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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte FRANK DAVID SERENA

Appeal 2018-006115
Application 13/444,702
Technology Center 2100

Before ST. JOHN COURTENAY III, MATTHEW J. McNEILL, and
SCOTT E. BAIN, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant¹ appeals under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1–3 and 5–18, which constitute all the claims pending in this application. Claim 4 is cancelled. We have jurisdiction over the pending claims under 35 U.S.C. § 6(b).

We Affirm.

¹ We use the word “Appellant” to refer to Applicant as defined in 37 C.F.R. § 1.42(a). According to Appellant, the real party in interest is the Assignee, Sony Corporation. Br. 2.

STATEMENT OF THE CASE ²

Disclosed embodiments of Appellant’s invention relates to “content replacement, and more particularly to the replacement of an advertisement with another advertisement, other content, or no content.” Spec. 1, ll. 16–17.

Representative Claim

1. A non-transitory computer-readable medium storing an observation program comprising executable instructions that cause a processor to:

receive content which includes at least one information item;

observe the content to detect the at least one information item;

append a hyperlink relating to each information item of the detected at least one information item,

[L1] wherein the executable instructions that cause the processor to append the hyperlink include executable instructions that cause the processor to *append the hyperlink based on preferences of a user included in a user profile,*

[L2] *wherein the user profile includes a location of the user, a time the user accesses the content, and a history of interests of the user; and*

² We herein refer to the Final Office Action, mailed April 12, 2017 (“Final Act.”); Appeal Brief, filed Sept. 12, 2017 (“Br.”); the corrected Claims Appendix, filed Nov. 8, 2017, as a Supplemental Appeal Brief, the Answer, mailed Feb. 5, 2018 (“Ans.”). No Reply Brief was filed.

provide the observed content including the at least one information item and the hyperlink to a client device for presentation to a recipient of the content.

Claims Appendix, *see* page 3 of the Supplemental Appeal Brief, filed Nov. 8, 2017) (emphasis added regarding disputed limitations L1 and L2).

*Rejections*³

- A. Claims 1–3 and 5–18 are rejected under pre-AIA 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement.
- B. Claims 1, 5–8, and 12–18 are rejected under pre-AIA 35 U.S.C. § 103(a) as being obvious over the combined teachings and suggestions of Logan et al. (US 5,761,683; issued June 2, 1998) (“Logan”), in view of Gupta et al. (US 6,487,538 B1; issued Nov. 26, 2002) “Gupta”).
- C. Claims 2, 3, and 9–11 are rejected under pre-AIA 35 U.S.C. § 103(a) as being obvious over the combined teachings and suggestions of Logan, Gupta, and further in view of Merriman et al. (US 2002/0082923 A1; pub. June 27, 2002) (“Merriman”).

Grouping of Claims

Based upon Appellant’s arguments, and our discretion under 37 C.F.R. § 41.37(c)(1)(iv), we decide the appeal of § 103 Rejection B of

³ The Examiner withdrew the rejection of claims 1, 2, 5–7, and 18 under pre-AIA 35 U.S.C. § 112, second paragraph. *See* Final Act. 4; Ans. 9. Therefore, this rejection is not before us on appeal.

claims 1, 5–8, and 12–18 on the basis of representative claim 1. We separately address Rejections A and C, *infra*.

ANALYSIS

We have considered all of Appellant’s arguments and any evidence presented. We have reviewed Appellant’s arguments in the Appeal Brief, the Examiner’s rejections in the Final Action, and the Examiner’s responses in the Answer to Appellant’s arguments. On this record, Appellant provides sufficient argument and evidence to persuade us of error regarding the Examiner’s findings as applicable to Rejection A under pre-AIA 35 U.S.C. § 112, first paragraph (written description).

However, Appellant does not proffer sufficient argument and evidence to persuade us of error regarding the Examiner’s underlying factual findings and ultimate legal conclusion of obviousness for all claims 1–3 and 5–18 that are rejected under Rejections B and C. In our analysis below, we highlight and address specific findings and arguments for emphasis.

Rejection A of Claims 1–3 and 5–18 under 35 U.S.C. § 112, first paragraph

Issue: Under pre-AIA 35 U.S.C. § 112, first paragraph, did the Examiner err by rejecting claims 1–3 and 5–18, as failing to comply with the written description requirement?

We reproduce the claim 1 language added by amendment during prosecution that the Examiner finds does not have sufficient written description support: “wherein the user profile *includes a location of the user, a time the user accesses the content, and a history of interests of the user; . . .*” Claim 1 (emphasis added).

Regarding the written description requirement, the Examiner finds:

Regarding claim 1, there does not appear to be adequate support for the following newly amended/added limitation(s): “wherein the user profiles includes a location of the user, a time the user accesses the content **and** a history of interests of the user” in line(s) 11-13 (emphasis added). The specification discloses “generat[ing] a profile of the user that includes a location of the user, a time the user accesses content, **or** a history of user interests.” Specification at 9 (emphasis added). *The coordinating conjunction “and” used in the claim differs from the coordinating conjunction “or” disclosed in the specification.*

Final Act. 3 (emphasis added).

Appellant disagrees with the Examiner’s basis for the rejection:

However, cited passages of the present specification specifically state “For example, the preference server might generate a profile of the user that includes a location of the user, a time the user accesses content, **or** a history of user interests.” Although the specification uses “**or**”, based on the fact that the specification refers to it as being an example of the profile which includes a location of the user, a time the user accesses content, or a history of user interests, it can be construed that the profile of the user *may include any one or all of the listed items.*

Accordingly, the [A]ppellant submits that a prima facie case of non-compliance under 35 U.S.C. §112, first paragraph for claim 1 has not been presented.

Br. 6 (emphasis added).

To satisfy the written description requirement, the specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1562–63 (Fed. Cir.

1991). Specifically, the specification must describe the claimed invention in a manner understandable to a person of ordinary skill in the art and show that the inventor actually invented the claimed invention. *Id.* at 1562–63; *Accord Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (*en banc*). “[T]he level of detail required to satisfy the written description requirement varies depending on the nature and scope of the claims and on the complexity and predictability of the relevant technology.” *Ariad*, 598 F.3d at 1351. In particular, the written description requirement does not demand any particular form of disclosure “or that the specification recite the claimed invention *in haec verba*.” *Id.* at 1352. However, “a description that merely renders the invention obvious does not satisfy the requirement.” *Id.* (citing *Lockwood v. Am. Airlines*, 107 F.3d 1565, 1571–72 (Fed. Cir. 1997)).

Here, the original Specification expressly describes:

When generating the preferences, the preference server could observe information relating to the user and generate the preferences based on these observations. For example, the preference server might generate a profile of the user that *includes a location of the user, a time the user accesses content, or a history of user interests.*

Spec. 9, ll. 20–23 (emphasis added).

The only literal difference in language is that claim 1 recites “**and**” instead of “**or**” as used in the Specification (9, ll. 20–23). *Cf.* Claim 1: “wherein the user profile *includes a location of the user, a time the user accesses the content, and a history of interests of the user; . . .*” (emphasis added).

As noted above, the written description requirement does not demand “that the specification recite the claimed invention *in haec verba*.” *Ariad*,

598 F.3d at 1352. Because the Specification discloses at least the *minimal* three claim elements included in the user profile, i.e., the *user location, time of user access, and history of user interests*, we find sufficient written description to demonstrate *possession* of the invention claimed, regardless of whether the three elements are used in the alternative (“**or**”), or together in combination (“**and**”), as recited in claim 1.

Accordingly, we are constrained on this record to reverse the Examiner’s Rejection A of claims 1–3 and 5–18, under pre-AIA 35 U.S.C. § 112, first paragraph (written description).

Rejection B under pre-AIA § 103(a) of Claims 1, 5–8, and 12–18

Issue: Under 35 U.S.C. § 103(a), did the Examiner err by finding the cited combination of Logan and Gupta would have taught or suggested disputed limitations L1 and L2:

receive content which includes at least one information item;

observe the content to detect the at least one information item;

append a hyperlink relating to each information item of the detected at least one information item,

[L1] wherein the executable instructions that cause the processor to append the hyperlink include executable instructions that cause the processor *to append the hyperlink based on preferences of a user included in a user profile*,

[L2] *wherein the user profile includes a location of the user, a time the user accesses the content, and a history of interests of the user; and*

provide the observed content including the at least one information item and the hyperlink to a client device for presentation to a recipient of the content[.]

within the meaning of independent claim 1?⁴ (emphasis added regarding disputed limitations L1 and L2).

The Examiner reads limitations L1 and L2 on the combination of Logan and Gupta as follows:

Append[ing] the hyperlink based on preferences of a user included in a user profile. In Logan, replacement rules ("commands") are applied to the content. Logan col. 7-8. Logan does not explicitly disclose that replacement rules are applied based on preferences associated with user profile. However, in Gupta, content to be inserted into a document may be selected based on a preferences ("demographic information" and "user's preferences") stored in a user profile. See Gupta col. 8, 11. 49-52.

Wherein the user profile includes a location of the user, a time the user accesses the content, and a history of interests of the user. Logan does not explicitly disclose, but Gupta teaches that a user profile may store demographic information such as the user's location (i.e., "residence" time spent accessing the content, and interests. Gupta cols. 6, 8-10.

Final Act. 6 (emphasis omitted).

⁴ We give the contested claim limitations the broadest reasonable interpretation ("BRI") consistent with the Specification. *See In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997).

Appellant disagrees with the Examiner's findings, and contends:

Although the cited passage of Gupta states that "specific advertisement inserted is based on user information such as demographic information or the user's preferences", this is different than what is claimed in claim 1, for example.

Claim 1 recites that the hyperlink (not the information item) is appended based on preferences of a user including a location of the user, a time the user accesses the content, and a history of interests of the user. In fact, the process of inserting an ad into content has already been done before and it cannot be argued that appending hyperlink based on preferences of a user (as claimed in claim 1, for example) reads on the advertisement insertion process of Gupta.

Br. 12–13 (emphasis added).

However, Appellant's argument is not commensurate with the scope of the claim:

Claim 1 recites that the hyperlink (not the information item) is appended based on preferences of a user including a location of the user, a time the user accesses the content, and a history of interests of the user.

Br. 12 (emphasis added).

Under a broad but reasonable interpretation, we conclude claim 1 does not require the user preferences in the user profile to include *only* "a location of the user, a time the user accesses the content, and a history of interests of the user." Thus, we conclude the scope of claim 1 broadly encompasses appending the hyperlink based on user preferences that are not limited to the "location of the user, a time the user accesses the content, and a history of interests of the user," as included in the user profile. (emphasis added).

Appellant could have avoided this issue by amending the claim(s) to recite: “wherein the user profile [**consists only**] of a location of the user, a time the user accesses the content, and a history of interests of the user” (Claim 1, emphasis added).

Our reviewing court guides: “[t]hrough understanding the claim language may be aided by the explanations contained in the written description, it is important not to import into a claim limitations that are not a part of the claim.” *SuperGuide Corp. v. DirecTV Enters., Inc.*, 358 F.3d 870, 875 (Fed. Cir. 2004). “We have cautioned against reading limitations into a claim from the preferred embodiment described in the specification, even if it is the only embodiment described, absent clear disclaimer in the specification.” *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1369 (Fed. Cir. 2004).

Applying this guidance here, we conclude a broad but reasonable interpretation of representative claim 1 supports the Examiner’s response in the Answer:

The claim does not limit user profile to only containing location, time, and interest information. Furthermore the claim does mention any link or relationship between the “preferences of a user” and the location, time, and interest information stored in the user profile. Accordingly, there is no basis for Appellant's allegation that *the claim requires a hyperlink be appended based on preferences of a user* including [only] a location of the user, a time the user accesses the content, and a history of interests of the user.

Ans. 12 (emphasis added).

Because “applicants may amend claims to narrow their scope, a broad construction during prosecution creates no unfairness to the applicant or

patentee.” *In re ICON Health and Fitness, Inc.*, 496 F.3d 1374, 1379 (Fed. Cir. 2007) (internal citation omitted).

Appellant has not filed a Reply Brief in further rebuttal of the Examiner’s response. *See* Ans. 12. We decline Appellant’s invitation to import limitations from the Specification into the claims. On this record, we are not persuaded the Examiner’s readings of contested limitations L1 and L2 on the cited portions of Logan and Gupta are overly broad or unreasonable. *See* Final Act. 6; Ans. 12. For at least the aforementioned reasons, and based upon a preponderance of the evidence, we are not persuaded the Examiner erred in finding that the combination of Logan and Gupta teaches or suggests contested limitations L1 and L2 of representative claim 1.

Moreover, we are not persuaded that combining the respective familiar elements of the cited Logan and Gupta references in the manner proffered by the Examiner (Final Act. 6–7) would have been “uniquely challenging or difficult for one of ordinary skill in the art” at the time of Appellant’s invention. *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007) (citing *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007)).

Therefore, we sustain the Examiner’s obviousness Rejection B of independent representative claim 1. Grouped claims 5–8 and 12–18 are also rejected under Rejection B, and are not separately argued. Accordingly, these grouped claims under Rejection B fall with representative independent claim 1. *See* 37 C.F.R. § 41.37(c)(1)(iv).

Rejection C of claims 2, 3, and 9–11 under § 103(a)

Regarding Rejection C of dependent claims 2, 3, and 9–11, Appellant avers that “since Merriman does not disclose the base limitations of amended claim 1 as stated above, claims 2-3 and 9-11 should be allowable over the combination of Logan, Gupta, and Merriman.” Br. 13.

However, we fully address *supra* the specific reasons why we find the combination of Logan and Gupta teaches or at least suggests the disputed limitations, as discussed above regarding Rejection B of independent claim 1. Appellant advances no further separate, substantive arguments regarding the remaining claims that are rejected under Rejection C. Arguments not made are waived. *See* 37 C.F.R. § 41.37(c)(1)(iv). Accordingly, we sustain the Examiner’s obviousness Rejection C of dependent claims 2, 3, and 9–11.

CONCLUSIONS

The Examiner erred in rejecting claims 1–3 and 5–18, under pre-AIA 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement.

The Examiner did not err in rejecting claims 1–3 and 5–18, as being obvious under pre-AIA 35 U.S.C. § 103(a), over the combined teachings and suggestions of the cited references.

DECISION SUMMARY

Claims Rejected	Pre-AIA 35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1-3, 5-18	112, first paragraph	Written description		1-3, 5-18
1, 5-8, 12-18	103(a)	Logan, Gupta	1, 5-8, 12-18	
2, 3, 9-11	103(a)	Logan, Gupta, Merriman	2, 3, 9-11	
Overall Outcome			1-3, 5-18	

Because we have affirmed at least one ground of rejection with respect to each claim on appeal, the Examiner's decision is affirmed. *See* 37 C.F.R. § 41.50(a)(1).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED