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JERRY.SHORMA@HP.COM  
ipa.mail@hp.com  
brandon.serwan@hp.com

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* DALE S. HOWARD, L. JOY GRIEBENOW, and KIM LENGER

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Appeal 2010-008243  
Application 10/941,303  
Technology Center 3600

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Before HUBERT C. LORIN, JOSEPH A. FISCHETTI, and  
BIBHU R. MOHANTY, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Dale S. Howard, et al. (Appellants) seek our review under 35 U.S.C. § 134 of the final rejection of claims 1-7 and 9-25. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

## SUMMARY OF DECISION

We AFFIRM-IN-PART.<sup>1</sup>

### THE INVENTION

Claim 1, reproduced below, is illustrative of the subject matter on appeal.

1. A method for customizing advertising in an electronic publication, comprising:

storing a consumer profile in a database, the consumer profile associated with a consumer and comprising a plurality of profile data items;

creating a database of content items and advertising items, at least some advertising items comprising targeted advertising items, each targeted advertising item associated with an inclusion criterion, wherein a decision as to whether the inclusion criterion for a particular advertisement has been met depends upon the value of one or more profile data items;

creating an electronic publication for a particular consumer, the electronic publication comprising at least some of the content items and at least one targeted advertising item where the inclusion criterion for that targeted advertising item has been met;

linking a specific one of the targeted advertising items included in the electronic publication to a specific one of the content items also included in the electronic publication; and

while displaying the electronic publication to the consumer and in response to the access of the specific one of the content items by

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<sup>1</sup> Our decision will make reference to the Appellants' Appeal Brief ("App. Br.," filed Dec. 7, 2009) and Reply Brief ("Reply Br.," filed May 4, 2010), and the Examiner's Answer ("Answer," mailed Mar. 4, 2010).

the particular consumer, displaying the linked specific one of the targeted advertising items to the particular consumer.

### THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Dedrick	US 5,724,521	Mar. 3, 1998
Reilly et al.	US 5,740,549	Apr. 14, 1998
Trader et al.	US 5,832,432	Nov. 3, 1998
Stefik et al.	US 6,236,971 B1	May 22, 2001

The following rejections before us for review:

1. Claims 1-7, 9-17, and 20-23 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Dedrick and Reilly.
2. Claim 18 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Dedrick, Reilly, and Trader.
3. Claim 19 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Dedrick, Reilly, and Stefik.
4. Claims 24 and 25 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Dedrick and Stefik.

### ISSUES

Has the Examiner made out a prima facie case of obviousness for the claimed subject matter over the combined disclosures of the cited prior art?

## ANALYSIS

*The rejection of claims 1-7, 9-17, and 20-23 under 35 U.S.C. § 103(a) as being unpatentable over Dedrick and Reilly.*

### *Claims 1-7 and 9-11*

We will focus on independent claim 1. The Examiner's position is that Dedrick discloses all the claim limitations but for

linking a specific one of the targeted advertising items included in the electronic publication to a specific one of the content items also included in the electronic publication; and

while displaying the electronic publication to the consumer and in response to the access of the specific one of the content items by the particular consumer, displaying the linked specific one of the targeted advertising items to the particular consumer.

(Claim 1. Answer 4.) Reilly is relied upon as evidence that this subject matter was known in the art at the time of the invention. (*Id.*) According to the Examiner, "it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Dedrick would display target ads to users when said users access specific items in an electronic publication, as it is old and well known to do so, as taught by Reilly." (*Id.*)

Appellants disagree that Reilly discloses the limitations at issue, arguing that "[s]imply put, Reilly teaches the advertisements displayed to the user correspond to the information category of the content viewed by the user and not to the particular content item." (App. Br. 10.)

Contrary to the assertion in the final Office Action that Reilly "teaches that it is old and well known in the promotion art to link advertisements to specific content items (e.g., news

items),” Reilly only teaches that forming a first link between an advertising item and a type of content and a second link between a news item and a content item. Thus, Reilly does not teach or make obvious the claimed featured of “linking a specific one of the targeted advertising items included in the electronic publication to a specific one of the content items also included in the electronic publication”.

(App. Br. 10-11.)

We agree with the Appellants’ view of the scope and content of Reilly. The Examiner draws our attention to Fig. 8 and the passages at col. 13, l. 60 to col. 14, l. 10 and argues that this discloses “linking a specific advertising item (i.e. A001) to a particular content item (i.e. N001) and displaying said specific advertising item (i.e. A001) when accessing said particular content item (i.e. N001).” (Answer 16-17.) We see it differently. Figure 8 shows ads and stories in each category (“News,” Weather,” etc.) linked to particular files (identified as A001, A002, etc. and N001, N002, etc., respectively). Col. 13, l. 60 to col. 14, l. 10 explains that the

advertisement image shown is selected on the basis of the information category associated with the news item being viewed ... if subscriber user clicks on the displayed advertisement, the subscriber's computer is automatically connected to the an associated World Wide Web page on the Internet that provides additional information from the advertiser.

By contrast, the method of claim 1 appears to employ a type of linking commonly known as “bookmarking”; to wit, “linking a specific one of the targeted advertising items *included in the electronic publication* to a specific one of the content items *also included in the electronic publication*”

(emphasis added) so that the linked specific one of the targeted advertising items is displayed to the particular consumer in response to the access of the specific one of the content items by the particular consumer while displaying the electronic publication to the consumer. Clicking on a displayed advertisement and being automatically connected to the an associated World Wide Web page on the Internet that provides additional information from the advertiser as Reilly discloses does not describe the technique as claimed.

Since Reilly does not disclose the claim limitations at issue as the Examiner alleges and a case has not been made that Reilly nonetheless would lead one of ordinary skill in the art to the technique as claimed, a prima facie case of obviousness has not been made out in the first instance for the subject matter of claims 1-7 and 9-11.

*Claims 12-15*

For the same reason, we will not sustain the rejection of independent claim 12 and claims 13-15 that depend from it. Here, too, the claims call for employing a type of linking commonly known as “bookmarking”; to wit,

linking the at least one targeted advertising item in the electronic publication to a specific one of the plurality of content items in the electronic publication;

delivering the electronic publication to a consumer by electronically sending the electronic publication to the consumer's electronic mail address; and

in response to an access by the consumer of the specific one of the plurality of content items included in the electronic publication, displaying the linked targeted advertising item to the consumer.

Claim 12.

Since Reilly does not disclose the claim limitations at issue as the Examiner alleges and a case has not been made that Reilly nonetheless would lead one of ordinary skill in the art to the technique as claimed, a prima facie case of obviousness has not been made out in the first instance for the subject matter of claims 12-15.

*Claims 16, 17, and 20-23*

We will sustain the rejection of independent claim 16 and claims 17 and 20-23 dependent thereon.

These claims are drawn to a system in terms of an apparatus. The apparatus as claimed comprises three elements: “a computer network;” “a publisher computer connected to the computer network;” and, “a consumer computer coupled to the computer network.” The publisher and consumer computers are further defined functionally (“operable to ...”). There can be no dispute that these elements per se are known. See e.g., Figure 1 of Dedrick. Appellants do not specifically challenge the rejection of these claims but rather rely on the arguments directed to the process claims. Since “apparatus claims cover what a device *is*, not what a device *does*,” *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1468 (Fed. Cir. 1990) (emphasis in original), the arguments directed to the process claims are not persuasive as to error in the rejection of apparatus claims 16, 17, and 20-23.

*The rejection of claim 18 under 35 U.S.C. § 103(a) as being unpatentable over Dedrick, Reilly, and Trader.*

The rejection of claim 18 (which depends from claim 16) will be sustained for the same reasons we gave above in sustaining the rejection of claim 16. The arguments presented in challenging the rejection of claim 18 (App. Br. 15) go to process steps such as are set forth in claims 1 and 12, not to any structural distinction over the apparatus of the cited prior art combination, notwithstanding the functional limitations claim 18 recites.

*The rejection of claim 19 under 35 U.S.C. § 103(a) as being unpatentable over Dedrick, Reilly, and Stefik.*

The rejection of claim 19 (which depends from claim 16) will not be sustained.

In contrast to the arguments relied upon to challenge the rejection of claim 16, the arguments presented in challenging the rejection of claim 19 (App. Br. 16) go to an element of the apparatus; that is, “an *application* running *on the consumer computer*, the application operable to prohibit the export of items of the electronic publication.” (Claim 19 (emphasis added).)

The Examiner takes the position that Stefik “teaches allowing consumers to run applications in their computers in order to control the export of items as identified by the publisher on an item-by-item basis (see col 34, lines 15-67).” (Answer 14.) Col 34, lines 15-67, describes a *server* for performing various types of transactions that are permissible given specific usage rights. In particular, there is described there a *server* operable to transmit contents and data to a requester given certain usage rights. Such a

server would be operable to prohibit the export of items but it is not “an *application running on the consumer computer*, the application operable to prohibit the export of items of the electronic publication” (claim 19 (emphasis added)).

Since Stefik does not disclose the claim limitation at issue as the Examiner alleges and a case has not been made that Stefik nonetheless would lead one of ordinary skill in the art to an “*application running on the consumer computer*, the application operable to prohibit the export of items of the electronic publication,” as claimed, a prima facie case of obviousness has not been made out in the first instance for the subject matter of claim 19.

*The rejection of claims 24 and 25 under 35 U.S.C. § 103(a) as being unpatentable over Dedrick and Stefik.*

This rejection suffers for similar reasons to those expressed above in our reversal of the rejection of claim 19.

The Examiner relies on col 34, lines 15-67 of Stefik as “teach[ing] allowing consumers to run applications in their computers in order to control the export of items as identified by the publisher on an item-by-item basis.” (Answer 14.) But the difficulty with that fact is that col 34, lines 15-67 of Stefik describes transactional functions of a *server*, not an application on a consumer’s computer. The preponderance of the evidence does not support the conclusion that the prior art renders the claimed method obvious because Stefik discloses or would lead one to

allow[ ] a publisher to identify on an item-by-item basis whether to allow a consumer to export a portion of the electronic publication for the consumer's personal use; and

deliver[ ] the electronic publication to the consumer;

wherein the electronic publication is suitable for viewing by *a reading application installed on a consumer's computer, the reading application operable to control the export of items as identified by the publisher on the item-by-item basis.*

(Claim 24 (emphasis added).)

Since Stefik does not disclose the claim limitation at issue as the Examiner alleges and a case has not been made that Stefik nonetheless would lead one of ordinary skill in the art to an “wherein the electronic publication is suitable for viewing by *a reading application installed on a consumer's computer, the reading application operable to control the export of items as identified by the publisher on the item-by-item basis,*” as claimed, a prima facie case of obviousness has not been made out in the first instance for the subject matter of independent claim 24 and claim 25 dependent thereon is not sustained.

## CONCLUSIONS

The rejection of claims 1-7 and 9-15 under 35 U.S.C. § 103(a) as being unpatentable over Dedrick and Reilly is reversed.

The rejection of claims 16, 17, and 20-23 under 35 U.S.C. § 103(a) as being unpatentable over Dedrick and Reilly is affirmed.

The rejection of claim 18 under 35 U.S.C. § 103(a) as being unpatentable over Dedrick, Reilly, and Trader is affirmed.

The rejection of claim 19 under 35 U.S.C. § 103(a) as being unpatentable over Dedrick, Reilly, and Stefik is reversed.

The rejection of claims 24 and 25 under 35 U.S.C. § 103(a) as being

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unpatentable over Dedrick and Stefik is reversed.

### DECISION

The decision of the Examiner to reject claims 1-7 and 9-25 is affirmed-in-part; that is, the rejection of claims 1-7, 9-15, 19, 24, and 25 is reversed and the rejection of claims 16-18 and 20-23 is affirmed.

### TIME PERIOD FOR RESPONSE

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

### AFFIRMED-IN-PART

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