

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte MICHAEL E. DERISO, MICHAEL J. HERRMANN, JUDY L. LAHTI,  
KENNETH W. MITCHELL, and JOSEPH A. LAROSA

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Appeal No. 2004-1959  
Application No. 09/465,465

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ON BRIEF

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Before THOMAS, BARRETT, and RUGGIERO, Administrative Patent Judges.

RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the final rejection of claims 1-17, which are all of the claims pending in the present application.

The disclosed invention relates to a system for delivering targeted marketing information to a customer in a variable format customer document in which stored customer information can be updated from multiple sources. After customer information is

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transmitted to a consolidating device, the customer information is reconfigured into a customer document output database, and customer buying preferences are determined based on the reconfigured stored customer information. Variable format customer documents which include targeted marketing information are subsequently created based on the determined customer buying preferences from the customer document output database.

Representative claim 1 is reproduced as follows:

1. A system for delivering targeted marketing information to a customer in a variable data customer document, comprising:

storing customer information on a mainframe computer, said customer information being updateable from multiple sources;

transmitting said customer information to a consolidating device;

parsing the customer information data;

reconfiguring and storing the customer information data into a customer output database;

mining and determining at least one customer preference using the reconfigured and stored customer output database; and

creating a statement including a variable data customer document based on the at least one customer preference mined and determined from the customer output database,

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wherein the variable data customer document includes selected information for consideration by the customer based on the mined and determined customer preferences originating from the customer information, and

wherein the statement including the variable data customer document is adapted to be electronically presentable to the customer.

The Examiner relies on the following prior art:

Gerace	5,848,396	Dec. 08, 1998
Schutzer	6,292,789	Sep. 18, 2001
		(filed Aug. 21, 1998)

Claims 1-4, 7-13, and 15-17 stand finally rejected under 35 U.S.C. § 102(e) as being anticipated by Gerace. Claims 5, 6, and 14 stand finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Gerace in view of Schutzer.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Briefs<sup>1</sup> and Answer for the respective details.

#### OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the Examiner and the evidence of anticipation and obviousness relied upon by the Examiner as

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<sup>1</sup> The Appeal Brief was filed November 17, 2003 (Paper No. 19). In response to the Examiner's Answer mailed December 17, 2003 (Paper No. 20), a Reply Brief was filed February 9, 2004 (Paper No. 21), which was acknowledged and entered by the Examiner as indicated in the communication dated February 27, 2004 (Paper No. 22).

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support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, 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 disclosure of Gerace fully meets the invention as recited in claims 1-4, 7-13, and 15-17. In addition, we are of the opinion that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 5, 6, and 14. Accordingly, we affirm.

Appellants' arguments in response to the Examiner's rejections of the appealed claims are organized according to a suggested grouping of claims indicated at pages 5 and 6 of the Brief. We will consider the appealed claims separately only to the extent separate arguments for patentability are presented. Any dependent claim not separately argued will stand or fall with its base claim. Note *In re King*, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986); *In re Sernaker*, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983).

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We consider first the Examiner's 35 U.S.C. § 102(e) rejection of claim 1, the representative claim for Appellants' first suggested grouping (including claims 1-3, 7, 9-13, and 15-17), based on Gerace. At the outset, we note that anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.), cert. dismissed, 468 U.S. 1228 (1984); W.L. Gore & Assocs. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

With respect to representative claim 1, the Examiner indicates (Answer, pages 3 and 4) how the various limitations are read on the disclosure of Gerace. In particular, the Examiner directs attention to the illustrations in Figures 1 and 2 of Gerace along with the accompanying description beginning at column 3, line 39 of Gerace.

After reviewing the Examiner's analysis, it is our opinion that the stated position is sufficiently reasonable that we find that the Examiner has at least satisfied the burden of presenting

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a prima facie case of anticipation. The burden is, therefore, upon Appellants to come forward with evidence and/or arguments which persuasively rebut the Examiner's prima facie case. 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 Briefs have not been considered and are deemed to be waived (see 37 CFR § 41.37(c)(1)(vii)).

Appellants' arguments in response to the rejection of claim 1 assert that the Examiner has not shown how each of the claimed features are present in the disclosure of Gerace so as to establish a case of anticipation. Appellants' primary point of contention (Brief, pages 6-9; Reply Brief, pages 2 and 3) is that Gerace lacks a disclosure of the claimed feature of "creating a statement including a variable data customer document . . . . "

After careful review of the Gerace reference in light of the arguments of record, we are in general agreement with the Examiner's position as stated in the Answer. Appellants' arguments, at various instances in the Briefs, urge that the claimed term "statement" must be interpreted as containing "at least one listing of a credit or a debit" (Brief, page 8), or an "account" statement (id., at 9), or "information regarding a customer's account." (Reply Brief, page 3). Our review of

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Appellants' specification, however, reveals no support for the restrictive interpretation of the term "statement" asserted by Appellants. In fact, throughout Appellants' specification the term "statement" is distinguished from a financial term such as "billing" or "bills" ("bill and/or statement," specification, page 3, line 26, "statement and/or bill," specification, page 4, line 25). Accordingly, we simply find no error in the Examiner giving the broadest reasonable interpretation to the term "statement" as articulated at pages 9-12 of the Answer.

We also make the observation that, as alluded to by the Examiner (Answer, page 11), the disclosure of Gerace in fact satisfies even the more restrictive interpretation of "statement" argued by Appellants. For example, in our view, the portfolio accounting page incorporating a list of stocks owned by a user (Gerace, column 20, lines 53-62) would be recognized by the skilled artisan as a financial account statement as would the "income statements" referenced at column 21, line 14 and column 24, line 42 of Gerace, and the analytical statement presented in response to a user's request (Gerace, column 11, lines 25-41). Further, contrary to Appellants' contention (Reply Brief, page 2), we find

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ample support in the disclosure of Gerace for the Examiner's conclusion (Answer, page 9) that the "statements" presented to the user are variable customer documents.

In view of the above discussion, since all of the claimed limitations are present in the disclosure of Gerace, the Examiner's 35 U.S.C. § 102(e) rejection of representative claim 1, as well as claims 2, 3, 7, 9-13, and 15-17 which fall with claim 1, is sustained.

Turning to a consideration of the Examiner's 35 U.S.C. § 102(e) rejection, based on Gerace, of dependent claims 4 and 8, each argued separately by Appellants, we sustain the rejection of these claims as well. With respect to dependent claim 4, we find no error in the Examiner's assertion of correspondence between the claimed customer service representative viewing of an archival document copy and the disclosure in Gerace, at column 7, lines 5-22, column 17, lines 53 through column 18, line 10, and column 33, lines 55-60, of the user history viewing object with user-sponsor access. Similarly, in our view, the use of an animation feature as set forth in appealed dependent claim 8 is fully described at column 20, lines 19-25 of Grace.

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Lastly, we also sustain the Examiner's 35 U.S.C. § 103(a) rejection of claims 5, 6, and 14 based on the combination of Gerace and Schutzer. With respect to claim 5, we find no error in the Examiner's line of reasoning (Answer, pages 7-9) which establishes motivation for the combination of Gerace and Schutzer. In our view, the skilled artisan would have been motivated and found it obvious to enhance the statement presentation system of Gerace by including billing statements as suggested by Schutzer (column 12, lines 25-37). Further, we find clear disclosure at column 2, lines 15-23 and column 20, line 21 of Gerace for the color display feature of claim 6, as well as a description of the mailing feature of claim 14 at column 21, lines 23-28 and lines 50-52 of Gerace.

In summary, we have sustained the Examiner's 35 U.S.C. § 102(e) rejection of claims 1-4, 7-13, and 15-17 as well as the 35 U.S.C. § 103(a) rejections of claims 5, 6, and 14. Therefore, the decision of the Examiner rejecting claims 1-17 is affirmed.

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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)(1)(iv)(effective September 13, 2004; 69 Fed. Reg. 49960 (August 12, 2004); 1286 Off. Gaz. Pat. and TM Office 21 (September 7, 2004)).

AFFIRMED

JAMES D. THOMAS	)	
Administrative Patent Judge	)	
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LEE E. BARRETT	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
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JOSEPH F. RUGGIERO	)	
Administrative Patent Judge	)	

JFR:hh

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