

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte WESLEY E. MUNSIL, JAMES R. LOGAN, and ALAN W. SWITZER

Appeal No. 2003-0957
Application No. 09/074,074

ON BRIEF

Before KRASS, BARRY, and SAADAT, *Administrative Patent Judges*.
BARRY, *Administrative Patent Judge*.

DECISION ON APPEAL

A patent examiner rejected claims 18-20. The appellants appeal therefrom under 35 U.S.C. § 134(a). We reverse.

BACKGROUND

The invention at issue on appeal concerns the billing of customers. Many providers of services or products periodically generate bills for their customers. For example, a cable television ("CATV") company may operate many CATV franchises in several geographic regions, covering millions of customers. Each month, it sends a bill to each such customer. (Spec. at 1.)

Messages are included with each bill. The space available on a standardized billing statement limits, however, the number of such messages that can be included. When all messages will not fit in the available space, the appellants explain, some messages are omitted "regardless of priority or importance." (*Id* at 2.) They assert, "[t]here is no known system for prioritizing the universe of messages that could appear on a bill and then print them on the available space according to their priority." (*Id.*)

In contrast, the appellants' "bill messaging system . . . prints . . . messages on a customer billing statement according to a predetermined priority in the space allocated on the billing statement for such . . . messages." (*Id.*) More specifically, billing personnel use the system to define a universe of available messages for a billing cycle. The personnel assign a priority to each message. (*Id.* at 4.)

Using data about each customer, the system qualifies each message; only messages relevant to a particular customer qualify for that customer. The system then arranges all the qualifying messages according to priority. Only those that fit on the bill are eventually printed. (*Id.*)

A further understanding of the invention can be achieved by reading the following claim.

19. A computer-readable media having instructions for use in automatically generating a customer billing statement for a plurality of customers; the instructions performing steps comprising:

creating a customer billing statement template having a message area;

storing in a database a plurality of billing messages each having an assigned priority;

defining criteria for determining which of the billing messages are to be included in a customer billing statement; and

generating the customer billing statement for each of the plurality of customers by repeating the steps of:

selecting billing messages from the database based on the criteria and information specific to the customer being billed;

arranging the selected billing messages based on their priority; and

using only those selected billing messages that have the highest priority and that can fit within the message area when generating each customer billing statement.

Claims 18-20 stand rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 5,121,945 ("Thomson") and U.S. Patent No. 5,177,687 ("Baggarly").

OPINION

Rather than reiterate the positions of the examiner or the appellants *in toto*, we address the point of contention therebetween. The examiner makes the following assertions.

Thomson et al show: arranging the selected billing messages (Fig. a¹ (A, 11, 98), Fig. b (B, 87), Fig. c (L,² C, 11, 22) and Fig. d. (D). The message A, Fig. a, seemingly looks that it would remain same for all the customers, however, it is just an example of types of the various messages under the element named "Variable message data" (Col. 13, line 17) stored (arranged) in the database (Col. 12, lines 63-65: This system includes the functions of generation (arranging, storing) of the initial customer and financial institution control file data base from source data) in some predefined scheme. Thomson et al also show "matching and extraction (selection) of information, col. 13, lines 65-68". From the above citations, it is clear that Thomson et al teach "arranging the selected messages".

(Examiner's Answer, § 11.³) He admits, "Thomson et al do not show . . . each [message] having an assigned priority. . . ." (*Id.*, §10.) Noting that "Baggerly et al teach priority of messages to be included in the envelope enclosing the statement of account (billing statement)," (*id.*), the examiner asserts, "it would have been obvious . . . to incorporate Baggerly et al's feature in Thomson et al's invention, because it would

¹Thomson omits "Fig. a," "Fig. b," "Fig. c," and "Fig. d" to which the examiner refers. Based on the numbers of the drawing element to which he cites (e.g., nos. 11, 98), we presume that the reference is to Figures 1a, 1b, 1c, and 1d of Thomson.

²We are uncertain to what "A," "B," "L," "C," and "D" refer.

³The examiner should number the pages of his answers.

facilitate storage of messages in accordance with most specific/special relevance and importance to the user/customer, so their automatic and unmistakable inclusion/incorporation in the billing statement for the user/customer is ascertained and thus help maintaining a great customer service and business relationship." (*Id.*) The appellants argue, "the teaching of 'highest priority' without more does not supply the requisite suggestion to lead one lead one of skill in the art to modify Thomson to include 'using only those selected messages that have the highest priority and that can fit within the message area (of a billing statement template) when generating each customer billing statement.'" (Reply Br. at 3.)

In addressing the point of contention, the Board conducts a two-step analysis. First, we construe claims at issue to determine their scope. Second, we determine whether the construed claims would have been obvious.

1. CLAIM CONSTRUCTION

"Analysis begins with a key legal question -- *what is the invention claimed?*" *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1567, 1 USPQ2d 1593, 1597 (Fed. Cir. 1987). In answering the question, "the Board must give claims their broadest reasonable construction. . . ." *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1668 (Fed. Cir. 2000).

Here, independent claim 19 recites in pertinent part the following limitations:
"creating a customer billing statement template having a message area; . . . arranging the selected billing messages based on their priority; and using only those selected billing messages that have the highest priority and that can fit within the message area when generating each customer billing statement." Claims 18 includes similar limitations. Giving the independent claims their broadest, reasonable construction, the limitations require assigning priorities to billing messages and including in a customer's bill only those messages that can fit within a message area of a billing template and that have the highest priority.

2. OBVIOUSNESS DETERMINATION

Having determined what subject matter is being claimed, the next inquiry is whether the subject matter would have been obvious. "In rejecting claims under 35 U.S.C. Section 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness." *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993) (citing *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992)). "A *prima facie* case of obviousness is established when the teachings from the prior art itself would . . . have suggested the claimed subject matter to a person of ordinary skill in the art." *In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed.

Cir. 1993) (quoting *In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976)).

Here, Thomson's "invention . . . involves the creation and use of an integrated billing document which includes at least two portions; namely, an invoice or bill, and a check document, each of which have printed and encoded thereon certain particular data pertaining to the payee, payer, the amount of the bill, the payer's account number and the payer's accounts receivable number." Col. 15, ll. 30-38. "This [invention] includes the functions of generation of the initial customer and financial institution control file data base from source data and from the extraction of data from other data base sources. . . ." Col. 12, ll. 63-66. "The contents of the file includes such elements as," *id.* at ll. 67-68, "[c]ustomer name and address," col. 13, l. 4; "[p]ayee name, *id.* at l. 11; and "[v]ariable message data. . . ." *id.* at l. 17.

For its part, Baggary discloses "an inserter machine which includes optional advertising inserts for stuffing with a customer's envelope if and only if the additional weight of the inserts does not increase the postage amount required by the stuffed envelope." Col. 2, ll. 20-24. The reference explains that "[w]hile [a] statement of account and . . . general interest and special interest informational enclosures [] are high priority 'required' items for inclusion in a customer's envelope, . . . advertising

literature is less significant and not deserving of inclusion in the envelope if the inclusion significantly increases the weight of the envelope and thus incurs additional postage."

Col. 1, l. 67 - col. 2, l. 6. In summary, Baggarly assigns priorities to inserts and excludes lower priority inserts based on their weight. We agree with the appellants that "Baggarly does not disclose . . . or suggest any features of [a] billing statement itself. Furthermore, Baggarly does not describe a billing statement template." (Appeal Br. at 5.)

"[T]o establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicants." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000) (citing *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984)). "[T]he factual inquiry whether to combine references must be thorough and searching." *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001). "This factual question . . . [cannot] be resolved on subjective belief and unknown authority." *In re Lee*, 277 F.3d 1338, 1343-44, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002). "It must be based on objective evidence of record." *Id.* at 1343, 61 USPQ2d at 1434.

Here, in contrast to the appellants' invention, the examiner has not shown that space available on Thomson's integrated billing document limits the number of messages that can be included therein. We agree with the appellants that the reference also "fails to disclose . . . or suggest considering if messages can 'fit within the message area (of the billing statement template)' when selecting which messages to use in the billing statement." (Reply Br. at 2.) While Thomson's data base includes a field for variable message data, *supra*, the examiner has not shown that the reference needs to determine, let alone does determine, whether that data can fit within a message area of a billing template. Because the reference is not concerned with limiting the number of messages or the amount of data that can be included in its integrated billing document, we are not persuaded that it would have been desirable to assign priorities to such data. Absent a teaching or suggestion of assigning priorities to billing messages and including in a customer's bill only those messages that can fit within a message area of a billing template and that have the highest priority, we are unpersuaded of a *prima facie* case of obviousness. Therefore, we reverse the obviousness rejection of claims 18 and 19 and of claim 20, which depends from the latter.

CONCLUSION

In summary, the rejection of claims 17-20 under § 103(a) is reversed.

REVERSED

ERROL A. KRASS
Administrative Patent Judge

LANCE LEONARD BARRY
Administrative Patent Judge

MAHSHID D. SAADAT
Administrative Patent Judge

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