Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MICHAEL D. BEDNAREK

Appeal 2017-004601
Application 12/437,196
Technology Center 3600


PYONIN, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the Examiner’s Final Rejection of claims 29–49. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM-IN-PART and ENTER NEW GROUNDS OF REJECTION pursuant to 37 C.F.R. § 41.50(b).

1 Michael D. Bednarek is identified as the real party in interest. App. Br. 3.
STATEMENT OF THE CASE

Appellant’s disclosure relates to a “personal communication and electronic commerce system for use by participating users and participating merchants in connection with incentive programs in the Network Economy.”

Abstract. Claims 29, 38, 42, and 49 are independent, and are reproduced below for reference (with emphasis added):

29. A wireless connectivity and electronic commerce system, the system comprising:
   merchant database hardware and computer implemented software for facilitating the digital distribution of at least one of products and services, the database hardware storing a plurality of merchant IDs in association with data provided by the merchant that describes products available from the merchant that have been approved for distribution through the system by a system operator;
   the computer implemented software allowing the system operator to control the selection of products available through the system on a product by product basis;
   the database hardware storing merchant provided data associated with each of the merchant ID, the computer implemented software allowing merchants to update merchant provided data associated with their merchant ID;
   a plurality of digital wireless communication devices, each of the digital wireless communication devices comprising:
   a touch selection display;
   audio output and input equipment to allow voice and data communication on a digital cellular network and additional equipment to allow wireless data exchange over a network other than the digital cellular network whereby a user of the digital wireless communication device may engage in voice dialog while accessing the database;
   a touch selection user interface for allowing user input through the touch selection display while voice dialog is occurring and a natural language user interface that interprets natural speech queries as user input;
a transmitter and receiver for wireless connectivity so as to allow a digital message generated on the digital wireless communication devices to be transmitted to hardware equipped to receive such messages;

a computer implemented search engine for querying the database in response to a user input and transmitting data to the digital wireless communication device so as to display information responsive to the user input on the touch selection display of the digital wireless communication device, the information displayed including at least an icon representing an available product; and the user interface allowing a user to download merchant specific content by touching an icon displayed on the touch selection display;

the user interface further providing touch selection menu choices by which a merchant product may be purchased while the user is engaged in voice dialog through the system using data stored in the system that allows transfer of monetary value from the user to the system operator and wherein the system operator transfers a portion of the monetary value received from the user to the merchant that provided the product purchased.

38. A computer implemented merchant digital content distribution system that allows users equipped with digital wireless communication devices to search for and purchase products provided by merchants, the system comprising:

a plurality of digital wireless communication devices, each of the digital wireless communication devices comprising:

a touch screen display;

communication equipment to allow simultaneous voice and data communication on a digital network so as to allow a user of the digital wireless communication device to access the system and engage in voice dialog at the same time;

a user interface for allowing user input through the touch selection display;

a transmitter and receiver for wireless connectivity so as to allow a digital message generated on the digital wireless communication devices to be transmitted to hardware equipped to receive such messages;
a database for storing a plurality of merchant ID’s in
association with merchant data;

wherein the database for storing a plurality of merchant
ID’s in association with merchant data is a database maintained
on a server by a system operator, each of the plurality of
merchant ID conforming to a standard and being approved by
the system operator, the system including computer
implemented software allowing the system operator to control
the selection of products available through the system;

the database storing content uniquely associated with a
plurality of different merchants in a consistent format, the
content including content provided by the respective merchant
to which the content is uniquely associated and the system
software controlling access to the database such that each of the
plurality of different merchants are allowed to access the server
to update content uniquely associated with their respective
merchant ID’s, but prevented from modifying content uniquely
associated with others of the plurality of different merchants;

a search engine for querying the database in response to a
user query and transmitting data to the digital wireless
communication device so as to display information responsive
to the user query on the touch selection display of the digital
wireless communication device, the information displayed
including at least an icon representing an available product; and
the user interface allowing a user to download merchant
specific content;

the user interface further allowing a merchant product to
be purchased through the system through the touch selection
display while the user is engaged in voice dialog through the
system using data stored in the system that allows transfer of
monetary value from the user to the system operator and
wherein the system operator transfers a portion of the monetary
value received from the user to the merchant that provided the
product purchased.

42. A computer implemented merchant product
distribution system for allowing users to identify and download
products of interest within a database containing digital content
provided by a plurality of merchants, the system including computer implemented software allowing allow merchants to update the content of information sent to users and permitting updated digital content to be downloaded by users and also allowing updated product information to be pushed to users, the system comprising:

- a database for storing a plurality of merchant ID’s in association with a description of the products including at least an icon representing an available product, the merchant name and the product name; wherein the database for storing a plurality of merchant ID’s in association with a description of products includes merchant provided data on a database maintained on a server by a system operator, each of the plurality of merchant ID’s conforming to a standard and being assigned by the system operator, the database storing content approved for distribution by the system operator and uniquely associated with a plurality of different merchants in a consistent format on a server, the system software allowing the system operator to control the selection of content available through the system on a product by product basis;

- the content including content provided by the merchant to which the content is uniquely associated and the system controlling access to the database such that each of the plurality of different merchants are allowed to update content on the server that is uniquely associated with their respective merchant ID’s, but prevented from updating content uniquely associated with others of the plurality of different merchants; and the user interface allowing a user to download merchant specific content through the touch selection display;

- the user interface further allowing a merchant product to be purchased through the system using data stored in the system that allows transfer of monetary value from the user to the system operator.

49. A computer implemented merchant product distribution system for allowing users to identify and download products of interest within a database containing digital content provided by a plurality of merchants, the system further
allowing merchants to update the content of information sent to users and permitting updated digital content to be downloaded by users and also allows updated product information to be pushed to users, the system comprising:

- a database for storing a plurality of merchant ID’s in association with a description of the products including at least an icon representing an available product, the merchant name and the product name, wherein the database for storing a plurality of merchant ID’s in association with a description of products includes merchant provided data stored within the system, each of the plurality of merchant ID’s conforming to a standard set by the system operator, the database storing content approved for distribution by the system operator and uniquely associated with a plurality of different merchants in a consistent format on a single server, the system allowing the system operator to control the selection of content available through the system on a product by product basis;

- the database further storing digital content including content provided by the merchant to which the content is uniquely associated and the system controlling access to the database such that each of the plurality of different merchants are allowed to load updates to content in the system that is uniquely associated with their respective merchant ID’s, but prevented from updating content uniquely associated with others of the plurality of different merchants; and the user interface allowing a user to download merchant specific digital content;

- the user interface further allowing a merchant product to be purchased through the system using data stored in the system that allows transfer of monetary value from the user to the system operator.

The Examiner’s Rejections

R1: Claims 29–48 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Final Act. 3.


R4: Claim 49 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Chan (US 6,381,603 B1; Apr. 30, 2002) and Rose (US 7,069,228 B1; June 27, 2006). Final Act. 15.

ANALYSIS

A. Rejection R1: Written Description

Claim 29 recites “whereby a user of the digital wireless communication device may engage in voice dialog while accessing the database.” Appellant argues this limitation is compliant with the written description requirement because of the disclosure in the Specification: “[t]he smart card of the present invention can also include cellular communication equipment 717 (also within casing 710) or be integrated into cellular communication equipment (detachably or permanently) so that the smart card can operate as a personal communication device.” App. Br. 8 (quoting Spec. ¶ 375). Appellant further contends that, “[b]ecause applicant has plainly described a device that includes both voice communication capability and touch screen selection capability, the written description requirement of this system claim has been met.” App. Br. 8.

We are not persuaded by Appellant’s arguments. The Examiner finds, and we agree, that “[t]he specification does not explicitly or implicitly disclose that a user of the digital wireless communication device may engage in voice dialog while accessing the database[] (as recited in claim 29).”
Final Act. 3. The Examiner further finds, and we agree that independent claims 29 and 38 “refer to the ability to allow voice and data communication while performing additional wireless communication (e.g., for a user to engage in a voice dialog while accessing a database),” and that “[i]t is not clear what the corresponding structure is actually programmed to do in order to make this possible.” Final Act. 5. Appellant’s argument that “the smart card is plainly described as a wireless communication device that can operate as a cell phone” (App. Br. 9) does not address the Examiner’s findings regarding the communications over two separate wireless networks required by the claims. Additionally, we note that Appellant’s Summary of Claimed Subject Matter does not provide a “concise explanation of the subject matter defined in each of the rejected independent claims” (see 37 C.F.R. § 41.20(c)(1)(iii)), as the independent claims are paraphrased; for example, the Summary points to no discernable support for the limitation of:

audio output and input equipment to allow voice and data communication on a digital cellular network and additional equipment to allow wireless data exchange over a network other than the digital cellular network whereby a user of the digital wireless communication device may engage in voice dialog while accessing the database

as appears in claim 29. See App. Br. 3–5.

Independent claim 42, however, does not contain the simultaneous cellular/other wireless communications that the Examiner relies on in the rejection, whereas dependent claims 43, 44, and 48 do contain this feature. Accordingly, we affirm the Examiner’s rejection of independent claims 29 and 38, and claims 30–37, and 39–41 that depend therefrom, and affirm the
Examiner’s rejection of dependent claims 43, 44, and 48. We reverse the
Examiner’s rejection of independent claim 42 and dependent claims 45–47.

B. Rejection R2: Enablement

The Examiner finds claim 29 does not comply with the enablement
requirement for the same limitation subject to the written description
rejection: “whereby a user of the digital wireless communication device
may engage in voice dialog while accessing the database.” Final Act. 6.
Appellant’s arguments repeat the written description argument (see App. Br.
10–11), and are not responsive to the Examiner’s enablement analysis of
claim 29 (see Ans. 22–24) as no Reply was filed. We agree with the
Examiner’s Wands analysis and find the analysis equally applicable to
independent claim 38, which recites “the user interface further allowing a
merchant product to be purchased through the system through the touch
selection display while the user is engaged in voice dialog through the
system using data,” as well as dependent claims 43, 44, and 48.

As discussed above, however, claim 42 does not contain the
simultaneous cellular/other wireless communications that the Examiner
relies on in the rejection, whereas dependent claims 43, 44, and 48 do
contain this feature. Accordingly, we affirm the Examiner’s rejection of
independent claims 29 and 38, and claims 30–37, and 39–41 that depend
therefrom, and affirm the Examiner’s rejection of dependent claims 43, 44,
and 48. We reverse the Examiner’s rejection of independent claim 42 and
dependent claims 45–47.
C. **Rejection R3: Indefiniteness**

The Examiner finds claims 29–49 are apparatus claims, and are indefinite for reciting functional language that is not limited to specific structure. Final Act. 11 (citing MPEP § 2114). For example, the Examiner finds that with respect to claim 29, “[t]he software is not clearly tied into limiting structure of the apparatus; therefore, it is unclear how Applicant intends for the software and its functionality to limit the scope of the claimed invention.” Final Act. 12.

We are persuaded by Appellant’s argument that the Examiner’s rejection relates to the “weight given to functional language, not the definiteness of the claims.” App. Br. 11; see also MPEP § 2114 (discussing patentability in relation to the prior art, not claim scope under 35 U.S.C. § 112); In re Miller, 441 F.2d 689, 693 (CCPA 1971) (“Breadth of a claim is not to be equated with indefiniteness.”). Accordingly, we reverse the Examiner’s indefiniteness rejection of claims 29–49.

D. **Rejection R4: Obviousness**

Appellant argues Chan fails to disclose “the system operator [controls] the selection of content available on the systems on a product by product basis” (App. Br. 13) and “Chan also fails to disclose a database storing digital content including content provided by the merchant to which the content is uniquely associated” (App. Br. 14). Appellant contends Rose

---

2 In the event of further prosecution, the Examiner may wish to consider whether the functional claim limitations should be interpreted as means plus function limitations, pursuant to 35 U.S.C. § 112, 6th paragraph. See MPEP §§ 2181–2186.
“does not teach or even remotely suggest a product distribution that includes a database storing data provided by the merchant that describes products available from the merchant that have been approved for distribution through the system by a system operator” (App. Br. 15), and that “[t]he systems of Rose and [Chan] are completely disparate and any attempt to combine select features from each would necessarily entail hindsight and completely alter the purpose, objective and system integrity of Chan.” App. Br. 15.

We are not persuaded of Examiner error. The Examiner finds, and we agree, that “Chan discloses that an information provider can request the update of information” and that the “maintained information includes merchandise information.” Ans. 25, citing Chan 2:18–53, 4:62–67. The Examiner further finds, and we agree, that “Chan discloses that merchant-specific merchandise data is stored in respective records in a relational database. Rose discloses additional functions to enhance interactions between a customer and merchant.” Ans. 25; see also Final Act. 17–19. Particularly, the Examiner finds that Rose’s “super-community” in which the merchant participates, “yields the benefits of increasing customer traffic to the merchant, providing electronic forums that result in wider advertising reach, attracting new customers that are more likely to be interested in the merchant’s services.” Final Act. 17, citing Rose 11:18–40.

Appellant makes conclusory statements without evidentiary support and does not persuasively argue the combination of the Rose and Chan fails to teach or suggest the limitations. For example, Appellant supplies no factual basis for the assertion that “the systems of Rose and [Chan] are completely disparate” and that their combination entails “hindsight” and
alters Chan. Appellant does not address and challenge the Examiner’s findings in the Answer as no Reply was submitted. Accordingly, we sustain the Examiner’s obviousness rejection of claim 49.

NEW GROUNDS OF REJECTION

Pursuant to our authority under 37 C.F.R. § 41.50(b), we enter new grounds of rejection and separately reject independent claim 42 under pre-AIA 35 U.S.C. § 103(a) as unpatentable over Rose and Chan. We find the subject matter of claim 42 does not differ materially from that of claim 49. For example, (1) the system of claim 42 includes “computer implemented software” that is omitted from claim 49, and (2) claim 42 references a “touch selection display” that is omitted from claim 49. Both Rose and Chan teach or suggest such computer implemented software and touch selection displays. See Rose Fig. 2, 4:51–52; Chan Figs. 1–3, 8:40–45. Thus, we find the combination of Rose and Chan teaches or suggests all limitations of claim 42. We incorporate the Examiner’s rejection of independent claim 49 (Final Act. 15–19, Ans. 25).

We note the Patent Trial and Appeal Board is a review body, rather than a place of initial examination. We have rejected independent claim 42 based on our authority under 37 C.F.R. § 41.50(b). We have not, however, reviewed dependent claims 43–48 to the extent necessary to determine whether those claims are unpatentable under 35 U.S.C. § 103(a). We leave it to the Examiner to ascertain whether claims 43–48 should be rejected on similar grounds to those set forth herein or in combination with additional prior art.
DECISION

The Examiner’s decision rejecting claims 29–41, 43, 44, and 48 under 35 U.S.C. § 112, first paragraph (written description and enablement) is affirmed.

The Examiner’s decision rejecting claims 42 and 45–47 under 35 U.S.C. § 112, first paragraph (written description and enablement) is reversed.


The Examiner’s decision rejecting claim 49 under 35 U.S.C. § 103(a) is affirmed.

We newly reject claim 42 under 35 U.S.C. § 103(a).

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 the Appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground 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 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). See 37 C.F.R. § 41.50(f).

AFFIRMED-IN-PART; 37 C.F.R. § 41.50(b)