

1 UNITED STATES PATENT AND TRADEMARK OFFICE

2
3
4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
6

7
8 *Ex parte* RICHARD L. GALLOWAY
9

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11 Appeal 2008-1227
12 Application 10/020,759
13 Technology Center 3600
14

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16 Decided: June 19, 2008
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19 Before HUBERT C. LORIN, ANTON W. FETTING, and DAVID B.
20 WALKER, *Administrative Patent Judges*.
21 FETTING, *Administrative Patent Judge*.

22
23 DECISION ON APPEAL

24 STATEMENT OF CASE

25 Richard L. Galloway (Appellant) seeks review under 35 U.S.C. § 134
26 of a final rejection of claims 1-17, 19-27, 29, and 30, the only claims
27 pending in the application on appeal.

28 We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b)
29 (2002).

1 We AFFIRM.

2 The Appellant invented a way for advising advertising clients about the
3 scheduling of their ads prior to broadcast (Specification 1:7-9).

4 An understanding of the invention can be derived from a reading of
5 exemplary claim 1, which is reproduced below [bracketed matter and some
6 paragraphing added].

7 1. A method for communicating a timing of ad broadcasts,
8 comprising:

9 [1] electronically accessing at least one electronically stored
10 record indicating, directly or indirectly, at least times for ads
11 broadcast in a past period;

12 [2] automatically generating a client report including at least a
13 time for a broadcast of an ad in a period; and

14 [3] automatically transmitting the report to an advertising client.

15 This appeal arises from the Examiner's final rejection, mailed June 19, 2006.
16 The Appellant filed an Appeal Brief in support of the appeal on November 16,
17 2006. An Examiner's Answer to the Appeal Brief was mailed on March 23, 2007.
18 A Reply Brief was filed on May 22, 2007.

19 PRIOR ART

20 The Examiner relies upon the following prior art:

21 Rogers	US 5,701,451	Dec. 23, 1997
22 Galloway	US 2003/0079223 A1	Apr. 24, 2003

23

24 REJECTION

25 Claims 1-17, 19-27, and 29-30 stand rejected under 35 U.S.C. § 103(a) as
26 unpatentable over Rogers and admitted prior art in the instant application and the
27 admitted prior art in the parent to the instant application.

1 ISSUES

2 The issue pertinent to this appeal is whether the Appellant has sustained its
3 burden of showing that the Examiner erred in rejecting claims 1-17, 19-27, and
4 29-30 under 35 U.S.C. § 103(a) as unpatentable over Rogers and admitted prior art.

5 The pertinent issue turns on whether one of ordinary skill would have known
6 to automate a report that was prepared manually for broadcast industry advertising
7 customers.

8 FACTS PERTINENT TO THE ISSUES

9 The following enumerated Findings of Fact (FF) are believed to be
10 supported by a preponderance of the evidence.

11 *Facts Related to Appellant's Disclosure*

12 01. The Appellant's system is adapted to automatically electronically
13 communicate with an electronically stored record of ads scheduled to be
14 aired, typically created by one of a variety of traffic and billing systems
15 or their equivalent. It produces a client advisory report of scheduled
16 times and other pertinent information for scheduled ads in advance of
17 broadcast and automatically distributes the report to the client
18 (Specification 2:20-28).

19 *Facts Related to Admitted Prior Art in Appellant's Disclosure*

20 02. Existing "traffic and billing systems" create electronic files known as
21 Schedule Logs and Inserter Logs that schedule a communication
22 company's advertising clients' ads for a coming period. The Schedule
23 Log details entries that satisfy contracts guaranteed for specified inserter
24 locations and times. The times remaining at inserter locations are filled
25 into the Schedule Logs with ads of advertisers who opted for less
26 certainty with a lower price. Some advertisers, thus, may get their ads

1 run at a prime time and in a prime inserter location even though they
2 paid a lesser price. However, such exposure is not guaranteed
3 (Specification 1:19-25).

4 03. Prior to the Appellant's invention, when a client advertiser on
5 broadcast media wanted advance notice of the times, channels, stations,
6 and sites scheduled for airing that client's ads, a person associated with a
7 communication company would review a record of which clients wanted
8 such advance notice of scheduled times and locations for ad airing, or
9 subsequent "as run" reports. The person would then manually request a
10 traffic and billing system to download a scheduled time/site report for
11 that client and prepare and fax the report as desired to the client
12 (Specification 2:8-17).

13 04. A RunRate efficiency report is helpful, reporting upon the execution
14 efficiency in regard to a Schedule Log/Inserter Log (Specification 2:2-
15 6).

16 05. Rating service data, including Nielson ratings, were available from
17 overnight ratings services (Specification 14:23-27).

18 *Rogers*

19 06. Rogers is directed to a way to allow Web users to request information
20 that is created by a data interpretation system and then presented by a
21 web server to the user of the web. Data is retrieved from multiple
22 sources which may be located remotely and processed by decision
23 support capsules. This permits users to access information from various
24 sources and obtain information at a desired location as a result of a
25 single request. Users of the information can be internal to a company, or
26 external. The result can be furnished to a user at a location which is

1 internal or external to the company, and as specified at a specified
2 location with a form and format desired. This allows a report to be
3 managed by the web support services, and in a form consistent with the
4 request, but without requiring a consistent interface solution (Rogers
5 4:52 – 5:9).

6 07. In order to create a way for Web users to request information
7 generation Rogers provides a web server with a control program agent
8 which is linked to a decision support tool of a data interpretation system
9 server, the application processing agent. Rogers then has that server
10 retrieve, process, and format information which is presented to the user
11 on the Web by the Web server. As a result, Web clients can request DIS
12 (IBM's Data Interpretation System) reports to be generated, specify the
13 parameters to be used in generating the reports, and then view the report
14 results on a Web home page (Rogers 5:10-27).

15 08. Rogers allows a user of a client to access and assemble information
16 structured and reported to the user in accordance with his desires, select
17 information for disparate servers, and access data on multiple databases
18 of different types using a single user request from a client. Rogers also
19 provides the ability to perform calculations with respect to any retrieved
20 data, to format the information in text or in graphics, and the facility of
21 presenting the results to the client for display or other use (Rogers 5:28-
22 45).

23 09. Rogers describes how its the control program agent allows alternative
24 output direction, or an additional output (Rogers 15:7-10).

1 Cir. 2003) (claims must be interpreted “in view of the specification” without
2 importing limitations from the specification into the claims unnecessarily).

3 Although a patent applicant is entitled to be his or her own lexicographer of
4 patent claim terms, in *ex parte* prosecution it must be within limits. *In re Corr*,
5 347 F.2d 578, 580 (CCPA 1965). The applicant must do so by placing such
6 definitions in the Specification with sufficient clarity to provide a person of
7 ordinary skill in the art with clear and precise notice of the meaning that is to be
8 construed. *See also In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994) (although
9 an inventor is free to define the specific terms used to describe the invention, this
10 must be done with reasonable clarity, deliberateness, and precision; where an
11 inventor chooses to give terms uncommon meanings, the inventor must set out any
12 uncommon definition in some manner within the patent disclosure so as to give
13 one of ordinary skill in the art notice of the change).

14
15 *Obviousness*

16 A claimed invention is unpatentable if the differences between it and the
17 prior art are “such that the subject matter as a whole would have been obvious at
18 the time the invention was made to a person having ordinary skill in the art.”
19 35 U.S.C. § 103(a) (2000); *KSR Int’l v. Teleflex Inc.*, 127 S.Ct. 1727, 1729-30
20 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 13-14 (1966).

21 In *Graham*, the Court held that that the obviousness analysis is bottomed on
22 several basic factual inquiries: “[1] the scope and content of the prior art are to be
23 determined; [(2)] differences between the prior art and the claims at issue are to be
24 ascertained; and [(3)] the level of ordinary skill in the pertinent art resolved.”
25 383 U.S. at 17. *See also KSR Int’l v. Teleflex Inc.*, 127 S.Ct. at 1734. “The

1 combination of familiar elements according to known methods is likely to be
2 obvious when it does no more than yield predictable results.” *KSR*, at 1739.

3 “When a work is available in one field of endeavor, design incentives and
4 other market forces can prompt variations of it, either in the same field or a
5 different one. If a person of ordinary skill can implement a predictable variation,
6 § 103 likely bars its patentability.” *Id.* at 1740.

7 “For the same reason, if a technique has been used to improve one device,
8 and a person of ordinary skill in the art would recognize that it would improve
9 similar devices in the same way, using the technique is obvious unless its actual
10 application is beyond his or her skill.” *Id.*

11 “Under the correct analysis, any need or problem known in the field of
12 endeavor at the time of invention and addressed by the patent can provide a reason
13 for combining the elements in the manner claimed.” *Id.* at 1742.

14
15 *Automation of a Known Process*

16 It is generally obvious to automate a known manual procedure or mechanical
17 device. Our reviewing court stated in *Leapfrog Enterprises Inc. v. Fisher-Price*
18 *Inc.*, 485 F.3d 1157 (Fed. Cir. 2007) that one of ordinary skill in the art would have
19 found it obvious to combine an old electromechanical device with electronic
20 circuitry

21 to update it using modern electronic components in order
22 to gain the commonly understood benefits of such
23 adaptation, such as decreased size, increased reliability,
24 simplified operation, and reduced cost. . . . The
25 combination is thus the adaptation of an old idea or
26 invention . . . using newer technology that is commonly
27 available and understood in the art.

28 *Id.* at 1163.

1 *Obviousness and Nonfunctional Descriptive Material*

2 Nonfunctional descriptive material cannot render nonobvious an invention
3 that would have otherwise been obvious. *In re Ngai*, 367 F.3d 1336, 1339 (Fed.
4 Cir. 2004). *Cf. In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983) (when
5 descriptive material is not functionally related to the substrate, the descriptive
6 material will not distinguish the invention from the prior art in terms of
7 patentability).

8 ANALYSIS

9 *Claims 1-17, 19-27, 29-30 rejected under 35 U.S.C. § 103(a) as unpatentable over*
10 *Rogers and admitted prior art.*

11 The Appellant does not argue each claim discretely, but rather presents each
12 argument and then in some cases indicates which claims are associated with that
13 argument.

14 The Appellant begins by arguing the distinction between accessing and
15 downloading (Br. 6:¶ A). We take this argument to mean that the applied art
16 describes downloading reports but not accessing records. The Appellant next
17 argues that the fair meaning of electronically stored record indicating, directly or
18 indirectly, at least times for ads broadcast in a past period (Br. 6-7:¶ B). We take
19 this argument to mean that the claims refer to records having particular structure,
20 and not to records of non-functional descriptive material. The Appellant next
21 argues what the knowledge of one of ordinary skill would entail (Br. 8-10:¶ C).
22 This does not appear to be an argument in favor of patentability *per se*, but rather
23 an argument as to how the other arguments are to be analyzed. The Appellant next
24 argues against a *per se* obviousness rule (Br. 10-11:¶ D) and that Rogers is non-
25 analogous art (Br. 11-12:¶ Traversal). The Appellant next separates claims into
26 five sets of arguments related to elements argued to be missing from the prior art.

1 The Appellant then presents arguments, apparently again applying to all claims as
2 a group, as to secondary considerations.

3 Claims 1, 7, 13, and 21 are independent. Claim 29 is multiply dependent
4 from claims 1, 2, and 23. Claims 1, 7, 13, and 21 are argued as a group. Claims
5 3 and 12 are argued as a group. Claims 8, 14, and 22 are argued as a group; claims
6 9-11 depend from claim 8 and claims 15, 17, and 20 depend from claim 14.
7 Claims 25-27 are argued as a group. We treat each dependent claim that is not
8 argued separately as being grouped with its parent independent claim. We
9 therefore treat claims 1, 2, 4-7, 13, 16, 19, 21, 23, 24, and 29 as being argued as a
10 group; 3 and 12 as a group; 8-11, 14, 15, 17, 20, and 22 as a group; and 25-27 as a
11 group.

12 Accordingly, we select claim 1 as representative of the first group.
13 37 C.F.R. § 41.37(c)(1)(vii) (2007).

14 *Claims 1, 2, 4-7, 13, 16, 19, 21, 23, 24, and 29*

15 Claim 1 is a method of preparing a client report using times for ads in a
16 media report by automating record retrieval, report generation, and distribution.
17 Thus, claim 1 is directed to an electronic report. Any electronic report requires
18 access of the records from which the report data is created, formatting of the report
19 and distribution. This is exactly the nature of the three limitations in claim 1.
20 Claim 1 makes no limitation on the system that the report is used within, other than
21 it contains or is able to otherwise derive the data required for the report.

22 The Examiner found that the admitted prior art described manually creating
23 the client report in claim 1 apart from automating its data retrieval, generation, and
24 transmission. This is uncontested. The Examiner found that one of ordinary skill
25 would have known to automate its data retrieval, generation, and transmission for
26 two reasons (Answer 3-4).

1 The first reason was that the Examiner found it was obvious to automate a
2 known manual process, whose automation was within the capacity of one of
3 ordinary skill. The second reason was that Rogers described automation of report
4 record retrieval, generation and transmission in general, and could be applied to
5 any report whose data and output were known (Answer 3-4).

6 The Appellant contends that such report automation was beyond the level of
7 one of ordinary skill (Br. 8-10:¶ C), that the admitted prior art did not include
8 electronic access (Br. 6:¶ A); that the Examiner failed to give patentable weight to
9 the claim limitations of the data contents as times for ads broadcast in the past (Br.
10 Br. 6-8:¶ B); that there is no *per se* rule regarding obviousness of automation (Br.
11 10-11:¶ D); that Rogers is non-analogous art and provides no pertinent teachings
12 (Br. 11-13); that Rogers fails to show an automated report system (Br. 13:¶ 1) and
13 a log record (Br. 13-14: ¶ 2); and that secondary considerations show evidence of
14 non-obviousness (Br. 12). Thus the issue before us is whether it was obvious to
15 automate a known manual report, along with its distribution.

16 We agree with the Examiner that the Appellant has not shown error in this
17 rejection. We initially take up the argument regarding the level of skill in the art.
18 The Appellant argues that one of ordinary skill is an operations manager in
19 broadcast media (Br. 8:¶ C). The Appellant argues that such a person would have
20 no knowledge of whether such a report as in claim 1 could be automatically
21 produced, and if it could, how to do so. The Examiner found that one of ordinary
22 skill was a one capable of designing reports according to Rogers's teachings
23 (Answer 19-20).

24 When confronted with the question of what the level of ordinary skill is, we
25 look to the problem to be solved by the invention and the level of skill required by
26 those practicing the comparable art. The factors for evaluating the level of skill

1 were set out in *GPAC*, 57 F.3d at 1579. Both the Examiner and the Appellant have
2 addressed the level of ordinary skill in the pertinent arts according to these factors.
3 The Examiner found that the level of skill was consistent with the level in Rogers.
4 The Appellant contends the level of skill is that of an operations manager (FF 10).

5 Our reviewing court, when confronted with the question of whether the
6 ordinary level of skill was that of an operator (a dyer) or a designer (a dying
7 systems designer), looked to the problem that was to be solved in both the patent's
8 specification and the prior art, and where they were the same, considered the level
9 of skill to be that needed in the prior art. *DyStar Textilfarben GmbH & Co.*
10 *Deutschland KG v. C. H. Patrick Co.*, 464 F.3d 1356, 1362 (Fed. Cir. 2006). In
11 that case, our reviewing court found that the need to select among various design
12 parameters required the higher level perspective of a systems designer in the
13 relevant art, and not just a system operator.

14 In the case before us, both the Specification and Rogers show the problem is
15 one of automating reports by retrieving data, generating reports and distributing
16 reports automatically. The Specification describes solving its problem of
17 automatically electronically communicating with an electronically stored record of
18 ads scheduled to be aired (FF 01) and Rogers describes its problem of allowing
19 Web users to request information that is created by a data interpretation system and
20 then presenting by a web server to the user of the web (FF 06).

21 Not only are the complexities of the problems comparable, but both present
22 the need to select design parameters, such as which fields in the underlying
23 database must be accessed and how their values are to be manipulated, which
24 requires a higher level perspective than a mere operator would have. Thus, as in
25 *Dystar*, we find that the ordinary level of skill required would be that of a systems
26 designer capable of creating and distributing reports by analyzing the data

1 requirements and coding the data retrieval and formatting with tools such as those
2 in Rogers.

3 To the extent the Appellant is arguing that the level of skill was such that
4 one of ordinary skill would not be expected even to know whether the reports
5 could be automated (Br. 8:Bottom ¶), this is simply inconsistent with the problem
6 being one of automating a process. The level of skill ordinarily needed would be
7 at least sufficient to know whether automation could be readily performed, and if
8 so, the techniques for such automation. The hypothetical manager/operator
9 suggested by the Appellant (Br. 8) might not have the skill to know whether some
10 report could be automated, but would at least have the skill to contact one having
11 the ordinary skill required by Rogers who could tell him the answer. Thus, we
12 agree with the level of skill found by the Examiner and we adopt the Examiner's
13 findings as to how each of the *GPAC* factors would need to be met.

14 The Appellant next argues that the Specification did not admit that electronic
15 access of a traffic and billing system was known (Br. 6: ¶ A). We find that the
16 Appellant did admit to manual access of the data from such a system (FF 02 & 03).
17 The Examiner relies upon Rogers to show electronic access of data for report
18 creation and distribution (FF 06). Rogers uses a conventional data interpretation
19 system, essentially an intelligent database, to retrieve, process, and format
20 information which is presented to the user (FF 07). Rogers allows a user of a client
21 to access and assemble information structured and reported to the user in
22 accordance with his desires, select information for disparate servers, and access
23 data on multiple databases of different types using a single user request from a
24 client (FF 08). Thus, Rogers is intended to be able to operate on a wide variety of
25 systems, and applicability to traffic and billing systems would have been
26 predictable to anyone with knowledge of such systems.

1 The Appellant also argues that it was not known to enter into the domain of
2 a traffic and billing software system to electronically access original records. This
3 is simply contrary to the nature of all report writers, such as that used by IBM's
4 data interpretation system. Any report writing software package inherently and
5 necessarily contains the software routines to access the data used in its reports.
6 The Appellant is simply trying to negate the past half century of report writing
7 software experience. As we found above, nothing in claim 1 limits the nature of
8 the system in which claim 1 operates. One of ordinary skill would have known to
9 simply create a system that would provide the requisite data if a software package
10 was not already available. But report writing software, such as that used by Rogers
11 already provides the data retrieval capacity required.

12 The Appellant next argues that the Examiner failed to afford patentable
13 weight to the limitations of the record contents of times in the body of the claim
14 (Br. 6-8:Bottom ¶ B). The Examiner found these were non-functional descriptive
15 material (Answer 5) and we agree with the Examiner. The Appellant argues that
16 the limitations of the type or source of data define the kind of data and therefore
17 should be given patentable weight.

18 The Appellant does not dispute that the data reported is descriptive.
19 Descriptive material can be characterized as either "functional descriptive
20 material" or "nonfunctional descriptive material." Exemplary "functional
21 descriptive material" consists of data structures¹ and computer programs, which
22 impart functionality when employed as a computer component. "Nonfunctional

¹ The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." *The New IEEE Standard Dictionary of Electrical and Electronics Terms* 308 (5th ed. 1993).

1 descriptive material” includes but is not limited to music, literary works and a
2 compilation or mere arrangement of data.

3 When presented with a claim comprising descriptive material, an Examiner
4 must determine whether the claimed nonfunctional descriptive material should be
5 given patentable weight. The Patent and Trademark Office (PTO) must consider
6 all claim limitations when determining patentability of an invention over the prior
7 art. *In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983). The PTO may not
8 disregard claim limitations comprised of printed matter. *See Gulack*, 703 F.2d at
9 1384; *see also Diamond v. Diehr*, 450 U.S. 175, 191 (1981). However, the
10 examiner need not give patentable weight to descriptive material absent a new and
11 unobvious functional relationship between the descriptive material and
12 the substrate. *See In re Lowry*, 32 F.3d 1579, 1583-84 (Fed. Cir. 1994); *In re Ngai*,
13 367 F.3d 1336, 1338 (Fed. Cir. 2004).

14 Thus, when the prior art describes all the claimed structural and functional
15 relationships between the descriptive material and the substrate, but the prior art
16 describes a different descriptive material than the claim, then the descriptive
17 material is nonfunctional and will not be given any patentable weight. That is, we
18 conclude that such a scenario presents no new and unobvious functional
19 relationship between the descriptive material and the substrate.

20 Thus, we agree with the Examiner’s finding that the limitations of the record
21 contents of times are non-functional descriptive material. Nonfunctional
22 descriptive material cannot render non-obvious an invention that would have
23 otherwise been obvious. *In re Ngai*, 367 F.3d at 1339. To the extent patentable
24 weight is given to the source of such data, we find, as the Examiner found, that the
25 admitted prior art manual reporting system used the same or equivalent sources
26 (FF 02 & 03).

1 The Appellant next argues that there is no *per se* rule regarding obviousness
2 to automate (Br. 10). While we agree that there are no *per se* rules regarding
3 obviousness, we also find that to automate a known manual report using modern
4 electronic components in order to gain the commonly understood benefits of such
5 adaptation, such as decreased size, increased reliability, simplified operation, and
6 reduced cost is thus the adaptation of an old idea or invention using newer
7 technology that is commonly available and understood in the art. *Leapfrog*, 485
8 F.3d at 1163. The presence of an automated system containing the requisite data
9 and the manual preparation of the reports is admitted (FF 02 & 03). To retrieve
10 data from an existing automated system and automatically prepare and distribute a
11 report is well within the capacity of one of ordinary skill in such automation
12 technologies.

13 The Appellant next argues that Rogers is non-analogous because it pertains
14 to web communication (Br. 11) and that Rogers provides no pertinent teachings as
15 to how one would actually retrieve data as claimed (Br. 12). The Appellant also
16 argues the lack of motivation to combine the art (Br. 15). We disagree with the
17 Appellant. Rogers is directed to a way to allow Web users to request information
18 that is created by a data interpretation system and then presented by a web server to
19 the user of the web (FF 06). Thus, Rogers is directed to the same problem as the
20 Appellant's of retrieving and reporting information. Rogers provides for creation
21 and distribution over the web, but the underlying problem is still the same, and
22 therefore Rogers is analogous art. Further, applying Rogers' automating of reports
23 to media markets is no more than a response to market forces in such markets.

24 When a work is available in one field of endeavor, design
25 incentives and other market forces can prompt variations
26 of it, either in the same field or a different one. If a
27 person of ordinary skill can implement a predictable
28 variation, § 103 likely bars its patentability. For the same

1 reason, if a technique has been used to improve one
2 device, and a person of ordinary skill in the art would
3 recognize that it would improve similar devices in the
4 same way, using the technique is obvious unless its
5 actual application is beyond his or her skill.

6
7 *KSR*, 127 S.Ct. at 1740.

8 As to the argument that Rogers does not describe how to retrieve the specific
9 data called for, we find that this would have been well within ordinary level of skill
10 of one using a report creation tool such as IBM's Data Interpretation System used
11 in Rogers. And as to the argument of lack of motivation to combine,

12 [t]he obviousness analysis cannot be confined by a
13 formalistic conception of the words teaching, suggestion,
14 and motivation, or by overemphasis on the importance of
15 published articles and the explicit content of issued
16 patents. The diversity of inventive pursuits and of
17 modern technology counsels against limiting the analysis
18 in this way. In many fields it may be that there is little
19 discussion of obvious techniques or combinations, and it
20 often may be the case that market demand, rather than
21 scientific literature, will drive design trends.

22
23 *KSR*, 127 S. Ct. at 1741. The use and benefits of automated reports was simply so
24 notorious at the time of the invention, that those benefits were sufficient motivation
25 to automate the manual reports in the admitted prior art.

26 Finally, the Appellant provides six letters from customers of a product
27 containing an embodiment of the invention. These letters are not affidavits. They
28 generally praise the speed provided by the automation of the reports (FF 11). The
29 Appellant also argues that another company attempted to copy the invention and
30 failed. The arguments provide no evidence of the scope of what was attempted or
31 the difficulties encountered (FF 12). We find that the increased speed of
32 automated reports over manual reports was the predictable effect of automation.

1 The Appellant has not shown that automation required more than the ordinary level
2 of skill in the arts relevant to creating such automated reports. Thus, the
3 automation provided by the product described in the customer letters did no more
4 than respond to market demand with technology known and available to those of
5 ordinary skill.

6 As to the arguments regarding copying, the arguments lack evidence upon
7 which to weigh them, such as the level of skill of the one attempting the copying,
8 the nature of what was attempted and the nature of the discrepancies. Thus, we
9 find these arguments to be insufficient to overcome a presumption of obviousness.

10 *Claim 3 and 12*

11 Claims 3 and 12² require electronically generating and distributing plural
12 reports. Such generation is within the admitted prior art (FF 02). The Appellant
13 argues that it is not admitted to have electronically distributed plural reports (Br.
14 13). We find that Rogers explicitly describes plural outputs, which in the case of
15 reports (FF 09), implies electronically distributed plural reports.

16 *Claim 8-11, 14, 15, 17, 20, and 22*

17 Claims 8, 14 and 22 require electronically accessing a broadcast schedule
18 log to produce the report. Such logs were within the admitted prior art (FF 02).
19 The Appellant does not argue that the art fails to describe this, but only that this
20 limitation is within these claims (Br. 14).

21 First, a statement which merely points out what a claim recites will not be
22 considered an argument for separate patentability of the claim.

23 37 C.F.R. § 41.37(c) (1)(vii) (2007). But were we to consider this as an argument

² Br. 13 inconsistently refers first to claims 3 and 12, and then to claims 3 and 13. As it is claims 3 and 12 that share the limitations being argued, the reference to claim 13 appears to be a typographic error, and we treat it as referring to claim 12.

1 that the art fails to show this limitation, we found *supra* that writing automated
2 reports by electronically retrieving records was known and the particular data
3 called for in the claims were both predictable and non-functional descriptive
4 material. To have accessed the files where the data was to be retrieved, such as
5 schedule logs, was a predictable step in such data retrieval. Claims 9-11 depending
6 from claim 8, and claims 15, 17, and 20 depending from claim 14 and are not
7 separately argued, and are treated as being grouped with claims 8, 14, and 22.

8 *Claims 25-27*

9 Claims 25-27 require electronically accessing and reporting rating data,
10 indicia of ad exposure and Nielson data. Such indicia and ratings were within the
11 admitted prior art (FF05), as was the reporting of measures of effectiveness (FF
12 04). We found *supra* that writing automated reports by electronically retrieving
13 records was known and the particular data called for in the claims were both
14 predictable and non-functional descriptive material. To have accessed the files
15 where the data was to be retrieved, such as rating service output, and to have
16 computed by automation what was done manually was a predictable step in such
17 data retrieval and reporting.

18 **CONCLUSIONS OF LAW**

19 The Appellant has not sustained its burden of showing that the Examiner
20 erred in rejecting claims 1-17, 19-27, and 29-30 under 35 U.S.C. § 103(a) as
21 unpatentable over the prior art.

22 On this record, the Appellant is not entitled to a patent containing claims
23 1-17, 19-27, and 29-30.

24 **DECISION**

25 To summarize, our decision is as follows:

