

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RABINDRANATH DUTTA and
KAMAL CHANDRAKANT PATEL

Appeal 2007-3381
Application 09/920,522
Technology Center 1700

Decided: October 29, 2008

Before JAMES D. THOMAS, JOSEPH L. DIXON, and
HOWARD B. BLANKENSHIP, *Administrative Patent Judges*.

THOMAS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1 through 7, 9 through 14, 16 through 20, 22, and 23. We have jurisdiction under 35 U.S.C. § 6(b).

As best representative of the disclosed and claimed invention,
independent claim 1 is reproduced below:

1. A method for controlling personal information of a user using a client computer system enabled to be communicatively connected to a plurality of network entities in a network environment, comprising:

storing personal information of the user at the client computer system;

receiving a request from a first network entity to send the personal information stored at the client to at least one other network entity;

enabling the at least one other network entity to be selectable by the user;

enabling the personal information to be edited; and

sending the edited personal information from the client computer system to each of the selected ones of the at least one other network entity.

The following references are relied on by the Examiner:

Goldhaber	U.S. 5,855,008	Dec. 29, 1998
O'Neil	U.S. 5,987,440	Nov. 16, 1999
Karp	U.S. 2003/0154171 A1	Aug. 14, 2003 (filed Mar, 31, 2000)

Claims 10, 17, and 23, stand rejected under 35 U.S.C. § 102(b) as being anticipated by Karp. In a second rejection based upon the same statutory provision, the Examiner relies upon Goldhaber to reject claims 1, 2, 5, 6, 11, 12, and 18.¹ Goldhaber is also used by the Examiner under

¹ Although the Examiner includes dependent claim 16 in this rejection, its parent independent claim 14 is not rejected on this statutory basis but in a separately stated rejection. We shall list it there.

35 U.S.C. § 103 alone to reject claims 7, 9, 14, 16, 20, and 22. Lastly, the Examiner relies upon Goldhaber and O'Neil to reject claims 3, 4, 13, and 19.

Rather than repeat the positions of the Appellants and the Examiner, reference is made to the Brief (no Reply Brief has been filed) for the Appellants' positions, and to the Answer for the Examiner's positions.

OPINION

For the reasons set forth by the Examiner in the Answer, as expanded upon here, we sustain each of the separately stated rejections encompassing all the claims on appeal. As to the rejection relying upon Karp, Appellants' remarks at page 18 of the Brief consider claim 10 as representative of independent claims 10, 17, and 23. With respect to the Examiner's reliance upon Goldhaber rejecting certain claims under 35 U.S.C. § 102, Appellants' remarks at page 16 of the Brief consider independent claim 1 as representative of independent claims 1, 11, 12, and 18. Similarly, as to the rejection by the Examiner using Goldhaber alone under 35 U.S.C. § 103, Appellants argue claim 7 as representative of independent claims 7, 14, and 20. Lastly, Appellants consider claims 3 and 4 as representative of claims 3, 4, 13, and 19, beginning at page 18 of the Brief, with respect to the rejection relying upon Goldhaber in view of O'Neil under 35 U.S.C. § 103. Other than these last stated claims, no other dependent claim on appeal is argued separately by Appellants and, therefore, each falls with its respective parent independent claim.

As to the rejection of representative independent claim 10 relying upon Karp, we agree with the Examiner's statement of the rejection at pages 4 and 5 of the Answer and the Examiner's responsive arguments at pages 13

and 14, which are responsive to the positions set forth at pages 17 and 18 of the Brief as to this rejection and this claim.

To the Examiner's reasoning, we add that representative independent claim 10 does not require that the claimed personal information be "directly" sent from or otherwise sent by or otherwise received directly from the user client system. An indirect sending or receiving operation from data that may have originated in the user client system, that is to say, that may be sent in an intermediate manner through intervening websites, is certainly encompassed by the subject matter of this claim. Thus, the Examiner's reasoning does point to Karp's teachings that do indicate that a requesting network entity receives information "from" a user client system to the extent actually claimed. Furthermore, the requesting network entity is not necessarily "separate" to the extent argued at page 18 of the Brief since this word has not been recited in the claim language. This claim does not recite a first network entity, and the remaining plural network entities are not said to be separate from each other or from the user client system. As such, the claim does not exclude the use of a trusted third party network entity as in Karp that acts as or on behalf of a user client system.

Therefore, we sustain the rejection of representative independent claim 10 and of independent claims 17 and 23 as well.

The Examiner's rejection relying upon Goldhaber under 35 U.S.C. § 102 includes independent claims 1, 11, 12, and 18, of which independent claim 1 is representative. The Examiner's statement of the rejection of these claims at pages 3 and 4 of the Answer appears to be modified by the discussion beginning at page 10 of the Answer in the responsive arguments

portion. As noted by the Examiner in the discussion at pages 9 and 10 of the Answer, the remarks presented by Appellants through page 15 of the Brief appear to relate only in an indirect manner to that portion of Goldhaber that the Examiner actually relies upon which is said at page 10 of the Answer to be the so-called information release embodiment on which the rejection apparently was based in part in the final rejection as well. The details of the correlation at pages 10 and 11 of the Answer are agreed with.

To the extent we discussed earlier that the claims do not recite a direct sending or direct receipt of personal information resident in a client system, the Examiner emphasizes this point again in the remarks at page 11 of the Answer. What appears to be left unappreciated by Appellants' remarks is the simple point made by the Examiner at the top of page 11 of the Answer that the attention broker system can act as an intermediary between the advertisers and customers. Thus, it is clear that the client system in Goldhaber does in fact store personal information which may be indirectly received by various other types of websites through the so-called attention broker system as noted by the Examiner. In like manner, the receiving clause of representative independent claim 1 does not require a direct receipt from the claimed first network entity. Appellants' position at page 16 of the Brief that a noted portion of Goldhaber does not teach a client computer system sending personal information to other network entities is misplaced by the next succeeding sentence which states "Goldhaber clearly describes the attention broker as filtering and passing all information between the client computer system and an advertising system." This latter statement in effect does admit that Goldhaber does send from a client computer system

certain personal information that is in turn filtered and passed through the so-called attention broker system to the claimed selected ones of various other network entities, such as the advertisers taught by this reference and noted by the Examiner.

Therefore, we sustain the rejection of independent claim 1 and of independent claims 11, 12 and 18.

As to the obviousness rejections, we note the following principles:

“To reject claims in an application under section 103, an examiner must show an un rebutted prima facie case of obviousness.... 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.”

In re Kahn, 441 F.3d 977, 985-86 (Fed. Cir. 2006)(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 Supreme Court 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.” *KSR*, 127 S. Ct. at 1739. 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. 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.” *Id.* at 1742.

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)). 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).

In the absence of separate arguments with respect to claims subject to the same rejection, those claims stand or fall with the claim for which an argument was made. *See In re Young*, 927 F.2d 588, 590 (Fed. Cir. 1991). *See also* 37 C.F.R. § 41.37(c)(1)(vii)(2004).

Dovetailing with this precedent, we note further that the test for obviousness has been further characterized as not whether the features of a secondary reference may be bodily incorporated into the structure of a primary reference. It is also not that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. *In re Keller*, 642 F.2d 414, 425 (CCPA 1981); *In re Young*, 927 F.2d 588, 591 (Fed. Cir. 1991).

The prior art relied on to prove obviousness must be analogous art. As explained in *Kahn*,

the ‘analogous-art’ test . . . has long been part of the primary Graham analysis articulated by the Supreme Court. *See Dann [v. Johnston]*, 425 U.S. [219,] 227-29 (1976), *Graham*, 383 U.S. at 35. The analogous-art test requires that the Board show that a reference is either in the field of the applicant’s endeavor or is reasonably pertinent to the problem with which the inventor was concerned in order to rely on that reference as a basis for rejection. *In re Oetiker*, at 1447. References are selected as being reasonably pertinent to the problem based on the judgment of a person having ordinary skill in the art. *Id.* (“[I]t is necessary to consider ‘the reality of the circumstances,’ - in other words, common sense-in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the invention.” (quoting *In re Wood*, 599 F.2d 1032 (C.C.P.A. 1979))).

Kahn, 441 F.3d at 986-87. *See also In re Clay*, 966 F.2d 656, 659 (Fed. Cir. 1992) (“[a] reference is reasonably pertinent if, even though it may be in a different field from that of the inventor’s endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor’s attention in considering his problem.”).

With respect to the Examiner's use of Goldhaber alone and with the combination of teachings of Goldhaber and O'Neil in the last two rejections to be considered, the Examiner's analysis in the Answer appears to be consistent with and follow the above-noted case law. Of particular note here is that the analogous art characterization by the Examiner of O'Neil has not been contested by Appellants in the Brief.

The Examiner's reasoning at pages 7 and 8 of the Answer in the statement of the rejection as to independent claim 7 may be reasonably construed by one of ordinary skill in the art as generally teaching the receiving, comparing and sending remuneration feature of the last three clauses of this claim. The responsive arguments portion of the Answer at pages 16 and 17 recognize and address Appellants' arguments at pages 26 through 29 of the Brief. From our perspective, we make note of our earlier reasoning with respect to Goldhaber set forth in this opinion where the Examiner has relied upon it under 35 U.S.C. § 102. Thus, taken in this light and perspective, the use of an intermediary between a requester and user is not excluded by the subject matter of representative independent claim 7 on appeal. The attention broker thus monitors the interaction between websites such as to determine user compliance and therefore the propriety of disbursing a payment or remuneration upon successful completion.

We therefore agree with the Examiner's observation at the bottom of page 17 of the Answer that the nature of the process set forth in Goldhaber in effect provides a motivation to check the validity of the personal data provided by a user to a requester to ensure that the terms of the transaction were met. To the extent argued otherwise, there is an adequate teaching

within Goldhaber alone for an artisan to understand and construe the breath of the subject matter of the language such as “based on comparison” of the sending of the information process. Of particular note again here is the Examiner’s correct assessment that the direct transfer of information, to the extent argued, is not required by the claims on appeal as discussed earlier in this opinion.

Therefore, we have sustained the rejection of independent claim 7 and of independent claims 14 and 20.

Lastly, we turn to the rejection under 35 U.S.C. § 103 of representative of dependent claims 3 and 4 based upon the teaching of Goldhaber in view of O’Neil. The Examiner’s statement of the rejection at pages 5 and 6 of the Answer as to these claims is embellished upon at pages 14 through 16 of the Answer which are responsive to the Appellants’ arguments beginning at page 20 of the Answer that Goldhaber and O’Neil do not teach all of what is set forth in the claims and that there is no teaching or suggestion or motivation to combine the teachings of the two references. From our perspective, the focus of the arguments appears to be upon the view that O’Neil does not teach or suggest watermarking, but only a technique of digital signatures. As to the discussion at pages 20 and 22 of the Brief, to the extent it makes reference to the definitions of digital signature and digital watermarking, the positions are clearly misplaced since there is no recited feature of digital watermarking per se in claims 3 and 4. There is only a broadly recited “watermarking” functionality set forth in claim 3 and an equally broadly stated “uniquely watermarking” functionality recited in dependent claim 4.

Page 14 of the Answer correctly refers to Specification page 25, lines 15 through 29, which should be construed as original filed Specification page 15, lines 15 through 29. Likewise, we refer to a corresponding discussion at Specification page 18, lines 18 through 26. The point of the Examiner's reasoning at pages 14 and 15 is that by Appellants' own definition of the use of the term watermark in the Specification as filed, the teachings of a digital signature in O'Neil are certainly representative of the broadest interpretation that Appellants intend to use for the general term of "watermarking" per se. We therefore agree with the Examiner's views at the top of page 15 of the Answer that a digital signature of O'Neil reads on "the broad interpretation of the special textual content, background graphics or subliminal watermarks as disclosed by the Appellants." The generation of a digital signature in figure 4 as briefly discussed at column 9, lines 27 through 55 of O'Neil supports the Examiner's views.

Lastly, as to the combinability issue argued at pages 23 and 24 of the Brief, we agree with the Examiner's Brief observations generally at the middle of page 15 of the Answer urging the combinability of the teachings of Goldhaber and O'Neil as a restatement of some of the reasoning relied upon in the initial statement of the rejection. We find misplaced Appellants' urging at page 24 of the Brief that Goldhaber does not motivate or suggest uniquely identifying a particular transmission of personal information by the attention broker's server in this reference to be a backwards argument. It is O'Neil rather than Goldhaber that teaches the desirability of modifying Goldhaber's teachings rather than Goldhaber teaching to modify itself. The Examiner's reasoning as well as the noted teachings of Goldhaber and

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O'Neil does not support the general observation at the bottom of page 24 of the Brief that the Examiner has utilized improper hindsight based upon Appellants' own teachings.

In view of the foregoing, we have sustained each of the noted rejections of the respective claims on appeal under 35 U.S.C. §§ 102 and 103 since Appellants have not presented to us in the Brief any persuasive arguments of substantive error in the Examiner's positions in the Answer. Therefore, the decision of the Examiner 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). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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