

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEFFREY P. SZMANDA

Appeal 2007-0220
Application 09/982,640
Technology Center 2100

Decided: November 16, 2007

Before JAMES D. THOMAS, JOSEPH F. RUGGIERO,
and ALLEN R. MACDONALD, *Administrative Patent Judges*.

THOMAS, *Administrative Patent Judge*.

ON REQUEST FOR REHEARING

In a decision dated May 31, 2007, we affirmed the decision of the Examiner rejecting various claims on appeal under 35 U.S.C. § 102 and 35 U.S.C. § 103. On August 2, 2007, the Board received a Request for Rehearing in this appeal. The electronic record for this application contains a transmittal cover sheet with an Express Mail number of EB560816506US. Electronic access to United States Postal Service records indicates that the postal item bearing the above-noted Express Mailed number was delivered

to the Office on August 1, 2007. The transmittal cover sheet and the Request for Rehearing at page 10 both bear the date of July 31, 2007, near the signature of Appellant's representative. Further such electronic access revealed that the request was accepted on July 31, 2007 at a U.S. Post Office for Post Office-to-addressee delivery. Thus, within 37 CFR 1.10, we consider the request to have been filed in a timely manner, that is, on July 31, 2007. The above-noted panel only recently received this request for decision.

The bulk of Appellant's remarks within the request relate to the discussion at pages 3 and 4 of our prior decision where we found that the subject matter of all claims on appeal recite non-functional descriptive material which did not provide a patentable distinction to the data or to the process of the claimed methods. More specifically, we found "that the meaning relating to facts about an advertisement and/or details of a plurality of advertisements cannot be used to distinguish the claimed invention from prior art data/facts/details." As argued in the Briefs and at oral hearing (note the paragraph at the bottom of page 4 of our prior decision), patentability of the subject matter of the claims on appeal was predicated on the nature of the information content, that is, advertising information. We further observe that there is a high degree of subjectivity of what the artisan/user considers advertising information versus any other type or category of information.

Notwithstanding Appellant's extensive remarks in the initial pages of the request to the contrary, our conclusion with respect to non-functional descriptive material is consistent with the case law noted in this portion of our opinion as well as the subsequent case law. *See also Ex parte Curry*,

BPAI Appeal No. 2005-0590 (Appl. No. 90/449,237) (*aff'd*, Appeal No. 06-1003 (Fed. Cir. Jun. 12, 2006)(Rule 36)(unpublished)); *Ex Parte Mathias*, BPAI Appeal No. 2005-1851 (Appl. No. 09/612,788) 2005 WL 5121483, at *3(*aff'd*, Appeal No. 06-1103, 2006 WL 2433879 (Fed. Cir. Aug. 17, 2006)(Rule 36)).

The discussion beginning at the bottom of page 8 of the request through page 9 asserts that when the limitations of the claims are given patentable weight, the correlations presented by the Board in our prior decision failed to disclose or suggest all the limitations of the claims. With this position we strongly disagree as the bulk of our prior decision fully explains. In the first paragraph of our decision at the top of page 3 as well as at the bottom of page 4, our reasoning merely buttressed that which the Examiner set forth in the Answer. Both the Examiner's position in the Answer as well as the bulk of our discussion in our prior decision alternatively assume for the sake of our respective analyses that patentable weight was given to the form of the information content, that is, advertisement information. The discussion at page 9 of the request appears to invite us to read specific features into the claims from the disclosed invention that are not recited in the claims to render patentable distinctions over those of the applied prior art to Skillen and Loeb. We observe again here that we mentioned earlier at page 5 of our prior decision that Skillen's advertising (selling) machine 10 in figure 1 clearly relates to advertising information; we also noted at the middle of page 9 of our prior decision that advertising information was specifically taught as well as column 9 of Loeb.

It is emphasized that the content of our prior decision set forth essentially two lines of reasoning as bases on which we affirmed the Examiner's rejections. The first included our finding not to give patentable weight to the information content of the subject matter recited in the claims on appeal. The second, separate line of reasoning, which is consistent with the Examiner's approach within the rejections, was to give patentable weight to all limitations.

In view of the forgoing, we have considered Appellant's Request for Rehearing, but it is denied as to making any change in our prior decision.

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).

DENIED

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