TOPIC:　O00　　Obviousness

SUJET:　O00　　Évidence

IN THE CANADIAN PATENT OFFICE

DECISION OF THE COMMISSIONER OF PATENTS

Patent application number 2,422,182 having been rejected under subsection 30(3) of the *Patent Rules* (SOR/96-423) as they read immediately before October 30, 2019 ("the former *Rules*"), has consequently been reviewed in accordance with paragraph 199(3)(c) of the *Patent Rules* (SOR/2019-251). The recommendation of the Patent Appeal Board and the decision of the Commissioner are to withdraw the rejection and allow the application.

Agent for the Applicant:

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INTRODUCTION

[1]   This recommendation concerns the review of rejected Canadian patent application number 2,422,182 ("the instant application"), which is entitled "METHODS FOR AUTOMATED ACCESS TO SHIPPING SERVICES" and is owned by United States Postal Service ("the Applicant"). A review of the rejected application has been conducted by the Patent Appeal Board ("the Board") pursuant to paragraph 199(3)(c) of the *Patent Rules*. As explained in more detail below, the Board's recommendation is that the Commissioner of Patents withdraw the rejection and allow the application.

BACKGROUND

The Application

[2]   The instant application, based on a previously filed Patent Cooperation Treaty application, is considered to have been filed in Canada on September 6, 2001 and was laid open to public inspection on March 14, 2002.

[3]   The instant application generally relates to obtaining shipping services information (such as addressing information or shipping labels) from a server over a network by a telephone call center using application programming interfaces ("APIs").

Prosecution History

[4]   On February 26, 2018, a Final Action ("FA") was written pursuant to subsection 30(4) of the former *Rules*. The FA stated that the instant application was defective because all the application claims 1-28 received at the Patent Office October 31, 2016 ("claims on file") were obvious and therefore did not comply with section 28.3 of the *Patent Act*.

[5]   In an August 14, 2018 response to the FA ("RFA"), the Applicant submitted new claims ("proposed claims") and arguments in favour of the patentability of these claims.

[6]   As the Examiner still considered the application not to comply with the *Patent Act*, pursuant to paragraph 30(6)(c) of the former *Rules*, the application was forwarded to the Board for review on February 8, 2019 along with an explanation outlined in a Summary of Reasons ("SOR"). The SOR set out the position that the specification on file was still considered to be defective.

[7]   In a letter dated February 12, 2019, the Board forwarded to the Applicant a copy of the SOR and requested that the Applicant confirm its continued interest in having the application reviewed.

[8]   In a letter dated May 8, 2019, the Applicant confirmed its interest in having the review proceed.

[9]   A Panel of the Board ("the Panel"), comprised of the undersigned members, was formed to review the instant application under paragraph 199(3)(c) of the *Patent Rules*. Given our recommendation that the rejection be withdrawn and the application allowed, no further written or oral submissions from the Applicant are necessary.

ISSUE

[10] The sole issue to be addressed by the present review is whether the claims on file would have been obvious and thus are non-compliant with section 28.3 of the *Patent Act*.

LEGAL PRINCIPLES

Purposive Construction

[11] In accordance with *Free World Trust v Électro Santé Inc*, 2000 SCC 66, essential elements are identified through a purposive construction of the claims done by considering the whole of the disclosure, including the specification and drawings (see also *Whirlpool Corp v Camco Inc*, 2000 SCC 67 at paras 49(f) and (g) and 52). Purposive construction is performed from the point of view of the person skilled in the art in light of the relevant common general knowledge.

Obviousness

[12] Section 28.3 of the *Patent Act* requires claimed subject-matter not to be obvious:

> 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.

[13] In *Apotex Inc v Sanofi-Synthelabo Canada Inc*, 2008 SCC 61 [*Sanofi*] at para 67, the Supreme Court of Canada stated that it is useful in an obviousness inquiry to follow a four-step approach. Below we consider the claims according to that approach.

ANALYSIS

Purposive Construction

[14] There has been no suggestion during the prosecution that any elements of the claims on file are non-essential. Likewise, there have been no issues identified in relation to the meaning and scope of the terms used in the claims on file. We proceed on the same basis below. The person skilled in the art and the relevant CGK will be identified as part of the obviousness analysis under *Sanofi*.

Obviousness

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

[15] The FA at page 2 identified the skilled person thus:

> The person skilled in the art would be a person or team skilled in the field of shipping services. The person skilled in the art would also [be] skilled in the field of general purpose computing and networking technologies.

[16] The Applicant did not dispute this identification of the person skilled in the art and we adopt it here.

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

[17] The FA at page 2 identified the CGK as:

> The skilled person or team is familiar with shipping services. More specifically, the person skilled in the art would be familiar with processing shipping services requests through a call centre.
>
> The skilled team in the field of information management is also familiar with call centre operations, implementations of call centre or mail centre servers, and implementations of XML-based applications.

> The skilled team in the field of shipping services is also familiar with general purpose computer hardware and general purpose computer programming techniques. Given the level of details in the specification, it is presumed that the implementation of the claimed features falls within the common general knowledge in the art.

[18] The Applicant did not dispute this definition of the CGK and we adopt it here.

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

[19] We will consider the independent claims 1, 9, 12, 19, 22, and 28 first as they are determinative of our obviousness analysis. These claims all recite the same elements; therefore we may consider claim 1 as representative of the independent claims and is presented here:

> 1. A method for obtaining shipping services information over a network by a call center receiving orders for merchandise, comprising:
>
> receiving, by a processor at the call center, order information related to the merchandise;
>
> generating, by the processor at the call center, an XML request for verified address information;
>
> sending, by the processor at the call center, the XML request to an API server storing the verified address information;
>
> receiving, by the processor at the call center, an XML response including verified address information;
>
> generating, by the processor at the call center, a request for the shipping services information, the shipping services information comprising information regarding shipping services for shipment of the merchandise, at least a portion of the requested shipping services information being related to the order information;
>
> sending, by the processor at the call center, the request for the shipping services information to a server over the network;
>
> receiving, by the processor at the call center, the requested shipping services information from the server over the network in response to the request sent to the server; and
>
> electronically providing, by the processor at the call center, over the network, to an operator at the call center, a printable delivery confirmation label for shipment of the merchandise, the printable delivery confirmation label including the shipping services information and a delivery confirmation number.

[20] We consider all the claim elements to be essential and to form the inventive concept, consistent with the FA identified inventive concept at pages 2 to 3. The Applicant did not dispute the identified inventive concept.

(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

[21] The FA cited the following prior art:

D1: US 5,918,213   June 29, 1999   Bernard et al.

D2: WO 00/46728   August 10, 2000   Creasy et al.

D3: US 6,029,143   February 22, 2000   Mosher et al.

D4: Glushko et al., "An XML framework for agent-based e-commerce", Communications of ACM, Vol. 42, No. 3, March 1999, pages 106-114

[22] In our view, consistent with the analysis presented in the FA, D1 and D3 are the closest prior art. D1 and D3 describe computer based purchasing systems which receive customer-placed orders including shipping information.

[23] With respect to the representative claim 1, in our view, D1 and D3 disclose the following (wherein the strikethrough text indicates claimed features not disclosed by D1 or D3):

- receiving, by a processor at the call center, order information related to the merchandise (D1: column 42, lines 36 to 49; column 43, lines 4 to 9; D3: column 6, lines 49-60);

- generating, by the processor at the call center, ~~an XML~~ request for ~~verified~~ address information; sending, by the processor at the call center or mail center, the ~~XML~~ request to ~~an API~~ server storing the ~~verified~~ address information; receiving, by the processor at the call center or mail center, ~~an XML~~ response including ~~verified~~ address information (D1: column 18, lines 9 to 22; column 22, line 67 to column 23, line 6; D3: column 6, lines 49-60).

[24] Also, in view of D1 and D3, D2, which describes methods of shipping a package and is in the same art as D1 and D3, further discloses:

- electronically providing, by the processor at the call center or mail center, over the network, to an operator at the call center, a printable delivery confirmation label for

shipment of the merchandise, the printable delivery confirmation label including the shipping services information and a delivery confirmation number (D2: page 5, lines 5 to 15).

[25] In our view, and consistent with the differences as identified in the FA at page 3, the cited references do not disclose the following features:

1) generating, by the processor at the call center, an XML request for verified address information; sending, by the processor at the call center or mail center, the XML request to an API server storing the verified address information; receiving, by the processor at the call center or mail center, an XML response including verified address information; and

2) generating, by the processor at the call center, a request for the shipping services information to a server over the network, the shipping services information comprising information regarding shipping services for shipment of the merchandise, at least a portion of the requested shipping services information being related to the order information; sending, by the processor at the call center, the request for the shipping services information to a server over the network; receiving, by the processor at the call center, the requested shipping services information from the server over the network in response to the request sent to the server.

[26] The Applicant did not disagree with the differences provided in the FA but argued that the prior art did not disclose these differences (see step 4 below).

(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?

Difference 1

[27] The FA at pages 3-4 took the position that utilizing XML requests and responses to obtain verified address information from a server would be considered CGK in view of D4.

[28] In the RFA, the Applicant addressed this difference in the context of the proposed claims. Relevant to our analysis regarding the claims on file, the Applicant noted that the claimed feature of verifying the shipping address allows a customer to provide an incorrect address requiring verification (page 4).

[29] In response to the RFA, the Examiner submitted in the SOR that address verification, with respect to both incomplete and inaccurate addresses, is CGK.

[30] D4 discloses the XML language and rules available to those skilled in the art, which includes verifying or updating customer address information. D4 states the ability to "use XML forms to place orders, make reservations, and schedule shipments" (page 107, left column, 1st paragraph) and at page 113, right column, last paragraph to page 114, left column, 1st paragraph:

> when a company submits a purchase order, the XML parser in the eCo server uses the purchase order … to transform the purchase order instance into a stream of information events. These events are then routed to any application[s]
>
> …
>
> In the purchase order example, information coming from the parser may be acted on by various applications:
>
> …
>
> • A customer database verifying or updating a customer's address;
>
> • A shipping company system using the address information to schedule a delivery;
>
> …

[31] In our view, the use of the XML request/response recited in the claims on file allows a shipping company to provide an API server to an order processing call center, the API server providing an address verification service through a network (paragraphs 37 to 39 of the description). The claimed feature determines the validity of a customer-provided address for shipping and confirms that an address is indeed correct for the purposes of shipping a package successfully to an address (paragraphs 37 to 39 of the description).

[32] Even if we consider address verification as part of the CGK, D4 at best describes the ability to verify customer addresses but does not disclose the process by which an API server is used to offer address verification through an XML request/response as claimed.

[33] In light of the above, in our view the combination of D1, D3, and D4 do not, alone, or in combination, disclose difference 1.

Difference 2

[34] The FA submitted that D1 and D3 combined disclosed this feature and that "generating, sending, and receiving requests relating to shipping services" and that the difference between this and the claimed feature were administrative and considered obvious. From the FA, D1 (column 24, lines 19-28) discloses:

> When an order is completed by a customer it is sent to fulfillment vendor 436 for fulfillment of the order. Fulfillment vendor 436 receives the order via wide area network 412 and processes and ships the order. Fulfillment vendor 436 can be an actual part of the automated product purchasing system, or alternatively, fulfillment vendor 436 can be an independent service contracted to perform order fulfillment related services such as warehousing, inventory control and shipping functions. In one embodiment, fulfillment vendor 436 is an independent contractor.

while D3 (column 8, lines 44-61) discloses:

> … fulfillment processing information pertinent to shipping is collected in appropriate data fields of the relevant service provider database during process 120… this fulfillment data is sent to the relevant service provider remote site ... The fulfillment data transmitted in operation 194 may also provide other information, including but not limited to: (1) shipped kit/package configurations, quantities, and designated shipping destinations, (2) accounting information, (3) components purchased or received, (4) kit orders received, (5) orders on hold or otherwise in process…

[35] In the response on October 31, 2016, the Applicant disputed this and stated that neither D1 nor D3 disclose or suggest these features. The Applicant stated that the order information of D1 does not include the claimed feature of "shipping services information" (page 3). The Applicant also stated that D3 discloses "fulfillment processing information pertinent to shipping [which] is collected and stored in a database" (page 4). The Applicant further stated that "although computer system 90 collects information pertinent to shipping, computer system 90 of D3 does not '**generat[e] … a request** for shipping information … **at least a portion** of the requested services information **being related to the order information**' as received in claim 1" (emphasis in the original, page 4).

[36] In the Panel's view, the claimed features of generating, sending, and receiving requests between the call center and the shipping service are not viewed as obvious in view of the sending of the orders to a fulfilment center of D1 and D3 as presented in the FA. In the claimed invention, the call center generates requests for the shipping services to provide accurate shipping information to their customers, which is not disclosed in D1 or D3. Therefore in our view the combination of D1 and D3 do not, alone, or in combination, disclose difference 2.

Conclusions on Obviousness

[37] In light of our obviousness analysis above, in our view, representative claim 1 would not have been obvious and complies with section 28.3 of the *Patent Act.*

[38] Independent claims 9, 12, 19, 22, and 28 also would not have been obvious as they recite the same inventive elements of using XML requests to an API server for address verification and generating, sending, and receiving requests between the call center and the shipping service for shipping services information as representative claim 1. Therefore in our view, independent claims 9, 12, 19, 22, and 28 also comply with section 28.3 of the *Patent Act*.

[39] The dependent claims would also not have been obvious as they depend on non-obvious claims 1, 9, 12, 19, 22, and 28. Therefore, in our view, all dependent claims also comply with section 28.3 of the *Patent Act*.

CONCLUSION AND RECOMMENDATION OF THE BOARD

[40] For the reasons set out above, we are of the view that the rejection is not justified on the basis of the defect indicated in the FA notice and we have reasonable grounds to believe that the instant application complies with the *Patent Act* and the *Patent Rules*. We recommend that the Applicant be notified in accordance with subsection 86(10) of the *Patent Rules* that the rejection of the instant application is withdrawn and that the instant application has been found allowable.

[41] As we consider the application in its present form to be allowable, we have not reviewed the proposed claims. In accordance with paragraph 199(3)(b) of the *Patent Rules*, these proposed amendments are considered not to have been made.

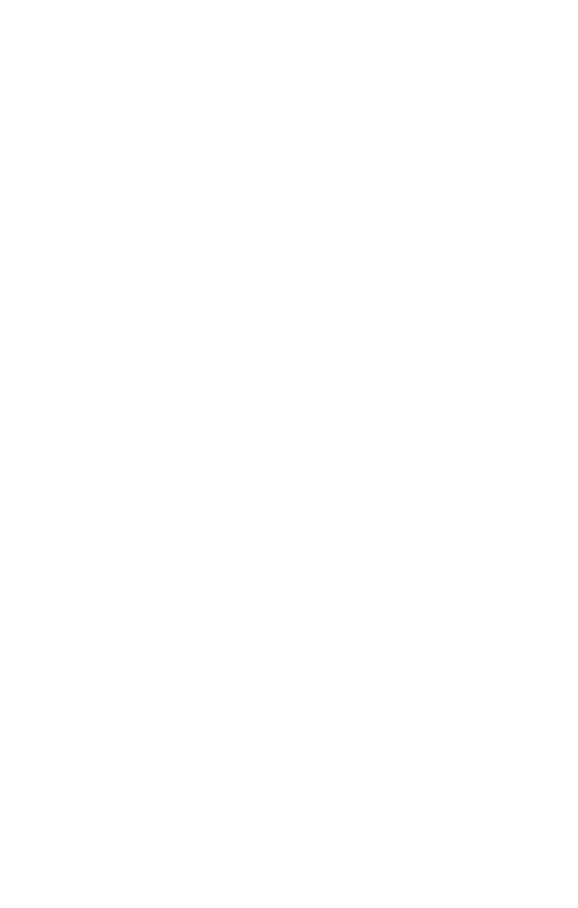|		
Mara Gravelle	Jeremy Garnet	Lewis Robart
Member	Member	Member

DECISION OF THE COMMISSIONER

[42] I concur with the findings and the recommendation of the Board. In accordance with subsection 86(10) of the *Patent Rule*s, I hereby notify the Applicant that the rejection of the instant application is withdrawn, the instant application has been found allowable, and I will direct my officials to issue a Notice of Allowance in due course.

Virginie Ethier
Assistant Commissioner of Patents

Dated at Gatineau, Quebec

this 25th day of March 2021