, Appellants argue claims 73, 75, 81, and 83 as a group. (Br. 11-12.) For claims 75, 81, and 83, Appellants repeat the same argument made for claim 73. We will, therefore, treat claims 75, 81, and 83 as standing or falling with claim 73.

In **Group III**, Appellants argue claims 74 and 82 as a group. (Br. 12-13.) For claim 82, Appellants repeat the same argument made for claim 74. We will, therefore, treat claim 82 as standing or falling with claim 74.

In **Group IV**, Appellants argue claims 76 and 84 as a group. (Br. 13-14.) For claim 84, Appellants repeat the same argument made for claim 76. We will, therefore, treat claim 84 as standing or falling with claim 76.

In **Group V**, Appellants argue claims 78, 79, 86, and 87 as a group. (Br. 15.) For claims 79, 86, and 87, Appellants repeat the same argument made for claim 78. We will, therefore, treat claims 79, 86, and 87 as standing or falling with claim 78.

In **Group VI**, Appellants argue claims 88, 90, 91, 94-97, and 112 as a group. (Br. 15-16.) For claims 90, 91, 94-97, and 112, Appellants repeat the same argument made for claim 88. We will, therefore, treat claims 90, 91, 94-97, and 112 as standing or falling with claim 88.

In **Group VII**, Appellants argue claims 89 and 100 as a group. (Br. 17 & 20.) For claim 100, Appellants repeat the same argument made for claim 89. We will, therefore, treat claim 100 as standing or falling with claim 89.

In **Group VIII**, Appellants argue claims 92 and 93 as a group. (Br. 17-18.) For claim 93, Appellants repeat the same argument made for claim 92. We will, therefore, treat claim 93 as standing or falling with claim 92.

In **Group IX**, Appellants argue claims 98 and 109 as a group. (Br. 18 & 21.) For claim 109, Appellants repeat the same argument made for claim 98. We will, therefore, treat claim 109 as standing or falling with claim 98.

In **Group X**, Appellants argue claims 99, 101, 102, 105-108, and 110 as a group. (Br. 19-20.) For claims 101, 102, 105-108, and 110, Appellants repeat the same argument made for claim 99. We will, therefore, treat claims 101, 102, 105-108, and 110 as standing or falling with claim 99.

In **Group XI**, Appellants argue claims 103 and 104 as a group. (Br. 20-21.) For claim 104, Appellants repeat the same argument made for claim 103. We will, therefore, treat claim 104 as standing or falling with claim 103.

See 37 C.F.R. § 41.37(c)(1)(vii). *See also In re Young*, 927 F.2d 588, 590 (Fed. Cir. 1991).

The Board's Claim Construction

As pointed out by our reviewing court, we must first determine the scope of the claim. "[T]he name of the game is the claim." *In re Hiniker Co.*, 150 F.3d 1362, 1369 (Fed. Cir. 1998).

Claims are given their broadest reasonable construction "in light of the specification as it would be interpreted by one of ordinary skill in the art." *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004).

We note that Appellants have not identified any specific definition for the terms "user support" and "user support party" (FF 1), nor have Appellants identified any special definition in the art for these terms. From our review of the original Specification, Appellants have not shown and we do not readily find an express definition of the aforementioned terms in the Specification. Therefore, we give these terms their ordinary and customary definition and find that "user support" designates any user help or assistance and "user support party" designates any entity that provides help or assistance to the user (FF 2).

The Obviousness Rejection

We now consider the Examiner's rejection of claims 72-112 under 35 U.S.C. § 103(a) as being obvious over Saliba.

GROUP I
Regarding Claims 72, 77, 80, 85, and 111

Appellants contend that "portions of Saliba do not disclose or suggest that the HTTP request is a request <u>for support</u>, as required by claim 72." (Br. 9.) Appellants further contend that "portions of Saliba do not disclose identifying <u>a user support party</u> in response to the request, as recited in claim 72." (Br. 10.)

The Examiner maintains that "the teaching of the reference is not limit [sic] to just the portion of the office citation but also the teachings of the whole reference." (Ans. 5.) We agree.

Saliba discloses a system and method for making function calls over a distributed network where specialized functions include services for facilitating merchant offerings whereby the commerce client includes various functionalities such as a shopping basket and the commerce server includes functionality such as retrieving price and inventory information (FF 3-4). Saliba further discloses a "Shopping server" that receives the function calling information and makes the call on behalf of the shopper (FF 5).

As a result, we find that Saliba discloses providing "user support" within the definition provided *supra*, by the mere acts of retrieving price and inventory information and providing that information to the shopper. Furthermore, we find that Saliba uses a Shopper server, i.e., user support party, to act on behalf of the shopper.

Based on our findings and those of the Examiner, we do not find that Appellants have shown error in the Examiner's rejection of exemplary claim 72. Instead, we find the Examiner has set forth a sufficient initial showing of obviousness, and Appellants have not shown that Saliba lacks the above noted disputed features of claim 72. Therefore, we affirm the rejection of independent claim 72 and of claims 77, 80, 85, and 111, which fall therewith.

GROUP II
Regarding Claims 73, 75, 81, and 83

Appellants contend that "[s]ince Saliba does not disclose or suggest identifying a user support party, Saliba cannot further disclose or suggest sending the request for support to the identified user support party, much less that the request is sent via a network, as required by claim 73." (Br. 11-12.) We disagree.

For at least the reasons noted *supra* regarding Saliba's teachings regarding "user support" and a "user support party", we find that Appellants have not shown error in the Examiner's rejection of exemplary claim 73. Instead, Appellants are relying on Saliba's non-teaching of a "user support party", which we have found to be present in the teachings of Saliba. We note that a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the reference does not comply with the requirements of MPEP § 1.111(b). Furthermore, a statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Therefore, we find the Examiner has set forth a sufficient initial showing of obviousness, and Appellants have not shown that Saliba lacks the above noted disputed features of claim 73. Therefore, we affirm the rejection of claim 73 and of claims 75, 81, and 83, which fall therewith.

GROUP III
Regarding Claims 74 and 82

Appellants contend that "[n]one of these portions of Saliba disclose or suggest sending a URL to a user support party, where the URL represents the web page with which the request was made, as recited in claim 74." (Br. 12.) Appellants further contend that "[t]he reference URL in Saliba is not sent to a user support party, as required by claim 74." (Br. 13.) We disagree.

Saliba discloses transmitting an HTTP POST message along with a target URL of the merchant Web site to the Web server, the URL includes a definition of the Shopping server to which the function-calling information is directed (FF 6-7). Thus, we find that Saliba discloses sending a URL to a user support party, where the URL represents the web page with which the request was made, i.e., the merchant's web page.

Therefore, we find the Examiner has set forth a sufficient initial showing of obviousness, and Appellants have not shown that Saliba lacks the above noted disputed features of claim 74. Therefore, we affirm the rejection of claim 74 and of claim 82, which falls therewith.

GROUP IV
Regarding Claims 76 and 84

Appellants contend that "Saliba at col. 12, lines 46-52 discloses that information regarding name, product ID, price, quantity, size, image and reference URL are arguments of a function call made by commerce client/shopper 132. None of this information in Saliba is sent to a user support party, as required by claim 76." (Br. 13-14.) We disagree.

Saliba discloses that when a user selects a button, the function calling information (OBJECT, INTERFACE, METHOD and ARGS) will be sent to an URL that includes the file name of the Shopper server, i.e., the support party (FF 8). Thus, we find that Saliba discloses the Shopper server and its related objects, including the address book object, and sends such information to an identified user support party. Furthermore, Saliba incorporates by reference U. S. patent application Ser. No. 08/748,688 (USP 6,125,352). (Col. 10, ll. 4-11.)

It is well settled that "material incorporated by reference is effectively part of the host document as if it were explicitly contained therein." *Liebel-Flarsheim Co. v. Medrad, Inc.*, 481 F.3d 1371, 1382 n.3 (Fed. Cir. 2007) (internal citations and quotation marks omitted).

Here we find that USP 6,125,352 discloses address book objects that includes, *inter alia*, the name of the person to receive parcels and a first and second phone numbers associated with the shipping address. (FF 10.) Thus, Saliba, through incorporation by reference, discloses sending information to a user support party, whereby the information includes the user's name or telephone number.

Therefore, we find the Examiner has set forth a sufficient initial showing of obviousness, and Appellants have not shown that Saliba lacks the above noted disputed features of claim 76. Therefore, we affirm the rejection of claim 76 and of claim 84, which falls therewith.

GROUP V
Regarding Claims 78, 79, 86, and 87

Appellants contend that "Saliba does not disclose determining an identifier associated with the user, and wherein the step of identifying a user support party comprises identifying the user support party based on the identifier, as recited in claim 78. In contrast, this portion of Saliba merely discloses that the name of a product, such as 'Socks', may be included as an argument in a function call." (Br. 15.) We disagree.

While Saliba may be identifying a product type, i.e., socks, in the portion referenced by the Examiner, Saliba further discloses in the incorporated by reference document (USP 6,125,352) an address data field that includes identifiers, such as name, address, and phone numbers, for the person to receive the merchandise. (FF 10.)

Thus, we find the Examiner has set forth a sufficient initial showing of obviousness, and Appellants have not shown that Saliba, and the portions incorporated by reference, lacks the above noted disputed features of claim 78. Therefore, we affirm the rejection of claim 78 and of claims 79, 86, and 87, which fall therewith.

GROUP VI
Regarding Claims 88, 90, 91, 94-97, and 112

Appellants contend that "Saliba does not disclose or suggest receiving information associated with the user . . . as required by claim 88. . . . Saliba, in contrast, merely discloses a user computer 108 interacting with a web server 116 to conduct an electronic commerce transaction (Saliba – col. 1, lines 5-12 and Fig. 1)." (Br. 16.) We disagree.

Saliba discloses receiving information associated with the user (FF 8) where the information includes the user name (see discussion of claims 78, 79, 86, and 87 above). Saliba further discloses accessing a web page based on received information and establishing a communication link with the user (FF 1-5). There is no express limitation recited in claim 88 that establishing a communication link with the user be related to receiving information associated with the user.

Thus, we find the Examiner has set forth a sufficient initial showing of obviousness, and Appellants have not shown that Saliba, and the portions incorporated by reference, lacks the above noted disputed features of claim 88. Therefore, we affirm the rejection of claim 88 and of claims 90, 91, 94-97, ad 112, which fall therewith.

GROUP VII
Regarding Claims 89 and 100

Appellants contend that "[t]he reference URL in Saliba is not sent to a user support system for providing support to a user accessing a web site, as required by claim 89. The URL in Saliba also does not represent a web page that the user was viewing when a request for user support was made, as further required by claim 89." (Br. 17.) We disagree.

Saliba discloses that a user initiates a call while viewing an HTML document via the standard Web browser (FF 9) and that the URL represents the merchant Web site (FF 7).

Thus, we find the Examiner has set forth a sufficient initial showing of obviousness, and Appellants have not shown that Saliba lacks the above noted disputed features of claim 89. Therefore, we affirm the rejection of claim 89 and of claim 100, which falls therewith.

GROUP VIII
Regarding Claims 92 and 93

Appellants contend that "[c]laim 92 recites that the method further comprises passing events performed on the user support system to the user via the communications link to enable the user to view a same web page as that being displayed by the user support system. This feature has not been addressed in either the Office Action or the Final Office Action. . . . Saliba does not disclose or suggest this feature" (Br. 17-18.) We agree with Appellants.

We find that the Examiner has failed to provide Appellants with any findings to support the rejection of claims 92 and 93. Thus, we find that the Appellants have shown that the Examiner has <u>not</u> set forth a sufficient initial showing of obviousness. Therefore, we reverse the rejection of claims 92 and 93.

GROUP IX
Regarding Claims 98 and 109

Appellants contend that "claim 98 does not recite on-line chat sessions in general, but the use of an on-line chat session within a method associated

with a user support system. Appellants assert that use of an on-line chat session in the claimed environment is not well known." (Br. 18.) Appellants further contend that "the Examiner has not pointed to any portion of Saliba as providing objective motivation for modifying Saliba to include the feature recited in claim 98." (Br. 19.)

The Examiner finds that establishing an on-line chat session with the user would have been obvious to one of ordinary skill in the art at the time the invention was made (Ans. 7).

In *KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. at 1739 (2007), the Supreme Court emphasized "the need for caution in granting a patent based on the combination of elements found in the prior art," and discussed circumstances in which a patent might be determined to be obvious without an explicit application of the teaching, suggestion, motivation test.

In particular, the Supreme Court emphasized that "the principles laid down in *Graham* reaffirmed the 'functional approach' of *Hotchkiss*, 11 How. 248." *KSR*, 127 S.Ct. at 1739 (citing *Graham v. John Deere Co.*, 383 U.S. 1, 12 (1966) (emphasis added)), 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 Court explained:

> When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, §103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in

> the same way, using the technique is obvious unless its actual application is beyond his or her skill.

Id. at 1740. 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.*

We have considered all of Appellants' arguments in the Brief, but we are not persuaded of error in the rejection of claim 98. We find that an on-line chat session within a user support system represents no more than the predictable use of prior art elements according to their established functions, yielding predictable results. Moreover, claim 98, as broadly drafted, fails to set forth a limitation commensurate in scope with the feature Appellants believe renders the claimed subject matter nonobvious.

In particular, claim 98 does not expressly recite that the on-line chat session be with a user support party or that it be at all related to support services. All that is required is that an IP address be used to establish a communication link with a user.

Thus, we find the Examiner has set forth a sufficient initial showing of obviousness, and Appellants have not shown that Saliba lacks the above noted disputed features of claim 98. Therefore, we affirm the rejection of claim 98 and of claim 109, which falls therewith.

GROUP X
Regarding Claims 99, 101, 102, 105-108, and 110

Appellants contend that "Saliba does not disclose . . . where the information identifies the web site that the user was accessing when a request for user support was made, as required by claim 99. . . .Saliba

merely discloses a user computer 108 interacting with a web server 116 to conduct an electronic commerce transaction (Saliba – col. 1, lines 5-12 and Fig. 1)." (Br. 19.)

We find that these arguments are essentially the same as for claim 89 *supra*. Thus, see our discussion of claims 89 and 100 above.

As above, we find the Examiner has set forth a sufficient initial showing of obviousness, and Appellants have not shown that Saliba lacks the above noted disputed features of claim 99. Therefore, we affirm the rejection of claim 99 and of claims 101, 102, 105-108, and 110, which fall therewith.

GROUP XI
Regarding Claim 103 and 104

Appellants contend that the features of claim 103 "ha[ve] not been addressed in either the Office Action or the Final Office Action, despite a request by Appellants that the feature be particularly addressed." (Br. 21.)

Again, we find that the Examiner has failed to provide Appellants with any findings to support the rejection of claims 103 and 104. Thus, we find that the Appellants have shown that the Examiner has <u>not</u> set forth a sufficient initial showing of obviousness. Therefore, we reverse the rejection of claims 103 and 104.

VII. CONCLUSIONS

We conclude that Appellants have <u>not</u> shown that the Examiner erred in rejecting claims 72-91, 94-102, and 105-112.

Appellants have established that the Examiner erred in rejecting claims 92, 93, 103, and 104.

VIII. DECISION

In view of the foregoing discussion, we affirm the Examiner's rejection of claims 72-91, 94-102, and 105-112 under 35 U.S.C. § 103(a) over Saliba, and we reverse the rejection of claims 92, 93, 103, and 104 under 35 U.S.C. § 103(a) over Saliba.

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

AFFIRMED-IN-PART

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