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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT ANDREW BYERS JR.,
DAN PEARSON,
MARK CONNER, and
JENNIFER HAMILTON

Appeal 2010-004416
Application 09/892,800
Technology Center 3600

Before MURRIEL E. CRAWFORD, ANTON W. FETTING, and BIBHU R. MOHANTY, *Administrative Patent Judges.*

FETTING, *Administrative Patent Judge.*

DECISION ON APPEAL[1]

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[1] The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the "MAIL DATE" (paper delivery mode) or the "NOTIFICATION DATE" (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE[2]

Robert Andrew Byers Jr., Dan Pearson, Mark Conner, and Jennifer Hamilton (Appellants) seek review under 35 U.S.C. § 134 (2002) of a final rejection of claims 1-2, 5, 8-9, 15-16, 18-19, 21-30, 32-33, and 35-42, the only claims pending in the application on appeal. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b) (2002).

The Appellants invented methods of selling healthcare products via a preloaded, user-specific template on the Internet. Specification 1:5-7.

An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below [bracketed matter and some paragraphing added].

> 1. A method for selling products over an electronic network, wherein said steps of said method are performed by a seller computer that electronically communicates with a buyer computer via the electronic network, said method comprising the steps of:
>
> [1] identifying a user;

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[2] Our decision will make reference to the Appellants' Appeal Brief ("App. Br.," filed June 23, 2009) and the Examiner's Answer ("Ans.," mailed November 12, 2009), and Final Rejection ("Final Rej.," mailed August 19, 2008).

[2] transmitting a user specific order entry form to the buyer computer, said order entry form comprising at least one user specific product, a user specific price for said at least one product, and a quantity entry field, wherein said user specific order entry form comprises a user specific purchase history form comprising all products that were purchased during a specified time period, and wherein said quantity entry field is the only field on said user specific order entry form in which entry of data by said user is required to purchase said at least one product;

[3] receiving a quantity of at least one product entered into said quantity entry field by said user and sent from the buyer computer;

[4] transmitting a shopping cart to the buyer computer, said shopping cart comprising each of said at least one product selected by the user; and

[5] receiving an instruction from said user to process an order from the buyer computer.

The Examiner relies upon the following prior art:

Barnes	US 5,970,475	Oct. 19, 1999
Willner	US 2002/0065736 A1	May 30, 2002
Gavarini	US 7,080,070 B1	Jul. 18, 2006
Wong	US 6,343,275 B1	Jan. 29, 2002

Claims 1-2, 5, 8-9, 15-16, 18-19, 21-30, 32-33, and 35-42[3] stand rejected under 35 U.S.C. § 103(a) as unpatentable over Barnes and Willner.

[3] The Examiner has omitted claim 8 in the statement of the rejection, however, has addressed claim 8 in the body of the rejection. Ans. 4 and 6. As such, we consider the omission of claim 8 from the statement of rejection as a mere typographical error.

Claims 1-2, 5, and 9 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Barnes and Gavarini.

Claim 8, 15-16, 18-19, 21-30, 32-33, and 35-42 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Barnes, Gavarini, and Wong.

ISSUES

The issue of whether the Examiner erred in rejecting claims 1-2, 5, 8-9, 15-16, 18-19, 21-30, 32-33, and 35-42 under 35 U.S.C. § 103(a) as unpatentable over Barnes and Willner turns on whether the Declaration of Kenneth R. Taylor is sufficient to rebut the Examiner's *prima facie* case of obviousness.

The issue of whether the Examiner erred in rejecting claims 1-2, 5, and 9 under 35 U.S.C. § 103(a) as unpatentable over Barnes and Gavarini turns on whether the Declaration of Kenneth R. Taylor is sufficient to rebut the Examiner's *prima facie* case of obviousness.

The issue of whether the Examiner erred in rejecting claims 8, 15-16, 18-19, 21-30, 32-33, and 35-42 under 35 U.S.C. § 103(a) as unpatentable over Barnes, Gavarini, and Wong turns on whether the Declaration of Kenneth R. Taylor is sufficient to rebut the Examiner's *prima facie* case of obviousness.

FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are believed to be supported by a preponderance of the evidence.

Facts Related to the Prior Art

Barnes

01. Barnes is directed to a procurement system and method for trading partners which enables a plurality of users within a purchasing organization to procure goods/services from pre-arranged suppliers, consistent with the level of authorization given to each user and enables automated payments to the supplier by a bank after the goods/services have been delivered. Barnes 1:7-14. When a user selects the option to purchase items, the user can create a new requisition request, repeat an old requisition request, or select a template. Barnes 22:46-49. When selecting to repeat an old requisition request, the user is prompted to select a request to repeat and edit that request as necessary. Fig. 11.

Willner

02. Willner is directed to a computerized system for ordering goods and/or services via an organization's internal computer network. Willner ¶ 0003. Willner is concerned with providing a system that minimizes human intervention. Willner ¶ 0008. Willner describes an e-procurement system that allows users with predetermined access codes to access product catalogs of vendors and make purchases based on their access codes. Willner ¶'s 0010-0012. Users can set up frequently purchased item lists and

the system can create a list for the users based on the users' history of purchases. Willner ¶ 0020.

Gavarini

03. Gavarini is directed to a system and method for assisting customers in locating items and generating orders from a merchant's electronic catalog. Gavarini 2:15-19.

Wong

04. Wong is directed to business-to-business web commerce and to business automation systems. Wong 1:15-16.

ANALYSIS

Claims 1-2, 5, 8-9, 15-16, 18-19, 21-30, 32-33, and 35-42 rejected under 35 U.S.C. § 103(a) as unpatentable over Barnes and Willner

The Appellants contend that the Declaration Kenneth R. Taylor is sufficient to fully rebut the Examiner's prima facie case of obviousness and place the application in condition for allowance. App. Br. 12. The Appellants specifically argue that the Taylor Declaration provides evidence that Barnes fails to describe specific limitations recited in the claims and that a person with ordinary skill in the art would not have been motivated to combine Barnes and Willner. App. Br. 14-24. The Examiner found that the Taylor Declaration sets forth opinion and fails to set forth factual evidence. Ans. 18-24.

We agree with the Examiner. The Declaration by Kenneth R. Taylor has been fully considered but is not deemed to be persuasive.

> The Board has broad discretion as to the weight to give to declarations offered in the course of prosecution. See *Velander v. Garner*, 348 F.3d 1359, 1371 (Fed. Cir. 2003)("[A]ccord[ing] little weight to broad conclusory statements [in expert testimony before the Board] that it determined were unsupported by corroborating references [was] within the discretion of the trier of fact to give each item of evidence such weight as it feels appropriate.") cf. *Ashland Oil, Inc. v. Delta Resins & Refactories, Inc.,* 776 F.2d 281, 294 (Fed. Cir. 1985)("Opinion testimony rendered by experts must be given consideration, and while not controlling, generally is entitled to some weight. Lack of factual support for expert opinion going to factual determinations, however, may render the testimony of little probative value in a validity determination." (citations omitted)). Although there is "no reason why opinion evidence relating to a fact issue should not be considered by an examiner," *In re Alton*, 76 F.3d 1168, 1175 n.10 (Fed. Cir. 1996). The Board is entitled to weigh the declarations and conclude that the lack of factual corroboration warrants discounting the opinions expressed in the declarations. See *Velander*, 348 F.3d at 1371; *Ashland Oil*, 776 F.2d at 294.

In re American Academy of Science, 367 F.3d 1359, 1368 (Fed. Cir. 2004).

Here, the Taylor Declaration sets forth the opinion that Barnes fails to describe a purchase history form (Declaration ¶ 5). However, Barnes describes that a user can repeat a previous purchase request. FF 01. The system then pre-populates a request form including all of the items from the previous request. FF 01. The repeat request provides a list of all of the items purchased during the last purchase, which is a specified time. Although the Declaration states that this is not a specified time period (Declaration ¶ 5), the claims do not narrow the scope of a specified time period, or how it is specified, and as such Barnes' requisition is within the scope of this broadly recited feature.

The Declaration also states that a person with ordinary skill in the art would not be motivated to modify Barnes or combine Barnes and Willner (Declaration ¶'s 6-7) and Willner teaches away from a user specific order entry form (Declaration ¶ 8). However, Barnes and Willner are both concerned with procurement systems that facilitate a user's ability to purchase products. FF 01-02.

Barnes describes a system that allows a user to repeat requisition requests, where the requisition request form is populated with the items associated with a previous purchase. FF 01. Willner also solves this problem by describing a system that allows users to create frequently purchased item lists or the system creates frequently purchased items lists based on users' shopping history. FF 02. A person with ordinary skill in the art would have found it obvious to combine Barnes and Willner and such a combination would have predictable results since both references are concerned with the solving the same problem and describe similar systems.

Although the Declaration states that Willner teaches away from the claimed user specific order entry because Willner does not provide a means for the user to view prior purchases (Declaration ¶ 8), Willner does describe that a frequently purchased item list can be created and viewed by a user. FF 02.

Although Mr. Taylor states that his opinion is based on facts (Declaration ¶'s 5-8), the conclusory statements in the Declaration are merely factual representations of his opinion. The Appellants fail to provide any further evidence or rationale pointing to where these statements are supported by facts. After evaluating and weighing all of the evidence, the

Declaration is considered to be insufficient to rebut the Examiner's *prima facie* case of obviousness.

The Appellants also contend that the Taylor Declaration provides evidence that the Appellants identified and solved a problem that had gone unrecognized prior to their invention. App. Br. 14. We disagree with the Appellants. The Appellants only provide a statement in the Taylor Declaration that Mr. Taylor believes that the Appellants have solved a long felt need in the art. Declaration ¶ 9. There is no factual evidence to support this conclusion. The Appellants further fail to provide a nexus between any factual evidence of a long felt need and the claims.

There must be a demonstrated "nexus" between the merits of the claimed invention and the evidence of secondary considerations before that evidence is accorded substantial weight in an obviousness determination. *Simmons Fastener Corp. v. Illinois Tool Works, Inc.*, 739 F.2d 1573, 1575 (Fed. Cir. 1984), cert. denied 471 U.S. 1065 (1985); *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1539 (Fed. Cir. 1983); see also *In re Huang*, 100 F.3d 135, 140 (Fed. Cir. 1996); *In re Fielder*, 471 F.2d 640, 646 (CCPA 1973). "Nexus" is a legally and factually sufficient connection between the objective evidence and the claimed invention, such that the objective evidence should be considered in determining nonobviousness. *Demaco Corp. v. F. Von Langsdorff Licensing Ltd.*, 851 F.2d 1387, 1392 (Fed. Cir. 1988). In the absence of an established nexus with the claimed invention, secondary consideration factors such as commercial success, satisfaction of a long-felt but unresolved need, licensing and copying by others are not entitled to much, if any, weight and generally have no bearing on the legal

issue of obviousness. See *In re Vamco Mach. & Tool, Inc.*, 752 F.2d 1564, 1577 (Fed. Cir. 1985).

After evaluating and weighing all of the evidence relied upon by the Examiner and provided by the Appellants, we find that the Appellants' evidence is insufficient to rebut the Examiner's *prima facie* case of obviousness.

The Appellants further contend that none of the cited references describe a user specific purchase history form comprising all products that were purchased during a specified time period, or provides any suggestion to modify the Barnes reference to include such a feature. App. Br. 22. We disagree with the Appellants.

This argument is nothing more than a general allegation that those limitations are not described by the prior art. "It is not the function of this court to examine the claims in greater detail than argued by an appellant, looking for nonobvious distinctions over the prior art." *In re Baxter Travenol Labs,* 952 F.2d 388, 391 (Fed. Cir. 1991). *See also In re Wiseman,* 596 F.2d 1019, 1022 (CCPA 1979) (arguments must first be presented to the board). A general allegation that the art does not teach any of the claim limitations is no more than merely pointing out the claim limitations. A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim. 37 C.F.R. § 41.37(c)(1)(vii).

Claims 1-2, 5, and 9 rejected under 35 U.S.C. § 103(a) as unpatentable over Barnes and Gavarini

The Appellants contend that these claims are allowable for the same reasons discussed *supra*. We disagree with the Appellants. The Appellants' arguments were not found to be persuasive *supra* and are not found to be persuasive here for the same reasons.

Claim 8, 15-16, 18-19, 21-30, 32-33, and 35-42 rejected under 35 U.S.C. § 103(a) as unpatentable over Barnes, Gavarini, and Wong

The Appellants contend that these claims are allowable for the same reasons discussed *supra*. We disagree with the Appellants. The Appellants' arguments were not found to be persuasive *supra* and are not found to be persuasive here for the same reasons.

CONCLUSIONS OF LAW

The Examiner did not err in rejecting claims 1-2, 5, 8-9, 15-16, 18-19, 21-30, 32-33, and 35-42 under 35 U.S.C. § 103(a) as unpatentable over Barnes and Willner.

The Examiner did not err in rejecting claims 1-2, 5, and 9 under 35 U.S.C. § 103(a) as unpatentable over Barnes and Gavarini.

The Examiner did not err in rejecting claims 8, 15-16, 18-19, 21-30, 32-33, and 35-42 under 35 U.S.C. § 103(a) as unpatentable over Barnes, Gavarini, and Wong.

DECISION

To summarize, our decision is as follows.

- The rejection of claims 1-2, 5, 8-9, 15-16, 18-19, 21-30, 32-33, and 35-42 under 35 U.S.C. § 103(a) as unpatentable over Barnes and Willner is sustained.
- The rejection of claims 1-2, 5, and 9 under 35 U.S.C. § 103(a) as unpatentable over Barnes and Gavarini is sustained.
- The rejection of claims 8, 15-16, 18-19, 21-30, 32-33, and 35-42 under 35 U.S.C. § 103(a) as unpatentable over Barnes, Gavarini, and Wong is sustained.

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) (2007).

AFFIRMED

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