UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DENIS CHALON

Appeal 2009-005318
Application 10/165,865
Technology Center 3600

Decided: *


FETTING, Administrative Patent Judge.

DECISION ON APPEAL
STATEMENT OF THE CASE

Denis Chalon (Appellant) seeks review under 35 U.S.C. § 134 (2002) of a non-final rejection of claims 1 and 3-9, the only claims pending in the application on appeal.

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

SUMMARY OF DECISION

We AFFIRM.

THE INVENTION

The Appellant invented a method of maintaining a user profile and a module operable to maintain a user profile in accordance with an information request (Specification 1:5-8).

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

1. A method of maintaining a user profile, comprising:
   a) searching user requested information for a profile tag;

1 Our decision will make reference to the Appellant’s Appeal Brief (“App. Br.,” filed April 1, 2008) and the Examiner’s Answer (“Ans.,” mailed June 19, 2008), and Non-Final Rejection (“Non-Final Rej.,” mailed November 1, 2007).
b) reading the user profile in accordance with the profile tag to
determine the presence of user preference information;
c) determining that user preference information is not present in
the user profile;
d) generating a profile enquiry for the user in accordance with
profile enquiry information provided in the profile tag;
e) receiving a response from the user to the profile enquiry; and
updating the user profile in accordance with the user response.

THE REJECTIONS

The Examiner relies upon the following prior art:


Claims 1 and 3-7 are rejected under 35 U.S.C. § 101 for failing to claim
statutory subject matter.

Claims 1 and 3-9 are rejected under 35 U.S.C. § 112, second paragraph,
as being indefinite for failing to particularly point out and distinctly claim
the subject matter which applicant regards as the invention.

Claims 1 and 3-9 are rejected under 35 U.S.C. § 102(e) as anticipated by
Dragulev or under 35 U.S.C. § 103(a) as unpatentable over Dragulev.
ISSUES

The issues pertinent to this appeal are

- Whether the Appellant has sustained the burden of showing that the Examiner erred in rejecting claims 1, 4, 6, 7, and 9-12 stand rejected under 35 U.S.C. § 101 for failing to claim patentable subject matter.
  
  o This pertinent issue turns on whether the Appellant has waived his arguments towards this rejection.

- Whether the Appellant has sustained the burden of showing that the Examiner erred in rejecting claims 1 and 3-9 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
  
  o This pertinent issue turns on whether the term “the user profile” lacks an antecedent basis.

- Whether the Appellant has sustained the burden of showing that the Examiner erred in rejecting claims 1 and 3-9 under 35 U.S.C. § 102(e) as anticipated by Dragulev or 35 U.S.C. § 103(a) as unpatentable over Dragulev.
  
  o This pertinent issue turns on whether Dragulev fails to describe or suggest the feature of generating a profile enquiry for the user in accordance with profile enquiry information provided in the profile tag.
FACTS PERTINENT TO THE ISSUES

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

Facts Related to the Prior Art

Dragulev

01. Dragulev is directed to a computer system and method for managing user-specific data over multiple devices (Dragulev ¶ 0002).

02. A user supplies a user identifier (user ID) and a password to a profile server (Dragulev ¶ 0094). After validating the user ID and password, the profile server transmits user profile data associated with the unique identifier to the profile client residing on the user’s machine (Dragulev ¶ 0094). When a user then requests a web page, the client profile intercepts the request and determines whether user profile data is associated with the requested web page (Dragulev ¶ 0095). If client profile information exists, the client filter posts this information to the requested web page (Dragulev ¶ 0095).

03. The profile data can include user bookmarks, personal address books, user preference data, or user specific data, which may be updated or modified by the user (Dragulev ¶ 0104).

Facts Related To The Level Of Skill In The Art

04. Neither the Examiner nor the Appellant has addressed the level of ordinary skill in the pertinent arts customer relationship
management and contact information management. We will therefore consider the cited prior art as representative of the level of ordinary skill in the art. See Okajima v. Bourdeau, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (“[T]he absence of specific findings on the level of skill in the art does not give rise to reversible error ‘where the prior art itself reflects an appropriate level and a need for testimony is not shown’”) (quoting Litton Indus. Prods., Inc. v. Solid State Sys. Corp., 755 F.2d 158, 163 (Fed. Cir. 1985).

Facts Related To Secondary Considerations

05. There is no evidence on record of secondary considerations of non-obviousness for our consideration.

PRINCIPLES OF LAW

101 - Bilski

The law in the area of patent-eligible subject matter for process claims has recently been clarified by the Federal Circuit, In re Bilski, 545 F.3d 943 (Fed. Cir. 2008) (en banc), petition for cert. filed, 77 USLW 3442 (U.S. Jan. 28, 2009) (No. 08-964).

The en banc court in Bilski held that “the machine-or-transformation test, properly applied, is the governing test for determining patent eligibility of a process under § 101.” Id. at 956. The court in Bilski further held that “the ‘useful, concrete and tangible result’ inquiry is inadequate [to determine whether a claim is patent-eligible under § 101.]” Id. at 959-60.
Indefiniteness

The test for definiteness under 35 U.S.C. § 112, second paragraph, is whether “those skilled in the art would understand what is claimed when the claim is read in light of the specification.” Orthokinetics, Inc. v. Safety Travel Chairs, Inc., 806 F.2d 1565, 1576 (Fed. Cir. 1986)(citations omitted).

Anticipation

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631 (Fed. Cir. 1987). "When a claim covers several structures or compositions, either generically or as alternatives, the claim is deemed anticipated if any of the structures or compositions within the scope of the claim is known in the prior art." Brown v. 3M, 265 F.3d 1349, 1351 (Fed. Cir. 2001). "The identical invention must be shown in as complete detail as is contained in the ... claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. In re Bond, 910 F.2d 831, 832 (Fed. Cir. 1990).

Obviousness

A claimed invention is unpatentable if the differences between it and the prior art are “such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art.” KSR Int’l Co. v. Teleflex Inc., 550 U.S. 398, 406 (2007); Graham v. John Deere Co., 383 U.S. 1, 13-14 (1966).
In *Graham*, the Court held that the obviousness analysis is bottomed on several basic factual inquiries: “[(1)] the scope and content of the prior art are to be determined; [(2)] differences between the prior art and the claims at issue are to be ascertained; and [(3)] the level of ordinary skill in the pertinent art resolved.” *Graham*, 383 U.S. at 17. See also *KSR*, 550 U.S. at 406. “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id*. at 416.

**ANALYSIS**

*Claims 1 and 3-7 rejected under 35 U.S.C. § 101 for failing to claim patentable subject matter*

This rejection was raised for the first time in the Answer. The Appellant has not argued this rejection in a Reply Brief. We take this as an indication that the Appellant has waived arguments as to this rejection and as such we summarily sustain the Examiner in rejecting claims 1 and 3-7 under 35 U.S.C. § 101 for failing to claim patentable subject matter.

*Claims 1 and 3-9 rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention*

The Examiner found that there is insufficient antecedent basis for the limitation “the user profile in accordance with the profile tag” as recited in limitation (b) of claim 1 (Ans. 3). The Examiner found that a recitation of “a user profile” is found in the preamble but is broad (Ans. 3). The Examiner
further suggests a step of associating a user profile with the profile tag (Ans. 3) to remedy this allegedly insufficient antecedent basis (Ans. 3).

The Appellant contends that the recitation of “a user profile” in the preamble serves as a proper antecedent basis for its recitation in limitation (b) and the Examiner’s finding that this recitation in the preamble is broad is irrelevant (App. Br. 3).

We agree with the Appellant. The recitation of “a user profile” in the preamble is sufficient to provide an antecedent basis for the recitation of “the user profile” in limitation (b). The recitation of “a user profile” in the preamble renders the subsequent recitation of “the user profile” clear and definite. As such, the Appellant has sustained the burden of showing that the Examiner erred in rejecting claims 1 and 3-9 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 3-9 rejected under 35 U.S.C. § 102(e) as anticipated by Dragulev or under 35 U.S.C. § 103(a) as unpatentable over Dragulev

The Appellant contends that Dragulev fails to describe or suggest the feature of generating a profile enquiry for the user in accordance with profile enquiry information provided in the profile tag, as required by limitation (d) of claim 1 (App. Br. 4-5). The Appellant particularly argues that a user is specifically asked for preference information when the preference information is missing (App. Br. 4). The Appellant also contends that there is nothing in Dragulev that directly interacts with a user to obtain information (App. Br. 4-5).
We disagree with the Appellant. Limitation (d) requires prompting the user for information to be stored in the user’s profile data. Limitation (d) does not require that the information that a user is prompted for is missing preference information. Limitation (d) is completely silent on preference information. As such, the Appellant’s argument that Dragulev fails to specifically ask a user for missing preference information is not found persuasive.

Dragulev describes that a user inputs identifying information in order to retrieve profile information (FF 02). That is, a user is prompted to submit a user ID and password information and the system uses this information to identify other profile data associated to the submitted user ID. This prompting is directly interacting with a user. As such, Dragulev describes limitation (d).

Furthermore, Dragulev describes that the profile data includes information that a user can update or modify (FF 03). This suggests that a user is queried for profile information to be added to the user profile or updated in the user profile. The information submitted by the user will be associated with the user ID provided by the user. That is, a user is prompted to enter or update his profile information and enabling a user to enter or update profile information is directly interacting with a user. As such, Dragulev also suggests limitation (d).

The Appellant has not sustained the burden of showing that the Examiner erred in rejecting claims 1 and 3-9 under 35 U.S.C. § 102(e) as anticipated by Dragulev or 35 U.S.C. § 103(a) as unpatentable over Dragulev.
CONCLUSIONS OF LAW

The Appellant has not sustained the burden of showing that the Examiner erred in rejecting claims 1 and 3-7 under 35 U.S.C. § 101 as failing to claim patentable subject matter.

The Appellant has sustained the burden of showing that the Examiner erred in rejecting claims 1 and 3-9 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Appellant has not sustained the burden of showing that the Examiner erred in rejecting claims 1 and 3-9 under 35 U.S.C. § 102(e) as anticipated by Dragulev or 35 U.S.C. § 103(a) as unpatentable over Dragulev.

DECISION

To summarize, our decision is as follows.

- The rejection of claims 1 and 3-7 under 35 U.S.C. § 101 as failing to claim patentable subject matter is sustained.

- The rejection of claims 1 and 3-9 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is not sustained.
The rejection of claims 1 and 3-9 under 35 U.S.C. 102(e) as anticipated by Dragulev or under 35 U.S.C. § 103(a) as unpatentable over Dragulev is sustained.

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)(2007).

AFFIRMED