

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TIMOTHY E. DICKSON

Appeal No. 2003-1402
Application No. 09/034,969

HEARD: January 22, 2004

Before TORCZON, GROSS, and BLANKENSHIP, Administrative Patent Judges.
BLANKENSHIP, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-33, which are all the claims in the application.

We reverse, and enter new grounds of rejection in accordance with 37 CFR § 1.196(b).

BACKGROUND

The invention relates to a system whereby a customer may purchase items or services at a first location in a fueling environment (e.g., at a gasoline pump) and receive those items or services at a second location. Representative claim 1 is reproduced below.

1. A multistage order system for a fueling environment comprising:
 - a) a fuel dispenser having an order entry user interface and associated first remote communications electronics adapted to communicate with a remote communications unit associated with a customer;
 - b) an order receipt position apart from said fuel dispenser for providing the customer with an order and having
 - i) second remote communications electronics adapted to communicate with the remote communications unit associated with the customer, and
 - ii) an output indicating the customer who placed the order is at the order receipt location;
 - c) a control system associated with said order interface and said first remote communications electronics of said fuel dispenser and said second remote communications electronics and said output of said order receipt position, said control system adapted to:
 - i) communicate with the remote communications unit through said first remote communications electronics when said remote communications unit is proximate said fuel dispenser;
 - ii) associate a customer order placed at the order entry user interface with the remote communications unit associated with the customer;
 - iii) communicate with the remote communications unit through said second remote communications electronics when said

remote communications unit is proximate said order receipt location; and

- iv) identify the order at the order receipt location associated with the remote communications unit of the customer who placed the order at the order entry user interface of the fuel dispenser and provide said output indicating the customer who placed the order is at the order receipt location.

The examiner relies on the following references:

Smith	5,327,066	Jul. 5, 1994
Theimer et al. (Theimer)	5,627,517	May 6, 1997 (filed Nov. 1, 1995)
Bustos	5,816,443	Oct. 6, 1998 (filed Dec. 12, 1995)

Claims 1-33 stand rejected under the judicially created doctrine of obviousness-type double patenting over claims contained in several U.S. patents; i.e., over claims 1-40 of U.S. 5,798,931, over claims 1-15 of U.S. 6,073,840, over claims 1-51 of U.S. 6,169,938 B1; over claims 1-15 of U.S. 6,157,871; over claims 1-51 of U.S. 6,116,505, over claims 1-33 of U.S. 6,098,879, over claims 1-26 of U.S. 6,078,896, over claims 1-114 of U.S. 6,078,888, over claims 1-36 of U.S. 6,089,284, over claims 1-19 of U.S. 6,185,307 B1, over claims 1-29 of U.S. 6,263,319 B1, over claims 1-20 of U.S. 6,070,156, over claims 1-8 of U.S. 6,026,868, over claims 1-39 of U.S. 6,184,846 B1, and over claims 1-39 of U.S. 6,176,421 B1.

Claims 1-10, 14, 15, 17-19, 25, 26, and 30-32 stand rejected under 35 U.S.C. § 102 as being anticipated by Smith.

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Claims 11-13, 16, 27, 28, and 29 stand rejected under 35 U.S.C. § 103 as being unpatentable over Smith and Bustos.

Claims 20, 22-24, and 33 stand rejected under 35 U.S.C. § 103 as being unpatentable over Smith and Theimer.

Claim 21 stands rejected under 35 U.S.C. § 103 as being unpatentable over Smith, Theimer, and Bustos.

We refer to the Final Rejection (Paper No. 6) and the Examiner's Answer (Paper No. 13) for a statement of the examiner's position and to the Brief (Paper No. 12) and the Reply Brief (Paper No. 14) for appellant's position with respect to the claims which stand rejected.

OPINION

Obviousness-type double patenting rejection of claims 1-31

The examiner has rejected all the instant claims under the judicially created doctrine of obviousness-type double patenting over claims contained in several U.S. patents. Appellant's response is that a terminal disclaimer was filed on December 18, 2001 and re-filed April 18, 2002. (Brief at 20.) The examiner responds in turn that the paper "provided with the response of 1/8/02" appears to be "incomplete." The examiner points to first paragraph, line 5, of the alleged disclaimer wherein, the examiner contends, the phrase "'applicant has provided a separate terminal' appears to be incomplete." (Answer at 19.)

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The paper filed via facsimile on April 18, 2002 purports to be a terminal disclaimer to obviate a provisional double patenting rejection over a pending second application. The first full paragraph of the paper, after listing the patents relied upon in the double patenting rejection, contains the sentence fragment, "Applicant has provided a separate terminal". Although the extraneous words are clearly an error, we agree with appellant that the informality does not render the paper insufficient as a terminal disclaimer. In particular, the examiner has not identified any authority (e.g., statute, regulation, or Manual of Patent Examining Procedure (MPEP) section) in support of the position that the "incomplete" sentence renders the paper ineffective. The informality should be corrected; however, the sentence fragment appears to be merely extraneous material, not related to the minimum requirements for a terminal disclaimer.¹

We therefore do not sustain the examiner's rejection, for the foregoing reasons. We find, however, the paper filed April 18, 2002 to be defective for another reason. Since our reasoning is different from the examiner's, we designate the obviousness-type double patenting rejection as a new ground, set forth infra.

¹ Although the procedure was apparently not followed in the instant case, the paralegal of the Office of the Special Program Examiner of the Technology Center having responsibility for the application normally reviews, in the first instance, any paper submitted as a terminal disclaimer, and records it if acceptable. See MPEP § 1409 (8th ed., Feb. 2003), under the heading "TERMINAL DISCLAIMER IN PENDING APPLICATION PRACTICE."

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Section 102 rejection of claims 1-10, 14, 15, 17-19, 25, 26, and 30-32 as being anticipated by Smith

Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim. Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984).

Ordinarily, reading a claim on separate embodiments described in a reference would not support a finding of anticipation, but might be subject to an inquiry under obviousness. Whether there is suggestion to combine elements or steps of different embodiments is an inquiry under obviousness, rather than anticipation. “Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference.” In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000).

The statement of the rejection of instant claims 1, 25, 26, and 30-32 (Answer at 4-6) appears to rely on different, distinct embodiments to show structures purported to correspond to the claim. For example, the rejection begins, “a fuel dispenser (see figure 8) having an order entry user interface (14 and 26)...” (Id. at 4.) However, card reader 14 and card adapter 26 (Fig. 1a) in Smith are associated with a different embodiment from that of Figure 8. The embodiment of Figure 8 does not contain card readers or adapters, but utilizes memory 1b, with account number information “automatically transferred between the vehicle 1 and the remote controller 20 during a

fueling operation.” Smith at col. 9, ll. 61-68. The embodiment of Figure 8 contains structures in common with the embodiment of Figures 6 and 7, described at column 7, line 28 et seq. of the reference. As a further example of error, the rejection refers to the fuel dispenser of Figure 8 in combination with “second remote communications electronics” alleged to be described by Figure 3. However, figures 1a, 1b, 3, and 4 relate to the “first embodiment” of the invention. Smith at col. 4, ll. 4-5.

Thus, even if Smith were regarded as disclosing individual elements identical to those of the instant claims, the reference has not been shown to disclose the combinations that are claimed. The rejection thus falls short of establishing a prima facie case for anticipation over Smith. We thus do not sustain the rejection of claims 1-10, 14, 15, 17-19, 25, 26, and 30-32 under 35 U.S.C. § 102 as being anticipated by Smith.

Section 103 rejection of claims 11-13, 16, 27, 28, and 29 as being unpatentable over Smith and Bustos

Claims 11-13 and 16 depend from claim 1. At least for the reason that Bustos does not remedy the deficiency in the rejection applied against claim 1, we do not sustain the rejection of claims 11-13 and 16.

Of the remainder of the claims subject to the rejection, claim 27 is independent, with claims 28 and 29 depending therefrom.

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As appellant notes (Brief at 18), the rejection does not address the specific requirements of claim 27. The rejection (Answer at 9-10) apparently refers to Bustos as teaching a “quick-serve restaurant,” which is language appearing in claim 27. The claim, however, requires more than a “quick-serve restaurant,” and the rejection does not show where all the limitations are disclosed or suggested by the references. Apparently, the rejection relies on the erroneous findings with respect to the disclosure of Smith, as applied against claims 1, 25, 26, and 30-32, that we have addressed supra.

We thus do not sustain the rejection of claims 11-13, 16, 27, 28, and 29 under 35 U.S.C. § 103 as being unpatentable over Smith and Bustos.

Section 103 rejection of claims 20, 22-24, and 33 as being unpatentable over Smith and Theimer

In addition to the above-described deficiencies in Smith as applied against the instant claims, we agree with appellant (Brief at 19) that the rejection fails to identify sufficient motivation to modify the fueling environment of Smith with the freight tracking system of Theimer. In particular, the rejection does not show any suggestion in the references for tracking the position of articles (e.g., automobiles) or persons relative to the battery charging, or refueling, systems described by Smith.

We thus do not sustain the rejection of claims 20, 22-24, and 33 under 35 U.S.C. § 103 as being unpatentable over Smith and Theimer.

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Section 103 rejection of claim 21 as being unpatentable over Smith, Theimer, and Bustos

We do not sustain the rejection of claim 21 under 35 U.S.C. § 103 as being unpatentable over Smith, Theimer, and Bustos. Bustos does not remedy the deficiencies in the rejection applied against claim 20, from which claim 21 depends. Moreover, in view of the subject matter of claim 21, the relevance of the allegation that Bustos would have suggested a “car wash service” (Answer at 16-17) is not apparent.

New Grounds of Rejection -- 37 CFR § 1.196(b)

We enter the following new grounds of rejection against the claims in accordance with 37 CFR § 1.196(b).

I. Obviousness-type double patenting

Claims 1-33 are rejected under the judicially created doctrine of obviousness-type double patenting.

At the oral hearing, appellant’s representative confirmed appellant’s intent to file a terminal disclaimer to obviate the rejection entered by the examiner over the patents cited in the Answer.² The latest paper offered as such a disclaimer, filed April 18, 2002, appears to be, as appellant contends, in a format suggested by the USPO as set forth

² See page 3, supra.

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in MPEP § 1490. However, although the paper lists the patents cited in the rejection, the format relates to obviating a provisional double patenting rejection over “a pending second application,” rather than “a prior patent.” The paper thus states a disclaimer with respect “to the grant of any patent granted on U.S. Patent Nos. 5,798,931; 6,073,840 [and others].” Patents are not granted on U.S. patents, of course, but on applications.

Perhaps more important, the paper states that any patent granted on the instant application shall be enforceable so long as “any patent granted on the second application are commonly owned.”

37 CFR § 1.321 provides, in pertinent part:

(c) A terminal disclaimer, when filed to obviate a judicially created double patenting rejection in a patent application or in a reexamination proceeding, must: ...

(3) Include a provision that any patent granted on that application or any patent subject to the reexamination proceeding shall be enforceable only for and during such period that said patent is commonly owned with the application or patent which formed the basis for the rejection.

Because the paper fails to state that any patent granted on the instant application shall be enforceable only for and during such period that said patent is commonly owned with the patents which formed the basis for the rejection, we hold that the requirements for a terminal disclaimer to overcome the double patenting rejection have not been met. Further, the ambiguity related to the “grant of any patent granted

on U.S. Patent[s]” results in a failure to meet the requirement of 37 CFR § 1.321(b)(2); i.e., a failure to “[s]pecify the portion of the term of the patent being disclaimed.”³

II. Section 112, second paragraph

Claims 1-24 and 30-33 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

We observe that the recitation “the order receipt location” in line 11 of claim 1 lacks proper antecedent basis in the claim. Upon review of the standing rejections over the prior art, it appears that the examiner may have regarded the recitations of “order receipt position” and “order receipt location” to refer to separate places, which seems to be a reasonable interpretation of the literal language of the claims. At the oral hearing, however, appellant’s representative stressed that the “position” and the “location” are intended to refer to the same place.

Instant independent claims 1 and 20 refer to both an order receipt “position” and an order receipt “location.” The claims thus appear to fail in particularly pointing out and distinctly claiming the subject matter which applicants regard as the invention. We therefore reject claims 1-24 under 35 U.S.C. § 112, second paragraph, but add that the

³ Any replacement or supplemental paper submitted by applicant as a terminal disclaimer should be reviewed in the appropriate Technology Center for conformance with all requirements for filing a terminal disclaimer in the USPTO. The two deficiencies we have noted are the reasons that we hold the paper filed April 18, 2002 to be ineffective.

rejection may be overcome by a properly submitted amendment changing each occurrence of order receipt “position” to order receipt “location” in independent claims 1 and 20.

We also reject claims 30 through 33 as being indefinite. Part “d)” of base claim 30 recites “communicating with the remote communications unit...” However, “the remote communications unit” -- there are two occurrences in part “d)” -- lacks a proper antecedent in the claim because there are two “remote communications unit[s]” previously set forth. In view of part “e)” of claim 30, and our review of other claims, perhaps the intent for part “b)” of the claim is to set forth an association between the entered order and a “customer,” rather than with a “remote communications unit.” On the other hand, parts “b)” and “d)” of claim 30 appear to associate “the entered order” with something else, rather than associating a “remote communications unit” with a “customer,” as suggested by part “e).” In any event, the recitation “the associated remote communications unit” in part “e)” also lacks proper antecedent basis in the claim.

Further, “the remote communications unit at the remote receiving location” in claim 30 appears to lack a proper antecedent in the claim. If, on the other hand, the “communicating” is intended to be “at the remote receiving location,” then the claim should clearly set forth the feature.

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CONCLUSION

The examiner's rejection of claims 1-33 under the judicially created doctrine of obviousness-type double patenting is reversed. The examiner's rejections of claims 1-33 under 35 U.S.C. § 102 or 103 are reversed.

Claims 1-33 are newly rejected by us under the judicially created doctrine of obviousness-type double patenting. Claims 1-24 and 30-33 are newly rejected by us under 35 U.S.C. § 112, second paragraph.

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This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b). 37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claim:

(1) Submit an appropriate amendment of the claim so rejected or a showing of facts relating to the claim so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner

. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

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No time period for taking any subsequent action in connection with this appeal
may be extended under 37 CFR § 1.136(a).

REVERSED; 37 CFR 1.196(b)

RICHARD TORCZON)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
ANITA PELLMAN GROSS)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
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