

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JAMES P. DELAPA, and JAMES W. WILLMAN

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Appeal No. 2003-1291  
Application 09/468,698

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ON BRIEF

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Before JERRY SMITH, FLEMING and SAADAT, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 63-66, 68-79, 81-96 and 98-117, which constitute all the claims remaining in the application.

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The disclosed invention pertains to a retail establishment discount coupon generating system, adapted for use with a chain comprising a plurality of different retail establishments.

Representative claim 68 is reproduced as follows:

68. A retail establishment discount coupon generating system, adapted for use with a chain comprising a plurality of retail establishments, said coupon generating system comprising:

a generating and delivery system which generates discount coupon offers and delivers said coupon offers to a plurality of different retail establishments, said coupon offers comprising an offer description and a discount value;

wherein said generating and delivery system including an enhancement function which provides tools for enhancing said coupon offers including selecting particular ones of said coupon offers for dispensing by particular one or ones of said retail establishments and not by other one or ones of said retail establishments; and

dispensers at said retail establishments dispensing coupon offers selected by said tools for dispensing at the retail establishments at which the respective dispensers are located, whereby an operator can select different coupon offers for dispensing at different retail establishments, wherein said coupon offers include targeted coupons that are assigned to individual households as a function of at least one attribute of each household, wherein the discount value is variable among said targeted coupons and targeted coupons having different discount values are assigned to individual households at least in part as a function of said at least one attribute of each household.

The examiner relies on the following references:

Lemon et al. (Lemon)	4,674,041	June 16, 1987
Deaton et al. (Deaton)	5,644,723	July 01, 1997

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Claims 63-66, 68-79, 81-96 and 98-117 stand rejected under 35 U.S.C. § 103(a). As evidence of obviousness the examiner offers Lemon in view of Deaton.

Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in the claims on appeal. Accordingly, we reverse.

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In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444

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(Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered and are deemed to be waived [see 37 CFR § 1.192(a)].

The examiner has indicated how he finds the claimed invention to be obvious over the teachings of Lemon and Deaton [answer, pages 3-12]. With respect to independent claims 68 and 85, which stand or fall together [brief, page 2], appellants argue, inter alia, that neither reference teaches a coupon-generating system adaptive for use with a chain composed of a plurality of retail establishments, including selecting particular ones of coupon offers for dispensing by particular one or ones of the retail establishments and not by other one or ones of the retail establishments. Appellants note that although

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Lemon teaches coupon limits, there is no matching of coupons with retail establishments in a chain [brief, page 3].

In the original rejection, the examiner asserted that Lemon teaches that the operator at the local level can prescribe the coupons for his store, and the examiner simply asserted that it was old and well known for local store managers to have a saying on the particular coupons to be available to the stores that he manages [answer, pages 3-4]. In response to appellants' argument noted above, the examiner responds that Lemon teaches a system wherein the operator (i.e. the retail establishment manager) is able to disable and prescribe the coupons that he wants to be generated for the particular establishment or store (terminals T) [answer, page 12].

Appellants respond that there is no disclosure in Lemon to suggest that the retail establishment manager has any control over any part of the system. Appellants assert that the only party having control over the system in Lemon is the operator of the host central computer H. Appellants note that every coupon in Lemon is available to every customer who activates a terminal T at any of the retail establishments [reply brief, pages 1-2].

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We will not sustain the examiner's rejection of independent claims 68 and 85 for essentially the reasons argued by appellants in the briefs. The examiner's interpretation of the disclosure of Lemon is incorrect. The portion of Lemon relied on by the examiner suggests that the central host computer H has complete control over the retail establishment computers. The disclosure indicates that the host computer H makes the same coupons available to every one of the retail establishment computers. As noted by appellants, there is no suggestion within this disclosure of Lemon that some coupon offers are made available to some of the retail establishments but not to others of the retail establishments. The examiner's finding that it is old and well known for local store managers to have control over the coupons available within a given store is unsupported by the record before us. Although there may be prior art which can support this finding by the examiner, the present record is not sufficient.

Even though appellants have made additional arguments in support of the patentability of these claims, the examiner's erroneous finding discussed above is sufficient to defeat the rejection. Since we have not sustained the examiner's rejection of independent claims 68 and 85, we also do not sustain the

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rejection of any of the claims which depend therefrom. The sole remaining independent claim 102 has the same recitation which has been discussed above. Therefore, we also do not sustain the examiner's rejection of independent claim 102 or of the claims which depend therefrom for the same reasons discussed above with respect to claims 68 and 85.

In summary, we have not sustained the examiner's rejection with respect to any of the claims on appeal. Therefore, the decision of the examiner rejecting claims 63-66, 68-79, 81-96 and 98-117 is reversed.

REVERSED

JERRY SMITH	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
MICHAEL R. FLEMING	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
MAHSHID D. SAADAT	)	
Administrative Patent Judge	)	

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