

Commissioner's Decision # 1385

Décision du Commissaire # 1385

TOPIC: O00

SUJET: O00

Application No. : 2,605,357

Demande № : 2,605,357

IN THE CANADIAN PATENT OFFICE

DECISION OF THE COMMISSIONER OF PATENTS

Patent application number 2,605,357, having been rejected under subsection 30(3) of the *Patent Rules*, has subsequently been reviewed in accordance with paragraph 30(6)(c) of the *Patent Rules*. The recommendation of the Board and the decision are as follows:

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INTRODUCTION

- [1] This matter concerns a review of patent application no. 2,605,357 [“the ‘357 application”] entitled “System and Method for Enhancing the Absorption and Retention of Advertising Material”. The Applicant is Crossroads Media Corporation. The application is based on a PCT application, filed December 14, 2006, and thus it bears this date as its filing date. The ‘357 application is based on a US priority application, filed December 6, 2006.
- [2] The application relates to a system including a display structure located in a place having pedestrian traffic, the display structure displaying primary advertising material, a remote advertising server containing secondary advertising material related to the primary advertising material, and an interactive terminal, connected through a communications network to the advertising server, situated in proximity to the display structure for eliciting user input and for presenting the secondary advertising material in response to the input. The application further relates to a method for displaying and providing information that utilizes such a system.
- [3] For the reasons that follow, we recommend that the application be refused.

PROSECUTION HISTORY

- [4] The Final Action, dated July 15, 2009, states that the claims fail to comply with section 28.3 of the *Patent Act* for comprising subject matter that would have been obvious on the claim date to a person skilled in the art. The Final Action further states that the claims comprise non-patentable subject matter falling outside the definition of invention in section 2 of the *Patent Act*.

- [5] In a Response to the Final Action, dated January 15, 2010, pursuant to subsection 30(5) of the *Patent Rules* the Applicant cancelled the claims that were in the application at that time and replaced them with claims 1-26, the latter set of claims thus becoming the “claims on file”. The Applicant argued that the claims on file defined non-obvious and patentable subject matter.
- [6] In a supplemental response dated November 29, 2010, the Applicant provided further arguments supporting its position that the claims on file comprised non-obvious, patentable subject matter.
- [7] Having determined the Applicant’s amendments and arguments did not render the application allowable, pursuant to subsection 30(6) of the *Patent Rules* the examiner forwarded the file to the Patent Appeal Board. The file included a Summary of Reasons for maintaining that the application did not comply with the *Patent Act*. The Summary of Reasons stated that the claims on file were not subject to the non-patentable subject matter defect raised against previous set of claims 1-24, but that the claims on file were subject to the obviousness defect. A copy of the Summary of Reasons was forwarded to the Applicant on July 3, 2013.
- [8] In a letter dated December 16, 2013 the Applicant provided arguments in response to the Summary of Reasons and submitted proposed claims 27-30 for consideration by the Board [“proposed claims”].
- [9] This panel of the Board reviewed the case and, in a letter dated February 14, 2014, posed questions concerning the framework for assessing obviousness set out by the Supreme Court of Canada in *Apotex Inc v Sanofi-Synthelabo Canada Inc*, [2008] 3 SCR 265, at para. 67 [“*Sanofi*”], and provided the Applicant an opportunity to make submissions. The Applicant responded in a letter dated May 7, 2014.

[10] A hearing was held by videoconference on May 14, 2014. At the hearing the Applicant was advised that in the event the claims on file (claims 1-26) are found not to be allowable, the panel will consider the proposed claims (claims 27-30).

ISSUES

[11] In view of the grounds for rejection stated in the SOR the sole issue to be determined is whether or not the claims comprise obvious subject-matter.

LEGAL PRINCIPLES

Purposive construction

[12] Purposive construction is an interpretive exercise in determining the meaning and scope of the claims. Claims construction is antecedent to consideration of validity: *Whirlpool Corp v Camco Inc*, 2000 SCC 67 at para. 43 [*“Whirlpool”*]. Purposive construction requires that the claims be interpreted from the point of view of the person skilled in the art, who possesses the common general knowledge of the particular art: *Whirlpool* at para. 53. During purposive construction, the elements of the claimed invention are identified as essential or non-essential: *Free World Trust v Électro Santé Inc*, 2000 SCC 66, at para. 31 [*“Free World Trust”*]. An element is considered non-essential if, based on a purposive construction, the skilled addressee would appreciate an element of the claim could be omitted or substituted without having a material effect on the working of the invention (*Free World Trust*, para. 55). According to the Examination Practice Respecting Purposive Construction - PN2013-02, the essential elements of a claim are those elements that contribute to the proposed solution to the problem identified in the application.

Obviousness

[13] The subject-matter of a patent claim must not have been obvious to persons skilled in the art or science on the relevant date. Section 28.3 of the *Patent Act* provides:

28.3 The subject-matter defined by a claim in an application for a patent in Canada must be subject-matter that would not have been obvious on the claim date to a person skilled in the art or science to which it pertains, having regard to

- (a) information disclosed more than one year before the filing date by the applicant, or by a person who obtained knowledge, directly or indirectly, from the applicant in such a manner that the information became available to the public in Canada or elsewhere; and
- (b) information disclosed before the claim date by a person not mentioned in paragraph (a) in such a manner that the information became available to the public in Canada or elsewhere.

[14] In *Sanofi*, the Supreme Court of Canada indicated that it is useful in an obviousness inquiry to use the following four-step approach:

- (1)
 - (a) Identify the notional "person skilled in the art";
 - (b) Identify the relevant common general knowledge of that person;
- (2) Identify the inventive concept of the claim in question or if that cannot readily be done, construe it;
- (3) Identify what, if any, differences exist between the matter cited as forming part of the "state of the art" and the inventive concept of the claim or the claim as construed;
- (4) Viewed without any knowledge of the alleged invention as claimed, do those differences constitute steps which would have been obvious to the person skilled in the art or do they require any degree of invention?

ANALYSIS

[15] The claims on file include four independent claims: 1, 15, 25 and 26. At the hearing the Applicant conceded that dependent claims 2-14 and dependent claims 17-24 contained nothing inventive beyond that which the Applicant considered to be inventive in independent claims 1 and 15, respectively. The only dependent claim for which the Applicant asserted a further inventive feature was claim 16. Accordingly, the only claims requiring analysis in this review are claims 1, 15, 16, 25 and 26. If these claims are obvious, then the Applicant concedes that all the other claims on file are also obvious.

Claim 1

[16] Briefly, claim 1 claims an apparatus for displaying and providing advertising material comprising the following combination of elements: a display structure presenting primary advertising material; a remote server having a database comprising secondary advertising material related to the primary advertising material; and an interactive terminal, connected to the remote server via a communications network, that permits a potential customer to provide input regarding the subject of the primary advertising material and to receive secondary advertising material in a physical form. Claim 1 reads as follows:

1. Apparatus for displaying and providing advertising material comprising:

a) at least one display structure configured to be located in or near a public walkway having pedestrian traffic, the display structure including a conspicuous and visually attractive visual display for attracting the attention of potential customers passing thereby, the visual display comprising primary advertising material containing information regarding a vendor, product or service, wherein the display structure is non-interactive to the potential customers;

b) an advertising server remote from the display structure, the advertising server comprising a computer server having a database, the database comprising secondary advertising material related to the primary advertising material, the secondary advertising material providing additional

information designed to help the potential customers decide whether or not to choose the vendor, product or service, and a server network interface for connecting to a communications network; and

c) at least one interactive terminal separate from and in proximity to the display structure such that the visual display remains unobstructed and undisturbed by a user of the interactive terminal, the interactive terminal comprising a terminal network interface connected to the communications network, a user input module for receiving user input from the potential customers, a computer processor for processing the user input and for retrieving the secondary advertising material from the advertising server through the terminal network interface, and a user output module for communicating the secondary advertising material to the potential customers;

d) wherein the user output module comprises an output device for providing the secondary advertising material to the potential customers in a physical form that allows the secondary advertising material to be taken away from the interactive terminal by the potential customers and to be reviewed by the potential customers at a later time.

Claim 1, purposively construed

[17] Since claims must be considered from the point of view of the skilled person in view of their common general knowledge, it is first necessary to identify such a person and such knowledge.

The person skilled in the art and the relevant common general knowledge

[18] Having reviewed the Applicant's submissions, in particular the Applicant's letter dated May 7, 2014 and the Applicant's arguments at the hearing, what we take from them is that the person skilled in the art would be a person having experience in creating "networked interactive displays for the purposes of advertising", and the common general knowledge of this person would include:

- familiarity with basic advertising concepts;

- possession of ordinary programming ability;
- familiarity with user interface programming techniques and networked database programming;
- a layman's understanding of consumer psychology or marketing; and
- knowledge of conventional advertising displays, including static displays.

[19] We accept the Applicant's characterization of the person skilled in the art and of the common general knowledge of this person, and our analysis proceeds on this basis.

Meaning of certain claim expressions

[20] Before determining the essential elements of claim 1, we will elaborate on the meaning of two claim expressions: "advertising material" and "separate".

"advertising material"

[21] Regarding "advertising material", the exemplary embodiments of the invention disclosed in the description relate to goods and services offered to customers by vendors or suppliers. The description refers to a catalogue showing items on sale at a store, and mentions products such as clothing, books, mobile phones and automobiles, and services such as hairstyling and advisory and professional services. However, the person skilled in the art would understand "advertising material" to have a broader meaning, encompassing any information presented to the public, regardless of whether or not the information is intended to generate sales or revenue. The skilled person would appreciate that whether or not the information relates to goods and services for sale would have no effect on the working of the invention.

"separate"

- [22] In its February 14, 2014 letter the panel invited the Applicant to provide comments concerning the interpretation of the term “separate” in the expression “interactive terminal separate from and in proximity to the display structure.” In its May 7, 2014 response, the Applicant submitted that this term should be given its plain and ordinary meaning of not being attached to, of being physically separate. The Applicant also pointed out that the description and drawings were consistent with this meaning. In particular, the May 7, 2014 letter points out that the description states at para. [0050] that the terminal is located “near” the display structure, which suggests that the interactive terminal and display structure are not physically connected. The Applicant’s letter also refers to Figure 1 as supporting this view.
- [23] In view of the above, we consider that the skilled person would interpret “separate” as meaning physically separate.

The essential elements of claim 1

The problem identified in the application

- [24] The Background of the Invention section of the description (pages 1-2) provides a number of examples of previous systems and methods for displaying advertising material. The description also describes (at paras. [0002]-[0004]) the problem associated with previous systems as being their inability to provide personalized, detailed information of interest to a potential customer.

The proposed solution to the problem

- [25] The Summary of the Invention portion of the description (paras. [0005]-[0009]) generally describes the Applicant’s proposed technical solution to this problem, namely a system comprising a combination of a non-interactive display structure, a server having a

database, and a separate interactive terminal connected to the server, the interactive terminal having a user input module, a computer processor and a user output module, and a method carried out using such a system.

[26] The skilled person would determine that the following elements form part of the solution to the problem identified at para. [24] and are thus essential elements of claim 1:

- a non-interactive display structure that displays primary information;
- a server having a database comprising secondary information related to the primary information;
- an interactive terminal that is separate from and in proximity to the display structure, such that the visual display remains unobstructed and undisturbed by a user of the interactive terminal;
- the interactive terminal connected to the server containing the secondary information; and
- the interactive terminal having a user input module that receives user input from potential customers, a computer processor that processes the user input and retrieves the secondary information from the server, and a user output module that communicates the secondary information to the customers in a physical form.

[27] Regarding the claims on file, having considered the Examination Practice Respecting Computer-Implemented Inventions - PN 2013-03, it is arguable that at least some of the claimed elements address non-computer related problems, *e.g.*, engaging the interest of potential customers for a long period of time, and enhancing the absorption and retention rate of the message. If all of the elements of the claims were found to address non-computer related problems, then the claims may be considered to be directed to non-patentable subject matter. However, in view of our conclusions on the issue of obviousness, the panel need not determine the issue in its review of this case.

Obviousness under the *Sanofi* framework

(1)(a) Identify the notional person skilled in the art

[28] The person skilled in the art was identified at para. [18].

(1)(b) Identify the relevant common general knowledge of that person

[29] The common general knowledge of the skilled person was identified at para. [18].

(2) Identify the inventive concept of the claim in question or if that cannot readily be done, construe it

[30] Having considered the problem the Applicant sought to address and the solution provided by the claimed invention, we take the essential features of claim 1, as noted at para. [26], to be reflective of the claim's inventive concept. This view is in accord with the Applicant's characterization of the inventive concept of claim 1 as set out in the Applicant's letter of December 16, 2013 and as supplemented at the hearing.

(3) Identify what, if any, differences exist between the matter cited as forming part of the "state of the art" and the inventive concept of the claim or the claim as construed

[31] In the Final Action and Summary of Reasons the following references were cited:

Patent Applications

D1: US 2002/0098001 A1	published 25 July 2002	Dahl
D2: US 2002/0124271 A1	published 05 Sept 2002	Herrmann
D3: US 2006/0059047 A1	published 16 Mar 2006	Cardone

- [32] The Final Action stated that the claims were obvious having regard to D1, D2 or D3 in light of the common general knowledge of the person skilled in the art. The Applicant, in its response to the Final Action, in its response to the panel's questions and in its arguments presented at the hearing, argued for the non-obviousness of its claims in view of the references, both individually and collectively, and the common general knowledge. We do not consider D2, which discloses a media display terminal including a large vertically orientated display that can be partitioned to display varied content to attract different groups of a viewing audience, to be particularly relevant to the claimed subject matter of the instant application. Accordingly, our obviousness analysis is based on a consideration of D1 and D3, as read by the skilled person in light of the common general knowledge in the art.
- [33] D1 discloses a large scale electronic display combined with an interactive terminal on a single display screen. The display is operative in two modes: a first mode, when no one is using the interactive terminal, in which the entire electronic display exhibits advertising material; and a second mode, when a passerby is using the interactive terminal, in which interactive terminal images are exhibited on the lower section of the electronic display and the advertising material remains on the upper section of the display. In use, the large scale electronic display is designed to exhibit images to catch the eye of passersby. An approach within a short distance by an interested passerby is detected by a motion detector, causing the computer to change to a message inviting use of the interactive terminal. When the interested passerby steps up to the terminal and touches a keyboard, touch pad or touch screen comprised of the lower section of the display screen, the display enters the second mode, and the user can access information stored on a peripheral device connected to the terminal or information from web sites via an internet connection. An example of an application of the system provides a large image representing a building complex to attract the eye of passersby, while the interactive terminal provides access to more detailed information concerning the complex, e.g., information regarding products for sale, retail store locations, and information on

restaurants and events. By connecting to the internet, commercial web sites of advertisers can be contacted, and transactions completed. The system also includes a printer connected to the terminal to allow copies of transaction details.

[34] D3 discloses a large communications display, which broadcasts predetermined media content such as video and banner advertisements, and a separate interactive module having a display screen and an interface device such as a keyboard, mouse or touchscreen, which module provides Internet access to a user free of charge. D3 includes an embodiment in which one or more business organizations can buy advertising space through the interactive module and/or through the communications display, which advertising is exposed to the user.

[35] The Applicant submitted at the hearing that there are three features of the inventive concept of claim 1 that are not taught by the state of the art, the most relevant reference of which is D1:

- i the non-interactive display structure for displaying primary advertising material [information] is separate from and in proximity to the interactive terminal;
- ii the interactive terminal provides secondary advertising material [information] that gives additional information regarding the primary advertising material [information] based on the input of the user; and
- iii the secondary advertising material [information] can be taken away by the user in physical form.

[36] Feature (i) is a difference, as it is not taught by D1.

[37] Feature (ii) is not a difference. D1 describes an example of an application of the type of system disclosed, which provides a large visual display representing a building complex to attract the eye of passersby (para. [0030] and Fig. 3), while the interactive terminal

provides access to more detailed information concerning the building complex, e.g., information regarding products for sale, retail store locations, and information on restaurants and events (para. [0035] and Fig. 3) based on user input (para. [0032]). As stated at para. [21], the skilled person would understand that “advertising material” was any information presented to the public. It follows that feature (ii) is not a difference between the state of the art and the inventive concept of claim 1. Further, even if “advertising material” were to be construed narrowly, as information intended to generate sales or revenue, feature (ii) would still not be considered a difference between the state of the art and the inventive concept of claim 1, since the person skilled in the art would understand from the Background of D1 (paras. [0003]-[0006]) that the primary information includes advertising, and the skilled person would appreciate from the Detailed Description of D1 (para. [0035]) that the secondary information includes content concerning products.

[38] Feature (iii) is not a difference. At the hearing the Applicant noted that D1 discloses a thermal printer (para. [0034]). The Applicant conceded that having a printer device within the apparatus in order to provide an output from the interactive terminal is not a difference between the state of the art and the inventive concept.

[39] In summary, the only difference between the state of the art and the inventive concept of claim 1 relates to feature (i): in the Applicant’s apparatus the non-interactive display structure for displaying primary information is separate from and in proximity to the interactive terminal whereas in D1 the non-interactive display and the interactive display comprise separate areas on a single display screen.

(4) Viewed without any knowledge of the alleged invention as claimed, do those differences constitute steps which would have been obvious to the person skilled in the art or do they require any degree of invention?

- [40] At the hearing the Applicant argued that in the system of D1, in which the large scale electronic display and the interactive terminal display are parts of a single display screen, a user of the interactive terminal would physically block a portion of the large scale electronic display from the view of passersby, and thus they would not be drawn in, or attracted, to the interactive terminal.
- [41] While this may conceivably occur in some cases, depending on the mounting height of the screen, the proportion of the screen that is to be dedicated to the interactive display and the overall height of the display screen, we note that in D1 the display screen is designed so as to be readily viewable by persons at some distance from the kiosk (paras. [0008] and [0022]) as well as to continue to present an image in the upper region of the display while the interactive terminal is in use (para. [0031]), and thus we consider that the skilled person would be led by D1 to provide, depending on these dimensions, an apparatus in which a user of the interactive terminal would not block a significant portion of the large scale electronic display from the view of passersby. Thus, it does not appear that there was any problem with the D1 system of users of the interactive terminal physically blocking a significant portion of the large scale electronic display from the view of passersby, as alleged by the Applicant.
- [42] The Applicant further argued at the hearing that even if a passerby's view of the large scale display in D1 was not physically blocked by a user of the interactive terminal, the mere presence of the user immediately in front of the display would provide a psychological barrier to others approaching, as it would be apparent that another user was occupying the space, and generally speaking people are conscious of respecting the privacy of others.
- [43] However, even in such a scenario, while a user of the interactive terminal may provide a psychological barrier to others approaching the interactive terminal (and this applies equally to the claimed invention as to D1), we see no reason why a user's presence at the

interactive terminal would prevent others from viewing the larger part of the split-screen from a distance, as intended by D1. We do not consider that this alleged problem with the D1 system was, in fact, a problem.

[44] In considering the difference between the state of the art and the inventive concept, namely feature (i), the non-interactive display structure being separate from and in proximity to the interactive terminal, the skilled person would understand from D3 that the provision of separate screens for the large scale display and the interactive terminal [see Fig. 2, and para. [0026] of D3] was still an alternative to a single, split-screen embodiment, even after the publication of D1.

[45] It would have been obvious to the skilled person to modify the apparatus and method of D1 by providing the known alternative of separate screens for the large scale display and the interactive terminal in place of the single, split screen used to provide both functions. Claim 1 would therefore have been obvious to the skilled person on the claim date in view of D1, having regard to D3.

Claim 15

[46] Claim 15 claims a method for displaying and providing information that can be practised using the apparatus of claim 1. Briefly, claim 15 includes the following steps: placing a display structure in a public area; presenting primary advertising material via the display structure; eliciting user input regarding the subject of the primary advertising material from a potential customer via an interactive terminal; receiving the user input; generating secondary advertising material, related to the primary advertising material, in response to the user input; and providing the secondary advertising material to the potential customer in a physical form. Claim 15 reads as follows:

15. A method for displaying and providing information, comprising the steps of:

- a) placing a display structure having a conspicuous and visually attractive visual display in or near a public walkway having pedestrian traffic, the display structure being non-interactive to potential customers;
- b) presenting primary advertising material containing information regarding a vendor, product or service to the potential customers by way of the display structure;
- c) eliciting user input from the potential customers by way of an interactive terminal located separate from and in proximity to the display structure such that the visual display remains unobstructed and undisturbed by a user of the interactive terminal;
- d) receiving user input from the potential customers through an input module of the interactive terminal;
- e) generating secondary advertising material related to the primary advertising material in response to the user input, the secondary advertising material providing additional information designed to help the potential customers decide whether or not to chose the vendor, product or service; and
- f) providing the secondary advertising material to the potential customers in a physical form that allows the secondary advertising material to be taken away from the interactive terminal by the potential customers and to be reviewed by the potential customers at a later time.

[47] The skilled person would determine that the following steps form part of the solution to the problem identified at para. [24] (i.e., the inability of previous systems to provide personalized, detailed information of interest to a potential customer) and are thus essential elements of claim 15:

- placing a display structure in a public area;
- presenting primary information via the display structure;
- eliciting user input regarding the subject of the primary information from potential customers via an interactive terminal located in proximity to, but separate from, the display structure;

- receiving user input from the potential customers through the interactive terminal;
- generating secondary information, related to the primary information, in response to the user input; and
- providing the secondary information to the potential customers in a physical form.

[48] We see no reason why the inventive concept of claim 15 should be anything more or less than the essential elements of claim 15.

[49] The Applicant submitted that the differences between the state of the art and the inventive concept of claim 15 are identical to those of claim 1, noted above at para. [35]. However, since claim 15 defines a method, we consider the alleged differences to comprise the features noted at para. [35], modified to reflect method steps, as follows:

- a eliciting user input regarding the subject of the primary information from potential customers via an interactive terminal located in proximity to, but separate from, the display structure;
- b generating secondary information, related to the primary information, in response to the user input; and
- c providing the secondary information to the potential customers in a physical form.

[50] Regarding feature (a), the step of eliciting user input regarding the subject of the primary information from potential customers via an interactive terminal is taught by D1. However, the feature of the interactive terminal being located in proximity to, but separate from, the display structure is not taught by D1 and comprises a difference.

[51] Concerning feature (b), for the reasoning provided at para. [37], this is not a difference between the state of the art and the inventive concept of claim 15.

- [52] As for feature (c), for the reasoning provided at para. [38], this is not a difference between the state of the art and the inventive concept.
- [53] In summary, the difference between the state of the art and the inventive concept of claim 15 is the same difference as that with respect to claim 1, as stated at para. [39].
- [54] Accordingly, claim 15 would have been obvious to the skilled person on the claim date for the reasoning provided with respect to claim 1.

Claim 16

- [55] Claim 16, which depends on claim 15, comprises the method steps of claim 15 plus the further feature of the step of generating secondary advertising material comprising the step of retrieving secondary advertising material from a remote advertising server through a communications network.
- [56] The essential elements of claim 16 include the essential elements of claim 15 plus the further feature of retrieving secondary advertising material from a remote advertising server through a communications network.
- [57] The Applicant submitted at the hearing that the inventive concept of claim 16 includes the inventive concept of claim 15 plus this further feature.
- [58] Considering this feature forms part of the solution to the problem identified at para [24], we accept the Applicant's characterization of the inventive concept of claim 16.
- [59] Since the further feature is disclosed by D1 (see para. [0036], which describes connecting to web sites using the internet) and thus does not constitute a difference, it follows that

the difference between the state of the art and the inventive concept of claim 16 is the same difference as that with respect to claim 15 (and the same difference as that with respect to claim 1).

[60] Accordingly, claim 16 would have been obvious to the skilled person on the claim date for the reasoning provided with respect to claim 1.

Claim 25

[61] Claim 25 is almost identical to claim 15 except that it provides a further limitation in that the secondary advertising material is personalized based on user input.

Meaning of claim expression “personalized information”

[62] Regarding the expression “personalized information”, the description provides one such example, at para. [0044]:

An example of personalization could take place in a terminal where one of the I/O devices 50 is a still image camera, and where the secondary advertisement material 34 relates to fashion. It is possible to take a picture of the customer’s face using the still image camera and pair it with a variety of different fashion looks or hairstyles. This creates greater engagement in the customer than if only the clothing were shown.

[63] At the hearing, the Applicant provided another example of personalized information: the postal code of a user. We note that support for this example is found in the description, at para. [0037], in describing types of information that may be inputted by a user:

Examples of such required customer information may be name, address, telephone number, e-mail address, credit information, personal identification number (PIN), geographical location, and so on. Another example of customer information might be demographic information used, for example, if secondary advertising material contained data to make recommendations to a customer

based on demographics.

- [64] The Applicant's example of the postal code of a user as a type of personalized information would be considered by the skilled person to be within the scope of "address" and "geographical location."
- [65] In view of the above, the skilled person would interpret personalized information as information particular to a specific user that can be used to tailor secondary information that is provided to that user.
- [66] The essential elements of claim 25 include the essential elements of claim 15 plus the further feature of the secondary information being personalized based on user input.
- [67] Considering this feature forms part of the solution to the problem identified at para. [24], the inventive concept of claim 25 includes the inventive concept of claim 15 plus this further feature.
- [68] This feature is not taught by D1 and thus comprises a further difference.
- [69] In summary, the differences between the state of the art and the inventive concept of claim 25 comprise the difference with respect to claim 15 (in the Applicant's apparatus the non-interactive display structure for displaying primary information is separate from and in proximity to the interactive terminal whereas in D1 the non-interactive display and the interactive display comprise separate areas on a single display screen) plus the further feature (the secondary information being personalized based on user input).
- [70] The analysis under step (4) of the *Sanofi* framework of the difference of the non-interactive display structure being separate and in proximity to the interactive terminal has already been presented, at paras. [40]-[45].

[71] Concerning the further difference of the secondary information being personalized based on user input, the skilled person, possessing knowledge of basic marketing techniques, would be aware of the well-known sales practice of asking questions of potential customers in order to ascertain their needs, budget and preferences, so that they can be directed to products that correspond to such criteria. For example, a car salesperson would not be expected to greet a potential new customer by showing them every vehicle on the lot, but would ask questions of the customer, the answers to which would allow the salesperson to pare down the number of vehicles that would meet the customer's requirements, and to thereafter show the customers those vehicles as well as any available literature regarding those vehicles, so as to permit the customer to make a more informed choice.

[72] Thus, the step of using personalized information obtained from a potential customer to tailor the information that is provided to that customer is within the knowledge of the skilled person.

[73] It would have been obvious to the skilled person to modify the apparatus and method of D1 by: (1) providing the known alternative of separate screens for the large scale display and the interactive terminal in place of the single, split screen used to provide both functions, for the reasoning provided at paras. [40]-[45]; and (2) using personalized information obtained from a potential customer to tailor the information that is provided to that customer. Claim 25 would therefore have been obvious to the skilled person on the claim date in view of D1, having regard to D3 and common general knowledge.

Claim 26

[74] Claim 26 is almost identical to claim 1 except that it provides a further limitation in that the secondary advertising material is personalized based on user input.

- [75] The essential elements of claim 26 include the essential elements of claim 1 plus the further feature of the secondary information being personalized based on user input.
- [76] Considering this feature forms part of the solution to the problem identified at para. [24], the inventive concept of claim 26 includes the inventive concept of claim 1 plus this further feature.
- [77] The further feature of claim 26 is the same as the further feature of claim 25, which, as stated above, is not taught by D1 and thus comprises a difference.
- [78] In summary, the differences between the state of the art and the inventive concept of claim 26 comprise the difference with respect to claim 1 (in the Applicant's apparatus the non-interactive display structure for displaying primary information is separate from and in proximity to the interactive terminal whereas in D1 the non-interactive display and the interactive display comprise separate areas on a single display screen) plus the further feature (the secondary information being personalized based on user input). These differences comprise the same differences as those relating to claim 25.
- [79] It follows that claim 26 would have been obvious to the skilled person on the claim date for the reasoning provided with respect to claim 25.

Dependent claims 2-14 and 17-24

- [80] As noted at para. [15], the Applicant conceded that dependent claims 2-14 contained nothing inventive beyond that which the Applicant considered was inventive in independent claim 1, and that dependent claims 17-24 contained nothing inventive beyond that which the Applicant submitted was inventive in independent claim 15. On consideration of the claims and the cited prior art references, we agree with this view. Accordingly, in view of our finding that independent claims 1 and 15 are obvious, it

follows that dependent claims 2-14 and 17-24 are also obvious.

Summary of findings for claims on file (1-26)

[81] Based on the foregoing analysis, we conclude that the subject matter of claims 1-26 would have been obvious to the skilled person on the claim date.

Proposed claims 27-30

[82] As the claims on file have been found to be obvious and thus not allowable, we consider proposed claims 27-30.

Claims 27 and 28

[83] In addition to the features of the inventive concept of claims 25 and 26, method claim 27 and system claim 28 include a first feedback loop that determines, based on the received user input, whether the received user input is sufficient to generate personalized secondary information and, if not, eliciting additional user input to supplement the user input.

[84] This additional claimed feature, however, is broad enough to include a loop that would recognize when information such as name or address was incorrectly or incompletely entered, and prompt the user to supply the correct and complete information. Such a feature would have been known in the field of user interface programming at the relevant time, as well as being a logical check in the system. The skilled person would not consider this feature to be inventive on its own, nor in combination with the other features of the inventive concepts of claims 25 and 26. Accordingly, claims 27 and 28 would have been obvious to the skilled person on the claim date in view of D1, having regard to D3 and common general knowledge.

Claims 29 and 30

- [85] In addition to the features of the inventive concept of claims 25 and 26, method claim 29 and system claim 30 include a second feedback loop that determines, based on the received user input, whether the initial [secondary] information is sufficient to generate personalized secondary information and, if not, retrieving additional secondary information from the server.
- [86] This additional claimed feature, however, merely illustrates an alternative embodiment in which additional secondary information is stored at the server beyond that which had previously been sent to the kiosk where the user is situated. In such a case, if the information first received from the server is insufficient, additional secondary information is retrieved from the server. This merely reflects the well-known practice of obtaining additional data from a remote server in order to avoid storing all of the information locally. The skilled person would not consider this feature to be inventive on its own, nor in combination with the other features of the inventive concepts of claims 25 and 26. Accordingly, claims 29 and 30 would have been obvious to the skilled person on the claim date in view of D1, having regard to D3 and common general knowledge.

RECOMMENDATION OF THE BOARD

- [87] The panel recommends that the application be refused because the claims on file, namely claims 1-26, would have been obvious to the person skilled in the art on the claim date and thus contravene section 28.3 of the *Patent Act*. Proposed claims 27-30 do not overcome this defect and are therefore not considered “necessary” under subsection 30(6.3) of the *Patent Rules*.

Paul Fitzner
Member

Stephen MacNeil
Member

Andrew Strong
Member

DECISION

[88] I concur with the Patent Appeal Board's findings and its recommendation that the application be refused because the claims on file, namely claim 1-26, would have been obvious to the person skilled in the art on the claim date and thus contravene section 28.3 of the *Patent Act*. I also concur with the Board's findings that proposed claims 27-30 do not overcome this defect and are therefore not considered "necessary" under subsection 30(6.3) of the *Patent Rules*.

[89] Accordingly, in accordance with section 40 of the *Patent Act*, I refuse to grant a patent on this application. Under section 41 of the *Patent Act*, the Applicant has six months within which to appeal my decision to the Federal Court of Canada.

Agnès Lajoie
Assistant Commissioner of Patents

Dated at Gatineau, Quebec,
this 30th day of July, 2015