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The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DANIEL E. ROSE, JEREMY J. BORNSTEIN,
KEVIN TIENE and DULCE B. PONCELEON

Appeal No. 1998-0630
Application 08/231,655

ON BRIEF

Before URYNOWICZ, THOMAS and FRAHM, Administrative Patent Judges.

FRAHM, Administrative Patent Judge.

DECISION ON APPEAL

Appellants have appealed to the Board from the examiner's final rejection of claims 1 to 30, which constitute all of the claims in the application on appeal before us here.

BACKGROUND

The subject matter on appeal is directed to the field of information access in multiuser computer

systems, and more particularly to a system and method for ranking and displaying to a user the relevance of information which is accessed. As indicated in the specification (page 2), prior art systems are known to rank information in order of relevance to a particular user based on content. Appellants recognized that the prior art suffered from the problem that known information relevance predicting techniques failed to utilize community feedback as a factor in making a prediction/ranking of relevance of information (specification, page 3). To overcome this problem, appellants provide a system and method for obtaining feedback information provided by users when an item of information is retrieved, thereby providing user correlation data which can be used along with content data to rank the item of information in order of relevance (specification, page 4).

As further discussed, infra, we find that the examiner has failed to make out a prima facie case of obviousness with respect to claims 1 to 30 on appeal.

Representative independent claim 1 is reproduced below:

1. In a computerized information access system, a method for presenting items of information to users, comprising the steps of:
 - a) storing user profiles for users having access to the system, where each user profile is based, at least in part, on the attributes of information the user finds to be of interest;
 - b) determining an attribute-based relevance factor for an item of information which is indicative of the degree to which an attribute of that item of information matches the profile for a particular user;
 - c) determining a measure of correlation between the particular user's interests and those of other users who have accessed said item of information;

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d) combining said relevance factor and said degree of correlation to produce a ranking score for said item of information;

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e) repeating steps b, c and d for each item of information to be presented to said particular user; and

f) displaying the items of information to the user in accordance with their ranking scores.

The following references are relied on by the examiner:

Yourick	4,775,935	Oct. 4, 1988
Chang et al. (Chang)	5,321,833	Jun. 14, 1994 (filed Aug. 29, 1990)
Scannell et al. (Scannell)	5,377,354	Dec. 27, 1994 (effectively filed Aug. 13, 1990)

Sheth, B., Maes, P., PROCEEDINGS OF THE 9TH IEEE CONFERENCE ON ARTIFICIAL INTELLIGENCE FOR APPLICATIONS, "Evolving Agents for Personalized Information Filtering," pp. 345 to 352 (March 5, 1993) (Sheth).

Claims 1 to 30 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner relies upon Scannell in view of Sheth, Yourick, and Chang.

Rather than repeat the positions of appellants and the examiner, reference is made to the Brief and the Answer for the respective details thereof.

OPINION

It is our view, after consideration of the record before us, that the examiner has failed to make out a prima facie case of obviousness under 35 U.S.C. § 103. In reaching our conclusion on the issues raised in this appeal, we have carefully considered appellants' specification and claims, the applied references, and the respective viewpoints of appellants and the examiner. As a consequence of our review, we find that the examiner has failed to meet his burden of adequately showing that Scannell in

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view of Sheth, Yourick, and Chang taught or would have suggested the combination of features of claims 1 to 30 on appeal of a computerized information access system and method for presenting items to users in order of ranking or relevance. Accordingly, we will reverse the examiner's decision rejecting claims 1 to 30 on appeal as being obvious under 35 U.S.C. § 103.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d

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1443, 1444 (Fed. Cir. 1992). Furthermore, when a rejection depends, as it does in the instant case on appeal, on a combination of prior art references, the PTO must show that there is some teaching, suggestion, or motivation to combine references. In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988); see also In re Geiger, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987). The Federal Circuit has stated that "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." In re Fritch, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992)(citing In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984)). "Obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor." Para-Ordnance Mfg. v. SGS Importers Int'l, Inc., 73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995)(citing W. L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1551, 1553, 220 USPQ 303, 311, 312-13 (Fed. Cir. 1983)).

We find that the examiner, at pages 2 to 8 of the Answer, has not met his burden of establishing a prima facie case of obviousness. The examiner has failed to establish a factual basis to support the legal conclusion of obviousness. In particular, the examiner has failed to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and the examiner has failed to provide a reason why one having ordinary skill in the pertinent art would have been led to modify Scannell or to combine Scannell, Sheth, Yourick, and Chang to arrive at the

claimed invention. No motivation or rationale has been provided by the examiner as to how or why the applied references would be combined except to say that "such a system will provide a measure of correlation with other users and a ranking system, thus providing improved filtering and ease of creating individual profile" (Final Office action, page 3). We note that only appellants' specification (see page 4) discusses the need for correlation with other users as a basis for providing a ranking of information, and the examiner's reliance upon such motivation constitutes hindsight.

In addition, we agree with appellants (Brief, pages 6 to 7) that the examiner has failed to point to some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art which would have led the artisan to combine the applied references other than to say that they are combinable because all of the references pertain to information accessing systems having information filtering features (Answer, pages 5 to 6). We agree with appellants (Brief, page 7) that "it is not at all apparent how the features of the Yourick patent, which pertain to a video merchandising system, can be considered to be related to the electronic mail messaging system of the Scannell et al patent or the news filtering system of the Sheth et al publication." Furthermore, we agree with appellants (Brief, page 7) that "[t]he mere fact that, at a very superficial level, the references can all be considered to relate to information access" does not constitute a prima facie case of obviousness.

We agree with appellants (Brief, page 6) that "[t]here is no disclosure in any of the references

which suggests that their teachings should be combined in the manner set forth in the final Office action," and in particular there are no reasons why the ordinary artisan would apply the video merchandising system teachings of Yourick to the e-mail messaging and sorting system of Scannell. We find that there is no reasonable explanation in the Answer or any other office action, as to how or why the references would be combined to achieve the invention of appellants' claims 1 to 30. The examiner's reliance on various portions of the references (Answer, top of page 6) for motivation to combine them is misplaced. Our review of these references indicates merely that Scannell (column 2, lines 28 to 31) suggests automatic message sorting, Sheth (page 349) suggests filtering information using a positive/negative system, Yourick (column 1, lines 50 to 53) teaches it is desirable to identify a given user's interests, and the Chang (column 1, lines 51 to 57) suggests weighting rules to sort information. None of the applied references teach or suggest how or why the information access features of one reference should be applied to the specific teachings of the other references which are directed to entirely different types of information access.

Appellants argue (Brief, pages 8 to 10) that the rejection of claims 1 to 30 is improper because the examiner has not adequately shown that the cited references teach or suggest each and every element as recited in combination in the claims. We agree. The examiner has failed to meet the requirements for an Answer set forth in 37 CFR 1.193(a) and in MPEP 1208 of stating where in the references each specific limitation of appellants' claims is found, identifying any differences in the claims

and the prior art, and explaining how and why the claims are unpatentable over the prior art.

Regarding claims 1, 14, and 28 for example, the examiner (Answer, page 2) only states that Scannell teaches a computerized access system having a storage means and a rule test unit. We agree with appellants (Brief, page 9) that the examiner has failed to adequately set forth where in Scannell, or the other applied references, the prior art taught or would have suggested the means for determining a correlation between the interests of a particular user and other users or the means for combining, ranking, or predicting based on the two factors - the relevance factor and the correlation factor. The examiner has nowhere provided a statement adequately addressing the underlying factual inquiries including: (1) the scope and content of the prior art; (2) the level of ordinary skill in the prior art; and (3) the differences between the claimed invention and the prior art. Accordingly, we cannot sustain the rejection of claims 1 to 30 under 35 U.S.C. § 103.

We agree with appellants (Brief, page 8) that even if there were some plausible reason for combining the applied references, their combined teachings would not have suggested the claimed subject matter of claims 1 to 30 on appeal, including the feature of ranking information based on a relevance factor and a correlation factor which represents a correlation between a given user's interests and the interests of other users who have accessed the same information. We find that the examiner, by pointing only to the abstract of Yourick, has not adequately shown that Yourick teaches the feature required by claim 1 of "determining a measure of correlation" between a particular user's interests and

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the interests of other users who have accessed that same item of information. The examiner has not sufficiently rebutted appellants' arguments (Brief, pages 5 and 8 to 9) that Yourick presents information on a user's profile based upon a generic

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profile or "best guess" as to an "assumed shopper" who is most likely to use the system at a certain time.

Lastly, and most importantly, appellants argue (Brief, page 9) that "each reference only discloses the use of a single factor, e.g., message content or time of day, to prioritize or select data," whereas claim 1 calls for ranking data based on a combination of two factors - an attribute-based relevance factor (i.e., content), and a measure of correlation between a particular user's interests and the interests of other users who have also accessed the same information. We agree, and we find that the examiner has failed to show that any of the applied references, whether taken singly or in any combination thereof, taught or would have suggested basing a ranking of information on two factors such as content and a correlation with other users.

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In view of the foregoing, the decision of the examiner rejecting claims 1 to 30 under 35 U.S.C.
§ 103 is reversed.

REVERSED

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STANLEY M. URYNOWICZ, JR.)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JAMES D. THOMAS)	
Administrative Patent Judge)	APPEALS AND
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)	INTERFERENCES
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ERIC FRAHM)	
Administrative Patent Judge)	

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JAMES W. PETERSON
BURNS, DOANE, SWECKER & MATHIS
P. O. BOX 1404
ALEXANDRIA, VA 22313-1404

EF:caw