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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* TIM RUIZ and ROBERT PARSONS

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Appeal 2012-009704  
Application 10/407,967  
Technology Center 2100

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Before KEVIN F. TURNER, STEPHEN C. SIU, and JUSTIN T. ARBES,  
*Administrative Patent Judges.*

SIU, *Administrative Patent Judge.*

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1, 3, 4, 6, and 8-10. Claims 2, 5, 7, and 11-19 have been cancelled. We have jurisdiction under 35 U.S.C. § 6(b).

The disclosed invention relates generally to systems and processes for registering domain names (Spec. 5).

Claim 1 reads as follows:

1. A system comprising:
  - A) a web page on a registrar website configured to receive a requested domain name;

B) one or more zone file server computers communicatively coupled to a network and comprising an internal database containing one or more domain names registered with one or more registries, wherein the one or more domain names were parsed from one or more zone files downloaded regularly from the one or more registries by the one or more zone file server computers;

C) one or more web servers communicatively coupled to the network and comprising:

i) a check availability service software displayed on the web page and configured to send a domain availability check request, responsive to receiving the requested domain name; and

ii) a zone file check service software communicatively coupled to the zone file server and configured to query the internal database for the requested domain name without contacting a registry and responsive to receiving the domain availability check request from the check availability service software, wherein, responsive to finding the requested domain name in the internal database, the web page displays that the domain name is not available, and wherein, responsive to not finding the requested domain name in the internal database, the requested domain name is searched in one or more registry databases hosted by each of the one or more registries and the results are displayed on the web page.

The Examiner relies upon the following references as evidence in support of the rejections:

Gardos	US 6,745,248 B1	Jun. 1, 2004 (filed Aug. 2, 2000)
Fellman	US 2002/0065903 A1	May 30, 2002
Hickman	US 6,996,609 B2	Feb. 7, 2006 (filed Apr. 28, 1997)

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The Examiner rejects claims 8 and 9 under 35 U.S.C. § 112, 1<sup>st</sup> paragraph as failing to comply with the written description requirement; claims 1, 4, 8, and 10 under 35 U.S.C. § 103(a) as unpatentable over Fellman and Gardos; and claims 3, 6, and 9 under 35 U.S.C. § 103(a) as unpatentable over Fellman, Gardos, and Hickman.

### ISSUES

Did the Examiner err in rejecting claims 1, 3, 4, 6, and 8-10?

### PRINCIPLES OF LAW

Under the written description requirement of 35 U.S.C. § 112, the disclosure of the application relied upon must reasonably convey to the artisan that, as of the filing date of the application, the inventor had possession of the later claimed subject matter. *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563 (Fed. Cir. 1991).

The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966).

“The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 416 (2007).

## ANALYSIS

### Written Description

Claim 8 recites files that are optimized by parsing one or more domain names and one or more corresponding websites from the one or more zone files. Claim 9 depends from claim 8. The Examiner states that the Specification lacks “support for the concept of parsing a corresponding website” (Ans. 5) while Appellants argue that the Specification discloses that “[z]one files, containing all the registered domain names *with their corresponding web sites*, may be periodically downloaded from the Registries” (App. Br. 10) (citing Spec., pg. 5, ll. 27-30).

To the extent that one of ordinary skill in the art would have understood that downloading data includes parsing data, we agree with Appellants that the Specification discloses “parsing” data including websites.

The Examiner erred in rejecting claims 8 and 9 under 35 U.S.C. § 112, 1<sup>st</sup> paragraph as failing to comply with the written description requirement.

Obviousness

Appellants assert that “neither [Fellman nor Gardos] teaches . . . an internal database” (App. Br. 11). Claim 1 recites an “internal database” that contains domain names parsed from zone files downloaded regularly from registries. As the Examiner points out, Gardos discloses “download[ing] the root zone file . . . directly from the Registry . . . and [utilizing] the downloaded root zone file data” (col. 4, ll. 14-16) (Ans. 28). Gardos also discloses that “[a]fter downloading, the root zone file data may be stored” (col. 4, l. 57). Since the data in Gardos is stored, one of ordinary skill in the art would have understood that the data are stored in a particular location or within a particular structure, such as a database. Appellants have not provided sufficient evidence that the database of Gardos differs from the database as recited in claim 1.

Appellants also assert that Fellman and Gardos fail to disclose data being “parsed from one or more zone files” (App. Br. 11), but Appellants do not indicate that the Specification provides a specialized definition of the term “parse.” In the absence of such a definition, we construe the term “parse” broadly but reasonably as would have been understood by one of ordinary skill in the art and in light of the Specification to include any activity involving the analysis or identification of data. Gardos discloses identifying data in a root zone file associated with a Registry (by utilizing

queries and “analyzing” the data) and downloading the identified data.<sup>1</sup> Appellants have not indicated a meaningful difference between identifying data of Gardos, for example, and data “parsed from one or more zone files” as recited in claim 1.

Also, Appellants state that the Specification discloses “zone files . . . may be periodically downloaded . . .” (App. Br. 10) and equates the downloading of files to “zone file information . . . [being] parsed and ‘stored in an internal database . . .’” (App. Br. 10). Hence, Appellants appear to state that “parsing” data is “downloading” data. Gardos discloses downloading data (e.g., “[d]ownloading an authoritative zone file” – Abstract). Hence, even utilizing Appellants’ alternative construction, we cannot agree that Gardos fails to disclose parsed data.

Appellants argue that Gardos merely discloses an “unparsed zone file” (App. Br. 11), which would “defeat the purpose of parsing the domain names” (*id.*). We disagree with Appellants at least because Appellants have not adequately demonstrated that Gardos fails to suggest “parsed data” (i.e., data which are analyzed or identified, as broadly but reasonably construed), as described above.

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<sup>1</sup> “. . . at least some entities . . . have direct access to the root zone file . . . [q]ueries could be directed into the root zone file and the data analyzed in that manner . . .” (col. 4, ll. 29-32); “[a]fter downloading, the root zone file data may be stored on a data server” (col. 4, ll. 57-59).

Appellants also argue that Fellman and Gardos fail to suggest querying “without contacting a registry” (App. Br. 11). However, as the Examiner indicates (Ans. 8-9), Gardos discloses “downloaded root zone file data” (col. 5, l. 42) and performing “[s]tring searches . . . on the root zone data file” (col. 5, ll. 44-45) to identify desired data “in the downloaded root zone file” (col. 5, ll. 47-48). In other words, Gardos discloses downloading data from a Registry, then searching the downloaded data. Appellants have not demonstrated that Gardos discloses searching (or “contacting”) the Registry. We therefore are not persuaded by Appellants’ argument.

Appellants also argue that Fellman and Gardos fail to disclose querying the database for a requested domain name “responsive to” receiving a request, as recited in claim 1 (see, e.g., App. Br. 12). However, as indicated by the Examiner (Ans. 29-31), Gardos discloses identifying a “search characteristic” and performing “a string search . . . in the downloaded root zone file” (e.g., col. 2, ll. 65-67). One of ordinary skill in the art would have understood that the “search characteristic” of Gardos would have been obtained in a “request” for the characteristic being searched since “requests” include such inquiries. Likewise, one of ordinary skill in the art, being “a person of ordinary creativity, not an automaton” (*KSR*, 550 U.S. at 421), would have understood that the search for the desired characteristic of Gardos would have been performed in response to the request for the desired characteristic since the desired characteristic is, in



fact, being searched. Appellants have not provided sufficient evidence to the contrary.

Appellants also argue that, while Fellman discloses “displaying an unavailable domain name” (App. Br. 12), the combination of Fellman and Gardos fails to disclose or suggest “displaying the unavailability of a domain name responsive to finding the requested domain name in an internal database” because, according to Appellants, “Fellman fails to teach . . . an internal database and Gardos fails to teach . . . finding a domain name in an internal database” (App. Br. 12). However, as previously described and in contrast to Appellants’ assertion, Gardos discloses “finding a domain name in an internal database.” Therefore, we are not persuaded by Appellants’ argument. In any event, the Examiner relies on the combination of Fellman and Gardos rather than any one of Fellman or Gardos alone. For this additional reason, we find unavailing Appellants’ arguments, even if assumed to be true, that each of Fellman and Gardos individually fails to disclose separate and distinct claim features.

Appellants also argue that Fellman and Gardos fail to disclose or suggest “databases being searched responsive to not finding the requested domain in the internal database” (App. Br. 12). However, as we stated in our previous decision regarding this issue:

The Examiner points to the downloading of the Registry in Gardos, with its inherent economies of speed and cost, and the more up-to-date searching of the Registry itself taught by Fellman, and states that it would be obvious to combine both

teachings to get the advantages of both, to wit search the cheaper method first, and if one does not get a ‘hit’ then go to the Registry . . . A closer review of Gardos shows that both methods are actually taught by that reference alone (col. 4, ll. 27-35). Gardos then states the speed and sophistication advantages of the download method (col. 4, l. 38) but recognizes that the data is not up-to-date (col. 4, l. 24). Considering all these teachings, we do not consider it erroneous to find that Gardos (and Fellman) provide sufficient teaching to render obvious the claimed process.

(Decision on Appeal, Appeal No. 2008-4504, Application 10/407,967, p. 12)

Appellants provide additional arguments regarding the alleged failure of Fellman and Gardos to disclose or suggest an internal database (see, in general, App. Br. 13-14), parsed data (App. Br. 16-18), querying the internal database (App. Br. 19-20), and the Examiner’s alleged reliance on “inherency” (App. Br. 14-15). We disagree with Appellants for at least the reasons set forth above and in the Examiner’s response (see Ans. 38-55).

Appellants argue that “[t]he art used by Examiner teaches away from the present invention” (App. Br. 21). “A reference may be said to teach away when a person of ordinary skill, upon [examining] the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.” *Para-Ordnance Mfg., Inc. v. SGS Importers Int’l, Inc.* 73 F.3d 1085, 1090 (Fed. Cir. 1995) (quoting *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994)).

Appellants argue Gardos “teaches away from the concept of querying an internal database” (App. Br. 21). However, as set forth above and as indicated by the Examiner, Gardos discloses querying an internal database. Gardos cannot “teach away” from a disclosure that Gardos provides. Further, even assuming (without deciding) that Appellants’ characterization of Fellman and Gardos is correct, Appellants’ have not indicated how either Fellman or Gardos discourages one of ordinary skill in the art from “following the path” set out in either reference or would lead one of ordinary skill in the art in a “divergent” direction (i.e., querying a database). We therefore are not persuaded by Appellants’ argument.

Claims 4, 8, and 10 recite similar features. Appellants do not provide additional arguments with respect to Hickman or in support of claims 3, 6, or 9, which depend from claims 1, 4, or 8.

## CONCLUSIONS

Based on the findings of fact and analysis above, we conclude that the Examiner erred in rejecting claims 8 and 9 under 35 U.S.C. § 112, 1<sup>st</sup> paragraph, and did not err in rejecting claims 1, 4, 8, and 10 under 35 U.S.C. § 103(a) as unpatentable over Fellman and Gardos and claims 3, 6, and 9 under 35 U.S.C. § 103(a) as unpatentable over Fellman, Gardos, and Hickman.

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### DECISION

We reverse the Examiner's rejection of claims 8 and 9 under 35 U.S.C. § 112, 1<sup>st</sup> paragraph, and affirm the Examiner's rejections of claims 1, 3, 4, 6, and 8-10 under 35 U.S.C. § 103(a). 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)(1)(iv).

AFFIRMED