

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 40

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte C. DOUGLASS THOMAS

Appeal No. 2003-0238
Application No. 08/886,349

HEARD: November 18, 2003

Before HAIRSTON, BARRETT, and GROSS, ***Administrative Patent Judges.***

GROSS, ***Administrative Patent Judge.***

REQUEST FOR REHEARING

In a decision dated February 23, 2004, the decision of the examiner rejecting all of the claims on appeal under 35 U.S.C. § 103 was affirmed.

Appellant argues (Rehearing, pages 2-3) that for means-plus-function elements, ***In re Donaldson*** places the initial burden on the examiner to consider the function and structure disclosed in the specification, and that neither the examiner nor the Board discussed any of the structures for the means-plus-function

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elements recited in claim 49. Appellant asserts that by affirming the examiner's rejection, the Board prematurely shifted the burden to appellant. We disagree.

The examiner (Answer, pages 31-34) specified which portions of the references relate to each means-plus-function element. For example, the examiner directed our attention to Greenfield Online, paragraphs 1-4 and 13-15 for the means for registering users and the means for storing the self-represented participant information in the database. In particular, paragraph 3 of Greenfield Online specifies "an exclusive base of respondents who have registered with Greenfield." For the means for providing the on-line survey, the examiner directed our attention to paragraphs 1-4 of Greenfield Online. More specifically, Greenfield Online discusses online surveys in the first paragraph and states in paragraph 3 that "[t]he heart of the operation is an in-house hardware and software system linked to the World Wide Web." The examiner recognized that Greenfield Online fails to teach how the participants are informed about the existence of the survey and, therefore, pointed to Dacko, paragraph 9, which suggests that researchers can send an e-mail prompting potential respondents to access an address that contains an interactive

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survey. As to the means for automatically selecting a group of participants from the database, the examiner (Answer, page 6) pointed to the discussion of focus groups at paragraphs 3 and 4 of Greenfield Online. Thus, the examiner did consider the various functions.

As to the "structure described in the specification" for the various means, we find no more structure in appellant's specification than that disclosed by Greenfield Online, and appellant has pointed to none. Appellant states, "the references utilized in the obviousness rejection . . . are so lacking in structure as to be unable to teach or suggest these means plus function elements." However, we find that appellant has provided no more structure in the specification than that disclosed in the references. Therefore, the examiner did establish a ***prima facie*** case of obviousness for the means-plus-function elements and properly shifted the burden to appellant. Further, as explained in the Decision at page 4, appellant failed to specifically point out what elements were ignored and what structure in the specification corresponds thereto.

Appellant contends (Rehearing, pages 3-5) that Dacko fails to teach or suggest on-line registration. Appellant argues

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(Rehearing, page 5) that "[o]n-line registration via an on-line registration form is not associated with any of these five areas of data collection identified in paragraph 23 of *Dacko*." We disagree. Greenfield Online includes a database of respondents who have registered, and registration involves answering questions. To create the database, the answers to the questions, or at least the names of the participants, would have to be entered into the computer. *Dacko* suggests data collection on-line to minimize errors in data and to save time by avoiding transcription of the paper copy for encoding answers into a computer data base.

Appellant asserts (Rehearing, page 5) that "failure to indicate any sort of registration causes *Dacko* to teach away from any on-line registration." However, merely not mentioning something does equate to a teaching away therefrom. Further, the skilled artisan would have recognized that the teachings of *Dacko* apply to all data collection which is to be entered into a computer. The level of the skilled artisan should not be underestimated. ***See In re Sovish***, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985).

Appellant argues (Rehearing, pages 6-7) that the statement

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in Greenfield Online "if all else fails . . ." regarding incentives, "indicates that *Greenfield Online* can offer a potential participant a single benefit and that if that specific benefit, such as free online hours or electronic coupons, fails to obtain enough participants, then a cash benefit can be tried." Appellant continues that "nothing in *Greenfield Online* can possibly teach or suggest allowing survey participants to select particular incentive awards from a plurality of available incentive awards." However, appellant has pointed to no support in Greenfield Online for his interpretation. Further, as both Greenfield Online and Dacko indicate a desire to save time, it is unclear why the skilled artisan would have interpreted Greenfield Online as offering a single incentive at a time rather than giving a choice up front. In any event, as Greenfield Online suggests offering different incentives and suggests that people won't all want the same thing, and the goal of both Greenfield Online and Dacko is to save time, it would have been obvious to the skilled artisan to offer a choice of incentives to obtain the maximum number of participants in a single iteration rather than having to go through multiple iterations by offering one incentive at a time. Again, the level of the skilled artisan

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should not be underestimated. ***See Id.***

Appellant contends (Rehearing, page 7) that none of the references teach or suggest an Internet based survey manager, as recited in claim 38. Appellant states that "[a]n Internet-based survey manager is a software module or computing apparatus, not a company or person," and thus Greenfield is not an Internet-based survey manager. However, nothing in the claim requires that the Internet-based survey manager be a software module or computing apparatus. Greenfield clearly manages the surveys in that they design, administer, and analyze the surveys. Further, as pointed out at page 10 of the Decision, Greenfield Online states (in paragraph 3) that "[t]he heart of the operation is an in-house hardware and software system linked to the World Wide Web." Thus, Greenfield is both Internet-based and also a survey manager, or, rather, an Internet-based survey manager, as required by claim 38.

In addition to arguing that the references fail to teach an Internet-based survey manager, appellant asserts (Rehearing, page 9) that the two references fail to teach or suggest a "computer-implemented method for producing surveys to be performed over the Internet" and "receiving survey information from a survey requestor, with the survey information including at least

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questions for the survey, answer choices to the questions, and a target audience indication." We first note that claim 38 recites a computer-implemented method for **performing** an on-line survey, but nowhere does the claim recite a computer-implemented method for producing a survey.

Second, as explained at page 10 of the Decision, "[a]lthough, Greenfield does not explicitly state that the survey is produced based on information provided by the client, it would have been obvious to use information provided by the client to assure that the survey best represented the needs of the client." The most useful information for the survey producer to obtain from the client would be the questions the client needed answered and the target audience. Again, the level of the skilled artisan should not be underestimated. **See Id.**

Appellant argues (Rehearing, pages 9-10) that neither reference teaches or suggests that the survey is created "through on-line interaction with the Internet-based survey manager," as recited in claims 39 and 45. Greenfield clearly must obtain information from the client to determine what to include in the survey. As explained at pages 10-12 of the Decision, since Dacko and Greenfield Online both suggest that the Internet allows for

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quick communication of data, it would have been obvious for the client to send Greenfield the information necessary to produce the survey **via** on-line interaction. The level of the skilled artisan should not be underestimated. **See Id.**

Regarding claim 43, appellant asserts (Rehearing, page 11) that "[n]owhere does *Greenfield Online* or *Dacko* teach that a survey report is made available on-line as part of a computer implemented method." Appellant further states that "[t]he quickest way to provide a survey report to a requestor would be by e-mail or facsimile. Neither *Greenfield Online* nor *Dacko* teach or suggest survey reports or how they might be made available to requestors." Beginning with appellant's last statement, *Greenfield Online* explicitly states (in paragraph 10) that the survey can be "analyzed almost overnight and ready for the weekly marketing meeting." That clearly suggests forming a survey report and providing it to the requestor. As to how to provide the report to the requestor, appellant provides no evidence that e-mail or facsimile would be quicker than on-line. However, as explained in the Decision at page 14, both *Greenfield Online* and *Dacko* teach that data transmission is faster and more accurate on-line, since there is no transcription and no mail

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time. Further, all other communications would be on-line according to the combination. Therefore, it would have been obvious to the skilled artisan to provide the survey report to the requestor on-line.

Appellant's last argument (Rehearing, page 12) is unclear. Appellant states "[r]egardless, of what the definition of a focus group might be, *Greenfield Online* does not teach or suggest that an on-line selection, by a requestor, of one or more participant categories for a target audience by way of an Internet-based survey manager." We have described *supra* how the combination of *Greenfield Online* and *Dacko* suggests an Internet-based survey manager, and that the survey manager produces the survey based on information received from the requestor. As explained in the Decision at page 14, *Greenfield Online* (paragraph 4) refers to focus groups, wherein focus groups have certain characteristics in common. Claims 40 and 46 effectively recite that the survey manager asks the client to which focus groups to send the survey. Since *Greenfield Online* discloses focus groups and suggests formulating the survey through interaction with the client, it would have been obvious for the client to select the focus groups, or participant categories, for the survey. Therefore,

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claims 40 and 46 would have been obvious over Greenfield Online and Dacko.

Appellant's request for rehearing has been granted to the extent that our decision has been reconsidered, but such request is denied with respect to making any modifications to the decision.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

**REHEARING
DENIED**

KENNETH W. HAIRSTON)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
LEE E. BARRETT)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
ANITA PELLMAN GROSS)	
Administrative Patent Judge)	

AG/RWK

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C. DOUGLASS THOMAS
1193 CAPRI DRIVE
CAMPBELL, CA 95008