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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/937,367	09/10/2004	Greg Roberts	074584-0311900	9417
909	7590	01/28/2013	EXAMINER	
Pillsbury Winthrop Shaw Pittman, I.L.P (NV)			LASTRA, DANIEL	
PO Box 10500			ART UNIT	PAPER NUMBER
McLean, VA 22102			3621	
			NOTIFICATION DATE	DELIVERY MODE
			01/28/2013	ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte GREG ROBERTS and SCOTT WILLS

Appeal 2011-006597
Application 10/937,367
Technology Center 3600

Before: ANTON W. FETTING, MICHAEL W. KIM, and
PHILIP J. HOFFMAN, *Administrative Patent Judges.*

KIM, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

This is an appeal from the final rejection of claims 1-40¹. We have jurisdiction to review the case under 35 U.S.C. §§ 134 and 6 (2002).

The invention relates to the electronic distribution of secure money saving or discount coupons and other marketing incentives, that includes the ability to electronically deliver personalized promotion information, such as a banner ad, to a user based on the user's location, profile information, proximity preferences and other information where the personalized promotion information has a direct link to the user's profile information (Spec. 1:20-24).

Claim 1, reproduced below, is further illustrative of the claimed subject matter.

1. A computer-implemented system for generating advertisements based on user profile information, the system comprising:
 - at least one server, the at least one server configured to:
 - receive user profile information from a user via a user device operatively connected to the at least one server via a communication link;
 - receive location information for the user;
 - receive proximity preference information;
 - generate at least one advertisement for a particular product or service for the user based on the user profile information, the location information, and the proximity preference information; and
 - transmit the at least one advertisement to the user device via the communication link, wherein the at least one advertisement includes a direct selectable link to the user profile information.

¹ Our decision will make reference to the Appellants' Appeal Brief ("App. Br.," filed August 20, 2010) and Reply Brief ("Reply Br.," filed January 4, 2011), and the Examiner's Answer ("Ans.," mailed November 16, 2010).

REFERENCES

Morga	US 2002/0165967 A1	Nov. 7, 2002
Barnes	US 2007/0118426 A1	May 24, 2007

We AFFIRM and enter a NEW GROUND of rejection pursuant to 37 C.F.R. § 41.50(b).

ISSUES

Did the Examiner err in asserting that a combination of Barnes and Morgan discloses or suggest “wherein the at least one advertisement includes a direct selectable link to the user profile information,” as recited in independent claims 1, 10, and 19?

Did the Examiner err in asserting that a combination of Barnes and Morgan discloses or suggest “wherein the direct selectable link to the user profile information comprises a user identifier,” as recited in dependent claim 3, and “wherein the user identifier is the name of the user,” as recited in dependent claim 4²?

Did the Examiner err in asserting that a combination of Barnes and Morgan discloses or suggest “wherein the provider-specified distance range comprises a radius, in miles, from an identified redemption facility associated with the provider,” as recited in dependent claim 9³?

Did the Examiner err in asserting that a combination of Barnes and

² As Appellant argues them together, we choose dependent claims 3 and 4 as also respectively representing dependent claims 12 and 13. *See* 37 C.F.R. § 41.37(c)(1)(vii).

³ As Appellant argues them together, we choose dependent claim 9 as representative of dependent claims 9 and 18. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Morgan discloses or suggest “generate at least one advertisement for a particular product or service for the user that is related to one or more of the generated search results, and that is additionally based on user profile information stored for the user,” as recited in independent claim 19?

FINDINGS OF FACT

FF1. Advertisements may consist of graphics, text, recipes, competitions or other inducements or a combination thereof (Spec. 15:6-7).

ANALYSIS

Independent Claims 1, 10, and 19

We are not persuaded the Examiner erred in asserting that a combination of Barnes and Morgan discloses or suggest “wherein the at least one advertisement includes a direct selectable link to the user profile information,” as recited in independent claims 1, 10, and 19 (App. Br. 5-9; Reply Br. 1-4).

Appellants assert that while Morgan may disclose “a hyperlink on a web page that a user can select to edit his personal profile,” that does not teach or suggest an “advertisement that includes a direct selectable link to user profile information” (App. Br. 8). Appellants also assert that the Examiner’s proffered rationale for combining is improper because it is gleaned from Appellants’ disclosure (App. Br. 8-9). However, the Examiner asserts that Barnes discloses every aspect of independent claim 1 except for the “direct selectable link to the user profile information.” Specifically, the Examiner asserts

Barnes allows users to program a device with users’ profile

information that determine how and whether the device respond to queries and different requests (see paragraph 208) and because Barnes targets advertisements to users based upon said users' profiles (see paragraph 397), where said advertisements targeted to said users may include said users' identification (see paragraph 250) then Barnes would include in said targeted advertisements an "hot link" (see paragraph 402)

(Ans. 11). Accordingly, Barnes, not Morgan, is cited for the advertisement itself. The "hot link" disclosed at paragraph [0402] of Barnes "is the address of the web page for obtaining product information and/or for purchasing the product." The Examiner then replaces the "hot link" of Barnes with the "Edit Profile" link at Figure 3A and paragraphs [0062]-[0063] of Morgan and provides the following modifying rationale:

[it] would allow said users to access their users' profile information upon selecting said link, as taught by Morgan in order that said users indicate their preference information and be better target with advertisements based upon said users likes or dislikes

(Ans. 6, 11). This rationale would be self-evident as the purpose of the "Edit Profile" link in Barnes, and thus is not improperly gleaned from Appellants' disclosure.

Appellants further assert that

Morgan does **not** teach "a personalized web page (i.e. target ad personalized webpage) that includes at least one advertisement wherein at least one advertisement includes a hyperlink (i.e. direct selectable link) that a user can select to edit his personal profile (see Morgan fig 3 item 330 'the edit profile information' with the Finance ad)", as asserted by the examiner

(Reply Br. 2-3). We agree that Morgan does not disclose "at least one advertisement wherein at least one advertisement includes a hyperlink (i.e. direct selectable link) that a user can select to edit his personal profile."

However, such a misstatement by the Examiner does not alter the obviousness analysis set forth above.

Dependent Claims 3 and 4

We are not persuaded the Examiner erred in asserting that a combination of Barnes and Morgan discloses or suggest “wherein the direct selectable link to the user profile information comprises a user identifier,” as recited in dependent claim 3, and “wherein the user identifier is the name of the user,” as recited in dependent claim 4 (App. Br. 9-10). The content of the direct selectable link is non-functional descriptive material. *See In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004); *cf. In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability).

As our analysis differs from that set forth by the Examiner, we denominate it a NEW GROUND of rejection under 37 C.F.R. § 41.50(b).

Dependent Claim 9

We are not persuaded the Examiner erred in asserting that a combination of Barnes and Morgan discloses or suggest “wherein the provider-specified distance range comprises a radius, in miles, from an identified redemption facility associated with the provider,” as recited in dependent claim 9 (App. Br. 10-11). After careful consideration of Appellants’ arguments, we agree with and adopt the Examiner’s findings and rationales, as set forth on page 11 of the Examiner’s Answer.

Independent Claim 19

We are not persuaded the Examiner erred in asserting that a combination of Barnes and Morgan discloses or suggest “generate at least one advertisement for a particular product or service for the user that is related to one or more of the generated search results, and that is additionally based on user profile information stored for the user,” as recited in independent claim 19 (App. Br. 11-13; Reply Br. 4-5). Appellants assert that “Barnes paragraph [0153] does not disclose advertisements, and the paragraph certainly does not disclose advertisements that are related to generated search results” (Reply Br. 5). However, paragraph [0153] of Barnes discloses retrieving vendors from memory, and paragraph [0159] discloses an output of those vendors to the user either visually or audibly, which meets Appellants’ definition of “advertisement” (FF1).

DECISION

The decision of the Examiner to reject claims 1-40 is AFFIRMED.

This decision contains a new rationale for rejecting dependent claims 3 and 4 under 35 U.S.C. § 103(a) pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that Appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of the appeal as to the rejected claims:

- (1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the

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examiner, in which event the proceeding will be remanded to the examiner

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record

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; 37 C.F.R. § 41.50(b)

MP