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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte THOMAS H. SLAIGHT, ALAN R. NORMAN,
PHILLIP W. KING, IV, and NIUL A. BURTON

Appeal 2010-011720
Application 09/737,697
Technology Center 3600

Before: MURRIEL E. CRAWFORD, BIBHU R. MOHANTY, and
MICHAEL W. KIM, *Administrative Patent Judges*.

CRAWFORD, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

Appellants seek our review under 35 U.S.C. § 134 from the Examiner's final rejection of claims 2-10 and 12-32. We have jurisdiction under 35 U.S.C. § 6(b).

SUMMARY OF THE DECISION

We affirm-in-part.

BACKGROUND

Appellants' invention is directed to purchasing products or services using a multi-parameter auction. (Spec. 1:9-12).

Claim 25 is illustrative:

25. A method of conducting an on-line auction, comprising:

receiving bids from a plurality of vendors, each bid comprising a plurality of parameters associated with at least one product;

calculating, using a computer, the total cost of the at least one product to a purchaser for each vendor in response to the vendors' bids, the total cost taking into account the plurality of parameters associated with the at least one product;

enabling the purchaser to make at least one adjustment corresponding to at least one vendor bid which is used by the computer to calculate the total cost of the product to the purchaser; and

outputting, using the computer, each of the vendors bids and the total cost of the product to the purchaser.

Appellants appeal the following rejections:

Claims 2¹, 3, 5-7, 10, 12, 14-18, 20-22, and 24²-32 are rejected under 35 U.S.C. § 102(e) as anticipated by Kinney (US 7,249,085 B1, iss. Jul. 24, 2007).

Claims 4, 8, and 13 are rejected under 35 U.S.C. § 103(a) as unpatentable over Kinney and Fisher (US 5,835,896, iss. Nov. 10, 1998).

Claim 9 is rejected under 35 U.S.C. § 103(a) as unpatentable over Kinney and Spiegelhoff (US 5,402,336, iss. Mar. 28, 1995).

Claim 19 is rejected under 35 U.S.C. § 103(a) as unpatentable over Kinney.

Claim 23 is rejected under 35 U.S.C. § 103(a) as unpatentable over Kinney and Zawadzki (US 7,107,268 B1, iss. Sep. 12, 2006).

Claims 15-24 are rejected under 35 U.S.C. § 112, first paragraph, as not being enabled for the scope of the claim.

FINDING OF FACT

We find the following facts by a preponderance of the evidence. Additional facts may appear below in the Analysis.

1. Fischer discloses a list of bidders as follows:

The current high bidders are:

- NY of Reno, NV, Tue Mar 26, 3:27 pm (\$25.00, 1)
- PM of Petersburg, VA, Tue Mar 26, 4:18 pm (\$19.00, 1)
- NA of Corinth, TX, Tue Mar 26, 3:43 (\$17.00, 1): "FOR THE WIFE"

¹ We take as inadvertent error that the statement of rejection at Answer page 5 includes canceled claims 1 and 11. App. Br. 5.

² We take as inadvertent error that the statement of rejection at Answer page 5 includes claim 23, because claim 23 is separately rejected. Ans. 8 and 10.

A portion of Fisher's Figure 2 identifying bids with location and two-character identifiers.

2. Fisher discloses the date and time an auction closes. (Fig. 2).

ANALYSIS

Claims 2, 3, 5-7, 10, 12, 14-18, 20-22, and 24-32

We are not persuaded of error by Appellants' argument that Kinney fails to disclose the means for calculating a total cost, as well as means for enabling the purchaser to make an adjustment corresponding to a vendor bid. App. Br. 17-20. Kinney discloses calculating total cost from a multi-year contract by converting cost into the net present value (col. 6, ll. 49-52), and further discloses making an adjustment to a vendor bid through a transformation function that transforms raw cost per ton into cost per million BTU (col. 8, ll. 35-38), thus meeting the means for calculating and enabling limitations.

We are not persuaded of error by Appellants' argument that the transformation function in Kinney is not adjustable by the purchaser. Rep. Br. 18. We find that the purchaser is enabled to make an adjustment to a vendor bid because Kinney discloses that the "transformation function (f) [is] implemented by the buyer" (col. 10, ll. 9-12), and therefore the buyer is enabled to make an adjustment to the vendor bid, from cost/ton to cost/BTU.

Finally, we are not persuaded of error by Appellants' argument that Kinney does not disclose permitting a purchaser to adjust parameters or weightings, and does not disclose making adjustments in a non-uniform manner across bids. Rep. Br. 18-19. These arguments fail, because the claim does not require adjustment to parameters, or adjustment variably

across bids, but only an adjustment to one of the vendor bids. Kinney discloses this bid adjustment by way of the buyer implementing the function to transform cost/ton to cost/BTU.

For these reasons, we affirm the rejection of claim 5 under 35 U.S.C. § 102(e) over Kinney. Independent claims 15 and 25 recite an essentially identical requirement for enabling a bid adjustment, and were argued by reference to the arguments of claim 5. App. Br. 20. Therefore, we affirm the rejection of claims 15 and 25 for the same reasons as claim 5. We also affirm the rejection of dependent claims 2, 3, 6, 7, 10, 12, 14, 16-18, 20-22, 24, and 26-32 because they are not separately argued. App. Br. 20-21.

Claims 4 and 13

Dependent claim 4 recites “means for communicating a vendor bid having the best total cost for the product to the vendors without revealing the identification of the vendor with the best total cost” Dependent claim 13 recites substantially similar language.

We are persuaded of error by Appellants’ argument that Fisher discloses a two-letter identifier and location of a bidder, as compared to the claim that requires communicating without revealing identification. Rep. Br. 22. Fisher clearly displays a two-letter bidder identifier and bidder location (FF 1), which provides identification. Therefore, Fisher does not meet the claim language. For this reason, we reverse the rejection of claims 4 and 13 under 35 U.S.C. § 103(a).

Claim 8

Dependent claim 8 recites “wherein said communication means enables messages to be sent to the vendors regarding the status of the bidding, ending time for the bidding and extensions of the bidding.”

We are not persuaded of error by Appellants' argument that Fisher does not disclose that any "extension of bidding is ever sent in a message to vendors, as required by this claim." Rep. Br. 23. Fisher discloses the date and time an auction closes (FF 2), and thus communicates a message regarding the ending time for the bidding. If an auction is extended, the closing time of the auction would be later, and therefore the message showing that later time would also be a message regarding an extension of the bidding, since the later close time is affected by the extension. The display of the information in the web interface of Fisher (FF 1) meets the claim requirement as specified by the structure disclosed in the Specification (page 29 line 30 to page 30 line 3). The message delivery structure is disclosed by Fisher, but the content of the message is non-functional descriptive material to which we do not give patentable weight. *See In re Ngai*, 367 F.3d 1336, 1338 (Fed. Cir. 2004).

We are not persuaded of error by Appellants' argument that Fisher fails to disclose communication to vendors, because Fisher instead discloses communicating with buyers. App. Br. 24-25. Fisher discloses communicating bids and auction close times to bidders. We find one of ordinary skill in the art would recognize that a bidder can be either a buyer or vendor, depending on the particular type of auction, which may include forward or reverse, Dutch, and many other types of auctions that may use the same methods to conduct the auction.

We have considered the remaining arguments of teaching away and hindsight as to claim 8 (App. Br. 25-26) but find them unpersuasive for the same reasons.

For these reasons we affirm the rejection of claim 8 under 35 U.S.C. § 103(a).

Claims 9, 19, and 23

We affirm the rejections under 35 U.S.C. § 103(a) of dependent claims 9, 19, and 23, because these claims were not separately argued. App. Br. 15.

Enablement Rejection of Claims 15-24

We are persuaded by Appellants' arguments that claim 15-24 are rejected in error under 35 U.S.C. § 112, first paragraph, for enablement, for the reasons given by the Appellants. Rep. Br. 26-29. Additionally, we find the Examiner has not performed an analysis of the *Wands* factors, as required. See, *Manual of Patent Examining Procedure* (MPEP) § 2164.04 (8th Ed., Rev. 9, Aug. 2012). For these reasons, we reverse the rejection of claims 15-24 under 35 U.S.C. § 112, first paragraph.

DECISION

We affirm the rejection of claims 2, 3, 5-7, 10, 12, 14-18, 20-22, and 24-32 under 35 U.S.C. § 102(e).

We affirm the rejection of claims 8, 9, 19, and 23 under 35 U.S.C. § 103(a).

We reverse the rejection of claims 4 and 13 under 35 U.S.C. § 103(a).

We reverse the rejection of claims 15-24 under 35 U.S.C. § 112, first paragraph.

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Application 09/737,697

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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