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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JOHN N. GROSS

Appeal 2010-010147
Application 11/369,796
Technology Center 3600

Before, MURRIEL E. CRAWFORD, ANTON W. FETTING and JOSEPH A. FISCHETTI, *Administrative Patent Judges*.

FISCHETTI, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134 of the Examiner's final rejection of claims 14 and 18. We have jurisdiction under 35 U.S.C. § 6(b). (2002)

SUMMARY OF DECISION

We AFFIRM.

THE INVENTION

Claim 14, reproduced below, is representative of the subject matter on appeal.

> 14. A method of allocating priority for playable media items over an electronic network between a first subscriber of a media distribution service and a second subscriber of the media distribution service, the method comprising:
>
> (a) providing a first subscriber selection queue for the first subscriber with a computing system, said first subscriber selection queue consisting of a list of one or more first playable media items delivered and/or to be delivered to said first subscriber;
>
> (b) monitoring an availability status of media items present in said first subscriber selection queue during a predetermined period, including identifying items selected by the first subscriber which have reduced availability;
>
> (c) providing a second subscriber selection queue for the second subscriber with the computing system, said second subscriber selection queue consisting of a second list of one or more second playable media items to be delivered to said second subscriber;
>
> (d) detecting when the first subscriber and the second subscriber have a common media item

> title in their respective first and second subscriber selection queues with the computing system;
>
> wherein said common playable media item is taken from a limited subset of playable media items determined to be popular by the computing system among subscribers;
>
> (e) determining a priority as between said first subscriber and said second subscriber using the computing system for said common playable media item title based on steps (a) - (c);
>
> (f) allocating said common playable media item title to either said first subscriber or said second subscriber with the computing system for said common playable title based in part on said priority;
>
> wherein said priority decisions are made by the computing system to increase priority for selected subscribers experiencing delays and/or reduced shipments of playable media items.

THE REJECTION

The Examiner relies upon the following as evidence of unpatentability:

Hunt B	US 2005/0125307 A1	Jun. 9, 2005
Pauliks	US 6,981,003 B2	Dec. 27, 2005
Hastings	US 7,024,381 B1	Apr. 4, 2006
Hunt A	US 7,403,910	Jul.22, 2008

http://www.theacsi.org/ ACSI (news and media resource-1999),p. 3

David Field, Volunteers for bumps fare better airlines have to pay only $400, but that may change, USA Today, Mar 6, 2001 at B7.

The following rejections are before us for review.

The Examiner rejected claims 14 and 18 under 35 U.S.C. § 103(a) as obvious over Hastings, Pauliks and Hunt.

FINDINGS OF FACT

1. We adopt the Examiner's findings as set forth on pages 3-11.

2. Serial No. 09/884,816 filed 6/18/01[1] now US Patent 7,403,910 which issued on July 22, 2008 (Hunt A) discloses "it is desirable to only recommend items which, according to the approach, are predicted to be rated favorably by user 702. Therefore, according to one embodiment of the invention, specified selection criteria are used to identify items that are likely to be rated highly (and therefore enjoyed) by user 702." (Hunt A, page 28).

ANALYSIS

Appellants argue that the disclosure of Hunt A fails to disclose the subject matter referenced by the Examiner in the final rejection in US 2005/0125307 (Hunt B). Hunt B is a reference against the claims on appeal only if as the disclosure in the earlier application, Hunt A, meets the requirements of 35 U.S.C. § 112, ¶ 1, including the written description requirement. *See Tech. Licensing Corp. v. Videotek, Inc.*, 545 F.3d 1316, 1326 (Fed. Cir. 2008) (citing *Transco Prods. Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 556 (Fed. Cir. 1994)).

We find that it does.

Appellant seizes on the fact the Hunt A fails to include Figure 8 which is part of the disclosure of Hunt B and because of this, the inclusion of Figure 8 in Hunt B constitutes new matter disqualifying Hunt B as a reference. (Appeal Br. 7). We disagree with Appellant because we find that

[1] Hunt A filed on 6/18/01 is earlier than the priority date of 1/31/2003 of the application on appeal.

Hunt A sufficiently discloses the involved feature required by the claim, such that Figure 8 of Hunt B is not necessary to support the claimed feature of:

> *wherein said common media title is taken from* a *limited subset* of *playable media items which the computing system has determined have* a *high subscriber interest* (see at least paragraph 102 - 106); (Answer 8).

Rather, we find with the Examiner that the sections in Hunt A which are referenced by the Examiner on page 9 of the Answer show that a person with ordinary skill in the art would understand that the Hunt A disclosure of a recommendation engine at page 28 results in the selection of items that are likely to be enjoyed by a user, e.g., a Best Bets.

Second, Appellants argue "that Hunt B says nothing about trying to identify only 'high subscriber interest' titles and then using these within the type of hypothetical system the Examiner concocts from Hastings/Pauliks. Nor do these latter references make any allusion to this type of operation." (Appeal Br. 8).

We disagree with Appellant because Hunt B explicitly discloses that "it is desirable to only recommend items which, according to the approach, are predicted to be rated favorably by user 702. Therefore, according to one embodiment of the invention, specified selection criteria are used to identify items that are likely to be rated highly (and therefore enjoyed) by user 702." (FF 2). Accordingly, we find that the Examiner has established a prima facie case for the rejection under 35 U.S.C. § 103(a), and Appellants' general allegation that the proposed combination is a concoction asserted without any specific reason(s), is not persuasive of error. "It is not the function of this court to examine the claims in greater detail than argued by

an appellant, looking for nonobvious distinctions over the prior art." *In re Baxter Travenol Labs,* 952 F.2d 388, 391 (Fed. Cir. 1991). *See also In re Wiseman,* 596 F.2d 1019, 1022 (CCPA 1979)

CONCLUSIONS OF LAW

We conclude the Examiner did not err in rejecting claims 14 and 18 under 35 U.S.C. § 103(a) as obvious over Hastings, Pauliks and Hunt.

DECISION

The decision of the Examiner to reject claim 14 and 18 is AFFIRMED.

AFFIRMED

Klh