

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANDREW GEORGE MINTER

Appeal No. 2001-1664
Application No. 08/960,787

ON BRIEF

Before HAIRSTON, LALL, and GROSS, Administrative Patent Judges.
LALL, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the Examiner's final rejection of claims 1-7, which constitutes all the pending claims in the application.

The disclosed invention is directed to a method and apparatus for identifying desired items of information from the vast amounts of information available in the modern world. The problem addressed by the present invention is that of finding a practical, scalable method of assisting a given user in finding items of interest from a large set of available items, for

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example on the World Wide Web. In essence, the method derives a list of suggested items based on the observed behavior of other users of the system. The selection of items of interest is further constrained by calculating a score used to quantify commonality of interest between pairs of users and based on this score, each user is allocated a set of "friends." Items are then suggested to a given user in response to his request, which (a) that user has not yet requested and which (b) a friend of that user has requested at least twice before the present request by the user.

Further understanding of the invention can be achieved by the following claim.

1. A method of identifying items of information from an information system, for at least one of a group of users of the information system, said method comprising the steps of:

(i) obtaining a first record indicative of items of information requested from the information system by each user in the group;

(ii) obtaining a second record indicative of items of information responsive to their having been requested from the information system on more than one occasion by the same user;

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(iii) for each pair of users in the group determining a score responsive to identification of a number of items from the second record requested by one user in the pair, that were also requested by the other user in the pair;

(iv) for each user allocating one or more group members as friends for the user on the basis of the scores for pairs containing that user; and

(v) for each user identifying items of information responsive both to their having been requested by a friend of the user and to their not having been requested by the user.

The Examiner relies on the following references:

de Hond	5,796,395	Aug. 18, 1998 (filed Mar. 11, 1997)
Herz et al. (Herz)	5,835,087	Nov. 10, 1998 (filed Oct. 31, 1995)

Claims 1-7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over de Hond in view of Herz.

Rather than repeat the arguments of Appellant and the Examiner, we make reference to the brief (paper no. 14), reply brief (paper no. 16) and the Examiner's answer (paper no. 15) for the respective details thereof.

Reference is also made to paper no. 4 which is a statement of the rejection adopted by the Examiner as an explanation of the rejection in the Examiner's answer at page 3.

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OPINION

We have considered the rejections advanced by the Examiner and the supporting arguments. We have, likewise, reviewed the Appellant's arguments set forth in the briefs.

We reverse.

REJECTION UNDER 35 U.S.C. § 103

As a general proposition, in an appeal involving a rejection under 35 U.S.C. § 103, an examiner is under a burden to make out a prima facie case of obviousness. If that burden is met, the burden of going forward then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness, is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

At the outset, we note that Appellant has elected, to have all the claims on appeal stand or fall together, claim 1 being elected as a representative of the group (brief at page 3).

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The Examiner gives a detailed explanation of the rejection of claim 1 at pages 4-6 of paper no. 4. The Examiner concludes (id. at page 6) that "[i]t would have been obvious . . . to integrate *De Hond's* system for publishing and searching interests of individual with *Herz et al.'s* customized electronic identification of desirable objects to join groups of user or friends in distributed communication environment to interact with each other, identify selected or non selected items within the group and also to point some items [that] are not selected by others to make information retrieval system more user friendly and interactive."

Appellant argues (brief at page 5) that, contrary to the Examiner's assertion, *de Hond* does not generate, or make use of, a second record as recited in claim 1. Appellant further argues (id. at page 6) that "[f]urthermore, *Herz* also neither teaches, discloses, nor in any other form suggests a step involving use of a record indicative of items of information responsive to their having been requested from the information systems on more than one occasion by the same user [that is, the use of the recited second record]."

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Appellant further argues (id. at page 7) that “[s]ince neither Herz nor De Hond teaches nor suggests a second record . . . , it is evident that they cannot therefore teach or suggest this third step which makes explicit use of said second record.” Appellant also argues (brief at page 7 and 8) that neither Herz nor de Hond teaches the concept of creating the recited “friends” using the score, and creating a set of items of information responsive to a user’s request, by identifying those items of information having been already requested by a friend of that user, though not by the user himself.

The Examiner responds to these arguments at pages 4, 5 and 6 of the Examiner’s answer. However, the Examiner merely reiterates his position explained in the statement of rejection.

We agree with the Appellant’s position. The de Hond reference does not create the recited second record indicative of the items of information responsive to their having been requested from the information system on more than one occasion by the same user. It may be possible to create such a record by the method disclosed by de Hond, however, de Hond does not have a need for creating such a record; or a need for the recited subsequent steps which make use of such a record. Consequently, the recited concept of determining a score based on the second

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record is missing in de Hond. We further find that whereas Herz does create sub-sets of information which are aligned with the frequent search for the same items of information by the same user, Herz also does not create a second record as recited in the claims and therefore does not disclose the concept of creating a score, which in turn is used to create "friends" which in turn are used to execute a more efficient searching of the information using the results created by "friends" of the user.

Therefore, we do not sustain the rejection of claim 1 over de Hond in view of Herz. The other independent claim 7, is an apparatus claim which corresponds to the method of claim 1 and contains the same limitations. Therefore, we do not sustain the rejection of all the appealed claims, 1-7, over de Hond in view of Herz.

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Accordingly, the rejection of claims 1-7 under 35 U.S.C.
§ 103(a) is reversed.

REVERSED

KENNETH W. HAIRSTON)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
PARSHOTAM S. LALL)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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ANITA PELLMAN GROSS)	
Administrative Patent Judge)	

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