

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN D. MCCALDEN, JOHN W. BACE,
and ROBERT LONGO

Appeal No. 2004-0044
Application No. 09/375,214¹

ON BRIEF

Before BARRETT, DIXON, and SAADAT, Administrative Patent Judges.
SAADAT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the Examiner's final rejection of claims 13-19, 22, and 33-38, which are all of the claims pending in this application.

We reverse.

¹ Application for patent filed August 16, 1999.

BACKGROUND

Appellants' invention is directed to a method and an apparatus for promoting taxpayer compliance by using data mining, decision management and case management. An understanding of the invention can be derived from a reading of exemplary independent claim 13, which is reproduced as follows:

13. An apparatus comprising:

a computer-implemented data mining system which mines taxpayer data by a computer to create taxpayer profiles of taxpayers, and identifies taxpayer profiles of the created taxpayer profiles for taxpayer compliance issues, each taxpayer profile being a profile of a respective taxpayer and including information relating to a plurality of taxpayer events for the respective taxpayer;

a computer-implemented decision management system which assigns the identified taxpayer profiles into groups by a computer based on characteristics of the taxpayer profiles;

a computer-implemented case management system which, by a computer, determines different treatments to be implemented for different of the groups to improve taxpayer compliance and, by a computer, implements the treatments for the groups in accordance with the determination; and

a feedback mechanism feeding back a result of the decision management system into the taxpayer data by a feedback loop for mining by the data mining system, and feeding back a result of the case management system into the taxpayer data by a feedback loop for mining by the data mining system, to increase effectiveness of the apparatus in improving taxpayer compliance.

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The Examiner relies on the following references:

Taricani, Jr. (Taricani)	6,016,479	Jan. 18, 2000 (filed May 14, 1998)
Honarvar	6,321,206	Nov. 20, 2001 (filed Dec. 21, 1998)

Claims 13-19, 22 and 33-38 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Honarvar and Taricani.

We make reference to the answer (Paper No. 23, mailed May 21, 2003) for the Examiner's reasoning, and to the appeal brief (Paper No. 22, filed February 27, 2003) for Appellants' arguments thereagainst.

OPINION

In rejecting the claims, the Examiner relies on Honarvar for teaching an apparatus and the corresponding method including a computer-implemented data mining, decision management system, case management system and a feedback mechanism for identifying taxpayer profiles and identifying links between the profiles (answer, page 4). The Examiner further relies on Taricani for disclosing a case management system which implements different treatments for taxpayer compliance (answer, the paragraph bridging pages 4 and 5). Based on the teachings of these two prior art references, the Examiner concludes that the skilled artisan would have found it obvious to combine the taxpayer data of Taricani with the data mining system of Honarvar in order to

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provide optimized decision strategies and efficient taxpayer tracking (answer, page 5).

Appellants point out that Honarvar does not disclose or suggest using the disclosed decision management system for any taxpayer compliance (brief, page 5). Appellants further point out that although Honarvar describes a loop back from the "execute process" 80, in figure 2, this loop is not for feeding back data for data mining (brief, page 6). With respect to Taricani, Appellants argue that the reference discloses a system for recovering sales tax from the purchaser in a sales transaction and does not relate to treatment of taxpayers in accordance with their taxpayer profiles (brief, page 8).

In response to Appellants' arguments, the Examiner argues that Honarvar does teach the feedback mechanism where the client ID is linked with the segment or group the client was in at the time of making the decision (answer, pages 6 & 7). The Examiner further asserts that the plurality of sales transactions of Taricani generates a profile of a plurality of taxpayer events, each including categories of sales or information related to tax exemptions (answer, page 7).

As a general proposition, in rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d

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1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993) and In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). A prima facie case of obviousness is established when the teachings of the prior art itself would appear to have suggested the claimed subject matter to one of ordinary skill in the art. See In re Bell, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993); In re Fritch, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992); Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985). In considering the question of the obviousness of the claimed invention in view of the prior art relied upon, the Examiner is expected to make the factual determination 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. See also In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). Such evidence is required in order to establish a prima facie case. In re Piasecki, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984); In re Cofer, 354 F.2d 664, 668, 148 USPQ 268, 271-72 (CCPA 1966).

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After reviewing Honarvar, we agree with Appellants' assertion that the claimed feedback mechanism is absent in the reference. Honarvar relates to a decision management system for creating strategies to control movement of clients across different client categories (col. 1, lines 25-31). What the Examiner characterizes as the claimed feedback mechanism in Honarver (answer, page 4), is actually a description of the representation of client categories in a matrix format (col. 16, lines 40-55) or the movement of the clients across categories (col. 17, lines 1-20). Furthermore, contrary to the Examiner's position (answer, page 6), storing the client observation points (col. 11, lines 20-25), actually relates to the history of the client category when the previous decision was made, not a feedback mechanism.

Taricani, on the other hand, relates to a database system for identifying the interstate sales transactions on which a taxpayer did not pay the sales tax (abstract). Therefore, the database of Taricani is arranged according to untaxed sales transactions although the taxpayer and the related information are also included in data fields. Although the reference mentions categories of sales (col. 9, lines 20-30), they relate to the agencies that collect the tax for that particular purchase category (col 9, lines 30-33). Therefore, we agree with

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Appellants that the sales transactions of Taricani relates to only a single taxpayer event, which does not constitute the claimed taxpayer profile including information relating to a plurality of taxpayer events for the respective taxpayer.

In concluding that Honarvar's case management system and the sales tax database of Taricani provide the teaching and suggestion for arriving at the claimed subject matter in claim 13, the Examiner attempts to forge a combination of a database related to uncollected sales tax that has nothing to do with a decision management system used for monitoring the movement of clients across different client categories. Thus, assuming, arguendo, that it would have been obvious to combine Taricani with Honarvar, as held by the Examiner, the combination would still fall short of teaching or suggesting the claimed taxpayer profile and the feedback mechanism. We note that other dependent claims, similar to claim 13, require identification of the taxpayer profile and the feedback mechanism for feeding back the result of the decision management system. Accordingly, as the Examiner has failed to set forth a prima facie case of obviousness, we do not sustain the 35 U.S.C. § 103 rejection of independent claims 13, 22, 35-38 as well as claims 14-19, 33 and 34, dependent thereupon, over Honarvar and Taricani.

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CONCLUSION

In view of the foregoing, the decision of the Examiner rejecting claims 13-19, 22 and 33-38 under 35 U.S.C. § 103 is reversed.

REVERSED

LEE E. BARRETT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JOSEPH L. DIXON)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
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MAHSHID D. SAADAT)	
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