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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MARK BECK

Appeal 2012-011007[1]
Application 10/447,823[2]
Technology Center 3600

Before JOSEPH A. FISCHETTI, NINA L. MEDLOCK, and CYNTHIA L. MURPHY, *Administrative Patent Judges*.

MEDLOCK, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1–5 and 7–32. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

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[1] Our decision references Appellant's Appeal Brief ("App. Br.," filed November 29, 2011) and Reply Brief ("Reply Br.," filed July 23, 2012), and the Examiner's Answer ("Ans.," mailed May 23, 2012).
[2] Appellant identifies the inventor, Mark Beck, as the real party in interest. App. Br. 3.

CLAIMED INVENTION

Appellant's claimed invention "relates generally to promotions and more particularly to sponsored promotions for consumer opportunities" (Spec. 1, ll. 4–5).

Claim 1, reproduced below, is the sole independent claim and is representative of the subject matter on appeal:

> 1. A computer-implemented method comprising:
> at a sponsor website comprising at least one server:
> receiving information from at least one property-related services provider regarding the at least one property-related services provider;
> receiving information from the at least one property-related services provider regarding at least one property consumer as corresponds to the at least one property-related services provider; and
> providing a redeemable-coupon-related promotion that:
> at least identifies the at least one property-related services provider, and
> corresponds to a consumer opportunity regarding at least one of goods and services as offered for sale by a sponsor of the sponsor-website wherein the sponsor is other than the at least one property-related services provider and wherein the goods and services are not offered by the at least one property-related services provider.

REJECTIONS[3]

Claim 1 is rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

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[3] The rejection of claim 1 under 35 U.S.C. § 112, second paragraph, has been withdrawn. Ans. 13.

Claims 1–5, 7–10, 12–17, 20–24, and 26–28 are rejected under 35 U.S.C. § 103(a) as unpatentable over Brown (US 2004/0030631 A1, pub. Feb. 12, 2004), Fogelson (US 7,254,553 B2, iss. Aug. 7, 2007), and Lowery (US 2003/0093287 A1, pub. May 15, 2003).[4]

Claims 11, 18, 19, and 25 are rejected under 35 U.S.C. § 103(a) as unpatentable over Brown, Fogelson, Lowery, and Official Notice.

Claims 29–32 are rejected under 35 U.S.C. § 103(a) as unpatentable over Brown, Fogelson, Lowery, and Forward (US 6,578,011 B1, iss. June 10, 2003).

ANALYSIS

Written Description

In rejecting claim 1 under 35 U.S.C. § 112, first paragraph, the Examiner finds that there is no support in the Specification for "wherein the sponsor is other than the at least one property-related services provider and wherein the goods and services are not offered by the at least one property-related services provider," as recited in claim 1 (Ans. 4–5). The Examiner acknowledges that paragraph 24 of the Specification discloses:

> The property-related service provider can comprise, for example, a realtor. In such an example, the sponsored website can facilitate provision of, for example, a discount coupon for building materials offered for sale by the sponsoring commercial enterprise, which discount coupon also presents the name and/or other identifying indicia as correlates to the realtor (paragraph 24).

[4] We treat, as inadvertent error, the Examiner's identification of claims 35–37 in the "***Claim Rejections - 35 USC § 103***" at page 5 of the Answer. These claims were canceled in an Amendment filed June 1, 2011.

Id. at 4. But the Examiner concludes, "[t]he specification does not teach *wherein the sponsor is other than the at least one property -related service provider and wherein the goods and services are not offered by the at least one property -related service provider*" (*id.*).

Appellant asserts that the § 112 rejection is improper and that paragraphs 23 and 24 of the Specification provide "written description support for the claimed expression that the goods and services offered by the sponsor '**are not offered**' by the at least one property-related services provider" (App. Br. 7).[5] Appellant further maintains that the claimed expression is taken verbatim from paragraph 28 of the Specification, which explicitly describes "'a promotion offered by a sponsor (typically a sponsor ***other than*** the property-related services provider)'" (Reply Br. 3).[6]

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[5] Paragraph 23 states that "[t]he sponsored website . . . facilitates provision of a promotion that at least identifies the at least one property-related services provider and that also corresponds to a consumer opportunity as offered by the sponsor." And paragraph 24 discloses a scenario in which the sponsor is a commercial business that sells building materials, construction tools, repair tools, household appliances, landscaping tools, landscaping materials, and/or interior furnishings, and the property-related service provider is a realtor. According to Appellant, paragraph 24, thus, makes clear that the claimed sponsor (i.e., a hardware store) is "other than" the property-related service provider (i.e., a realtor) and the goods and services sold by the sponsor are not "offered for sale" by the property-related services provider (App. Br. 6).

[6] Paragraph 28 reads:

> [**0028**] Referring now to the illustrations, and in particular to **FIG. 1**, a sponsor website (existing, in a preferred embodiment, on the World Wide Web of the Internet) can be configured in a variety of known (or hereafter developed) ways to essentially facilitate these basic activities: receiving **10** information regarding property-related services providers, receiving **11** information regarding property consumers as corresponds to these property-

Whether a specification complies with the written description requirement of 35 U.S.C. § 112, first paragraph, is a question of fact and is assessed on a case-by-case basis. *See, e.g.*, *Purdue Pharma L.P. v. Faulding, Inc.*, 230 F.3d 1320, 1323 (Fed. Cir. 2000) (citing *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1561 (Fed. Cir. 1991)). The disclosure, as originally filed, need not literally describe the claimed subject matter (i.e., using the same terms or *in haec verba*) in order to satisfy the written description requirement. But the Specification must convey with reasonable clarity to those skilled in the art that, as of the filing date, Appellant was in possession of the claimed invention. *See id.* *See also Lockwood v. Am. Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997) (The Specification need not provide verbatim support but "the specification must contain an equivalent description of the claimed subject matter"). Moreover, any negative limitation or exclusionary proviso must have basis in the original disclosure. *See Santarus, Inc. v. Par Pharm., Inc.*, 694 F.3d 1344, 1351 (Fed. Cir. 2012) ("Negative claim limitations are adequately supported when the specification describes a reason to exclude the relevant limitation.").

Here, we agree with Appellant that the Specification, specifically paragraphs 23, 24, and 28, conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, Appellant was in possession of the invention as now claimed, including providing, at a sponsor website, a redeemable-coupon-related promotion that identifies a property-related

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> related services providers, and providing **12** a promotion offered by a sponsor (*typically a sponsor other than the property-related services provider*) that also identifies the property-related services provider that corresponds to the respective property consumer. . . .

(Emphasis added).

services provider and corresponds to goods and/or services offered for sale by the website sponsor "wherein the sponsor is other than the . . . property-related services provider and . . .the goods and services are not offered by the . . . property-related services provider," as recited in claim 1.

Therefore, we do not sustain the Examiner's rejection of claim 1 under 35 U.S.C. § 112, first paragraph.

Obviousness

Appellant argues that the Examiner erred in rejecting independent claim 1 under 35 U.S.C. § 103(a) because none of Brown, Fogelson, and Lowery discloses or suggests "at a sponsor website comprising at least one server . . . providing a redeemable-coupon-related promotion," as recited in claim 1 (App. Br. 9). The Examiner maintains that the rejection is proper, and that Brown discloses the argued limitation in at least paragraphs 28–31 (Ans. 6). We agree with Appellant.

Brown is directed to a system and method for assisting buyers interested in renting, leasing, acquiring, or selling real property in selecting appropriate real estate properties, and for facilitating cooperation among various parties that contribute to the selection, transaction, and associated services (Brown, Abstract). Brown discloses real estate transaction system 100, with reference to Figure 1, and describes that the central coordinating element in the system is real estate server 102 (*id.* ¶ 26). Other participants include realtor-reseller 104, which establishes a reseller agreement with real estate server 102 and communicates a commitment of a selling commission discount (*id.*); promotional alliance partner 112, which provides services of interest to potential customers of various realtor-resellers 104, e.g., information about real estate available for sale or rent;

home repair supplies; and home repair services (*id.* ¶ 27); and buyer 114, who wants to acquire, i.e., purchase, rent, lease, or otherwise identify and perform a real property transaction pertaining to, a certain type of real property (*id.* ¶ 28)

Brown discloses in paragraph 28 that in one exemplary embodiment, buyer 114 notices a promotion of promotional alliance partner 112, e.g., an offer to receive real estate related services at a discounted price; buyer 114 can respond to the offer by "clicking on an appropriate actuator on a world wide web site configured for this purpose . . . or by signaling the response by filling in a coupon at a retail outlet of a promotional partner." Buyer 114 is then directed to a personalized web page or portal 120 on real estate server 102 where the buyer registers by supplying relevant personal information and information about the real property in which buyer 114 is interested (*id.* ¶ 29).

The Examiner equates promotional alliance partner 112 to the claimed sponsor (*see* Ans. 15), which indeed is an entity, disclosed in the cited portions of Brown, that provides a redeemable promotion that "corresponds to a consumer opportunity regarding at least one of goods and services as offered for sale by a sponsor." However, claim 1 requires that the sponsor website provide the "redeemable-coupon-related promotion," and, as Appellant points out, the sponsor website in Brown is real estate server 102, not promotional alliance partner 112 (Reply Br. 7). We find nothing in the cited portions of Brown that discloses or suggests that real estate server 102 "provid[es] a redeemable-coupon-related promotion," as recited in claim 1 (*see id.*).

Therefore, we do not sustain the Examiner's rejection of claim 1 under 35 U.S.C. § 103(a).

The remaining rejections of dependent claims 2–5 and 7–32 based on Brown, Fogelson, and Lowery in combination with Official Notice or Forward do not cure the deficiency in the Examiner's rejection of claim 1. Therefore, we also do not sustain the Examiner's rejections of claims 2–5 and 7–32 under 35 U.S.C. § 103(a).

DECISION

The Examiner's rejection of claim 1 under 35 U.S.C. § 112, first paragraph, is reversed.

The Examiner's rejections of claims 1–5 and 7–32 under 35 U.S.C. § 103(a) are reversed.

REVERSED

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