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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ROY SHKEDI

Appeal 2020-001216
Application 15/893,354
Technology Center 3600

Before MAHSHID D. SAADAT, ALLEN R. MacDONALD and IRVIN E. BRANCH, *Administrative Patent Judges*.

MacDONALD, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant[1] appeals from a Final Rejection of claims 34–61. Appeal Br. 12. Appellant has cancelled claims 1–33. Final Act. 2. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

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[1] Appellant identifies the real party in interest as Datonics, LLC. Appeal Br. 1.

CLAIMED SUBJECT MATTER

Claim 34 is illustrative of the claimed subject matter (emphasis, formatting, and bracketed material added):

> 34. A method of causing delivery of electronic advertisements based on provided profiles comprising:
>
> (a) with a computer system automatically storing, in a central database associated with the computer system, profile information associated with a visitor, as a result of electronic receipt from a profile owner computer of indicia of the profile information, which profile information associated with the visitor matches a profile or kind of profiles ***requested by an entity controlling the computer system***, wherein a tag associated with a visitor device serves as a link to the profile information associated with the visitor;
>
> (b) wherein the profile owner computer is programmed:
>
> (i) to automatically select a ***media property entity*** of a plurality of media property entities based on a comparison of
>
> [(A)] profile information about a visitor who electronically accessed electronic apparatus of a profile supplier
>
> with
>
> [(B)] a plurality of stored requests from the plurality of ***media property entities***,
>
> ***one of which media property entities is the entity controlling the computer system***, each stored request being for requested profiles or kinds of profiles, which plurality of stored requests includes the profile or kind of profiles ***requested by the entity controlling the computer system***, and

(ii) to automatically arrange for electronic storage of a requested profile linked to a tag that is associated with the visitor device and that is readable by ***equipment controlled by the selected media property entity***,

which equipment is part of the computer system of part (a) when ***the selected media property entity is the entity controlling the computer system***, and

which tag is the tag of part (a) when ***the selected media property entity is the entity controlling the computer system***; and

(c) later, when the visitor device is available to receive an advertisement, with the computer system,

(i) using the tag of part (a) that is associated with the visitor device to access the profile information stored in the central database, and

(ii) using the profile information linked to the tag of part (a) to automatically cause delivery of an electronic advertisement to the visitor device, wherein the electronic advertisement is dependent on the profile information associated with the visitor.

REFERENCES[2]

The Examiner relies on the following references:

Name	Reference	Date
Horowitz	US 2005/0097204 A1	May 5, 2005
Kublickis	US 2007/0067297 A1	Mar. 22, 2007
Jaschke	US 2007/0130005 A1	June 7, 2007

[2] All citations herein to patent and pre-grant publication references are by reference to the first named inventor only.

REJECTIONS

A.

The Examiner rejects claims 34–37, 39, 41–43, 45, 47–51, 53–56, 58, 60, and 61 under 35 U.S.C. § 103 as being unpatentable over the combination of Kublickis and Jaschke. Final Act. 5–17.

We select claim 34 as the representative claim for this rejection. The contentions discussed herein as to claim 34 are determinative as to this rejection. Therefore, except for our ultimate decision, we do not address the merit of the § 103 rejection of claims 35–37, 39, 41–43, 45, 47–51, 53–56, 58, 60, and 61 further herein.

B.

The Examiner rejects claims 38, 40, 44, 46, 52, 57, and 59 under 35 U.S.C. § 103 as being unpatentable over the combination of Kublickis, Jaschke, and Horowitz. Final Act. 18–23.

We select claim 49 as the representative claim for this rejection. The contentions discussed herein as to claim 34 are determinative as to this rejection. Therefore, except for our ultimate decision, we do not address the merit of the § 103 rejection of claims 38, 40, 44, 46, 52, 57, and 59 further herein.

OPINION

We have reviewed the Examiner's rejections in light of Appellant's arguments that the Examiner has erred. Appellant's contentions we discuss are determinative as to the rejections on appeal. Therefore, Appellant's other contentions are not discussed in detail herein.

A.

The Examiner determines as to the above "media property entity" of claim 34:

> **Media Property** and **Media Property entity** do appear to be given an "explicit" and "clear" definition in the specification and from a reading of this definition the two terms appear to be synonymous with each other. Provisional Specification (60/805,114) at pg. 5 provides the following definition:
>
> > "*. . . a media property for this application could also be defined as any entity that controls an ad space viewed by a visitor. This definition of a media property will therefore include a web site, an ad network of sites where the ad network represents the ad space of different sites, a TV program, a cable company that represents some of the ad space within TV programs or TV channels, a TV network, any entity allowed to sell an advertisement and deliver it within an advertisement space whether the ad space is owned by that entity or whether the entity pays the owner of the ad space when using its ad space to deliver an ad sold by the entity. Ad space could be on a web site, in a TV program, in a text message, in a radio show, in any broadcasted material, in any streaming video or audio etc*."

Final Act. 4 (formatting added).

B.

Appellant contends that the Examiner erred in rejecting claim 49 under 35 U.S.C. § 103 because:

> Appellant proposes that the Board construe "media property equipment" as "equipment, which is part of the computer system that controls an ad space viewed by a visitor, at least temporarily" and "media property entity" as "an entity that controls media property equipment (as defined above)."
>
> . . .

The specification, at page 5, lines 1–27, contains the following explanation and definition, supporting the proposed definition:

> Because the purpose of the tag is to enable the delivery of additional ads on other media properties visited by the visitor, and because the delivery of an ad requires only control of the ad space and not necessarily control of the entire media property visited by the visitor, a media property (in the present context) can also be defined as any equipment that controls an ad space viewed by a visitor, including a web site, an ad network's site (where the ad network represents the ad space of different sites), a TV program, some of the ad space within TV programs or TV channels (represented by a cable company), a TV network, or any ad space for which an entity is allowed to sell an advertisement and deliver it within the ad space; whether the ad space is owned by that entity, or whether the entity pays the owner of the ad space when using its ad space to deliver an ad sold by the entity. Ad space can be on a web site, in a TV program, in a text message, in a radio show, in any broadcasted material, in any streaming video or audio, etc.

Appeal Br. 6–7.

The specification later says, on page 8, lines 5-6: "A low-value ad space owner could be any media property owner, whether it owns a web site, a TV program, a radio show, or any other media property." On line 23 of page 8, the specification similarly ***refers to "a media property (if acting as a profile owner)*** . . . ." Those page 8 citations indicate that the specification uses the term "media property" in some contexts to refer to an "owner" (entity), whereas the above quotation on page 5 of the specification uses the term "media property" in the context of "equipment." ***To avoid confusion, appellant crafted the claims to distinguish between "media property entity" and "media property equipment." Which of the two is being***

> ***referenced at various points in the specification is clear from context.*** The Final Office Action says that "media property" and "media property entity" are "two terms [that] appear to be synonymous with each other." Although that is not exactly true, the usage (owner vs. equipment) is parallel in the specification, and appellant's proposed construction defines one by reference to the other.

Appeal Br. 8.

C.

As articulated by the Federal Circuit, the Examiner's burden of proving non-patentability is by a preponderance of the evidence. *See In re Caveney*, 761 F.2d 671, 674 (Fed. Cir. 1985) ("preponderance of the evidence is the standard that must be met by the PTO in making rejections"). "A rejection based on section 103 clearly must rest on a factual basis[.]" *In re Warner*, 379 F.2d 1011, 1017 (CCPA 1967). "The Patent Office has the initial duty of supplying the factual basis for its rejection. It may not . . . resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis." *Id.* We conclude the Examiner's analysis fails to meet this standard because the Examiner's determination that the two terms "media property entity" and "media property equipment" are ***synonymous*** with each other is not properly founded. Thus, the Examiner's findings of fact as to the "media property entity" are based on error as to the definition of that term.

D.

We agree with Appellant that the terms "media property entity" and "media property equipment" are distinct. We determine that "media property entity" (shortened to "entity" at page 5 of the Specification) refers to an "owner" in a legal/business context; and "media property equipment"

refers to hardware or hardware/software such as a web site, a computer, a mobile device, a TV set, a TV set top box, or any other device (Spec. 5) in a technology context.

We conclude, consistent with Appellant's arguments that there is insufficient articulated reasoning to support the Examiner's finding that Kublickis or Jaschke discloses the argued "media property entity" claim limitations, as required by claim 34. Therefore, we conclude that there is insufficient articulated reasoning to support the Examiner's final conclusion that claim 34 would have been obvious to one of ordinary skill in the art.

E.

We have determined that the "media property entity" and "media property equipment" are distinct and are not synonymous. For this reason alone, the Examiner's articulated reasoning is insufficient. However, for example, Figure 1 of Jaschke teaches an advertiser entity 110 and advertiser equipment 132 as distinct items. Similarly, a profiler entity 100 and profiler equipment 131 are distinct items.

We recommend that the Examiner reevaluate the appropriateness of a rejection under 35 U.S.C. § 103 based on the teachings of the Kublickis, Jaschke, and Horowitz references in light of the proper claim construction.

CONCLUSION

Appellant has demonstrated the Examiner erred in rejecting claims 34–61 as being unpatentable under 35 U.S.C. § 103.

The Examiner's rejections of claims 34–61 as being unpatentable under 35 U.S.C. § 103 are **reversed**.

DECISION SUMMARY

In summary:

Claims Rejected	**35 U.S.C. §**	**Reference(s)/Basis**	**Affirmed**	**Reversed**
34–37, 39, 41–43, 45, 47–51, 53–56, 58, 60, 61	103	Kublickis, Jaschke		34–37, 39, 41–43, 45, 47–51, 53–56, 58, 60, 61
38, 40, 44, 46, 52, 57, 59	103	Kublickis, Jaschke, Horowitz		38, 40, 44, 46, 52, 57, 59
Overall Outcome				34–61

REVERSED