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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* PHIL LIBIN, PHIL CONSTANTINOU,  
DMITRY STAVISKY, ALEX PACHIKOV,  
PAVEL SKALDIN, and ANDREW SINKOV

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Appeal 2015-005772  
Application 13/227,787  
Technology Center 2100

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Before DEBRA K. STEPHENS, KEVIN C. TROCK, and  
JESSICA C. KAISER, *Administrative Patent Judges*.

TROCK, *Administrative Patent Judge*.

DECISION ON APPEAL

*Introduction*

Appellants<sup>1</sup> appeal under 35 U.S.C. § 134(a) from a Final Rejection of claims 1–20. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

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<sup>1</sup> According to Appellants, the real party in interest is Evernote Corporation. App. Br. 2.

*Invention*

The claims are directed to modifying a website to include relevant information by searching a database containing private, user-collected information. Spec. 11:22–12:6, Abstract.

*Exemplary Claim*

Claim 1, reproduced below, is illustrative of the claimed subject matter with disputed limitations emphasized:

1. A method for presenting information on a website to a user that accesses the website, comprising:

extracting information, as extracted information, from the website;

*searching a database containing private information for relevant information that is relevant to the extracted information from the website, wherein the private information is collected by the user and wherein the relevant information is stored in the database prior to the extracting of the extracted information from the website; and*

presenting the relevant information to the user in a manner that associates the relevant information with content displayed on the website.

*Applied Prior Art*

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Ramer	US 2010/0082431 A1	Apr. 1, 2010
Baluja	US 2010/0153422 A1	June 17, 2010
Gade	US 2011/0191321 A1	Aug. 4, 2011

## REJECTION

The Examiner made the following rejection:

Claims 1–20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gade, Ramer, and Baluja. Final Act. 4–7.

## ANALYSIS

We have reviewed the Examiner’s rejections and the evidence of record in light of Appellants’ argument that the Examiner has erred. We disagree with Appellants’ arguments and conclusions. We adopt as our own the findings and reasons set forth by the Examiner in the action from which this appeal is taken (Final Act. 2–7) and the findings and the reasons set forth in the Examiner’s Answer (Ans. 2–3). We concur with the conclusions reached by the Examiner and further highlight specific findings and argument for emphasis as follows.

### *Independent Claims 1 and 11*

Appellants contend the combination of Gade, Ramer, and Baluja does not teach or suggest “searching a database containing private information for relevant information that is relevant to extracted information extracted from a web page where the private information is collected by the user,” as recited in independent claim 1 and similarly recited in independent claim 11. App. Br. 8–11; Reply Br. 3–6. Specifically, Appellants argue that Ramer’s database information “is *about* the user and collected by someone other than the user” instead of “information [that] is collected *by* a user.” App. Br. 10 (emphasis in original); Reply Br. 4. Additionally, Appellants argue Ramer teaches “personal information that identifies a person” rather than “private information.” Reply Br. 4. Appellants also argue Baluja’s personal

information “is not searched.” App. Br. 10. Appellants further argue Ramer and Baluja “search[ ] a *public* database (the Web) using results from a *private* database” rather than “searching a *private* database using results from a *public* database (the Web).” Reply Br. 5–6 (emphasis in original); App. Br. 10.

We are not persuaded. The Examiner finds, and we agree, Gade searches a database to find advertisements relevant to content extracted from a webpage. Final Act. 4 (citing Gade ¶ 25); Ans. 2. The Examiner further finds, and we agree, Ramer teaches that databases can contain a user’s private information. Final Act. 4 (citing Ramer ¶ 1129); Ans. 3. The Examiner combines Gade and Ramer, resulting in a system which searches a database that contains a user’s private information. Ans. 2–3; Final Act. 4. The Examiner further finds, and we agree, Baluja teaches that a user’s private information can be “provided by the user.” Final Act. 5 (citing Baluja ¶ 40); Ans. 3. The Examiner combines Gade and Ramer with Baluja, resulting in a system where the private information in the database has been provided by the user. Ans. 3; *see* Final Act. 5.

Appellants’ argument that Ramer does not teach personal information collected by the user (App. Br. 10; Reply Br. 4) is unpersuasive. The Examiner does not rely on Ramer to teach personal information collected by the user, but instead relies on Baluja, which teaches “personal information [is] provided by the user.” (Final Act. 5 (citing Baluja ¶ 40); Ans. 3).

Appellants’ argument that Ramer teaches personal information, rather than the claimed private information (Reply Br. 4) is also unpersuasive. Appellants’ Specification discloses a “system described herein provides methods for presenting users with relevant personal (private) information,”

i.e., that personal information is equivalent to private information. Spec. 7:18–19. When read in light of the Specification, one of ordinary skill in the art would reasonably interpret the scope of the claimed “private information” to include personal information. Accordingly, Ramer’s teaching of using personal information falls within the meaning of the claimed private information. Ramer ¶ 1129.

Additionally, Appellants’ arguments that Ramer and Baluja search public databases rather than private databases (Reply Br. 5–6; App. Br. 10) and that Baluja does not search for personal information (App. Br. 10) does not address the Examiner’s combination of Gade, Ramer, and Baluja. The test for obviousness is not whether the features of one reference may be bodily incorporated into the structure of another reference. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. *In re Keller*, 642 F.2d 413, 425 (CCPA 1981) (citations omitted).

Here, the Examiner’s combination relies on Gade—not Ramer or Baluja—to teach searching a database for relevant information. Final Act. 4 (citing Gade ¶ 25). The Examiner relies on Ramer and Baluja to teach the type of information contained in Gade’s searched database (private information collected by a user). Final Act. 4–5 (citing Ramer ¶ 1129; Baluja ¶ 40); Ans. 3. The Examiner combines Ramer and Baluja, which, in combination, teach that a database can contain private information provided by a user, with Gade’s searched database to result in a system which searches a database containing private information provided by a user. Final Act. 4–5; Ans. 3.

Furthermore, Appellants' arguments are directed to types of databases, i.e., public and private databases (Reply Br. 5–6; App. Br. 10), but those arguments do not address the claim language which only restricts the type of information the database contains, i.e., “a database containing private information.” Appellants' arguments do not persuasively address the Examiner's combination which modifies the type of information Gade's database contains (Final Act. 4–5; Ans. 3).

Accordingly, we are not persuaded the Examiner erred in finding the combination of Gade, Ramer, and Baluja teaches or suggests “searching a database containing private information for relevant information that is relevant to extracted information extracted from a web page where the private information is collected by the user,” within the meaning of claims 1 and 11. Therefore, we sustain the Examiner's rejection of independent claims 1 and 11.

*Teaching Away*

Appellants contend the Examiner improperly combined Gade, Ramer, and Baluja because Baluja teaches away from the claimed invention. App. Br. 10; Reply Br. 5. Specifically, Appellants argue Baluja “teach[es] the opposite of the present claimed invention” by “searching a public database (the Web) using results from a private database.” App. Br. 10 (emphasis omitted); Reply Br. 5.

We are not persuaded. As discussed *supra*, the Examiner's combination relies on Gade to teach database searches and relies on Ramer and Baluja to teach the type of information a database can contain (private information provided by a user). Final Act. 4–5 (citing Gade ¶ 25, Ramer ¶ 1129; Baluja ¶ 40); Ans. 3. To teach away, a reference must “criticize,

discredit, or otherwise discourage” investigation into the claimed solution. *In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004). Appellants’ arguments discuss features in Baluja the Examiner does not rely on, i.e., searching a public database (App. Br. 10; Reply Br. 5). Moreover, Appellants’ discussion of one particular embodiment in Baluja does not persuade us that Baluja actually criticizes, discredits, or otherwise discourages the combination found by the Examiner, i.e., searching a database containing private information. *See In re Fulton*, 391 F.3d 1201. That is, Baluja’s embodiment where a public database is searched is not persuasive evidence that Baluja teaches that a database with private information should not be searched. Furthermore, Appellants’ argument bodily incorporates Baluja’s search features (*see* Reply Br. 5–6; App. Br. 10) and does not address the Examiner’s combination discussed *supra*. Accordingly, we are not persuaded the Examiner improperly combined Gade, Ramer, and Baluja.

*Remaining Claims 2–10 and 12–20*

Appellants do not argue separate patentability for dependent claims 2–10 and 12–20 which depend directly or indirectly from claims 1 or 11. App. Br. 5–11. For the reasons set forth above, therefore, we are not persuaded the Examiner erred in rejecting these claims. *See In re Lovin*, 652 F.3d 1349, 1356 (Fed. Cir. 2011) (“We conclude that the Board has reasonably interpreted Rule 41.37 to require applicants to articulate more substantive arguments if they wish for individual claims to be treated separately.”). Accordingly, we sustain the Examiner’s rejections of claims 2–10 and 12–20. *See* 37 C.F.R. § 41.37(c)(1)(iv).

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DECISION

We AFFIRM the Examiner's 35 U.S.C. § 103 rejection of claims 1–20.

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