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Stephen Corey Wren

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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte STEPHEN COREY WREN

Appeal 2011-000832
Application 12/124,027
Technology Center 3600

Before: MURRIEL E. CRAWFORD, HUBERT C. LORIN, and JOSEPH
A. FISCHETTI, *Administrative Patent Judges*.

CRAWFORD, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant seeks our review under 35 U.S.C. § 134 from the Examiner's final rejection of claims 7-26. We have jurisdiction under 35 U.S.C. § 6(b).

SUMMARY OF THE DECISION

We affirm-in-part.

BACKGROUND

Appellant's invention is directed to a system for facilitating transactions between central and remote facilities utilizing electronic communications devices and computing equipment (Spec., p. 1, ll. 21-26).

Claim 7 is illustrative:

7. An apparatus for providing marketing and/or sales information relating to goods and/or services comprising:

a computerized central communications facility;

a database of marketing and/or sales information relating to goods and/or services at said computerized central communications facility, and;

a communications device at said computerized central communications facility;

wherein said computerized central communications facility is operable to be linked to a plurality of other computerized central communications facilities and to a plurality of computerized remote communications facilities;

wherein said database of marketing and/or sales information relating to goods and/or services is accessible to a customer at one or more of said computerized remote communications facilities;

wherein said communications device at said computerized central communications facility is operable to transmit at least a portion of said marketing and/or sales

information relating to said goods and/or services to at least one of said computerized remote communications facilities;

wherein said computerized central communications facility is operable to provide at least a portion of said marketing and/or sales information relating to said goods and/or services to one or more of said computerized remote communications facilities upon request;

wherein at least one of said other computerized central communications facilities enables said customer at one or more of said computerized remote communications facilities to select and contact a computerized central communications facility of a different provider, and;

wherein said computerized central communications facility of a different provider is equipped with:

a database of marketing and/or sales information relating to goods and/or services accessible to said customer at one or more of said computerized remote communications facilities, and;

a communications device adapted to transmit at least a portion of said marketing and/or sales information relating to said goods and/or services to at least one of said computerized remote communications facilities, whereby said customer has access to information at multiple computerized central communications facilities of different providers.

Appellant appeals the following rejections:

Claims 23-26 are rejected under 35 U.S.C. § 101 as being directed to ineligible subject matter.

Claims 8-11 and 21 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

Claims 17-20 are rejected under 35 U.S.C. § 112, second paragraph, as indefinite.

Claims 7-23 and 26 are rejected under 35 U.S.C. § 102(e) over Bernard (US 5,918,213, iss. Jun. 29, 1999).

Claim 24 is rejected under 35 U.S.C. § 103(a) as unpatentable over Bernard and Woolston (US 5,845,265, iss. Dec. 1, 1998).

Claim 25 is rejected under 35 U.S.C. § 103(a) as unpatentable over Bernard and Belknap (US 5,586,264, iss. Dec. 17, 1996).

FACTUAL FINDINGS

We find the following facts by a preponderance of the evidence.

1. The original Specification of application 08/268,309, to which this application claims priority, describes, “the present invention would with central storage permit each remote facility or location to communicate with an array of central facilities” (Spec., pg. 5, ll. 4-11).
2. The original Specification of application 08/268,309, to which this application claims priority, describes, “[f]or auction houses a number of the remote locations may be concurrently linked with one or more central facilities or auction houses so that groups of customers at each remote or local auction facility may participate in the actual auction at one or more distant central facilities or houses.” (Spec., pg. 6, l. 31 to pg. 7, l. 3).
3. The original Specification of application 08/268,309, to which this application claims priority, describes,

[i]n that sense an electronic phone book may be stored at the remote facility or instead upon pressing or utilizing the touch screen, keyboard or input device the customer may activate the system causing it to retrieve from a central facility a directory of goods and services available and thus permitting the customer to select another central facility from a displayed list or catalogue and establish contact with it and thus have access to

numerous central facilities and a myriad of goods and services. [(Spec., pg. 9, l. 32 to pg. 10, l. 7)].

ANALYSIS

Patentable subject matter

Appellant argues that claims 23-26 are tied to a computer because the database is computerized, and the method claims are therefore patent-eligible subject matter. App. Br. 2. The Examiner rejected these method claims as not being “tied to another statutory class (such as an apparatus) or transform[ing] underlying subject matter....” Ans. 4. The Examiner also reasoned that the undefined term “database” was interpreted as “software.” Ans. 8.

However, we find that merely stating what the test and conclusion under that test is, and separately stating that the database is construed as software, does not adequately analyze the issue or articulate the reasoning for the conclusion the Examiner has reached. For example, we do not find an analysis of recited terms in claim 23, such as “database,” “accessed by a customer at [a] remote location[],” or “access said first and [an] other database[] of another provider,” to explain how the stated (and no longer applicable) test leads to the Examiner’s conclusion. The Examiner also does not explain how an element being software, in a method claim, renders the claim ineligible for patent protection. As such, the Examiner has failed to set forth a prima facie case of patent ineligibility, so we will not sustain the rejection of claims 23-26 under 35 U.S.C. § 101.

Written Description – Claims 8 and 21

We are persuaded of error by Appellant’s argument that support exists for claims 8 and 21 at page 14, lines 1-2 of the originally-filed Specification,

which states, “customer requests their product information or is shown it involuntarily based on a customer’s profile.” App. Br. 2-3. This is in response to the Examiner’s rejection on the basis that these amended claims contain new matter unsupported by the original disclosure, specifically the recited term “involuntarily.” Ans. 4-5. The “test for sufficiency is whether the disclosure of the application relied upon reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date.” *Ariad Pharm., Inc. v. Eli Lilly and Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (quoting *Ralston Purina Co. v. Far-Mar-Co, Inc.*, 772 F.2d 1570, 1575 (Fed. Cir. 1985)). Because the term “involuntarily” appears in the original Specification, describing what one of ordinary skill in the art would recognize as an automatic display of content, we reverse the rejection under 35 U.S.C. § 112, first paragraph, for lack of written description support of claims 8 and 21.

Written Description – Claims 9-11

We are persuaded of error by Appellant’s argument that support exists in the original disclosure for the subject matter of current claims 9-11. App. Br. 2-3. First, the Examiner only objects to “recommendations based on a history of multiple customers,” citing to page 14, lines 20-27 of the Specification, as supporting profiles for a “*single* customer.” Ans. 4-5, 9. Therefore, the Examiner’s own argument indicates support is found for the subject matter of claims 9 and 10 in the Specification, because claim 9 recites a “profile based on said customer’s use of said apparatus” and claim 10 recites “a profile from a single customer’s use.” Next, we note that claim 11 recites “build a profile from multiple customers’ use.” We find support for this claim in originally-filed claim 6, which recites, “wherein a profile is

built from multiple customers' use," because originally-filed claims are part of the original disclosure.

For these reasons, we reverse the rejection of claims 9-11 under 35 U.S.C. § 112, first paragraph, for lack of written description support.

Indefiniteness – Claims 17-20

We are not persuaded of error by Appellant's argument that claims 17-20 are not indefinite, because the word "'customer' should not be read as part of 'entertainment-based programing', but rather by itself." App. Br. 4. The Examiner rejected claims 17-20 as indefinite because of the phrase "said customer entertainment-based programming" had no antecedent basis. Ans. 5. We find the claim leaves open at least two possible interpretations. First, the term "adapted to provide said customer entertainment-based programming" could mean a type of programming. Second, the clause could instead mean "adapted to provide said customer [*with*] entertainment-based programming."

The Examiner argues that the word "customer" is without antecedent basis, because parent claim 15 does not refer to any particular customer in singular form, but only a groups of "customers" in plural form. Ans. 9. We agree with the Examiner, because the lack of antecedent basis means it is not clear whether claims 17-20 refer to one customer or all customers recited in parent claim 15.

Because the claim language is ambiguous, we sustain the rejection of claims 17-20 as indefinite under 35 U.S.C. § 112, second paragraph.

Anticipation and Obviousness

We are persuaded of error by Appellant's argument that Bernard is not available as prior art for use in the rejection under 35 U.S.C. § 102(e) of independent claims 7, 15, and 23. App. Br. 5.

The Examiner notes that Bernard is available as prior art under 35 U.S.C. § 102(e) based on the filing date of December 22, 1995. Ans. 5. The Examiner also argues that he finds "no support for the claimed limitations in Appellant's (*chart section v*)," which refer to "different [(claims 7 and 15)]" and "another [(claim 23)] provider." Ans. 10. The Examiner repeats from the Final Rejection that "central facilities #2...#n first appear in Fig. 1 as amended on 03/29/1996 in application 08/268309 Claims that refer to a '...computerized central communications facility of a different provider ...' receive a priority date of 03/29/1996." Ans. 11. That is, the Examiner finds the term "central facilities" is first present in a drawing upon amendment in 1996, but not in the originally-filed disclosure.

However, the originally-filed Specification of application 08/268,309 discloses an array of central facilities that communicate with each other and a remote facility. The '309 application therefore does provide written description support for multiple central communications facilities, for example, at page 5, lines 8-10 (FF 1), page 6, line 31 through page 7 line 3 (FF 2), and page 9 line 33 through page 10 line 7 (FF 3). We find the effective filing date for the aforementioned features of claims 7, 15, and 23 is at least as early as the June 29, 1994 filing date of the '309 application, to which this application claims priority in the originally filed declaration. As a result, Bernard is not available as prior art for a rejection under 35 U.S.C. §

102(e), because Bernard's 102(e) date of December 22, 1995 is after the priority date of June 29, 1994 of this application.

Therefore, we cannot sustain the rejection of claims 7-23 and 26 under 35 U.S.C. § 102(e) over Bernard, nor of dependent claims 24 and 25, each rejected under 35 U.S.C. § 103(a) on Bernard in combination with other references.

DECISION

We reverse the rejection of claims 23-26 under 35 U.S.C. § 101.

We reverse the rejection of claims 8-11 and 21 under 35 U.S.C. § 112, first paragraph.

We reverse the rejection of claims 7-23 and 26 are rejected under 35 U.S.C. § 102(e).

We reverse the rejection of claims 24 and 25 separately rejected under 35 U.S.C. § 103(a).

We affirm the rejection of claims 17-20 under 35 U.S.C. § 112, second paragraph, as indefinite.

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

AFFIRMED-IN-PART

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