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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* GEOFFRY A. WESTPHAL<sup>1</sup>

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Appeal 2019-003034  
Application 15/081,153  
Technology Center 2100

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Before JASON V. MORGAN, DEBORAH KATZ, and  
JOHN A. EVANS, *Administrative Patent Judges*.

EVANS, *Administrative Patent Judge*.

DECISION ON APPEAL  
STATEMENT OF THE CASE

This is a decision on appeal under 35 U.S.C. § 134(a) from the Examiner's Final Rejection of Claims 1–8, all claims on appeal. Appeal Br.

1. We have jurisdiction over the pending claims under 35 U.S.C. § 6(b).

We AFFIRM.

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

## INVENTION

The invention is directed to a method for providing personalized search results. *See* Abstract. Claim 1, reproduced below, is the sole independent claim and is representative of the invention.<sup>2</sup>

1. A method for providing personalized search results, the method comprising:

storing within a database for each of a plurality of users information related to an interaction with a one or more opt-out elements associated with a direct marketing email electronically sent to each of the plurality of users wherein the stored information is cross-referenced to a unique user identifier for each of the plurality of users;

receiving at a server device from a user device associated with a one of the plurality of users a search request for searching an electronic catalog;

using by the server device a unique user identifier for the one of the plurality of users to locate within the database information related to interaction by the one of the plurality of users with a one or more opt-out elements associated with a direct marketing email;

providing by the server device to a search engine associated with the electronic catalog the search request received from the one of the plurality of users and information related to interaction by the one of the plurality of users with a one or more opt-out elements associated with a direct marketing email as located within the database;

using by the search engine the provided search request to generate an electronic search result wherein the electronic

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<sup>2</sup> Claim 5 recites, inter alia, “[t]he computer-readable media as recited in claim 1.” Claim 1 does not recite “computer-readable media.” Should prosecution continue, the Examiner is encouraged to determine whether Claim 5 has proper antecedent basis.

search result comprises a plurality of items within the electronic catalog and the provided information related to interaction by the one of the plurality of users with a one or more opt-out elements associated with a direct marketing email as located within the database to personalize the generated electronic search result wherein one or more items from the plurality of items within the electronic catalog are removed from the generated electronic search result; and

causing the server device to electronically transmit the personalized search result to the user device for display on a display associated with the user device as a response to the received search query.

#### PRIOR ART

Name	Reference	Date
Bostock	US 8,312,009 B1	Filed Nov. 13, 2012
Huynh	US 8,296,378 B2	Filed Oct. 23, 2012

#### REJECTIONS<sup>3</sup> AT ISSUE<sup>4</sup>

Claims 1–8 stand rejected under 35 U.S.C. § 103(a) over Huynh and Bostock. Final Act. 3–7.

#### ANALYSIS

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<sup>3</sup> The present application is being examined under the pre-AIA first to invent provisions. Final Act 2.

<sup>4</sup> Throughout this Decision, we refer to the Appeal Brief (“Appeal Br.”) filed November 9, 2018, the Reply Brief (“Reply Br.”) filed March 7, 2019, the Final Office Action (“Final Act.”) mailed August 13, 2018, the Examiner’s Answer mailed January 9, 2019, and the Specification (“Spec.”) filed March 25, 2016.

We have reviewed the rejections of Claims 1–8 in light of Appellant’s arguments that the Examiner erred. We have considered in this Decision only those arguments Appellant actually raised in the Briefs. Any other arguments which Appellant could have made but chose not to make in the Briefs are deemed to be waived. *See* 37 C.F.R. §41.37(c)(1)(iv). We provide the following explanation to highlight and address specific arguments and findings primarily for emphasis. We consider Appellant’s arguments as they are presented in the Appeal Brief and the Reply Brief.

CLAIMS 1–8: OBVIOUSNESS OVER HUYNH AND BOSTOCK.

*Search engine.*

Claim 1, the sole independent claim, recites, *inter alia*: “providing by the server device to a search engine associated with the electronic catalog the search request received from the one of the plurality of users” and “using by the search engine the provided search request to generate an electronic search result.”

Appellant contends Huynh is directed to an email delivery system and that the Examiner finds Huynh does not explicitly disclose, teach, or suggest “a search engine.” Appeal Br. 5. Appellant argues:

because the Office has failed to provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art, it cannot be said that Huynh inherently discloses a “search engine.”

*Id.* Appellant further argues because Huynh fails to teach or suggest a search engine, Huynh must further fail to teach or suggest “a server device providing anything to a search engine.” Appeal Br. 7.

The Examiner finds Huynh does not explicitly teach a search engine, but that “[t]he process of identifying ‘digital content elements’ fig. 6 item 604 is consider a searching process, and thus, is considered inexplicitly read on ‘a search engine.’” Ans. 3. The Examiner finds Bostock was introduced to teach search engines are well-known in the art. *Id. See* Final Act. 2 (“Huynh is the primary reference, which teaches majority of claim limitations. Bostock is introduced to show that search engine is well known in the art. So applicant’s argument does not stand as to argument against search engine.”).

Appellant contends disclosure of a “search engine” does not teach or suggest the specific, claimed properties of the search engine. *See* Appeal Br. 7 (because Huynh fails to teach or suggest a search engine, Huynh must further fail to teach or suggest “a server device providing anything to a search engine.”). Appellant argues:

no explanation or reasoning has been provided to explain how or why this disclosure within Huynh, reads on that which is claimed, i.e., “using by the search engine the provided search request to generate an electronic search result wherein the electronic search result comprises a plurality of items within an electronic catalog and the provided information related to interaction with the one of the plurality of users with a one or more opt-out elements . . .”

Reply Br. 2.

We find the Examiner has synthesized the “search engine” limitation from the combined teachings of Huynh and Bostock, but that Appellant argues the limitations separately. “[O]ne cannot show non-obviousness by attacking references individually where . . . the rejections are based on combinations of references.” *In re Keller*, 642 F.2d 413, 426 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed.Cir.1986).

*Motivation to combine Huynh and Bostock.*

In response to Appellant’s contention that there is no reason to combine Huynh and Bostock, the Examiner finds:

In response to the Applicant’s arguments, that “reasons to combine,” the argument has been fully considered but is not found to be persuasive, because the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of “ordinary skill in the art.”

Ans. 4 (citing *In re Fine*<sup>5</sup> and *In re Jones*<sup>6</sup>). The Examiner further finds: Huynh and Bostock are analogous art because they are from the “same field of endeavor” and both from the same “problem-solving area.” Namely, they are both from the field of “user preference data.” *Id.*

Appellant argues the reasoning the Examiner provides fails “to provide . . . articulated reasoning with some rational underpinning” to show that the combination would have been obvious. Reply Br. 2. Thus, Appellant argues the Examiner’s “conclusion of obviousness is based upon nothing more than impermissible use of hindsight reasoning.” *Id.* at 2–3. But the Examiner’s findings show that the claimed invention merely represents the combination of familiar elements according to known methods to yield predictable results. See Final Act. 4–5; Ans. 4; *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 416 (2007). We are not persuaded that the Examiner relies on improper hindsight reasoning and we, therefore, are not persuaded of error in the Examiner’s rejection.

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<sup>5</sup> *In re fine*, 837 F.2d 1071 (Fed. Cir. 1988).

<sup>6</sup> *In re Jones*, 958 F.2d 347 (Fed. Cir. 1992).

CONCLUSION

In summary:

Claims Rejected	35 U.S.C. §	References	Affirmed	Reversed
1-8	103	Huynh, Bostock	1-8	--

TIME PERIOD FOR RESPONSE

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