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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte GEOFFRY A. WESTPHAL and MARY BEE PIETROWICZ

Appeal 2018-004146
Application 15/237,690
Technology Center 2600

BEFORE JEREMY J. CURCURI, JOSEPH P. LENTIVECH, and PHILLIP
A. BENNETT, *Administrative Patent Judges*.

JEREMY J. CURCURI, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from the
Examiner's decision to reject claims 1–15. We have jurisdiction under
35 U.S.C. § 6(b).

We REVERSE.

¹ We use the word Appellant to refer to “applicant” as defined in 37 C.F.R.
§ 1.42(a). Appellant identifies the real party in interest as W.W. Grainger,
Inc. Appeal Br. 2.

CLAIMED SUBJECT MATTER

The claims are directed to “us[ing] a current geographic location of a mobile device, such as a smart phone, tablet computer, or the like, to retrieve lists of and/or to facilitate the searching for one or more products, product related services, and/or other product related information.” Spec. 2:16–19.

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

1. A method for using a mobile device to provide access to at least one list of product related items, comprising:

determining a geographic location of the mobile device;

causing a selection guide to be presented on the mobile device, the selection guide comprising a plurality of selectable entries each for use in specifying a characteristic of a product;

using the determined geographic location to inhibit the use of one or more of the plurality of selectable entries of the selection guide;

receiving from the selection guide a specification of one or more characteristics of a product of interest, the one or more characteristics of the product of interest being provided via use of a corresponding one or more of the plurality of selectable entries of the selection guide the use of which were not caused to be inhibited;

using the specified one or more characteristics to retrieve from a data store information related to at least one product;
and

causing the mobile device to display in a user interface the information related to the at least one product.

REFERENCES

The prior art relied upon by the Examiner is:

Name	Reference	Date
Dunko	US 2007/0097929 A1	May 3, 2007
Scott	US 8,538,836 B1	Sept. 17, 2013
Hitaka	US 2002/0095352 A1	July 18, 2002
Sasankan	US 2012/0259732 A1	Oct. 11, 2012
Elliot	US 2010/0262554 A1	Oct. 14, 2010

REJECTIONS

Claims 1–4 are rejected under 35 U.S.C. § 103 as obvious over Dunko and Scott. Final Act. 3–7.

Claim 5 is rejected under 35 U.S.C. § 103 as obvious over Dunko, Scott, and Hitaka. Final Act. 7–8.

Claims 6–9 are rejected under 35 U.S.C. § 103 as obvious over Dunko, Scott, and Sasankan. Final Act. 8–10.

Claim 10 is rejected under 35 U.S.C. § 103 as obvious over Dunko, Scott, Sasankan, and Hitaka. Final Act. 10–11.

Claims 11–14 are rejected under 35 U.S.C. § 103 as obvious over Dunko, Scott, and Elliot. Final Act. 11–14.

Claim 15 is rejected under 35 U.S.C. § 103 as obvious over Dunko, Scott, Elliot, and Hitaka. Final Act. 14–15.

OPINION

Claims 1–4 as obvious over Dunko and Scott

The Examiner finds Dunko and Scott teach all limitations of claim 1. Final Act. 3–6. The Examiner finds Dunko teaches several claim limitations of claim 1 including “using the determined geographic location to inhibit the use of one or more of the plurality of selectable entries of the selection guide” as recited in claim 1. Final Act. 4; *see also* Dunko ¶ 8. The Examiner finds Scott teaches several claim limitations of claim 1 including “the

selection guide comprising a plurality of selectable entries each for use in specifying a characteristic of a product” as recited in claim 1. Final Act. 5; *see also* Scott Fig. 2. The Examiner reasons

it would have been obvious to one [of] ordinary skill in the art to modify Dunko’s method of using the location information available in the device to tailor the retrieval of electronic feed content with the selectable list of products using product characteristics and displaying of the information related to the product of interest on user mobile communication taught by Scott, in order to efficiently display[] the availability of products and product features that meet the customer’s needs without having to switch between separate web pages for each of the product features.

Final Act. 6 (citing Scott col. 3, ll. 23–29).

Among other arguments, Appellant presents the following principal arguments:

while Dunko describes using a location characteristic *to filter search results after search results are obtained by a remote content server*, Dunko does not disclose, teach, or suggest using location information *to inhibit* the ability of [the] user to specify characteristics that are to be used in the performance of the search for electronic content itself, i.e., in Dunko location information is not used by the system *to inhibit the ability of a user* to specify items, channels, required elements, optional elements, categories, etc. that are to be used by the remote content server in obtaining search results.

Appeal Br. 4; *see also* Reply Br. 2.

Appellant also argues that Scott does not disclose “using a determined geographic location to inhibit the use of one or more of a plurality of selectable entries of a selection guide provided to locate product of interest.”

Appeal Br. 5; *see also* Reply Br. 2–3 (“Scott may disclose using

unavailability of a product located during the performance of search to ‘inhibit and/or control’ how such search results may be filtered/displayed”).

In response, the Examiner explains Dunko inhibits content. *See* Ans. 2–3; *see also* Ans. 4–8. The Examiner further explains Scott teaches some characteristics are not selectable. *See* Ans. 4; *see also* Ans. 8–9. Further, the Examiner repeats the reasons to combine the references given in the Final Action. *See* Ans. 9–10.

In the Reply Brief, Appellant further argues

nothing within Scott discloses, teaches, or suggests modifying Dunko such that *location information* (as opposed to availability information) *is used to inhibit the characteristics that a user may specify* to a search engine for the purpose of retrieving electronic feeds in the first instance.

In view of the foregoing, it is respectfully submitted that the Examiner’s Answer continues to evidence that the rejection of the claims is based upon nothing more than the impermissible use of hindsight reasoning, i.e., it is evident that, absent **knowledge gleaned only from applicant’s disclosure**, one of skill in the art would never use the cited to and relied upon disclosures from Dunko and Scott to arrive at the exact invention claimed.

Reply Br. 3.

We review the appealed rejections for error based upon the issues identified by Appellant, and in light of the arguments and evidence produced thereon. *Ex parte Frye*, 94 USPQ2d 1072, 1075 (BPAI 2010) (precedential).

Dunko discloses “us[ing] location information available within the device to tailor the retrieval of electronic feed content.” Dunko ¶ 8. Thus, we find Dunko discloses “using the determined geographic location to inhibit” content retrieval. Claim 1.

Scott discloses “width identifier **142A** is shown in an outlined font indicating that the width ‘4A’ is not available for the selected shoes and the associated width icon **140** is not selectable.” Scott col. 11, ll. 56–60; *see also* Scott Fig. 2 (unselectable icon 142A). Thus, we find Scott discloses using product availability “to inhibit the use of one or more of the plurality of selectable entries of the selection guide.” Claim 1.

Accordingly, this appeal turns on whether the combined teachings of the references teach “using the determined geographic location to inhibit the use of one or more of the plurality of selectable entries of the selection guide” as recited in claim 1.

Appellant argues that the Examiner relies on improper hindsight. *See* Reply Br. 3. We agree with Appellant.

The Examiner is required to articulate a reasoning with a rational underpinning as to why one of ordinary skill in the art would have modified *Dunko*, in light of Scott, to “us[e] the determined geographic location to inhibit the use of one or more of the plurality of selectable entries of the selection guide” as recited in claim 1. However, the Examiner’s reasoning on page 6 of the Final Action (repeated on pages 9–10 of the Examiner’s Answer) does not meet this requirement.

The Examiner reasons that an ordinarily skilled artisan would have done so “in order to efficiently display[] the availability of products and product features that meet the customer’s needs without having to switch between separate web pages for each of the product features,” but we do not see how this reasoning results in the modifications to *Dunko* to meet the subject matter in claim 1. Final Act. 6. The cited portion of Scott (Scott col. 3, ll. 23–29) also does not enlighten us as to how the Examiner’s reasoning

results in the modifications to Dunko to meet the subject matter in claim 1. In short, Scott's selectable entries are inhibited based on availability, and the record does not establish why Dunko would have been modified to include such selectable entries *and then to inhibit such selectable entries based on geographic location*.

On the record before us, we agree with Appellant that the rejection uses impermissible hindsight, and lacks the required reasoning with a rational underpinning.

We, therefore, do not sustain the Examiner's rejection of claim 1. We also do not sustain the Examiner's rejection of claims 2–4, which depend from claim 1.²

The remaining rejections

The Examiner's remaining rejections do not cure the deficiency discussed above with respect to the rejection of claim 1. *See* Final Act. 7–15.

We, therefore, do not sustain the Examiner's rejections of claims 5–15 for the same reasons discussed above with respect to claim 1.

CONCLUSION

The Examiner's decision rejecting claims 1–15 is reversed.

² Our decision does not determine that the claim is patentable. Rather, our decision determines that the record before us does not establish that the claim is unpatentable.

DECISION SUMMARY

In summary:

Claims Rejected	35 U.S.C. §	Basis	Affirmed	Reversed
1–4	103	Dunko and Scott		1–4
5	103	Dunko, Scott, and Hitaka		5
6–9	103	Dunko, Scott, and Sasankan		6–9
10	103	Dunko, Scott, Sasankan, and Hitaka		10
11–14	103	Dunko, Scott, and Elliot		11–14
15	103	Dunko, Scott, Elliot, Hitaka		15
Overall Outcome				1–15

REVERSED