



UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DARYL JARVIS BELINNE, SHREE DANDEKAR,
JAMES A. HOWELL JR., and
SHANNON CHRISTOPHER BOESCH

Appeal 2009-004693
Application 10/137,623
Technology Center 2100

Decided: August 10, 2009

Before ALLEN R. MACDONALD, *Vice Chief Administrative Patent Judge*,
JOSEPH L. DIXON, and DEBRA K. STEPHENS, *Administrative Patent
Judges*.

MACDONALD, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE ¹

According to Appellants, the invention relates to activating services when configuring a "build to order" system. (See Spec. 1:8-9).

The Examiner rejected claims 1-16 under 35 U.S.C. § 102(e) over Lee US 6,985,876 B1 Jan. 10, 2006.

The issue before us is whether Appellants have shown that the Examiner failed to explain how the relied upon prior art reference discloses an element of the claim.

In rejecting claims under 35 U.S.C. § 102, “[a] single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation.” *Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368, 1375-76 (Fed. Cir. 2005) (citation omitted).

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006). Therefore, we look to Appellants' Briefs to show error in the Examiner's proffered prima facie case.

Exemplary Claim

1. A computer implemented system for enabling configuration of an information handling system comprising:

a configurator, the configurator configuring a system with options selected according to user input;

a checkout module, the checkout module presenting payment options and obtaining payment and delivery information;

a service activation module for enabling a user to activate a service for use on the information handling system; and

¹ Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1-16. We have jurisdiction under 35 U.S.C. § 6(b).

a database, the database receiving information from and supplying information to the configurator, the checkout module and the service activation module.

FINDINGS OF FACTS

The Examiner found that all of the limitations of claims 1-16 were taught by Lee reference (09-21-2009 Non-Final Office Action pp. 3-9; *See also* Ans. 3-17 and Ans. 18-24). Specifically, at page 3 of the Rejection dated September 21, 2007, the Examiner found with respect to claim 1:

3. Lee taught the invention as claimed including a system for enabling configuration of an information handling system comprising:

4. A configurator (PXI configurator), the configurator configuring a system with options selected according to user input (e.g., see figs. 3,4 and col. 6, lines 30-65 and);

5. A checkout module, the checkout module presenting payment options and obtaining payment and delivery information e.g., see, col. 4, lines 1-30)[the browser software for accessing ecommerce website that performs the checkout operation using the virtual shopping cart of Lee];

6. A service activation module for enabling a user to activate a service (e.g., see col. 3, lines 43-col. 4, line 30)[the ecommerce software that provides for purchase of services such ISP service or content subscription services]; and

7. A database, the database receiving information from and supplying information to the configurator, the checkout module and the service activation module (e.g., see col. 4, lines 59-col. 5, line 63 and figs. 2a,2b)[the media such as disk or CDROM receive or store instructions and/or data in accordance with the ecommerce method of figs.2a,2b that includes configuring a system and purchasing or activating a service (e.g., see col. 3, lines 34-65).

Lee at column 6, lines 30-65, as referenced by the Examiner, discloses in part that “The user may be allowed to select customized component options”

and that the options are of a “customizable product.” We find that the product is “such as a computer system” (Lee, col. 5, ll. 35-36).

Additionally, at pages 9-10 of the Answer, the Examiner further found with respect to claim 1:

Lee disclosed that the products that were selected, customized and purchased included a computer system and Lee discussed the customization of a computer system (e.g., see fig. 3, 4, 6 and col. 9, lines 16-63). Also Lee disclosed that products selected customized and purchased by the system included content subscription services and ISP service (INTERNET service provider service)(e.g., see col. 3, lines 44-54). The Lee system provided for the purchase of these services (that are used on a configured computer) via downloaded graphical interface with the configuring and purchase of a computer (e.g., see col. 6, lines 21-59). The portion of the interface that enables "services" selection and purchase meets the enabling a user to activate a service limitation. The advantage is clearly to provide a "one stop shop" for purchasing each thing that would be desired for the user of the purchased computer product. Lee disclosed that the purchase is an interactive process where the user selects and configures a product until each item the user desires is selected and configured and then the purchase is finalized (e.g., see col. 8, lines 1-23).

At page 5 of the Rejection dated September 21, 2007, the Examiner found with respect to claim 2:

8. As per claim 2, Lee taught the configurator and the service activation module provide a customer with consistent customer experience (e.g., see fig. 3, 4), [where the PXI configurator provides consistent view of the system and the ecommerce software that provides for the purchase of services is taught part of the same ecommerce system with display therefore the experience of purchasing a item is consistent]

The Examiner’s findings with respect to claim 7 are found at page 5 of the Rejection dated September 21, 2007 and pages 12-13 of the Answer.

The Examiner's findings with respect to claim 13 are found at pages 7-8 of the Rejection dated September 21, 2007 and page 16 of the Answer.

APPELLANTS' CONTENTIONS

Appellants contend that the Examiner erred in finding that the limitations of the claims were met by the Lee reference and Appellants contend that a number of limitations are missing from the Lee reference (*See App. Br. 3-5; See also Reply Br. 2*). Specifically, with respect to claims 1-6, at pages 3-4 of the Appeal Brief, Appellants argue:

Lee does not teach or suggest a computer implemented system for enabling *configuration of an information handling system* which includes a configurator, *a service activation module for enabling a user to activate a service for use on an information handling system*, and a database where database receives information from and supplies information to the configurator and *the service activation module*, all as required by claim 1. Accordingly, claim 1 is allowable over Lee. Claims 2 - 6 depend from claim 1 and are allowable for at least this reason.

The Appeal Brief presents no other arguments with respect to claim 1.

With respect to claims 7-12, at page 4 of the Appeal Brief, Appellants argue:

Additionally, Lee does not teach or suggest a method of enabling *configuration of an information handling system* which includes configuring a system with options selected according to user input, *enabling a user to activate a service*, and *using information derived during the configuring for the enabling*, all as required by claim 7. Accordingly, claim 7 is allowable over Lee. Claims 8 - 12 depend from claim 7 and are allowable for at least this reason.

The Appeal Brief presents no other arguments with respect to claim 7.

With respect to claims 13-16, at page 4 of the Appeal Brief, Appellants argue:

Additionally, Lee does not teach or suggest an on-line store for enabling configuration of an information handling system which includes *means for configuring a system with options selected according to user input, means for enabling a user to activate a service for use on an information handling system*, and a database where the database receives information from and supplies information to the means for configuring, the means for presenting and the means for enabling, all as required by claim 13. Accordingly, claim 13 is allowable over Lee. Claims 14 -16 depend from claim 13 and are allowable for at least this reason.

The Appeal Brief presents no other arguments with respect to claim 13.

With respect to claims 2, 8, and 14, at pages 4-5 of the Appeal Brief, Appellants separately argue:

As discussed in the application, one aspect of the present invention relates to providing an on-line store which allows a customer to order services of other providers while maintaining a consistent customer experience. (See e.g., Belinne application, page 6, lines 9 - 17.) This aspect of the invention is affirmatively claimed in claims 2, 8 and 14 which set forth that the configurator and the service activation module provide a customer with a consistent customer experience.

When setting forth that Lee discloses a configurator and the service activation module provide a customer with a consistent customer experience, the Examiner sets forth:

Lee taught the configurator and the service activation module provide a customer with a consistent customer experience (e.g., see fig. 3,4), [where the PXI configurator provides consistent view of the system and the ecommerce software that provides for the purchase of services is taught part of the same ecommerce system with display therefore the experience of purchasing a item is consistent]. (Final office action dated September 21, 2007, Page 4.)

However, this portion of Lee, or anywhere else in Lee, does not disclose or suggest *a configurator* (the configurator configuring a system with options selected according to user input) *and a service activation module providing a customer with a consistent customer experience*, as required by claim 2 and as substantially required by claims 8 and 14. Accordingly, claims 2, 8 and 14 are allowable over Lee.

The Appeal Brief presents no other arguments beyond those quoted above.

ANALYSIS

In our review, we find that the Examiner has made extensive specific fact finding, as detailed *supra*, with respect to each of the argued claims. Appellants' argument, as detailed *supra*, repeatedly restates elements of the claim language² and simply argues that the elements are missing from the reference. However, Appellants do not present any arguments to explain why the Examiner's explicit fact finding is in error. Arguments not presented in the Appeal Brief "will be refused consideration by the Board, unless good cause is shown"³ (i.e., are waived). In contrast, the Examiner findings address each claim limitation raised on appeal by Appellants and also these findings reference specific teachings in Lee as showing these claim limitations.

Weighing as a whole the Appellants' arguments, which are not supported by further explanation, that the elements are missing and the

² A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim (*See* 37 C.F.R. § 41.37 (c)(1)(vii)).

³ 37 C.F.R. § 41.37 (c)(1)(vii).

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Examiner's specific and detailed findings, we reach a conclusion that Appellants have not shown error in the Examiner's finding of anticipation based on Lee regarding claims 1-16.

DECISION

We affirm the Examiner's rejection of claims 1-16.

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

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