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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte CHRISTINA ANN LACOMB, JANET ARLIE BARNETT,
SCOTT CHARLES DRAKE, and STEVEN TODD SACKS

Appeal 2014-008024¹
Application 11/765,070²
Technology Center 3600

Before JOSEPH A. FISCHETTI, NINA L. MEDLOCK, and
BRUCE T. WIEDER, *Administrative Patent Judges*.

MEDLOCK, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1–32. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ Our decision references Appellants' Appeal Brief ("App. Br.," filed March 25, 2014) and Reply Brief ("Reply Br.," filed July 21, 2014), and the Examiner's Answer ("Ans.," mailed May 21, 2014) and Final Office Action ("Final Act.," mailed October 10, 2013).

² Appellants identify NBCUniversal Media, LLC as the real party in interest. App. Br. 2.

CLAIMED INVENTION

Appellants' claimed invention "relate generally to gathering opinions from a population of people" and, more specifically, "to the use of a market-driven model to collect participant input for media content generation" (Spec. ¶ 1).

Claims 1 and 14 are the independent claims on appeal. Claim 1, reproduced below, is illustrative:

1. A method for rank-ordering a plurality of answers to an open-ended question using a virtual market, the method comprising:
 - providing from a computing device a plurality of market participants with an open-ended question, wherein the open-ended question comprises a fundamentally subjective question;
 - receiving on the computing device a plurality of answers to the question, wherein at least one of the answers to the open-ended question is provided by the market participants;
 - establishing each answer as a security in a virtual market of a market engine executed by a processor of the computing device;
 - attaching an initial value to each said security in the virtual market of the market engine;
 - facilitating trading of the securities by the participants via the virtual market of the market engine; and
 - establishing, via the processor of the computing device, a rank-order for the plurality of answers based upon the value associated with each said security after a period of trading.

REJECTIONS

Claims 1–28 are provisionally rejected on the ground of non-statutory obviousness-type double patenting as unpatentable over claims 1–30 of application Serial No. 11/765,064.

Claims 1–4, 6–23, and 25–32 are rejected under 35 U.S.C. § 103(a) as unpatentable over Vinarsky (US 6,390,472 B1, iss. May 21, 2002) and Palestrant (US 8,019,637 B2, iss. Sept. 13, 2011).

Claims 5 and 24 are rejected under 35 U.S.C. § 103(a) as unpatentable over Vinarsky, Palestrant, and Courbois, (US 8,015,098 B2, iss. Sept. 6, 2011).

ANALYSIS

Obviousness-Type Double Patenting

Appellants state that they “do not necessarily agree with the rejection” but “will consider filing a terminal disclaimer if the present claims are indicated as allowable and no additional substantive issues remain” (App. Br. 5). Appellants’ proposal would ultimately resolve the issue; but it does not constitute a substantive argument in response to the Examiner’s rejection. Therefore, we summarily affirm the rejection of claims 1–28 on the ground of non-statutory obviousness-type double patenting.

Obviousness

Independent Claim 1 and Dependent Claims 2–4, 6–13, and 29–31

We are not persuaded by Appellants’ argument that the Examiner erred in rejecting claim 1 under 35 U.S.C. § 103(a) because Vinarsky, on which the Examiner relies, does not disclose or suggest “providing . . . a plurality of market participants with an open-ended question, wherein the open-ended question comprises a fundamentally subjective question” and “receiving . . . a plurality of answers to the question, wherein at least one of the answers to the open-ended question is provided by the market participants,” as recited in claim 1 (App. Br. 9–11).

Vinarsky is directed to an interactive trading game where participants trade “contracts” as pseudo-commodities in a virtual trade market (*see, e.g.*, Vinarsky, Abstract; col. 2, ll. 22–36). The contracts are “defined as issues each having no innate financial value but of local, national or international interest and involving social, financial, business, political, sports, or general, etc. matters that can be influenced by the actual or potential occurrence of different events or factors” (*id.* at Abstract). Vinarsky states that an important aspect of the trading is the periodic polling of traders for their opinions on how certain current events or other factors may influence the trading prices of particular contracts (*id.* at Abstract; col. 4, ll. 20–44). Vinarsky discloses that the poll contains statements or questions related to the pseudo commodity contract issue to which the participant responds by rating “the possible significance or influence each poll statement/question might have on the resolution of the contract issue: firstly for potentially influencing the contract price for the better or the worse, and secondly by an anticipated little bit or a lot” (*id.* at col. 4, ll. 24–32). Vinarsky also provides examples of this type of polling in which participants are asked to rank the impact of a statement on a particular contract price between -3 and +3 (with -3 being the most negative and +3 being the most positive) (*id.* at col. 5, l. 53–col. 6, l. 49).

Appellants argue that polled questions in Vinarsky are not “open-ended” questions and further that the answers to the polled questions in Vinarsky are not “fundamentally subjective,” as called for in claim 1 (App. Br. 9–11).³ Appellants’ argument is unavailing.

³ The term “open-ended question” is commonly understood to refer to an “[u]nstructured question in which (unlike in a multiple choice question)

As an initial matter, Vinarsky clearly discloses that registered traders are polled for “their opinions how such matters might influence the resolve of the specific contract issue” (Vinarsky, col. 4, ll. 20–24). We agree with the Examiner that the registered traders are market participants being questioned about their opinions and that Vinarsky, thus, discloses providing market participants with subjective questions (Ans. 4).

Appellants’ further argument that the polled questions in Vinarsky are not “open-ended” questions is similarly unpersuasive because, as the Examiner observes, the subject matter or type of question asked does not functionally affect how the claimed method is performed (*id.*). As such, the nature of the question, i.e., that it is “open-ended,” constitutes non-functional descriptive material that may not be relied on to distinguish over Vinarsky for purposes of patentability.

The Federal Circuit has long held that where a limitation claims printed matter that is not functionally or structurally related to its physical substrate, the printed matter may not be relied on to distinguish over the prior art for purposes of patentability. *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). In applying the printed matter doctrine, the first step is to determine whether the limitation is, in fact, directed to printed matter, i.e., whether the limitation claims the content of information. *See In re Distefano*, 808 F.3d 845, 848 (Fed. Cir. 2015). If so, “one must

possible answers are not suggested, and the respondent answers it in his or her own words.” *See* <http://www.businessdictionary.com/definition/open-ended-question.html> (last accessed August 16, 2016).

then determine if the matter is functionally or structurally related to the associated physical substrate, and only if the answer is ‘no’ is the printed matter owed no patentable weight.” *Id.* at 851. *See also King Pharms., Inc. v. Eon Labs, Inc.*, 616 F.3d 1267, 1278–79 (Fed. Cir. 2010) (applying the “printed matter” reasoning to method claims containing an “informing” step that could be either printed or verbal instructions).

Here, claim 1 claims the informational content of the question, and as such, is directed to printed matter. The relevant inquiry then is whether the recitation that the question is an “open-ended” question, i.e., the claimed informational content, has a “new and unobvious functional relationship” with the method. *Id.* at 1279.

There is no objective evidence of record here that there is a functional distinction in providing participants with an open-ended question as opposed to providing some other type of question, e.g., a multiple choice question. Regardless of the nature of the question, the underlying method is the same, e.g., the answer is received and established as a security in a virtual market. The subject matter or type of question does not depend on the method, and the method does not depend on the subject matter or type of question. As such, it constitutes non-functional descriptive material that may not be relied on for patentability. *See In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004).

We also are not persuaded by Appellants’ argument that the Examiner failed to “provide a reason [why] one skilled in the art would be motivated to combine Vinarsky and Palestrant to arrive at independent claim 1” (App. Br. 11–12 (emphasis omitted)).

In rejecting claim 1 under § 103(a), the Examiner acknowledges that Vinarsky does not explicitly disclose “establishing each answer as a security

in a virtual market” (Final Act. 7), as recited in claim 1. The Examiner cites Palestrant to cure the deficiency of Vinarsky (*id.* (citing Palestrant, col. 3, l. 46–col. 4, l. 8 as disclosing “answers established as tickets which may be voted or bid on”). And the Examiner concludes that

[i]t would have been obvious to one of ordinary skill in the art at the time of the invention to establish answers as securities . . . as taught by Palestrant in the system of Vinarsky, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Id. at 8.

Palestrant is directed to a system and method for providing an “early indication of consensus of opinion among a number of users regarding an event or observation indicated by a user” (Palestrant, Abstract). Palestrant discloses that, according to one aspect of the invention, a user submits an observation in the form of a “ticket” to an online system; the ticket is then displayed to other users of the online system who may cast a “vote” expressing their opinion on the observation (*id.* at col. 3, l. 46–col. 4, l. 8).

Appellants argue that the Examiner has failed to provide articulated reasoning with a rational underpinning that explains why one skilled in the art would have modified Vinarsky to utilize the ticket establishment of Palestrant to establish answers to open-ended questions as securities for trading and that claim 1 is not a combination of old elements disclosed in the cited references because neither Vinarsky nor Palestrant discloses providing an open-ended question to a plurality of users and receiving at least one answer to the open-ended question from a user (App. Br. 11–12). That argument is not persuasive at least because, as described above, the subject

matter or type of question is non-functional descriptive material that may not be relied on to distinguish over the prior art for purposes of patentability.

Appellants also argue that when the elements in Vinarsky and Palestrant are combined, the elements do not function in the same way as they do separately, as the Examiner suggests (App. Br. 12–13). Appellants observe that in Vinarsky, the polling questions in Vinarsky request information, i.e., answers, from users regarding how the users expect a current event or factor to influence the value of issue contracts being traded whereas in the proposed combination, the polling questions request answers that are then established as securities to be traded. Yet Appellants cannot reasonably deny that in both cases, the polling questions function in the same way, i.e., the questions elicit information, albeit different types of information, from users.

In view of the foregoing, we sustain the Examiner’s rejection of independent claim 1 under 35 U.S.C. § 103(a). We also sustain the rejection of dependent claims 2–4, 6–13, and 29–31, which are not argued separately.

Independent Claim 14 and Dependent Claims 15–19, 21–23, 25–28, and 32

Appellants’ arguments with respect to claim 14 are substantially identical to Appellants’ arguments with respect to claim 1 (App. Br. 13–15). We found those arguments unpersuasive with respect to claim 1, and we find them equally unpersuasive as applied to claim 14.

Therefore, we sustain the Examiner’s rejection under 35 U.S.C. § 103(a) of claim 14 for the same reasons set forth above with respect to claim 1. We also sustain the rejection of dependent claims 15–19, 21–23, 25–28, and 32, which are not argued separately.

Dependent Claims 5, 20, and 24

Claim 5 depends from independent claim 1, and claims 20 and 24 ultimately depend from independent claim 14. Appellants do not present any arguments in support of the patentability of these dependent claims except to assert that the Examiner's rejection of claims 5 and 24 based on Courbois, in combination with Vinarsky and Palestrant, does not cure the alleged deficiency in the Examiner's rejection of claims 1 and 14, and that claim 20 is allowable based on its dependence on claim 14 (App. Br. 15–17).

We are not persuaded for the reasons set forth above that the Examiner erred in rejecting claims 1 and 14 under 35 U.S.C. § 103(a). Therefore, we sustain the Examiner's rejections of claims 5, 20, and 24.

DECISION

The Examiner's rejection of claims 1–28 on the ground of non-statutory obviousness-type double patenting is affirmed

The Examiner's rejections of claims 1–32 under 35 U.S.C. § 103(a) are affirmed.

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