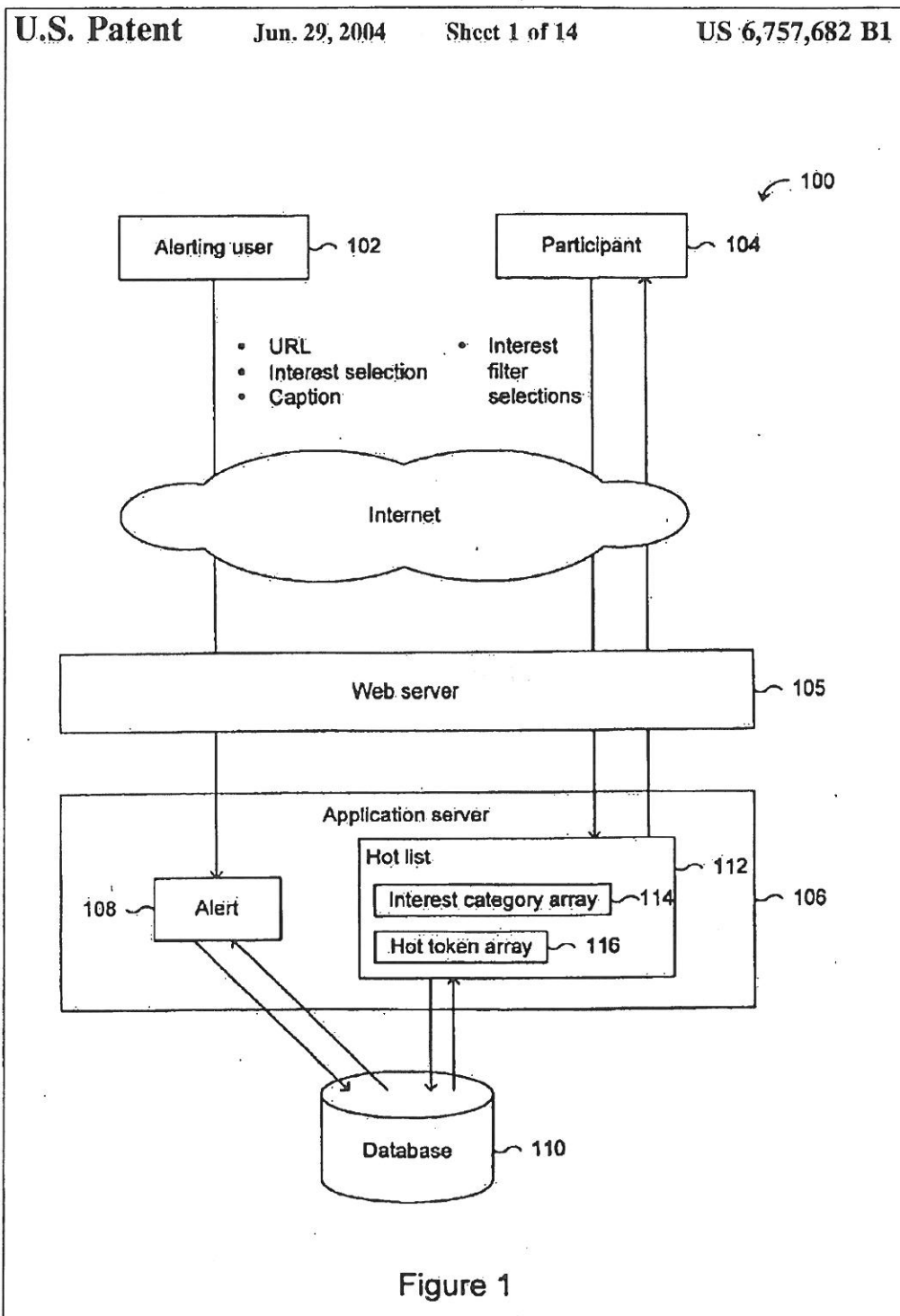
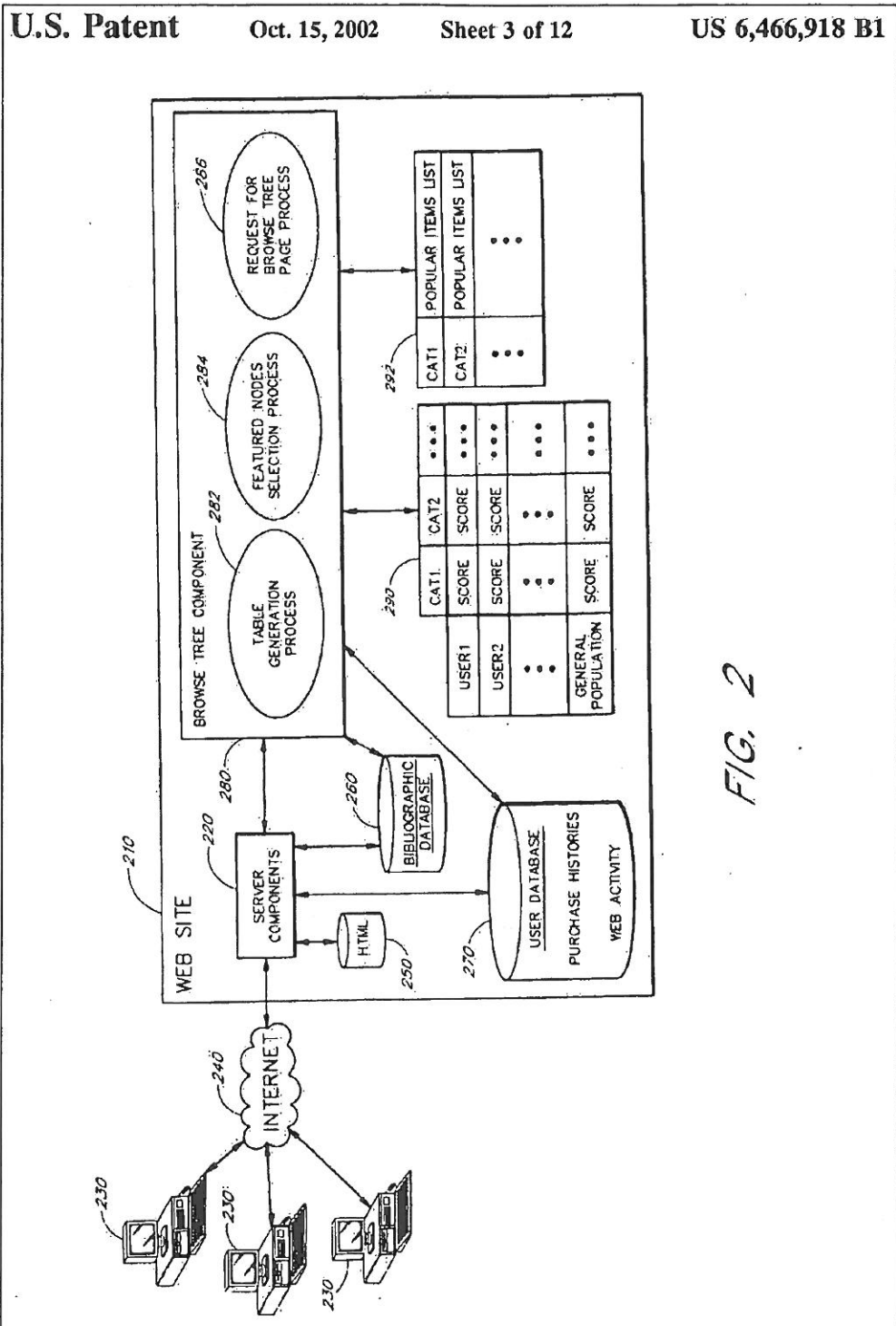


'682 Patent



Spiegel



Reasons for Not Adopting Proposed Rejections (D)-(E) over Spiegel

First, 3PR treats **Spiegel** and **Bezos** as a single prior art reference because **Spiegel** incorporates by reference the provisional application (60/128,557) to which **Bezos** claims priority. For the reader's convenience, 3PR's arguments as to this issue are reproduced below. (*Request, pg. 63*)

1. CLAIMS 1-13, 16-17, AND 20 ARE ANTICIPATED BY SPIEGEL

Spiegel discloses a system for identifying and notifying users of popular items within an on-line system. Spiegel is closely related to the system disclosed in **Bezos**; both patents purport to describe aspects of Amazon.com (the assignee of both patents) and Spiegel explicitly incorporates by reference the disclosures of **Bezos**. See Spiegel, Col. 10, lines 52-58.³ Spiegel and **Bezos** are therefore treated as a single prior art reference for purposes of anticipation under § 102 as authorized by the MPEP:

Instead of repeating some information contained in another document, an application may attempt to incorporate the content of another document or part thereof by reference to the document in the text of the specification. The information incorporated is as much a part of the application as filed as if the text was repeated in the application, and should be treated as part of the text of the application as filed.

³ Spiegel specifically incorporates by reference the disclosures of the **Bezos** provisional application, U.S. Provisional Application No. 60/128,557, filed April 9, 1999, not the issued **Bezos** patent. See Spiegel, Col. 10, lines 52-58. This distinction is of no significance because, as explained in Section V.A above, the disclosures of the issued **Bezos** patent were also disclosed in the earlier-filed provisional application.

Consequently, for the reasons set forth above for not adopting the anticipation rejection over **Bezos** are incorporated here because 3PR relies on the teachings of **Bezos** that are allegedly incorporated by reference through **Spiegel's** references to **Bezos'** provisional application (60/128,557) to anticipate the claims.

In addition, 3PR argues that **Spiegel** provides an alternative technique to **Bezos** for adjusting the 'intensity value' associated with indications by other users, such as purchases. (*Request, pg. 64*)

Spiegel is cited in this Request because it provides an alternative technique (in addition to the one disclosed in **Bezos**) for determining and adjusting the "intensity value" associated with indications by other users, such as purchases. This alternative technique also anticipates, under the broadest reasonable construction, the requirement recited in all independent claims of determining "**an intensity value to be associated with the indication,**" and "**adjusting the intensity value based on a characteristic for the item provided by the source.**" All other elements of claims 1-13, 16-17, and 20 are fully disclosed in by the incorporated **Bezos** reference as explained above.

3PR sets forth the disclosures of **Spiegel** that allegedly provide an alternative technique to **Bezos** for adjusting the 'intensity value' associated with indications by other users, such as purchases. (*Request, pg. 65*)

Spiegel also discloses the element of "**adjusting the intensity value based on a characteristic for the item provided by the source**" (under its broadest reasonable construction). Spiegel explains that when a user purchases an item, searches for it, adds the item to its shopping cart or provides a rating, the Spiegel "intensity value" associated with that indication is adjusted in accordance with how significant the action is within the system. "For example, actual purchases are preferably given more weight than merely placing an item in a shopping cart." Spiegel, Col. 13, lines 42-43. An example is provided in Table 7, which shows some actions (such as "Purchase") being given greater numerical significance than other actions:

Purchase	10
Click-through	1
Search	3
Rating	8
Shopping Cart	7

Spiegel, like **Bezos**, discloses adjusting the intensity value (*product count value*) when a user purchases an item or provides a rating for it. **Spiegel** additionally discloses that the intensity value (*product count value*) will be adjusted by click-through, search, and shopping cart events for the item. However, like **Bezos**, **Spiegel** discloses these values are adjusted based on a characteristic for the item provided by the user, which is not the claimed source.

Since **Spiegel** adjusts the intensity value (*product count value*) based on a characteristic (*click through, search, or addition to the shopping cart*) of an item (*book*) provided by the user, it does not anticipate adjusting the intensity value based on a characteristic provided by the source. For this additional reason, proposed anticipation rejection (D) is not adopted.

Also, proposed rejection (E) is not adopted because it does not set forth a prima facie case of obviousness as required by *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). The factual inquiries set forth in *Graham v. John Deere Co* that are applied for establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

However, 3PR does not ascertain the differences between **Spiegel** and the claims at issue. (*Request, pgs. 68-69*) Although 3PR has proposed obviousness rejection (E) as an alternative to the anticipation rejection (D), proposed obviousness rejection

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(E) must nonetheless set forth a prima facie case of obviousness by addressing the factual inquires as required by *Graham v. John Deere Co.* Consequently, proposed rejections (D)-(E) are not adopted because they do not establish a prima facie case of obviousness because they do not ascertain the differences between **Spiegel** and the claims at issue.

RUCKER: Proposed Rejection (F)

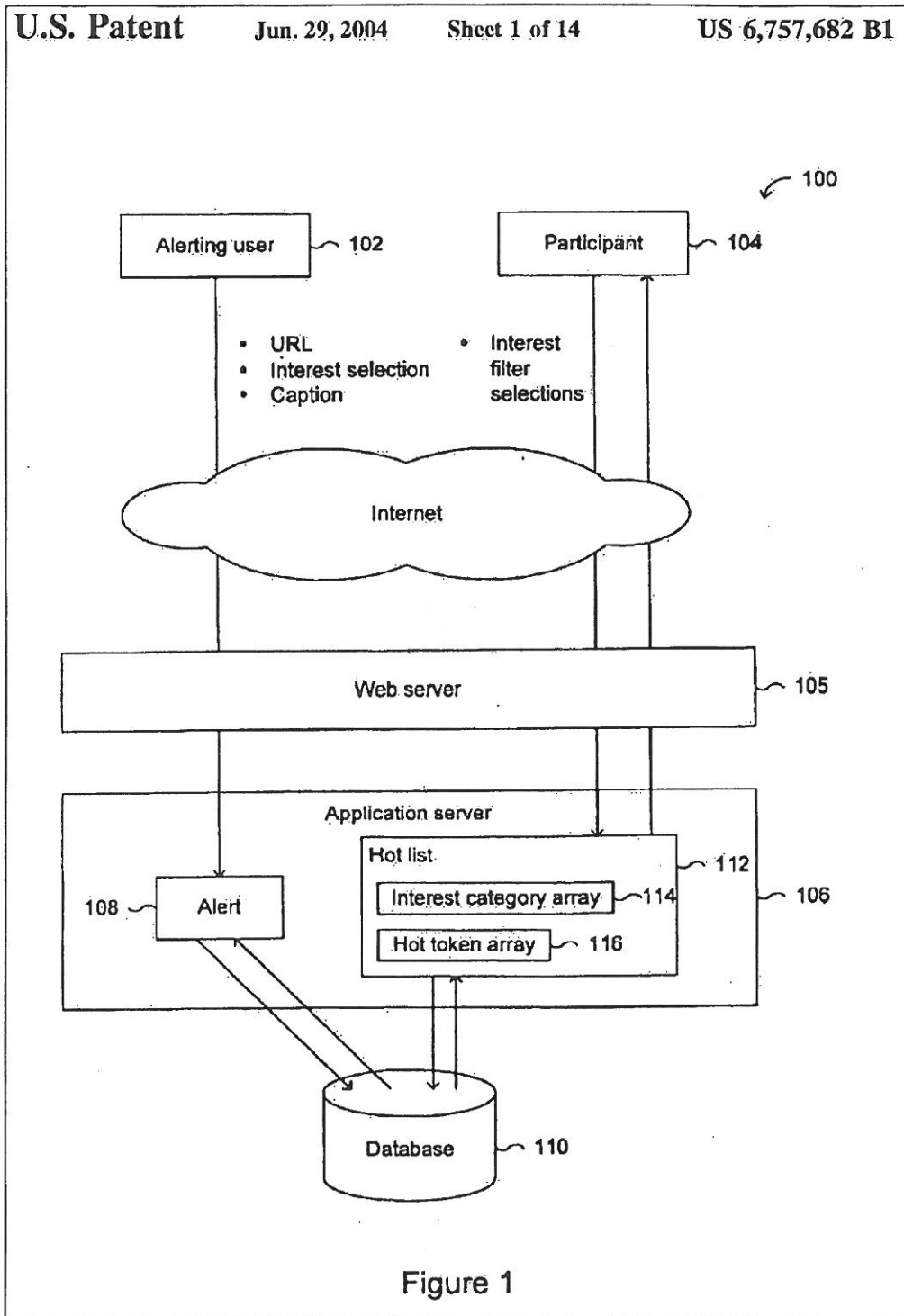
20. The Request indicates that **3PR** considers:

(F) **Claims 1-13, 16-17, and 20** are anticipated by **Rucker**.

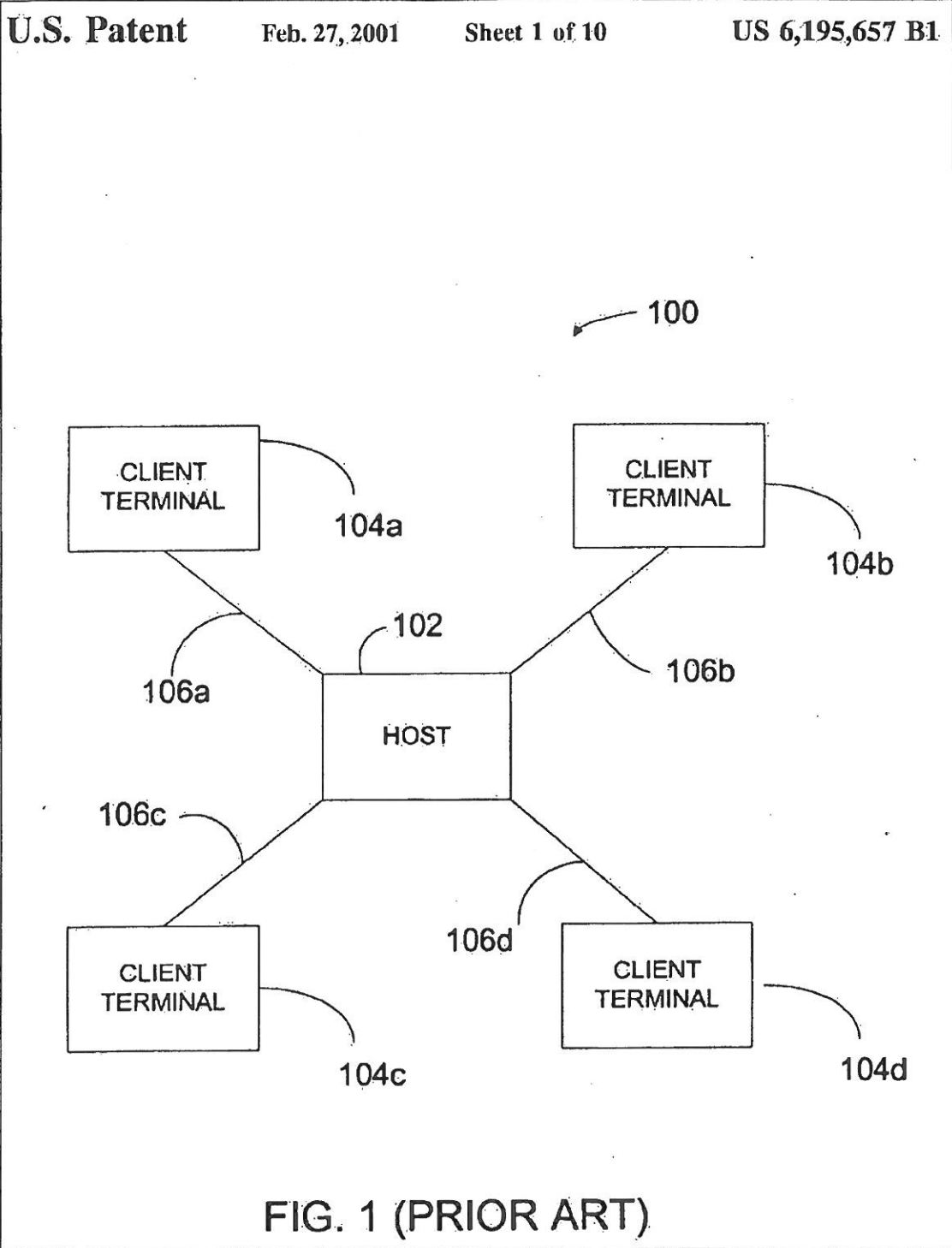
21. For the reader's convenience, *figure 1* of the '**682 patent** and *figure 1* of **Rucker**, which is the prior art network used by the invention of **Rucker**, are provided for comparison.

22. Proposed rejection (F) is not adopted for the reasons set forth below.

'682 Patent



Rucker



Reasons for Not Adopting Proposed Rejection (F) over Rucker

First, **Rucker** does not anticipate receiving *in real time* from a source other than the participant an indication that the item is of current interest. 3PR argues **Rucker's** host processing station is configured to receive from one or more other users an indication that an item is of current interest. 3PR also argues the indication that the item is of current interest is received by the recommendation system.

For the reader's convenience, 3PR's argument as to this issue is reproduced below. (*Request, pg. 73*)

a computer configured to receive in real time from a source other than the participant an indication that the item is of current interest;

Rucker discloses a computer (e.g., host processing station 102) configured to receive in real time from a source other than the participant (e.g., one or more other users) an indication that the item is of current interest, giving this claim language its broadest reasonable construction. *See* Rucker, Col. 3, lines 43-46 ("As shown here [in Fig 2], host processing station 102 includes I/O controller 204 to interface between client terminals 104x via links 106x and a processor 206.") (emphasis added).

Rucker discloses that the indication of interest is received by the recommendation system when another user creates and submits a category of interest containing one or more documents ("information objects"). Rucker refers to this other user (or source) as the "originating user" and refers to the user submitted category containing the document as the "originating category":

Each recommended information object delivered to the target user was submitted to the recommendation system by one or more "originating users". For each originating user the information object was submitted in the context of a particular category, referred to as the "originating category". As well as delivering recommended information objects, at step 408 the recommendation system will additionally deliver identifiers of the originating categories and originating users.

Rucker, Col. 5, line 65-Col. 6, line 2 (emphasis added).

3PR argues the claimed 'computer' is the host processing station #102. As such, in order to meet this claim limitation **Rucker** must disclose that the computer (*host processing station*) is configured to receive in real time from a source (*originating user*) other than the participant (*target user*) an indication (*via the creation and submission of a category of interest by another user*) that an item (*document*) is of current interest (*submitted in the originating category*). Since proposed rejection (F) does not address the claim limitation of *receiving in real-time*, it does set forth a prima facie case of anticipation. As such, proposed rejection (F) does not address this claim limitation, the proposed rejection is not adopted.

Second, **Rucker** does not anticipate *adjusting the intensity value based on a characteristic for the item provided by the source* in combination with the other features of the claims. 3PR argues the claimed *intensity value* is met by the disclosed match count for the category. 3PR further argues the claimed *intensity weight value* is met by the disclosed total matching categories and the claimed *characteristic for the item* is met by the disclosed relevance rating.

For the reader's convenience, 3PR's arguments as to this issue are reproduced below. (*Request, pgs. 76-77*)

Rucker, Col. 13, lines 1-14 (emphasis added). For purposes of this Request, therefore, the Rucker "intensity value" can be represented by the match count associated with the category submitted by the originating user.

The Rucker "intensity weight value," giving the claim language its broadest reasonable construction, can comprise the total number of "matching categories" as computed at the end of the process described Figure 8. In particular:

Rucker discloses "adjusting the intensity value based on a characteristic for the item provided by the source;" under its broadest reasonable construction, through its ability to adjust the "match count" based on the relevance ratings provided by the originating user. In particular, the "match count" value is adjusted based on the difference between (a) the originating user's relevance rating for objects in the category and (b) the rating for those same objects provided by the "target user" (the user to whom recommendations will be provided):

An alternative to step 816 is to use the ratings for matching information objects, if supplied. In that case, the current information object will have a "target rating" as supplied by the target user, and it will also have an "other rating" as supplied by the originating user of the current category. The match count of the current category is then incremented by an amount proportional to the similarity between the target rating and the other rating. For instance, the absolute value of the difference between the target rating and the other rating integers could be calculated. Then the match count of the current category could be incremented by the result of subtracting that difference from 100.

3PR argues **Rucker** discloses adjusting the intensity value (*match count*) based on a characteristic (*relevance rating*) for the item (*document*) provided by the source (*originating user*). This argument, however, is not persuasive because **Rucker** discloses the characteristic (*relevance rating*) is provided by the participant (*target user*). (col. 12:11-32) Since the participant (*target user*) and not the source (*originating user*) is disclosed as providing the characteristic (*relevance rating*) for the item (*document*), proposed anticipation rejection (F) is not adopted.

SHEENA: Proposed Rejections (G)-(H)

23. The Request indicates that **3PR** considers:

(G) **Claims 1-5, 8-10, 16-17, and 20** are anticipated by **Sheena**.

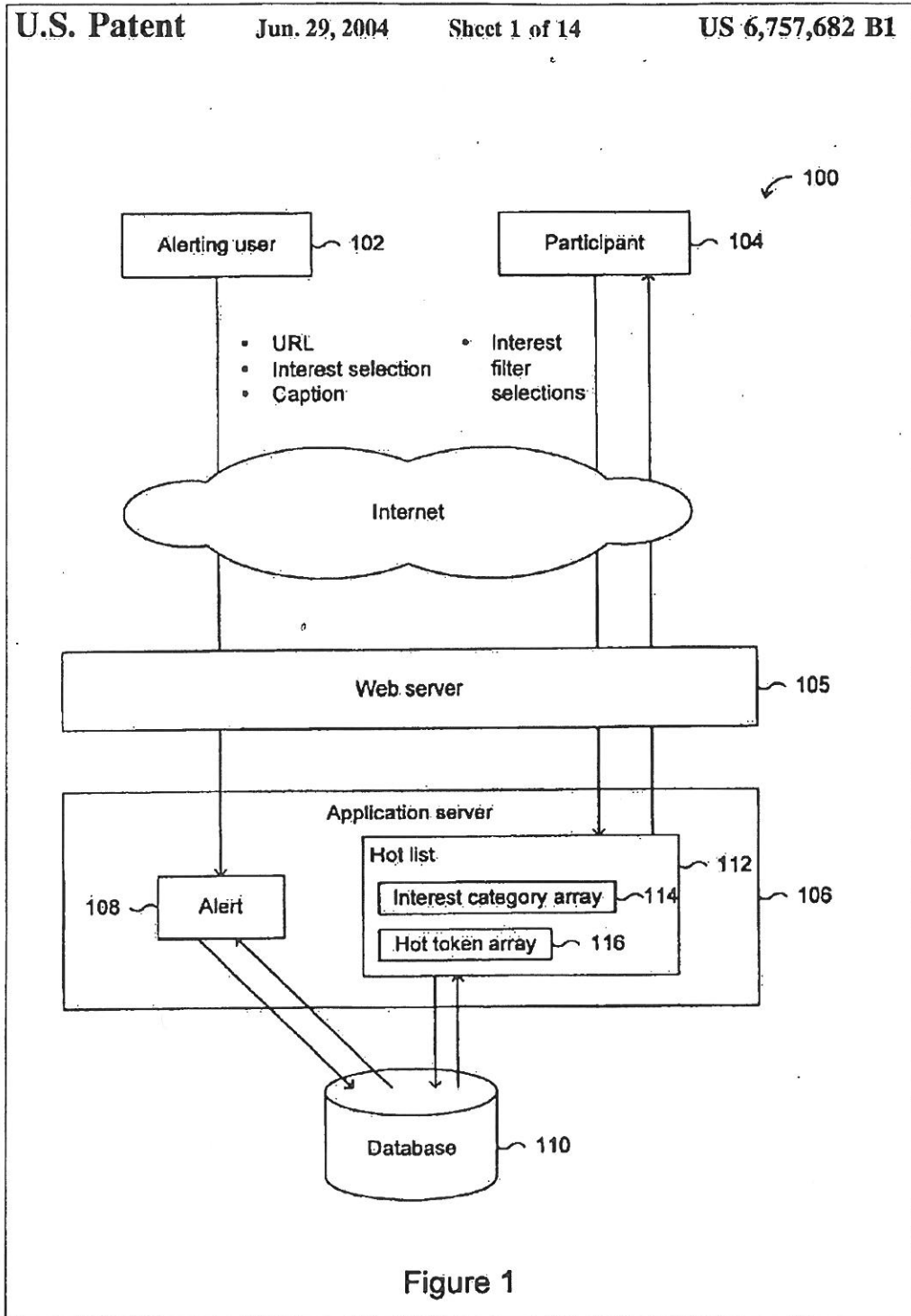
(H) **Claims 6-7 and 11-13** are obvious over **Sheena** in view of **Bezos**.

24. These proposed rejections are not adopted for the reasons set forth below.

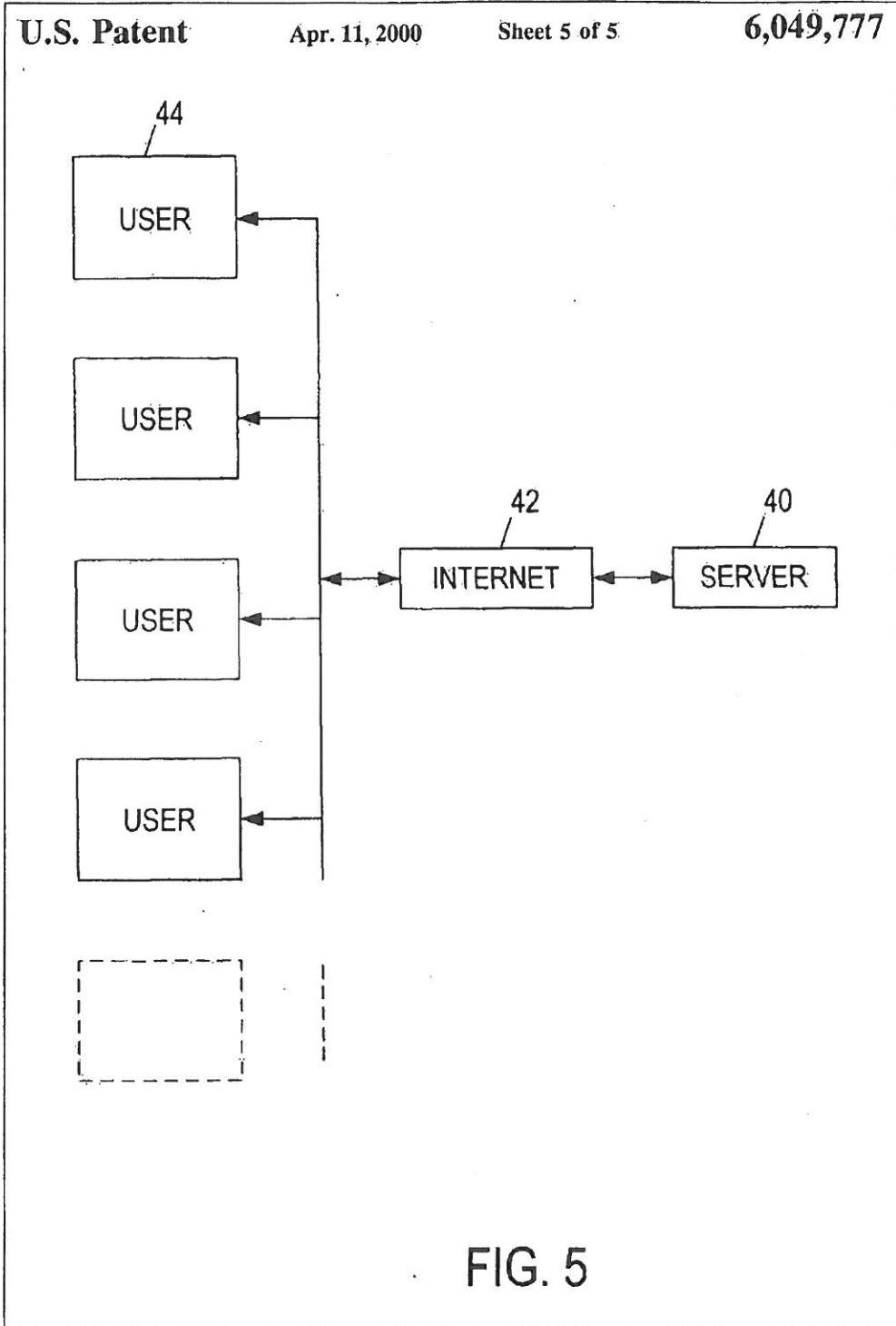
25. For the reader's convenience, figure 1 of the '**682 patent** and figure 5 of **Sheena** are provided for comparison.

26. Proposed rejections (G)-(H) are not adopted for the reasons set forth below.

'682 Patent



Sheena



Reasons for Not Adopting Proposed Rejections (G)-(H) over Sheena

First, **Sheena** does not anticipate receiving *from a source other than the participant an indication that the item is of current interest*. 3PR argues **Sheena** discloses disseminating to a participant (*user*) an indication (*recommendation*) that an item (*e.g. webpage*) accessible by the participant (*user*) via a network (*Internet*) is of current interest (*by giving more weight to newer ratings than older ratings from other users*). Further, for the reader's convenience 3PR's argument as to this claim limitation is reproduced below. (*Request, pg. 111*)

1. A system for disseminating to a participant an indication that an item accessible by the participant via a network is of current interest, comprising:

Sheena discloses a system for disseminating to a participant an indication (e.g., recommendation) that an item accessible by the participant (e.g., user) via a network (e.g., the Internet) is of current interest. *See Sheena, Col. 25, lines 57-59* (“An apparatus may be provided to recommend items to a user. The apparatus, as shown in FIG. 4 has a memory element 12 for storing user and item profiles.”) (emphasis added).

The system disclosed in Sheena recommends items of “current interest” by giving more weight to newer recommendations than to older recommendations. *See Sheena, Col. 13, lines 51-54*. (“In this embodiment, the additional information may indicate that a rating is possibly invalid or old, and could result in that rating being weighted less than other ratings.”) (emphasis added).

a computer configured to receive in real time from a source other than the participant an indication that the item is of current interest;

Sheena discloses a computer (e.g., server 40) configured to receive in real time from a source other than the participant (e.g., other users) an indication that the item is of current interest (e.g., entry of a rating for the item), giving the claim language its broadest reasonable construction. See Sheena, Col. 26, lines 14-16 ("In some embodiments a receiving means is included in the apparatus (not shown in FIG. 4). Receiving means is any device which receives ratings for items from users.") These indications can be received at the time the other users select a rating:

Ratings for items which are received from users can be of any form that allows users to record subjective impressions of items based on their experience of the item. Ratings can be received from users singularly or in batches, and may be received from any number of users simultaneously.

Sheena, Col. 4, lines 21-23, 37-39 (emphasis added).

3PR argues that **Sheena** discloses a computer (server #40) is configured to receive in real time from a source (e.g. other users) other than the participant (user), an indication that the item is of current interest (e.g. entry rating for the item). The crux of the issue here is whether the '*indication that the item is of current interest*' is received from the other users or the server.

3PR's argument is not persuasive because whether the item is of current interest, i.e. warrants recommendation to the participant (user), is not assessed until the ratings provided by other users are received by the server from the other users because the server stores the user profiles and associates items with the ratings given to those items by the user. (col.7:43-47) Whether the item is of current interest is determined by the server which calculates a similarity factor that represents the degree of correlation between any two users with respect to a set of items. (fig. 1, #104) Thus, the server

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makes the determination as to whether the item will be recommended to the user and as such, **Sheena** does not anticipate receiving from a source (*other users*) other than the participant (user) an indication (*recommendation*) that the item is of current interest because the other users do not determine whether the item is of current interest to the user. For at least this reason, proposed anticipation rejection (G) is not adopted.

Second, **Sheena** does not anticipate receiving *in real time from a source other than the participant an indication that the item is of current interest*. 3PR relies on **Sheena's** disclosure that "ratings can be received from users singularly or in batches, and may be received from any number of users simultaneously" to meet the claim limitation of receiving *in real time from a source other than the participant an indication that the item is of current interest*. (*Request, pg. 111*)

However, this argument is not persuasive because receiving ratings from multiple users simultaneously is not a disclosure as to receiving *in real time from a source other than the participant an indication that the item is of current interest*. For this additional reason, proposed rejection (G) is not adopted.

Also, proposed rejection (H) is not adopted because it does not set forth a prima facie case of obviousness as required by *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). The factual inquiries set forth in *Graham v. John Deere Co* that are applied for establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

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4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

However, 3PR does not ascertain the differences between **Sheena** and the claims at issue. (*Request, pgs. 123-125*) Consequently, proposed rejection (H) is not adopted because it does not establish a prima facie case of obviousness because it does not ascertain the differences between **Sheena** and the claims at issue.

ROSE: Proposed Rejections (I)-(K)

27. The Request indicates that **3PR** considers:

(I) **Claims 1-5, 8, 17, and 20** are anticipated by **Rose**.

(J) **Claims 6-7, 9-13, and 16** are obvious over **Rose** in view of **Bezos**.

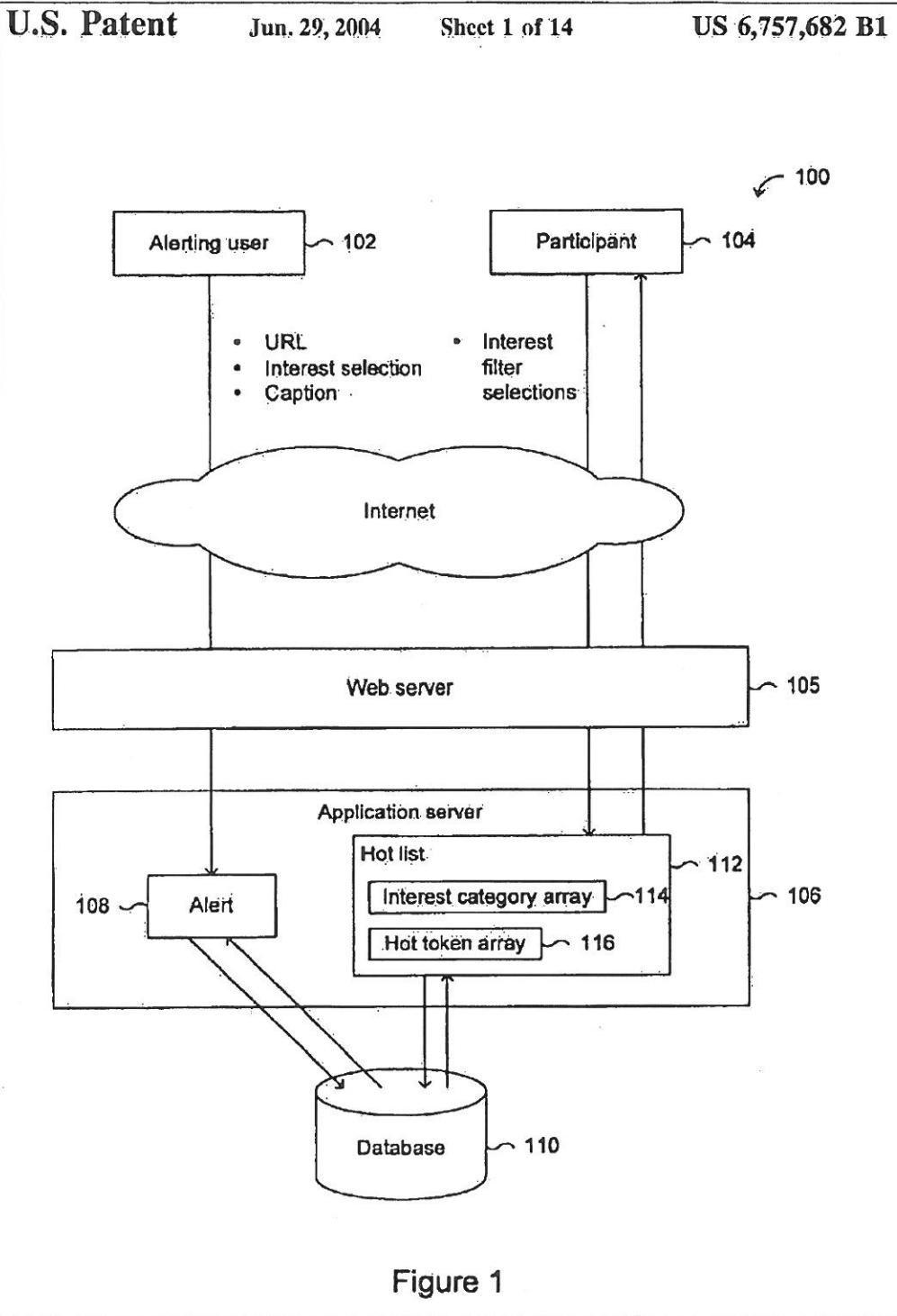
(K) **Claims 9-10 and 16** are obvious over **Rose** in view of **Sheena**.

28. These proposed rejections are not adopted for the reasons set forth below.

29. For the reader's convenience, figure 1 of the **'682 patent** and figures 1-2 of **Rose** are provided for comparison.

30. Proposed rejections (I)-(K) are not adopted for the reasons set forth below.

'682 Patent



Rose

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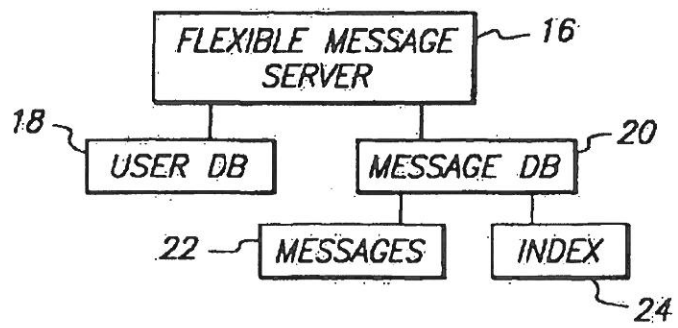
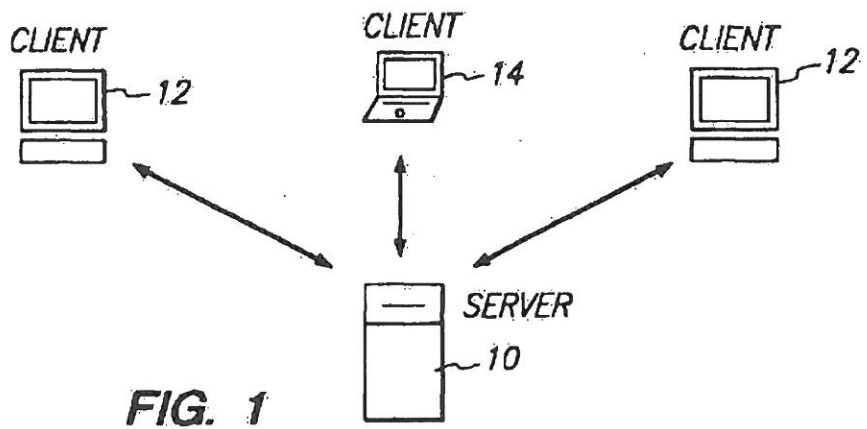


FIG. 2

Reasons for Not Adopting Proposed Rejections (I)-(J) over Rose

3PR's proposed rejection over **Rose** addresses the claim limitations as follows.

(Request, pgs. 125-138)

Rose discloses a system with a computer readable medium and its method of operation comprising:

- a computer (server #10) configured to
 - receive from a source (other users) other than the participant (user)
 - an indication (ratings such as thumbs-up/down) that the item (document) is of current interest (relevant to the user's interest).
 - process the indication; (entry of a rating for the item)
 - determine an intensity value (rank; col.7:40)

(The rank is determined according to the prediction score which is a function of the correlation R_{ij} of the ratings of users i and k col.7:15-20)

- an intensity weight value (degree of correlation)

(The degree of correlation R_{ij} is a measure of the correlation between the various user's interests in commonly retrieved messages. col.7:1-3 and 15-20)

- adjusting the intensity value (rank)

(The prediction is computed for each document to be presented to the user and the resulting scores are then ranked to determine the order of presentation. col.7:38-40)

- based on a characteristic (V_{kj}) for the item (document) provided by the source (other users)

(The 'characteristic is V_{kj} which is the weight indicating the feedback of user k on document j ; col. 7:22)

- inform the participant (user) that the item (document) is of current interest (relevant to the user's interest); and

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- a database (*message database*) associated with the computer (*server*) configured to store data (*index*) relating to the item (*document*).

(The message database is a global, unstructured database which provides access to all of the stored messages supplied by and to users of the database. The message database has associated with it an index which provides a representation of each of the stored messages, e.g. its title. col. 4:7-14)

Rose, however, does not anticipate or make obvious **claims 1-3** for the following reasons. First, **Rose** does not anticipate or make obvious a *system/computer program product/method for disseminating to a participant an indication that an item accessible by the participant via a network is of current interest* in combination with the other features of the claims. The proposed rejections over **Rose** would require the participant (*user*) to disseminate the indication (*rating*). The indication (*rating*), however, is not disseminated to the participant (*user*). Rather, it is the participant (*user*) that provides (*i.e. disseminates*) the indication (*rating*) to computer (*server*). For at least the reason that **Rose** does not disclose or make obvious a system/computer program/method for disseminating to the participant (*user*) an indication (*rating*), the proposed rejections over **Rose** are not adopted.

Second, **Rose** does not anticipate *receiving in real-time...that the item is of current interest* in combination with the other features in the claim. For the reader's convenience 3PR's argument as to this claim limitation is reproduced below. (*Request, pg. 130*)

receiving in real time from a source other than the participant an indication that the item is of current interest;

As explained above with respect to claim 1, Rose discloses receiving in real time (e.g., at the time the user selects a rating) from a source other than the participant (e.g., other users) an indication that the item is of current interest (e.g., entry of a 'thumbs-up' or 'thumbs-down' rating for the item), giving the claim language its broadest reasonable construction:

Located to the right of this information are two icons which permit the user to indicate his or her interest in that particular message. If the user found the message to be of interest, a 'thumbs-up' icon 38 can be selected. Alternatively, if the message was of little or no interest to the user, a 'thumbs-down' icon 40 can be selected. When either of these two icons is selected, the indication provided thereby is forwarded to the server 10 where it is used to update the user profile.

Rose, Col. 5, lines 26-34 (emphasis added).

Rose discloses a computer configured to receive these indications. See Rose, Col. 3, lines 43-46 ("The illustrated architecture comprises a client-server arrangement, in which a database of information is stored at a server computer 10 and is accessible through various client computers 12, 14.") (emphasis added).

Rose discloses that indications are received in real time. See Rose, Col. 9, lines 36-38 ("The frequency with which rankings are recomputed can also be varied as desired. For example, it can be continual, e.g., each time a user votes on a message.").

3PR argues that at the time the user selects the rating, the system of **Rose** receives this selection in 'real-time'. This argument is not persuasive because a disclosure of a mere 'selection' of a rating would not be understood by one of ordinary skill in the art (e.g. a network engineer) as receiving the selection in 'real-time' because a selection of a rating is not *necessarily* received in 'real-time'. For at least this additional reason, the proposed anticipation rejection over **Rose** is not adopted.

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Also, proposed rejections (J)-(K) are not adopted because they do not set forth a prima facie case of obviousness as required by *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). The factual inquiries set forth in *Graham v. John Deere Co* that are applied for establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

However, 3PR does not ascertain the differences between **Rose** and the claims at issue. (*Request, pgs. 140-145*) Consequently, proposed rejections (J)-(K) are not adopted because they do not establish a prima facie case of obviousness because they do not ascertain the differences between **Rose** and the claims at issue.

Conclusion

31. All correspondence relating to this *inter partes* reexamination proceeding should be directed:

By Mail to: Mail Stop *Inter Partes* Reexam
Attn: Central Reexamination Unit
Commissioner for Patents
United States Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX to: (571) 273-9900
Central Reexamination Unit

By hand: Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

32. Registered users of EFS-Web may alternatively submit such correspondence via the electronic filing system EFS-Web, at:

<https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>.

EFS-Web offers the benefit of quick submission to the particular area of the Office that needs to act on the correspondence. Also, EFS-Web submissions are "soft scanned" (i.e., electronically uploaded) directly into the official file for the reexamination proceeding, which offers parties the opportunity to review the content of their submissions after the "soft scanning" process is complete.

33. Extensions of time under 37 CFR 1.136(a) will not be permitted in these proceedings because the provisions of 37 CFR 1.136 apply only to "an applicant" and not to parties in a reexamination proceeding. Additionally, 35 U.S.C. 314(c) requires that *inter partes* reexamination proceedings "will be conducted with special dispatch"

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(37 CFR 1.937). Patent Owner extensions of time in *inter partes* reexamination proceedings are provided for in 37 CFR 1.956. Extensions of time are not available for third party requester comments, because a comment period of 30 days from service of patent owner's response is set by statute. 35 U.S.C. 314(b)(3).

34. The patent owner is reminded of the continuing responsibility under 37 CFR 1.985(a) to apprise the Office of any litigation activity, or other concurrent proceeding, involving this patent throughout the course of this reexamination proceeding. The third party requester is also reminded of the ability to similarly apprise the Office of any such activity or proceeding throughout the course of this reexamination proceeding. See MPEP §2686 and 2686.04.

35. Any inquiry concerning this communication or earlier communications from the examiner, or as to the status of this proceeding, should be directed to the Central Reexamination Unit at telephone number (571) 272-7705.

Signed:

/Deandra M. Hughes/
Primary Examiner, CRU 3992

Conferees:

/CLI/
ESK

