

The opinion in support of the decision being entered today is *not* binding
precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEPHEN COREY WREN

Appeal No. 2007-3066
Application No. 09/504,374
Technology Center 3600

Decided: September 7, 2007

Before TERRY J. OWENS, ROBERT E. NAPPI, and LINDA E. HORNER
Administrative Patent Judges.

NAPPI, *Administrative Patent Judge.*

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 of the final rejection of claims 12 through 18, 20 through 22, 34 through 39, 41, 47 through 50, and 52 through 88. For the reasons stated *infra* we affirm in part the Examiner's rejection of these claims.

INVENTION

The invention is directed to a system for marketing goods and services where a user uses a remote facility to access a computerized central communications system to obtain information about goods and services. See page 7 of Appellant's Specification. Claims 12 and 66 are representative of the invention and reproduced below:

12. An apparatus for marketing goods and/or services, comprising:
a computerized central communications facility of a first provider providing information relating to goods and/or services to a customer at a computerized remote facility, said computerized central communications facility configured to provide information permitting the customer to select and contact at least one other computerized central communications facility of a second provider to request and access additional information relating to said goods and/or services;

a communication device at said computerized central communications facility of a first provider, said computerized central communications facility communicating with the computerized remote facility, said communication including transmitting said information to the computerized remote facility; and

a database of information relating to said goods and/or services accessible to the customer at said computerized remote facility.

66. An apparatus for marketing goods and/or services, comprising:
a computerized central communications facility providing information relating to goods and/or services to customers at a plurality of computerized remote facilities, each of said plurality of computerized remote facilities remote from and linked to said computerized central communications facility; and

a database of information relating to said goods and/or services accessible to customers at said plurality of computerized remote facilities;

wherein said computerized central communications facility provides auctioning services including receipt of auction bids placed by customers from said plurality of computerized remote facilities.

REFERENCES

The references relied upon by the Examiner are:

Shavit US 4,799,156 Jan. 17, 1989

Filepp US 5,347,632 Sep. 13, 1994

Bruce, Bob, *Home-Based Banking Slowly Catching On*, Bolder County Business Report, p. 6, Oct. 1989.

Williams, Bob, *Verity Announces TOPIC Real-Time and Strategic Alliance with Dow Jones & Co.*, Business Wire, Apr. 23, 1990.

Viescas, John, *The Official Guide to the Prodigy Service*, pp. 210, 217, 220, 227 (1991).

Prodigy Services Adds Offerings, Wall Street Journal, Mar. 18, 1991.

New Competitor for Prodigy, Catalog Age, p. 38, Aug. 1991.

Pollick, Michael, *Online Services get on Track more Firms Offering Computer Networks*, The Sun, p. 1E, Aug 11, 1991.

Oldenburg, Don, *Making the Right Connection*, The Washington Post, p. b5, Jan. 29, 1992.

AT&T Provides Compass, Communications International, p.6, Jul. 1993.

Cheseby, Karen, *What the Analysts Say*, The Washington Post, p. F33, Aug. 23, 1993.

Filppu, Len, *Software Publishing Corp. Unveils New Support Warranty Policy*, Business Wire, p. 1, Aug. 26, 1993.

REJECTIONS AT ISSUE

Claim 66 stands rejected under 35 U.S.C. § 102(b) as anticipated by Shavit.

Claims 12, 34 through 39, 41, 47, 48, 52, 64, and 66 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Filepp.

Claims 12 through 18, 20 through 22, 34 through 39, 41, 47 through 50, 52 through 65, 70 and 81 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Filepp in view of Viescas (*Official Guide to the Prodigy Service*).

Claims 16, 50, and 56 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Filepp in view of *AT&T Provides Compass*.

Claims 67 and 78 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Filepp in view of *Prodigy Services Add Offerings*.

Claims 68 and 79 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Filepp in view of Williams (*Verity Announces TOPIC Real-Time and Strategic Alliance with Dow Jones & Co.*).

Claims 69 and 80 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Filepp in view of Oldenburg (*Making the Right Connection*).

Claims 71 and 82 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Filepp in view of Bruce (*Home-Based Banking Slowly Catching*).

Claims 72, 73, 83, and 84 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Filepp in view of *New Competitor for Prodigy*.

Claims 74 and 85 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Filepp in view of Pollick (*Online Services get on Track more Firms Offering Computer Networks*).

Claims 75, 76, 86, and 87 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Filepp in view of Filppu (*Software Publishing Corp. Unveils New Support Warranty Policy*).

Claim 77 and 88 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Filepp in view of Cheseby (*What the Analysts Say*).

The Examiner's rejections are set forth in Appendix D of the Answer. Throughout the opinion we make reference to the Brief and Reply Brief (filed March 6, 2007 and May 10, 2007 respectively), and the Answer (mailed April 9, 2007) for the respective details thereof.

Rejection of claim 66 under as anticipated by Shavit.

On pages 20 through 22 of the Brief, Appellant presents several arguments as to why the Examiner's rejection of claim 66 over Shavit is in error. Appellant argues, on page 22 of the Brief:

[C]laim 66 differs from the Shavit reference not because it recites an auctioning system where a sale is made to the highest bidder, but rather because it recites an auctioning system where customers submit bids as opposed to the Shavit reference where it is instead sellers who submit bids (quotes).

In response, on page 6 of the Answer, the Examiner, finds that Shavit teaches auctions and that "Shavit discloses acceptance or rejection of bids and that when bids are accepted, the bids are converted to orders."

We disagree with the Examiner's rationale. Anticipation requires that a single reference disclose directly or through the principles of inherency each element of the claim. Claim 66 recites that the computer central communications facility "provides auctioning services including receipt of auction bids placed by customers from said plurality of computerized remote facilities" While we concur with the Examiner that Shavit teaches providing auction services in the context of

providing freight services, see column 16, lines 50-65, and column 38, lines 37-40, we do not find that Shavit teaches that these auction services include receiving bids placed by customers. In the instance of auctioning freight services, the bids are provided by the freight providers, who are sellers of services, not customers. Similarly, in the context of the customers submitting request for quotes for other services or goods, see column 16, lines 50-65, the bids are provided by the seller. Thus, we do not find that Shavit teaches all of the limitations of claim 66 and we reverse the Examiner's rejection of claim 66 as anticipated by Shavit.

*Rejection of claims 12, 34 through 39, 41 47, 48, 52, 64, and 66
unpatentable over Filepp.*

Appellant argues, on pages 23 through 27 of the Brief, that the Examiner's rejection of claims 12, 34 through 39, 41 47, 48, 52, 64, and 66 is in error. Appellant's arguments focus on the "select and contact" limitation in the independent claims. Appellant argues, "Filepp's system was designed to eliminate the need to consult multiple information sources." (Br. 23). Appellant argues that in contrast, Appellant's invention is to create a system of multiple hosts each of which a customer may contact. (Br. 24). Thus, Appellant argues that Filepp teaches away from the claimed invention. (Br. 24). Appellant also argues that the "select and contact" limitations are not non-functional descriptive material, as they recite information that is functionally related to the substrate. (Br. 26-27).

The Examiner, in the statement of the rejection, states that the difference between the prior art and the claimed invention lies in the nonfunctional descriptive material describing the apparatus. See second page of Appendix D. Further, in Appendix E to the Answer, the Examiner identifies that Filepp discloses

in column 7, lines 13-23 that customers can use the system to access other computerized central communications facilities.

Initially, we note that Appellant's arguments on pages 23 through 28 of the do not separately address claims 12, 36-39, 41, 47, 48, 52, and 64.

37 C.F.R. § 41.37(c)(1)(vii) states:

Each ground of rejection must be treated under a separate heading. For each ground of rejection applying to two or more claims, the claims may be argued separately or as a group. When multiple claims subject to the same ground of rejection are argued as a group by appellant, the Board may select a single claim from the group of claims that are argued together to decide the appeal with respect to the group of claims as to the ground of rejection on the basis of the selected claim alone. Notwithstanding any other provision of this paragraph, the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately. Any claim argued separately should be placed under a subheading identifying the claim by number. Claims argued as a group should be placed under a subheading identifying the claims by number. A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim.

Thus in accordance with 37 C.F.R. § 41.37(c)(1)(vii) we group rejected claims 12, 47, 48, 52, and 64 together, and we select claim 12 as representative of the group. On page 28 of the Brief Appellant separately addressed the Examiner's rejection of claim 34, 35, and 66 as unpatentable over Filepp. As such, we grouped rejected claims 34, 36 through 39, and 41 together, and we select claim 34 as representative of the group. Accordingly, we will address the Examiner's rejection based upon Filepp as directed to claims 12, 34, 35, and 66.

Claim 12.

Appellant's arguments directed to the "select and contact" limitation have not persuaded us of error in the Examiner's rejection. Claim 12 recites "said computerized central communications facility configured to provide information permitting the customer to select and contact at least one other computerized central communications facility of a second provider to request and access additional information relating to said goods and/or services" and "said communication including transmitting said information to the computerized remote facility." Thus, claim 12 recites that a computerized central communication provides information to a customer by transmitting the information to a computerized remote facility. The information also permits the customer to select and contact another computer facility. Claim 12 recites no limitation describing the format of the information (i.e., whether it is the form of computer executable instruction) or an apparatus or steps which use the information to do anything (i.e., there is no claimed step of using the information to contact the second service provider.) Thus, the statement "permitting the customer to select and contact at least one other computerized central communications facility of a second provider to request and access additional information relating to said goods and/or services" is merely descriptive of the information provided. "Where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability." *In re Ngai*, 367 F.3d 1336, 1339, 70 USPQ2d 1862, 1864 (Fed. Cir. 2004), citing *In re Gulack*, 703 F.2d 1381, 217 USPQ 401 (Fed. Cir. 1983); see also our recent final decision in *Ex parte Curry*, Appeal No. 2005-0509 (BPAI 2007), available at <http://des.uspto.gov/Foia/ReterivePdf?flNm=fd050509.pdf> (Affirmed, Rule 36, Appeal No. 06-1003, (Fed. Cir., June 2006)). Thus, for this reason alone

Appellant's arguments directed to the "select and connect" limitation have not persuaded us of error in the Examiner's rejection.

Further, even if the "select and connect" limitation were not drawn to non-functional descriptive material, we find that Filepp teaches this limitation and as such do not find that Filepp teaches away from the claimed invention. We note that claim 12 also does not recite how the customer selects and contacts another computerized central facility. As the Examiner identifies, in Appendix E to the Answer, Filepp teaches that the information the user requests is either, locally at the file server or "via the gateway 210, which may be coupled to external providers." (Col. 7, ll. 20-23). Thus, we find Filepp teaches that through the file server (Appellant's claimed computerized central facility) the user is able to connect and contact to obtain information from external providers (Appellant's claimed one other computerized central communications center). Thus, we find ample evidence to support the Examiner's finding that Filepp teaches this limitation and we affirm the Examiner's rejection of claim 12 and claims 47, 48, 52, and 64 grouped with claim 12.

Claim 34.

Appellant argues, on page 28 of the Brief that, similar to the arguments directed to claim 12, Filepp teaches away from a central communication facility configured to provide information permitting the customer to select and contact another central communication facility. We note that claim 34 differs from claim 12 in that claim 34 also recites that the central communications facility is configured to "facilitate a transaction between said customer at said computerized remote facility and one of said first provider and said second provider," as such claim 34 is limited to a system in which there are two providers. However, as

discussed *supra* with respect to claim 12, we find that Filepp teaches communication with multiple service providers and we affirm the Examiner's rejection of claim 34.

Claims 36 through 39 and 41 depend upon claim 34. Appellant has not presented a separate argument addressing the limitations of these claims. Accordingly, we group claims 36 through 39 and 41 with claim 34 and affirm the Examiner's rejection of these claims for the same reasons.

Claim 35.

Appellant argues, on page 28 of the Brief, that Filepp does not teach a system where the providers are in competition with each other.

The Examiner does not address this argument in Answer.

We concur with the Appellant. Claim 35 is dependent upon claim 34 and further recites, "wherein said at least one other computerized central communications facility is a competing provider of said goods and/or services." ¹ As discussed *supra* with respect to claim 12, we find that Filepp teaches communication with multiple service providers. However, we find no discussion in Filepp that the different service providers are competitors. Accordingly, we will not sustain the Examiner's rejection of claim 35.

¹ We note that it is questionable whether Appellant's Specification provides support for this limitation. Appellant's Brief, on page 7, cites page 6, line 37 of the originally filed Specification as providing support for this limitation. However, page 6 line 37 of Appellant's originally filed Specification includes a discussion of the prior art restricting the completion for sales of goods and services, this section does not discuss competitors providing information to access each others' communications systems. Nonetheless, as there is no issue related to written

Claim 66.

Appellant argues on, page 28 of the Brief, that the Filepp does not teach the limitation “wherein said computerized central communications facility provides auctioning services including receipt of auction bids placed by customers from said plurality of computerized remote facilities.”²

The Examiner responds on pages 6 and 7 of the Answer, stating that Filepp discloses use of the system for transactions related to stocks and bonds. The Examiner reasons that stocks and bonds are auctioned at stock markets and bond markets and as such Filepp teaches using the system to provide auctions.

We disagree with the Examiner’s rationale. Initially we note that the Examiner has not provided evidence to support the finding that stock markets are auctions. Further, as discussed above, with respect to the rejection of claim 66 as being anticipated by Shavit, claim 66 recites “including receipt of auction bids placed by customers from said plurality of computerized remote facilities.” The Examiner has not presented evidence to support a finding that using Filepp for transactions related stock markets are auctions and the system receives auction bids placed by customers from said plurality of computerized remote facilities. Thus, we do not find the evidence supports the Examiner’s rejection of claim 66 and we reverse the Examiner’s rejection of claim 66 as being unpatentable over Filepp.

description before us, we leave it to the Examiner to make findings as to whether claim 35 is in compliance with 35 U.S.C. §112 first paragraph.

² We note that Appellant’s Specification, on page 11, provides limited support for this limitation as it only discusses the computerized central facility as receiving bids placed by customers where the actual auction is occurring at an auction house. Appellant’s Specification does not teach that the computerized central facility actually provides or performs an auction, i.e., Appellant’s Specification supports

Rejection of claims 12 through 18, 20 through 22, 34 through 39, 41, 47 through 50, 52 through 65, 70 and 81 as unpatentable over Filepp in view of Viescas (Official Guide to the Prodigy Service).

On pages 29 and 30 of the Brief Appellant argues that the Examiner's rejection of claim 12 through 18, 20 through 22, 34 through 39, 41, 47 through 50, 52 through 59, 70 and 81 as unpatentable over Filepp in view of Viescas is in error. Appellant's arguments group the claims into six groups. Therefore, we will address the rejection as to the following groups of claims:

Group A, Claims 12-15, 20, 22, 34 through 37, 41, 47 through 50, 52 through 56, 58, 59, 61, 63, 64, 70, and 81 and we select claim 12 as representative of this group;

Group B, claim 16;

Group C, claims 17, 38 and 57, we select claim 17 as representative of this group;

Group D, claims 18 and 39 we select claim 18 as representative of this group;

Group E, claims 21, 62, and 65, we select claim 21 as representative of this group; and

Group F, claim 60.

using the system to receive bids in a physical auction not operating a virtual auction.

Claim 12 (Group A).

Appellant argues that the Examiner's rejection of claim 12 is error for the reasons discussed above and that none of the other reference cited by the Examiner prove otherwise. (Br. 29).

As discussed *supra* we find ample evidence exists to support the Examiner's rejection of claim 12 based upon Filepp alone. Thus, for the reasons stated *supra* with respect to the Examiner's rejection of claim 12 based upon Filepp, we affirm the Examiner's rejection of claim 12, and the other claims of group A (claims 13 through 15, 20, 22, 34 through 37, 41, 47 through 50, 52 through 56, 58, 59, 61, 63, 64, 70, and 81) based upon Filepp in view of Viescas.

Claim 16 (Group B).

Appellant argues that the Examiner's rejection of claim 16 based upon Filepp and Viescas is in error as there is no citation identifying where the references teach the limitation that the central facility "provides a directory of providers of said goods and/or services." (Br. 16).

The Examiner does not address this argument in Answer.

We concur with the Appellant. Claim 16 is dependent upon claim 12 and further recites that "the computerized central communications facility provides a directory of providers." The Examiner has not identified where this limitation is taught by either Filepp or Viescas, nor do we find that either reference teaches such

a limitation.³ Accordingly, we reverse the Examiner's rejection of claim 16 as unpatentable over Filepp and Viescas.

Claim 17 (Group C).

Appellant argues that the Examiner's rejection of claim 17 is in error as the references do not teach use of "an audio or a video presentation." Appellant states:

Displaying or presenting data alone to the user as at column 18, line 40 of Filepp is not the same as giving them an audio or a video presentation. Producing a beep such as described at column 65, line 50 and detailed at column 91, line 12 of Filepp on a remote user's computer is not the equivalent.

(Br. 29).

The Examiner responds to Appellant's argument stating that Filepp suggests that audio presentations are provided by the central provider, citing column 90, line 66. (Answer 8.)

We concur with the Examiner's finding. Claim 17 is dependent upon claim 12 and further recites that "the information relating to said goods and/or services is an audio or a video presentation." We consider this limitation to be functionally related to the system as it is directed to the format of the information and not the content. We agree with the Appellant in that producing a sound such as a "beep" is different than an audio presentation. However, we find that Filepp teaches both sound, as pointed out in Appellant's arguments, and audio as identified by the Examiner. We find that Filepp teaches that the display manager may use protocols for the presentation of media such as audio. See column 90, lines 60-67 and

³ Note, the Examiner also has rejected claim 16 relying upon Filepp in view of *AT&T Provides Compass*. As discussed *infra* the AT&T reference does provide

column 18, lines 44-48. Thus, Appellant's arguments have not persuaded us of error in the Examiner's rejection of claim 17 as we find ample evidence to support the Examiner's finding that Filepp teaches providing audio presentations. Accordingly, we sustain the Examiner's rejection of claim 17 and the other claims of group C (claims 38 and 57).

Claim 18 (Group D)

Appellant argues that the Examiner's rejection of claim 18 as being unpatentable over Filepp and Viescas is in error as the references do not teach or suggest "record a search stopping point for future reference" as recited in claim 18. (Br. 29).

The Examiner identifies on page 6 of the Answer that this limitation was known to the skilled artisan.

We disagree with the Examiner's finding. Claim 18 recites "wherein said computerized central communications facility is adapted to record a search stopping point for future reference." Claim 39 recites a similar limitation. We do not find that the Examiner has provided sufficient evidence to support a finding that such a feature was known in the art at the time of filing of the application. With regard to the Examiner's statement, on page 9 of the Answer, that noticed facts become admitted facts if not seasonably challenged, we note that the Appellant's statements on page 29 of the Brief are a seasonable challenge. Accordingly, we reverse the Examiner's rejection of claims 18 and the other claim in group D (claim 39).

evidence of a service provider providing a directory.

Claim 21 (Group E).

Appellant argues that the Examiner's rejection of claim 21 is in error as the combination of the references does not teach an auction as recited in claim 21. (Br. 30).

The Examiner applies a dictionary definition of auction and finds that Filepp teaches an auction which meets the definition of an auction. (Answer 9).

Appellant's arguments have not convinced us of error in the Examiner's rejection. While, as discussed above with respect to claim 66, we do not find that Filepp teaches an auction where bids are placed by customers, we note as discussed above Filepp does teach auctions in the context of freight services where sellers place bids. Further, claim 21 is of different scope than claim 66. Claim 21 is dependent upon claim 12. Claim 12 recites the limitation "a computerized central communications facility of a first provider providing information relating to goods and/or services to a customer at a computerized remote facility." Claim 21 further recites "wherein said goods and/or services include auctioning services." Thus, claim 21 further defines the information provided by the computerized remote facility. The claim recites no limitation describing an apparatus or steps which perform auctioning services. As discussed *supra* "[w]here the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability." *Ngai*, 367 F.3d at 1339, 70 USPQ2d at 1864. Thus, we find that the limitation of claim 21 is directed to non functional descriptive material which will not distinguish the claim from the system of Filepp. Further, we find that Filepp teaches providing auction services. As Appellant has not convinced us of error in the Examiner's rejection and we affirm the Examiner's rejection of claim 21 and the remaining claims of group E (claims 62 and 65).

Claim 60 (Group F).

Appellant argues that the Examiner's rejection of claim 60 is in error as the references do not teach the claim 60 limitation "each customer's profile based on the customer's search." (Br. 30).

The Examiner does not address this argument in Answer.

We concur with the Appellant. Claim 60 is a dependent claim and further recites "wherein the apparatus compiles each customer's profile based on the customer's search." The Examiner has not cited where this limitation is taught by either Filepp or Viescas, nor do we find that either reference teaches such a limitation. Accordingly, we reverse the Examiner's rejection of claim 60 as unpatentable over Filepp and Viescas.

*Rejection of claims 16, 50 and 56 as unpatentable over
Filepp in view of AT&T Provides Compass*

Appellant argues that the Examiner's rejection of claims 16, 50, and 56 as unpatentable over Filepp and the article *AT&T Provides Compass* is in error. (Br. 30-31). Appellant reasons that Filepp teaches away from the invention as the reference does not teach the "select and contact" limitation discussed above with respect to the rejection of claim 12 as unpatentable over Filepp. Appellant also asserts that AT&T teaches away from being used with Filepp's system as Filepp teaches using one provider of information whereas AT&T teaches using multiple providers. Further, Appellant reasons that the rejection is in error as AT&T is not "an apparatus to market and sell goods." (Br. 31).

Appellant's arguments have not persuaded us of error in the Examiner's rejection. Claim 16 is dependent upon claim 12 and further recites that "the computerized central communications facility provides a directory of providers."

As discussed *supra*, we are not persuaded of error in the Examiner's rejection by Appellant's arguments regarding the "select and contact" limitation of claim 12. Further, as discussed *supra* with respect to claim 12, we find that Filepp teaches that there are multiple service providers. Thus, Appellant's arguments have not persuaded us that AT&T teaches away from the combination. Further, as discussed by the Examiner, Filepp teaches using the computerized central facility to market goods or services, thus it is immaterial whether AT&T teaches this limitation. Accordingly, we affirm the Examiner's rejection of claim 16, 50 and 56 as we are not persuaded by Appellant's arguments that the rejection is in error.

*Rejection of claims 67 and 78 as unpatentable over Filepp in view of
Prodigy Services Add Offerings*

Appellant argues that the Examiner's rejection of claims 67 and 78 as unpatentable over Filepp and the article *Prodigy Services Add Offerings* is in error. (Br. 31). Appellant reasons that Filepp teaches away from the invention as the reference does not teach the "select and contact" limitation discussed above with respect to the rejection of claim 12 as unpatentable over Filepp. Appellant also asserts that "the Prodigy reference only supports a customer picking 50 dates for Prodigy to send electronic reminders." Appellant thus concludes that Prodigy is only responding to a customer request and not initiating contact as recited in the claims.

Appellant's arguments have not persuaded us of error in the Examiner's rejection. Initially, we note, as discussed *supra*, we are not persuaded of error in the Examiner's rejection by Appellant's arguments regarding the "select and contact" limitation of claim 12. Claim 67 is dependent upon claim 12 and further recites that "said computerized central communications facilities is configured to

contact said customer.” Claim 67 is not limited as to who or how the facility is configured to contact the customer. Appellant admits that Prodigy contacts the customer in response to the customer’s selection of a reminder date. Thus, Prodigy teaches that the customer configures the central facility to provide reminders on dates. On those dates, the central facility initiates contact with the customer. Accordingly, we affirm the Examiner’s rejection of claims 67 and 78 as we are not persuaded by Appellant’s arguments that the rejection is in error.

*Rejection of claims 68 and 79 as unpatentable over Filepp in view of
Williams (Verity Announces TOPIC Real-Time and
Strategic Alliance with Dow Jones & Co.)*

Appellant argues that the Examiner’s rejection of claims 68 and 79 as unpatentable over Filepp and Williams is in error. (Br. 32). Appellant reasons that Filepp teaches away from the invention as the reference does not teach the “select and contact” limitation discussed above with respect to the rejection of claim 12 as unpatentable over Filepp. Appellant also asserts that Williams is incompatible with Filepp as Williams involves systems where documents arrive from multiple information sources while Filepp is argued to teach away from multiple information sources.

Appellant’s arguments have not persuaded us of error in the Examiner’s rejection of claims 68 and 79. Initially, we note, as discussed *supra*, we are not persuaded of error in the Examiner’s rejection by Appellant’s arguments regarding the “select and contact” limitation of claim 12. Further, as discussed *supra* with respect to claim 12, we find that Filepp teaches that there are multiple service providers. Thus, Appellant’s arguments have not persuaded us that Williams teaches away from the combination. Accordingly, we affirm the Examiner’s

rejection of claims 68 and 79 as we are not persuaded by Appellant's arguments that the rejection is in error.

Rejection of claims 69 and 80 as unpatentable over Filepp in view of Oldenburg (Making the Right Connection).

Appellant argues that the Examiner's rejection of claims 69 and 80 as unpatentable over Filepp and Williams is in error. (Br. 32-33). Appellant reasons that Filepp teaches away from the invention as the reference does not teach the "select and contact" limitation discussed above with respect to the rejection of claim 12 as unpatentable over Filepp. Appellant also asserts that Oldenburg does not teach providing employee recruiting information as claimed, but rather a system which permits job seekers to register to be included in an online database.

Appellant's arguments have not persuaded us of error in the Examiner's rejection of claims 69 and 80. Initially, we note, as discussed *supra*, we are not persuaded of error in the Examiner's rejection by Appellant's arguments regarding the "select and contact" limitation of claim 12. Claim 69 is dependent upon claim 12 and further recites that "at least one of said computerized central communications facilities is configured to provide employee recruiting information." We consider the limitation "employee recruiting" to be merely descriptive of the information provided, and as such drawn to non functional descriptive material. As discussed *supra* "[w]here the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability." *Ngai*, 367 F.3d at 1339, 70 USPQ2d at 1864. Thus, the limitation will not differentiate the claimed invention from the prior art. Further, we note that Appellant's Specification, on page 34,

discusses the invention as being beneficial to an employment agency, but does not define what is meant by “employee recruiting information.” Thus, we construe the term broadly and find that Olson’s teaching that potential employees can register and provide information about their job search, discussed on page 2 of the article, to meet the claimed “employee recruiting information.” Accordingly, we affirm the Examiner’s rejection of claims 69 and 80 as we are not persuaded by Appellant’s arguments that the rejection is in error.

Rejection of claims 71 and 82 as unpatentable over Filepp in view of Bruce (Home-Based Banking Slowly Catching).

Appellant argues that the Examiner’s rejection of claims 71 and 82 as unpatentable over Filepp and Bruce is in error. (Br. 33-34). Appellant reasons that Filepp teaches away from the invention as the reference does not teach the “select and contact” limitation discussed above with respect to the rejection of claim 12 as unpatentable over Filepp. Appellant also asserts that Bruce does not teach that a service provider provides “information about the sale or financing of housing” as claimed.

Appellant’s arguments have not persuaded us of error in the Examiner’s rejection of claims 71 and 82. Initially, we note, as discussed *supra*, we are not persuaded of error in the Examiner’s rejection by Appellant’s arguments regarding the “select and contact” limitation of claim 12. Claim 71 is dependent upon claim 12 and further recites that “at least one of said computerized central communications facilities is configured to provide information about the sale or financing of housing.” We consider the limitation “about the sale or financing of housing” to be merely descriptive of the information provided, and as such drawn to non functional descriptive material. Further, even if such a limitation were to be

functional, as admitted by Appellant “Home-Based Banking [PC based banking at home] does speak of banks as ‘on the verge of being able to ... deal in real estate.’” (Br. 33). Thus, we find by Appellant’s admission, Bruce suggests providing banking (financial services) about real estate (which includes housing). Accordingly, we affirm the Examiner’s rejection of claims 71 and 82 as we are not persuaded by Appellant’s arguments that the rejection is in error.

*Rejection of claims 72, 73, 83, and 84 as unpatentable over Filepp in view of
New Competitor for Prodigy*

Appellant argues that the Examiner’s rejection of claims 72, 73, 83, and 84 as unpatentable over Filepp and the article *New Competitor for Prodigy* is in error. (Br. 34). Appellant reasons that Filepp teaches away from the invention as the reference does not teach the “select and contact” limitation discussed above with respect to the rejection of claim 12 as unpatentable over Filepp. Appellant also asserts that “in the reference it is the Online Service Company (Power Vision) that provides coupons or discounts, not a particular central facility as is claimed” and that if combined, the combination would only teach one information source. (Br. 34).

Appellant’s arguments have not persuaded us of error in the Examiner’s rejection of claims 72, 73, 83, and 84. Initially, we note, as discussed *supra*, we are not persuaded of error in the Examiner’s rejection by Appellant’s arguments regarding the “select and contact” limitation of claim 12. Also, as discussed *supra* with respect to claim 12, we find that Filepp teaches that there are multiple service providers. Claim 72 is dependent upon claim 12 and further recites that “at least one of said central communications facilities is configured to provide a coupon relating to said goods or services to said customer.” As admitted by Appellant, the

article *New Competitor for Prodigy* teaches that an online service provider provides coupons to customers. We find no claimed distinction between a central communication facility and an online service provider. Thus, Appellant's arguments have not persuaded us of error in the Examiner's rejection and we affirm the Examiner's rejection of claims 72, 73, 83, and 84.

Rejection of claims 74 and 85 as unpatentable over Filepp in view of Pollick (Online Services get on Track more Firms Offering Computer Networks).

Appellant argues that the Examiner's rejection of claims 74 and 85 as unpatentable over Filepp and Pollick is in error. (Br. 34-35). Appellant reasons that Filepp teaches away from the invention as the reference does not teach the "select and contact" limitation discussed above with respect to the rejection of claim 12 as unpatentable over Filepp. Appellant also asserts that "[a]ccording to the references users were charged to access the system by the online service company, not by a particular central facility to access their information." (Br. 34-35).

Appellant's arguments have not persuaded us of error in the Examiner's rejection of claims 74 and 85. Initially, we note, as discussed *supra*, we are not persuaded of error in the Examiner's rejection by Appellant's arguments regarding the "select and contact" limitation of claim 12. Claim 74 is dependent upon claim 12 and further recites that "at least one of said central communications facilities is configured to charge said customer a fee to obtain access to said information." As admitted by Appellant, the references teach online service companies charge users fees to access the system. Further, in these systems the user must access the system to access the information; as such a fee to access the system is a fee to

access the information. We find no claimed distinction between a central communication facility and an online service provider. Thus, Appellant's arguments have not persuaded us of error in the Examiner's rejection and we affirm the Examiner's rejection of claims 74 and 85.

Rejection of claims 75, 76, 86, and 87 as unpatentable over Filepp in view of Filppu (Software Publishing Corp. Unveils New Support Warranty Policy).

Appellant argues that the Examiner's rejection of claims 75, 76, 86, and 87 as unpatentable over Filepp and Filppu is in error. (Br. 35). Appellant reasons that Filepp teaches away from the invention as the reference does not teach the "select and contact" limitation discussed above with respect to the rejection of claim 12 as unpatentable over Filepp. Appellant also asserts that Filppu merely describes a software vendor charging customers a fee to provide assistance via telephone and does not teach obtaining live support over a central communication facility.

Appellant's arguments have not persuaded us of error in the Examiner's rejection of claims 75, 76, 86 and 87. Initially, we note, as discussed *supra*, we are not persuaded of error in the Examiner's rejection by Appellant's arguments regarding the "select and contact" limitation of claim 12. Claim 75 is dependent upon claim 12 and further recites that "at least one of said central communications facilities is configured to charge said customer a fee to obtain live assistance from said computerized central communications facility." On page 12 of the Answer, the Examiner finds that Filppu teaches that an emerging trend in customer support is to charge customers a fee, or greater fee for live assistance from a provider of goods or services. Appellant's arguments do not contest this, but rather assert that

the teaching is only applicable to software and not an apparatus for marketing goods or services using a computerized central facility. We disagree.

The Supreme Court has recently stated:

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. . . . [A] court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions.

KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. 1727, 1740, 82 USPQ2d 1385, 1396 (2007). “One of the ways in which a patent’s subject matter can be proved obvious is by noting that there existed at the time of the invention a known problem for which there was an obvious solution encompassed by the patent’s claims.” *Id.* at 1742, 82 USPQ2d at 1397. Filppu discusses that for software providers, having live support for a customer is expensive and that this expense should be paid by the customers using the support. One skilled in the art would recognize that similar to a software provider, providing live assistance for a centralized communications facility is also expensive and that similarly customers should be charged for it. Thus, we find that Filppu shows that at the time of the invention there was a known problem, i.e., cost of live customer support, and a solution, i.e., charging the customers for the support. Further, we consider that implementing a charge for live support is a predictable variation of Filepp’s system. Thus, Appellant’s arguments have not persuaded us of error in the Examiner’s rejection and we affirm the Examiner’s rejection of claims 75, 76, 86 and 87.

*Rejection of claim 77 and 88 as unpatentable over Filepp in view of Cheseby
(What the Analysts Say).*

Appellant argues that the Examiner's rejection of claims 77 and 88 as unpatentable over Filepp and Cheseby is in error. (Br. 35-36). Appellant reasons that Filepp teaches away from the invention as the reference does not teach the "select and contact" limitation discussed above with respect to the rejection of claim 12 as unpatentable over Filepp. Appellant also asserts that Cheseby "only provides that a new Online Service Company is to be formed with the assistance of another, not that a provider on such a system will be charged to provide information on it." (Br. 36).

In response, the Examiner states, on pages 12 and 13 of the Answer, that Cheseby teaches "that provider America Online and Apple Computer entered into an agreement whereby Apple uses the provider's technology and develop an Apple-based on-line service in exchange for royalty fees."

We disagree with the Examiner's rationale. While we agree with the Examiner's findings regarding Cheseby, we do not find that Apple is a service provider that provides information to the customer. Claim 77 is dependent upon claim 12 and further recites: "at least one of said first provider or said second provider is charged a fee to provide said information relating to goods and/or services to said customer." Claim 88 recites similar limitations. Thus, the scope of the claims is that one of two service providers is charged a fee to provide information to the customer. In Cheseby, Apple is providing a good to a customer (a computer) and paying a fee to provide access to an information provider America Online, Apple is not a service provider paying a fee to provide information. Thus, Appellant's arguments have persuaded us that the Examiner's

rejection of claims 77 and 88 as unpatentable over Filepp and Cheseby is in error. Accordingly, we reverse the Examiner's rejection of claims 77 and 88.

CONCLUSION

Appellant's contentions have not convinced us of error in the Examiner's rejections of claims 12 through 17, 20 through 22, 34, 36 through 39, 41, 47 through 50, and 52 through 59, 61 through 65 67 through 76, 78 through 87 under 35 U.S.C. § 103(a) and we affirm these rejections. However, Appellant has convinced us of error in the Examiner's rejections of claim 66 under 35 U.S.C. § 102(b) and claims 18, 35, 60, 66, 77 and 88 under 35 U.S.C. § 103(a), accordingly we reverse these rejections.

ORDER

The decision of the Examiner is affirmed-in-part.

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) (2006).

AFFIRMED-IN-PART

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