

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DANIEL T. MCCRYSTAL, ROBERT EUBANKS,
and KELLY NEAL FORD

Appeal 2007-3801
Application 10/317,517
Technology Center 2100

Decided:

Before JOSEPH L. DIXON, HOWARD B. BLANKENSHIP, and
STEPHEN C. SIU, *Administrative Patent Judges*.

BLANKENSHIP, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 27-43, which are all the claims remaining in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

Appellants claim methods of delivering advertising to a user having a Web browser. Advertising content requested by the user is delivered to the user without using the browser for delivery. Claim 27 is illustrative.

27. A method to deliver advertising with minimized interruption to web browsing, comprising operations of:

 during an online web browsing session of a user, an internet service provider (ISP) causing the user's web browser to supplement content requested by the user with display of advertising material, the advertising material soliciting a mouse click to indicate user agreement to receive follow-up advertising concerning a subject stated by the advertising material;

 the ISP monitoring user activity to detect whether the user agrees to receive the follow-up advertising;

 responsive to the ISP detecting user agreement to receive the follow-up advertising, the ISP automatically returning the user's web browsing session to where it was previous to the agreement and conducting the following operations separate from the web browsing session:

 identifying a predefined delivery address of the user;

 causing transmission of follow-up advertising to the identified delivery address via a web browser independent delivery mechanism.

The Examiner relies on the following references as evidence of unpatentability.

Miyazaki	US 2002/0013785 A1	Jan. 31, 2002
Swart	US 2003/0028884 A1	Feb. 6, 2003 (filed Oct. 16, 2001)
Goldman	US 2006/0031405	Feb. 9, 2006 (effectively filed Mar. 8, 1999)

Claims 27-43 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Miyazaki, Goldman, and Swart.

Based on Appellants' arguments in the Appeal Brief, we will decide the appeal on the basis of independent claims 27 and 37, and dependent claims 29, 33, and 34. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Miyazaki describes an Internet advertisement system in which a “partner” Web site provides to end-user terminals, by e-mail, a Web page on which one or more banners from an advertisement server site are inserted. When a user clicks on a browsed banner, content linked to the selected banner is retrieved from a content database and delivered to the user by e-mail. Miyazaki Abstract. The end-user’s e-mail address, and a mailing server, is maintained at the advertisement server site (Miyazaki ¶ [0025]; Fig. 1), with e-mail addresses generally obtained from partner Web sites (¶ [0027]).

Miyazaki does not describe an Internet service provider (ISP) that performs the functions of the advertisement server site. Goldman, however, teaches that advertisement selection and delivery may be conducted at the level of the ISP. Goldman Abstract. In particular, as shown in Figure 3B, a user’s profile (154') is stored at ISP 160. The ISP determines the advertisements to be delivered to the user. When a user requests a document from a remote server, the ISP inserts selected advertisement materials into the document that is transmitted from the ISP 160 to the Internet browser 56 at client system 110. Goldman further teaches that selecting and inserting advertisements at the ISP level has the advantage of allowing a periodically

updated copy of the user profile to be stored at the ISP. Goldman ¶¶ [0052-54].

In *KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 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.*

Combining the features of Miyazaki and Goldman appears to represent no more than the predictable use of prior art elements according to their established functions. The advantage derived from Miyazaki is in sending requested follow-up advertising materials via e-mail so as not to interrupt the user's browsing session. The advantage derived from Goldman is in having the ISP monitor the user's requests and maintain timely information respecting the user. To the artisan, the combination is that of familiar elements according to known methods, yielding predictable results.

Appellants argue supposed deficiencies of each Miyazaki and Goldman taken alone. We acknowledge the truth, for example, that Miyazaki does not speak of an ISP. However, non-obviousness cannot be established by attacking references individually where the rejection is based upon the teachings of a combination of references. *In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986) (citing *In re Keller*, 642 F.2d 413, 425 (CCPA 1981)).

With respect to supposed deficiencies of the individual references, we disagree that “[i]n Goldman . . . there is absolutely no teaching of the ISP monitoring user activity.” (App. Br. 16.) When a user requests a document from a remote server (Goldman Fig. 3B), “the URL [Uniform Resource Locator] is transmitted to the remote server via a request router 80 at the Internet service provider 160.” Goldman ¶ [0052]. We disagree that “with Miyazaki, there is no operation of identifying a predefined delivery address of the user ‘conducted separate form [sic; from] the web browsing session.’” (App. Br. 20.) Even in the Miyazaki embodiment referenced by Appellants - - which is not the embodiment the Examiner applies against instant claim 27

-- the embedded end-user ID and AD ID (advertisement identification) are transferred to the advertisement server site, where an e-mail address is retrieved from a database on that site so that the follow-up advertising content can be delivered to the end-user by e-mail. Miyazaki ¶ [0036]. Miyazaki thus describes “identifying a predefined delivery address of the user” on the advertisement server site, which is an operation “separate from the web browsing session” in the terms of claim 27.

Appellants also argue, at great length, that Swart is not analogous art - - apparently holding that the digital communications network described by Swart is not within the field of electronic networks, to which the present invention is purported to relate (Spec. 1: 9). If Appellants’ field of endeavor were more narrowly defined as relating to the display and selection of information at an interactive Web page (*id.*, ll. 9-11), or even limited to “the navigation of web pages using a web browser” (App. Br. 9), we find it unlikely that an artisan in the relevant field would be surprised by the existence and use of pop-up windows. Using the technique is obvious unless its actual application is beyond his or her skill. *KSR*, 127 S. Ct. at 1740.

We disagree that Swart is non-analogous art, but consider the reference to be merely cumulative evidence of unpatentability. The claims do not specify how the user’s Web browsing session is automatically returned to “where it was” previous to the selection to receive follow-up advertising. Neither does Miyazaki specify how the action is performed, but teaches that the user is able to obtain an advertisement banner-linked content by a single click operation while enjoying a game uninterrupted (¶ [0031]), which is sufficient to show the “automatically returning” feature. Appellants

seem to acknowledge as much. “Obviously . . . there is no reason to incorporate any teachings of Swart, since Miyazaki already purports to achieve the stated goal.” (App. Br. 29.)

Appellants also allege, frequently, that the references “teach away” from the combination. “A reference may be said to teach away when a person of ordinary skill, upon [examining] the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.”

Para-Ordnance Mfg. v. SGS Importers Int'l, Inc., 73 F.3d 1085, 1090 (Fed. Cir. 1995) (quoting *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994)).

However, support for the “teaching away” position consists of alleging that some portions of the references teach features that are not in the claims, with the allegations sometimes coupled with further allegations of increased cost or complexity that are not supported by evidence in this record. Appellants have identified no warnings to discourage the artisan from combining the requisite teachings of the references.

Appellants also suggest lack of a “reasonable expectation of success” in the combination of teachings in this predictable art. Appellants have not, however, provided evidence in support of the view; evidence, for example, that an ISP would not reasonably be expected to be capable of monitoring user activity and providing e-mail to the user.

Claim 37 requires that the user’s web browser transmits a request to a “third party advertising server,” with the third party advertising server sending the follow-up advertising to the ISP, which in turn transmits the follow-up advertising to a predefined delivery address of the user.

Goldman teaches that advertisement selection and insertion may be conducted at any of the ISP level (Fig. 3B), a client (Fig. 3C), and a remote (“third party advertising”) server (Fig. 3A).

Appellants’ arguments in support of claim 37 (App. Br. 22-24) allege a “teaching away,” and further allege deficiencies in the references when considered one at a time. The arguments are not persuasive of non-obviousness.

Appellants’ arguments in support of dependent claim 29 (App. Br. 24-25) are not persuasive, noting that Miyazaki does not teach using an ISP to identify an item of follow-up advertising and transmitting the identified item to the identified delivery address. The arguments fail to acknowledge that the rejection is not for anticipation. Goldman, and its teachings regarding ISPs, forms part of the evidence relied upon in the § 103(a) rejection.

Dependent claims 33 and 34 further limit the subject matter of claim 27, with the “causing transmission” of follow-up advertising comprising “initiating” physical delivery of printed material, or “initiating” physical delivery of product samples concerning the subject stated by the advertising material.

Miyazaki teaches delivery of follow-up advertising by e-mail. Physical delivery of product samples or printed material (e.g., via U.S. mail) has been commonplace for many years, and predicated delivery of advertising by e-mail. Appellants have provided no evidence that “initiating” physical delivery of product samples or printed advertising material was “uniquely challenging or difficult for one of ordinary skill in the art.” *See Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007)

(citing *KSR*, 127 S. Ct. at 1740-41). Moreover, the “initiating” of physical delivery requires no more than an indication (i.e., information) sent in a message.

We have considered all of Appellants’ arguments in the briefs but are not persuaded that the claims have been rejected in error. We sustain the rejection of claims 27-43 under 35 U.S.C. § 103(a) as being unpatentable over Miyazaki, Goldman, and Swart.

CONCLUSION

The rejection of claims 27-43 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).

AFFIRMED

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