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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* MARK JOSEPH GARDNER

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Appeal 2018-006755  
Application 13/706,071  
Technology Center 2100

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Before PHILLIP J. KAUFFMAN, JENNIFER S. BISK, and  
JULIET MITCHELL DIRBA, *Administrative Patent Judges*.

DIRBA, *Administrative Patent Judge*.

DECISION ON APPEAL<sup>1</sup>

Appellant<sup>2</sup> seeks our review under 35 U.S.C. § 134(a) of the Examiner’s rejection of claims 1–3, 5, 7–10, 12, 14–17, 19, 21, and 23–26. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

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<sup>1</sup> This Decision uses the following abbreviations: “Spec.” for the Specification, filed December 5, 2012; “Final Act.” for the Final Office Action, mailed August 11, 2017; “App. Br.” for the Appeal Brief, filed January 11, 2018; “Ans.” for the Examiner’s Answer, mailed April 20, 2018; and “Reply Br.” for the Reply Brief, filed June 20, 2018.

<sup>2</sup> Appellant identifies the real party in interest as eBay Inc. App. Br. 3.

## BACKGROUND

Appellant's invention relates to generating a search results page that allows a user to access a data item stored in an external system without navigating away from the search results page. Abstract.

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

1. A method comprising:
  - determining that a plurality of search result pages were generated in response to a plurality of enterings of a search term at a search engine by a plurality of users;
  - identifying that a portion of the plurality of users navigated away from the search results pages to a web site of a networked system that is external from the search engine, the networked system facilitating transactions pertaining to a plurality of items featured in a plurality of listings posted on the networked system;
  - identifying an action that the portion of the plurality of users typically performed with respect to the plurality of listings at the web site after navigating away from the search results pages to the web site;
  - identifying an additional entering of the search term by an additional user at the search engine; and
  - based on the portion of the plurality of users transgressing a predetermined threshold and the identifying of the action that the portion of users typically performed at the web site, generating an additional search results page in response to the additional entering of the search term by the additional user, the generating of the additional search results page including embedding, using a processor, a user interface in the additional search results page, the user interface providing the additional user with

an option to perform the action without navigating away from the additional search results page.

App. Br. 14 (Claims Appendix).

#### THE REJECTIONS

1. Claims 1–3, 5, 8–10, 12, 15–17, 19, 21, and 23–25 stand rejected under 35 U.S.C. § 103(a) as being obvious over Govani (US 2010/0293178 A1, published November 18, 2010) and Scofield (US 8,386,509 B1, filed June 30, 2006).<sup>3</sup> Final Act. 3–12.
2. Claims 7, 14, and 26 stand rejected under 35 U.S.C. § 103(a) as being obvious over Govani, Scofield, and Jain (US 2007/0050251 A1, published March 1, 2007).<sup>4</sup> Final Act. 12–13.
3. Claims 1, 8, and 15 stand alternatively rejected under 35 U.S.C. § 103(a)

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<sup>3</sup> Although claims 4, 11, and 18 are listed as rejected in the Answer (Ans. 3), Appeal Brief (App. Br. 6), and the Office Action (Final Act. 3), those claims were canceled in an Amendment filed prior to the Rejection on appeal. *See* Amendment filed July 6, 2017. Although claim 25 is not listed in the heading of the rejection, it is addressed in the body of the rejection, and Appellant recognized that claim 25 was rejected. Final Act. 3, 10–12; App. Br. 6.

<sup>4</sup> The Examiner lists Rejection 2 as including claim 25 (Final Act. 12, 13), but the Examiner discusses the contents of claim 26 instead of claim 25 (*id.* at 13). Appellant identifies Rejection 2 as including claim 26, rather than claim 25. App. Br. 6. As such, we consider the reference to claim 25 rather than claim 26 to be a typographical error. In addition, the Examiner did not list Scofield as a cited reference in Rejection 2 (Final Act. 12); however, the Examiner relied upon the combination of Govani and Scofield to reject independent claims 1 and 8 and dependent claim 25, from which claims 7, 14, and 26 depend. Appellant identifies Rejection 2 as including the Scofield reference. App. Br. 6. As such, we consider the lack of reference to Scofield in the heading to be a typographical error as well.

as obvious over Scofield in view of Govani. Final Act. 13–17.

## ANALYSIS

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).

We have considered all of Appellant’s arguments and any evidence presented. We highlight and address specific findings and arguments for emphasis in our analysis below.

### *Claims 1–3, 5, 8–10, 12, 15–17, 19, 21, and 23–25*

Appellant argues claims 1–3, 5, 8–10, 12, 15–17, 19, 21, and 23–25 together as a group. *See* App. Br. 7–10. Therefore, consistent with the provisions of 37 C.F.R. § 41.37(c)(1)(iv), we limit our discussion to independent claim 1. Claims 2, 3, 5, 8–10, 12, 15–17, 19, 21, and 23–25 stand or fall with claim 1.

The Examiner rejects claim 1 over a combination of Govani and Scofield. Final Act. 3–6. The Examiner relies on Govani as teaching most of the limitations of claim 1. The Examiner relies on a combination of Govani and Scofield as teaching “identifying an action that the portion of the plurality of users typically performed with respect to the plurality of listings at the web site after navigating away from the search results pages to the web site” (referred to in this Decision as the “identifying an action limitation”). And the Examiner relies solely on Scofield for teaching “based on the portion of the plurality of users transgressing a predetermined threshold” (referred to in this Decision as the “threshold limitation”). Final

Act. 3–6. The Examiner also relies on Scofield for providing a motivation to combine these features with Govani. Final Act. 6.

*“identifying an action that the portion of the plurality of users typically performed with respect to the plurality of listings at the web site after navigating away from the search results pages to the web site”*<sup>5</sup>

Appellant argues that the references fail to teach or suggest identifying an action that users performed on an external web site after navigating to that web site from search results. App. Br. 7–11. For this limitation, the rejection relies on a combination of Govani and Scofield. Final Act. 4–6 (citing Govani ¶ 32 and Scofield col. 40, ll. 54–64 & Fig. 17B, item 1702). The cited paragraph of Govani states:

Targeted information 318 illustrates a customer service phone number, which has been taken directly from the target search result and saved to a database for future retrieval. In this instance it has been previously determined that a customer service number is what many users are searching for when entering the query “amazon,” and therefore it is subsequently presented to users who enter the same query.

Govani ¶ 32. According to the Examiner, Scofield teaches identifying an action that users typically performed at an external website. Final Act. 6

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<sup>5</sup> Appellant also quotes another limitation of claim 1—“identifying that a portion of the plurality of users navigated away from the search results pages to a web site of a networked system that is external from the search engine, the networked system facilitating transactions pertaining to a plurality of items featured in a plurality of listings posted on the networked system.” See, e.g., App. Br. 7. Appellant’s arguments, however, are directed to the identifying an action limitation. We find Appellant does not show error with regard to this other limitation of claim 1.

(citing Fig. 17B); *see* Scofield Fig. 17B (“People are leaving this source to follow these paths: Content src D[;] Content src E.”) (emphasis removed).

First, Appellant argues that Govani does not teach or suggest identifying an action performed at an external website. App. Br. 7–8. In particular, Appellant notes that Govani teaches the generation of search results based on past user behavior and the creation of targeted information to associate with those search results, but Appellant argues that Govani does not indicate “how” it identifies that targeted information. App. Br. 7–9. The Examiner explains that it would have been obvious to analyze users’ past behavior at the search web page *and* at the web site(s) associated with the search results, using the disclosure of Scofield. Ans. 4–6. The Examiner reasons that “common behavior at the external site has to come first and be tracked” for Govani’s system to identify popular targeted information to provide with search results. Ans. 5. Appellant replies that the claim limitation is not obvious because Govani does not provide an express disclosure to this effect and there are “a variety of other ways” to identify the targeted information, for example “human knowledge” or “search results clicked by users in the search results page.” Reply Br. 3–4.

Appellant has not shown that the Examiner’s proposed modifications are beyond the level of skill of one of ordinary skill in the art, or that the modifications are more than the use of known elements to yield predictable results. The Appellant’s recitation of two other, potential ways that Govani could have identified targeted information does not demonstrate that the claims are nonobvious. *See KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 421

(2007) (explaining that obviousness may be shown where there are a “finite number of identified, predictable solutions”).

Second, Appellant argues that Scofield fails to cure the deficiencies of Govani because Scofield navigates between content sources, in contrast to the claim where “the action can be done without navigating away from the search results page.” App. Br. 10 (emphasis removed). However, the disputed claim language does not require “without navigating away”; rather, this phrase is found in a different claim limitation that has not been challenged on appeal. Accordingly, we are not persuaded by this argument. *See In re Sneed*, 710 F.2d 1544, 1550 (Fed. Cir. 1983) (“[I]t is not necessary that the inventions of the references be physically combinable to render obvious the invention under review.”).

Appellant does not persuade us of error in the Examiner’s finding. Govani improves search results using past user behavior, including actions taken at both its search result page (e.g., selecting a search result) and the search result’s external web site (e.g., how long a user stays on a webpage associated with a search result). Govani ¶ 26. Scofield tracks user request traffic to determine the most popular destinations for users leaving a particular content source. Scofield, col. 40, ll. 51–62; Fig. 17B. The Examiner explained, and we agree, that it would be obvious to use past user behavior at an external web site to improve the targeted information provided with the search results of Govani. Thus, we agree with the Examiner that a person of ordinary skill in the art would have found obvious the identifying an action limitation based on the combined disclosures of Govani and Scofield.

*“based on the portion of the plurality of users transgressing a predetermined threshold”*

Appellant contends that the references fail to teach or suggest the threshold limitation. The Examiner found that Scofield uses thresholds to evaluate user request traffic (*e.g.*, to determine a popular content source). Final Act. 6 (citing Scofield, col. 12, lines 13–21; col. 35, lines 61–65; col. 40, lines 52–60). The Examiner found that it would have been obvious to modify Govani “to include a predetermined threshold of a plurality of other users” because it “would help locate interest data for the most popular [] content sources.” Final Act. 6.

Appellant argues that Govani fails to teach or suggest a threshold and that Scofield does not use a threshold to provide “an action [] within a search results page based on a number of users who performed an action at a website after navigating to the website from [the] search results.” App. Br. 11–12.

Appellant does not address the Examiner’s rationale to combine the references to yield the threshold limitation. By arguing that neither Govani nor Scofield alone teaches all aspects of the limitation at issue, Appellant does not address the rejection as articulated, in which the Examiner relies on certain combined teachings of the prior art. *See* Final Act. 6; *see also In re Keller*, 642 F.2d 413, 425 (CCPA 1981) (“[T]he test [for obviousness] is what the combined teachings of the references would have suggested to those of ordinary skill in the art.”). We determine that the Examiner’s reasoning supports a *prima facie* case of obviousness for claim 1. *See In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

*Claims 7, 14, and 26*

The Examiner rejects claims 7, 14, and 26 over a combination of Govani, Scofield, and Jain. Final Act. 12–13. For each of these claims, Appellant relies on the same arguments made with respect to claim 1. App. Br. 12. These arguments however, are not persuasive for the reasons discussed above. Consequently, we find Appellant’s arguments do not show error in the Examiner’s factual findings and the conclusion of obviousness of claims 7, 14, and 26.

*Alternative Ground for Claims 1, 8, and 15*

The Examiner alternatively rejects claims 1, 8, and 15 over a combination of Scofield and Govani. Final Act. 13–17. For this Rejection, Appellant simply references arguments made with respect to claim 1 in Rejection 1. App. Br. 13. As discussed above, we find Appellant’s arguments do not show error in the Examiner’s factual findings and the conclusion of obviousness of claims 1, 8, and 15.

DECISION

We affirm the Examiner’s decision to reject claims 1–3, 5, 7–10, 12, 14–17, 19, 21, and 23–26.

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