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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/751,313	03/31/2010	Ji Bae	09-864	1419

107681 7590 11/23/2016
NCR Corporation
3097 Satellite Boulevard
Building 700, 2nd Floor, Law Department
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EXAMINER

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ART UNIT	PAPER NUMBER
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3622

NOTIFICATION DATE	DELIVERY MODE
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11/23/2016

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JI BAE and THOMAS V. EDWARDS

Appeal 2014-009551¹
Application 12/751,313
Technology Center 3600

Before: MURRIEL E. CRAWFORD, JOSEPH A. FISCHETTI, 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 1–24. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ Appellants identify NCR Corporation as the real party in interest. Appeal Br. 1.

Appellants' invention "relates generally to product placement data."

Spec. para. 1.

Claim 1 is illustrative:

1. A method comprising:

receiving a request from a client device for product placement data for a specific item, the request further comprising a location;

determining, via a processor, one or more providers within a proximity to the location that provide the specific item;

obtaining product placement data for the specific item for each of the one or more providers determined; and

transmitting a response comprising the one or more providers determined integrated with the product placement data for the specific item for each of the one or more providers.

Appellants appeal the following rejections:

Claims 1–5, 7, 8, 11–18, and 21–24 are rejected under 35 U.S.C. § 102(b) as anticipated by Dewitt et al. (US 2009/0076896 A1, pub. Mar. 19, 2009, hereinafter "Dewitt").

Claims 6, 10, and 20 are rejected under 35 U.S.C. § 103(a) as unpatentable over Dewitt and Hoerenz (US 2004/0267611 A1, pub. Dec. 30, 2004).

Claims 9 and 19 are rejected under 35 U.S.C. § 103(a) as unpatentable over Dewitt and Steele et al. (US 2002/0046084 A1, pub. Apr. 18, 2002, "Steele").

Claims 1–24 are rejected under 35 U.S.C. § 101 as reciting ineligible subject matter.²

² This rejected was introduced in the Examiner's Answer. *See* Ans. 2.

ANALYSIS

Claims Rejected under 35 U.S.C. § 102(b)

Appellants argue independent claims 1, 13, and 21 together as a group. Appeal Br. 8–9. We select claim 1 as representative. *See* 37 C.F.R. § 41.37(c)(1)(iv).

We are not persuaded by Appellants’ argument that Dewitt discloses “no explicit reference to product placement data.” Appeal Br. 4–5.

In an anticipation rejection, the elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 832 (Fed. Cir. 1990). The Examiner finds the claimed “product placement data” is disclosed in Dewitt by at least the “description of an inventory of the merchant.” Final Act. 7; *see also* Ans. 4 (both citing Dewitt para. 7).

We are unpersuaded by Appellants’ arguments that the Examiner’s construction of the claimed “product placement data” is unreasonable and inconsistent with the Specification, and thus, according to Appellants, is undisclosed by Dewitt. Appeal Br. 5–8; *see also* Reply Br. 4–5.

During prosecution the PTO gives claims their “broadest reasonable interpretation consistent with the [S]pecification.” *In re Hyatt*, 211 F.3d 1367, 1372, (Fed. Cir. 2000). However, limitations appearing in the [S]pecification but not recited in the claim are not read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed. Cir. 2003). To act as its own lexicographer, a patentee must “clearly set forth a definition of the disputed claim term” other than its plain and ordinary meaning. *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366 (Fed. Cir. 2002). It is not enough for a patentee to simply disclose a single embodiment or use a

word in the same manner in all embodiments, the patentee must “clearly express an intent” to redefine the term. *Helmsderfer v. Bobrick Washroom Equip., Inc.*, 527 F.3d 1379, 1381 (Fed. Cir. 2008); *see also Kara Tech. Inc. v. Stamps.com*, 582 F.3d 1341, 1347–48 (Fed. Cir. 2009).

We agree with the Examiner that Appellants have not clearly defined the term “product placement data.” *See, e.g.*, Ans. 3. In addition, the Specification describes by example that “[w]hen the providers in proximity to the location are determined, then provider specific product placement data is searched to determine the actual product placement of the item within the particular provider.” Spec. para. 22. This sentence indicates that “product placement data” broadly includes more data than “actual product placement of the item within the particular provider,” because the “actual product placement” is searched from within the broader “product placement data” of each provider.

We, thus, decline to import “actual product placement of the item within the particular provider” into the claims by way of redefining the broad term “product placement data” to include that example from the Specification. As a result, Dewitt’s “description of an inventory of the merchant” meets the claimed “product placement data,” because it is data about the placement of a product in inventory.

In addition, Dewitt relies on further inventory information, such as “whether the inventory is at a franchisor's store in the mall or at a[n] intersection with little traffic, whether the inventory is located at the door of the store where other items may be of interest to the consumer or at the back of the store” (Dewitt para. 46), which the ordinary artisan would recognize could be included with the transmitted “inventory list” (*id.* at para. 58).

Additionally, Dewitt discloses “the description of the inventory may be a location of the POS of the merchant M(m) **106** at which the inventory may be purchased,” which may be transmitted along with, or instead of, the product description (*id.* at para. 79).

For these reasons we sustain the rejection under 35 U.S.C. § 102(b) of claims 1, 13, and 21, because Dewitt meets the broad claim language by disclosing “product placement data.” We also sustain the rejection of dependent claims 2–5, 7, 8, 11, 12, 14–18, and 22–24 that were not argued separately. Appeal Br. 9.

Claims Rejected under 35 U.S.C. § 103(a)

Appellants argue the rejections of claims 6, 9, 10, 19, and 20 under 35 U.S.C. § 103(a) only by reference to the arguments directed to claim 1. Appeal Br. 9. We sustain the rejections under 35 U.S.C. § 103(a) for the same reasons we set forth above.

Claims 1–24 Rejected under 35 U.S.C. § 101

We are not persuaded by Appellants’ assertions that the claims are “in no way abstract,” and are not long-prevalent fundamental economic practices “in the way risk hedging and intermediated settlement are.” Reply Br. 6. Though Appellants make assertions that the claims are not abstract, and not fundamental economic processes, Appellants provide no evidence or reasoning to support the assertions. Claim 1 receives a request for product data, retrieves the data for providers determined from the location of the requesting device, and provides the data in response. This is a normal analytic process which is part of the commerce of product sales: responding

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to potential customer inquiries, including indicating where the product can be purchased. In addition, the method of claim 1 can be performed entirely through mental thought along with the basic input and output of data.

Absent evidence by the Appellants to the contrary, we agree with the Examiner that the claims recite “no more than a generic computer to perform generic computer functions that are well-understood” (Answer 2).

For this reason, we sustain the rejection under 35 U.S.C. § 101.

DECISION

We affirm the rejections of claims 1–24.

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