

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ERIC WILLIAMS

Appeal No. 2005-1632
Application No. 10/448,194

ON BRIEF

Before THOMAS, BLANKENSHIP, and NAPPI, 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 68-97, which are all the claims remaining in the application.

We affirm.

BACKGROUND

The invention relates to interconnected computer systems with respect to a plurality of retail store environments for use in dissemination of promotions and/or incentives for retail customers. Representative claim 68 is reproduced below.

68. A computer network system, comprising:

a central incentive computer system;

a plurality of retailer POS systems including a first retailer POS system;

wherein said first retailer POS system includes at least one POS terminal, a POS computer, a local network providing for data communication between said at least one POS terminal and said POS computer, and a POS database to which said POS computer controls access;

said central incentive computer system comprising a central incentive computer and a central incentive computer system database;

wherein said central incentive computer system database stores (1) outstanding offers including a specification of an incentive offer in association with a retail customer identification and (2) offer selection criteria for qualifying a retail customer having said retail customer identification for said incentive offer; and

a network providing for data communication between each one of said plurality of retailer POS systems and said central incentive computer system;

wherein said first retailer POS system is structured to transmit from said at least one POS terminal certain information regarding transaction information received at said at least one POS terminal during a transaction occurring at said at least one POS terminal, said certain information including said retail customer identification and less than all of said transaction information, said certain information transmitted via said POS computer to said central incentive computer system; and

said central incentive computer system structured to respond to receipt of said certain information by determining whether said retail customer qualifies for said incentive offer and, if so, transmitting said specification of said incentive offer in

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association with said retail customer identification to said first retailer POS system during said transaction; and

wherein, upon receipt by said first retailer POS system of said incentive offer in association with said retail customer identification transmitted from said central incentive computer, said retailer POS system transmits said specification of said incentive offer to said at least one POS terminal during said transaction so that said incentive offer can be provided to said retail customer having said retail customer identification while said retail customer is at said at least one POS terminal in connection with said transaction.

The examiner relies on the following reference:

Deaton et al. (Deaton)	5,642,485	Jun. 24, 1997
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Claims 68-73, 75-83, 85-93, and 95-97 stand rejected under 35 U.S.C. § 102 as being anticipated by Deaton.

Claims 74, 84, and 94 stand rejected under 35 U.S.C. § 103 as being unpatentable over Deaton.

We refer to the Final Rejection (mailed Apr. 26, 2004) and the Examiner's Answer (mailed Dec. 16, 2004) for a statement of the examiner's position and to the Brief (filed Sep. 23, 2004) and the Reply Brief (filed Feb. 16, 2005) for appellant's position with respect to the claims which stand rejected.

OPINION

Appellant places headings over groups of claims in the Brief, suggesting that appellant believes the claims as grouped to be separately patentable. However, with the possible exception of one argument relating to dependent claims (73, 83, and 93)

that we will address infra, appellant's remarks in the Brief are not arguments for separate patentability of claims. See 37 CFR § 41.37(c)(1)(vii) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)) ("A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim.").

We select claim 68 as a representative claim in our review of the § 102 rejection over Deaton. To the extent that appellant's remarks might be considered separate arguments for patentability, we refer to the examiner's findings in the Final Rejection and the Answer in support of the rejection against dependent claims, which are not addressed by appellant.

The points of contention in the rejection of claim 68 relate to the system architecture and networking that is disclosed by Deaton. Appellant seems to change the rejection that is applied and argue against the nonexistent rejection.

The examiner finds that Deaton discloses a plurality of retailer POS systems as claimed. A plurality of retailer POS systems are depicted in Figure 1; i.e., remote systems 110.¹ The rejection is based on what appellant denominates the "second claim construction" (Brief at 17.) The pages of appellant's Brief setting forth how the transaction terminals 120 cannot meet the terms of the claimed plurality of systems, while ultimately correct, are inapposite.

¹ As noted by the examiner, reference numeral "10" in the remote system shown in detail should be "110."

Appellant's argument as to why the rejection based on the "second claim construction" should be considered in error appears to be that, as discussed at pages 23 through 29 of the Brief, Deaton fails to disclose "a network providing for data communication between each one of said plurality of retailer POS systems and said central incentive computer system," as recited in claim 68.

Appellant seems to ignore the examiner's finding that Deaton's host system (e.g., Fig. 1) meets the terms of the claimed "central incentive computer system." We find ample support for the finding at least at column 20, line 63 through column 21, line 35 and column 59 of the reference, discussing the respective tasks of the host and remote systems. With respect to an asserted lack of communication, appellant in fact quotes (Brief at 23-24) from column 11 of Deaton, disclosing that a transaction processor 112 is able to communicate with other systems through a telecommunications interface. According to appellant, there is not a network providing for data communications between each one of the plurality of remote systems and the host (notwithstanding, for example, Deaton Figure 1) because Deaton does not teach transaction processor 112 processing requests from other stores. We disagree, because the host transaction processor does process requests from other stores, as made plain in the particular sections of Deaton that we have noted.

The remainder of appellant's arguments in defense of claim 68 consist of alleging benefits of the disclosed invention over Deaton and quoting from the instant written description and alleging that Deaton fails to teach what is described. We decline to --

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in fact, cannot -- read disclosed limitations into any claim before us in an attempt to distinguish the claim over the prior art. The claims measure the invention. SRI Int'l v. Matsushita Elec. Corp., 775 F.2d 1107, 1121, 227 USPQ 577, 585 (Fed. Cir. 1985) (en banc). During prosecution before the USPTO, claims are to be given their broadest reasonable interpretation, and the scope of a claim cannot be narrowed by reading disclosed limitations into the claim. See In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989); In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550 (CCPA 1969).

Appellant's remarks in nominal support of the separate patentability of claim 69 (Brief at 30) fail to call the examiner's findings into question and demonstrate why, even were the remarks considered arguments for separate patentability of the claim, there would be no reason to reproduce the examiner's findings and discuss the support for each in the reference. Appellant submits that Deaton fails to include a printer that can print an incentive offer as claimed, while seeming to ignore both the rejection and the reference (beyond its name). We would refer, for example, to coupon dispenser 123b (Fig. 2A) of Deaton and column 12, lines 28 through 35. We would refer, for example, to column 78, lines 40 through 50. We might reproduce, for example: "A third technique of distributing coupons utilizes a system to actually print, at the point-of-sale, coupons bearing the desired information based upon selected criteria." Deaton col. 69, ll. 16-18.

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Appellant submits (Brief at 32) that the phrase “consists of,” as used in instant claim 73, covers embodiments of “certain information” having the recited elements of “retail customer identification” and “a total dollar amount associated with said transaction” and no others. While the phrase “consists of” may normally be considered to limit a group of elements in terms of excluding combination with other elements, in this case the elements are not defined in the first instance in the exclusionary terms of the dependent claim.

Base claim 68 recites that the “certain information” includes the retail customer identification and “less than all of said transaction information....” Dependent claim 73 does not require, under a broad but reasonable interpretation, that the “certain information” contain the recited elements and no others. Base claim 68 defines the limits of the “information.” The depending claim may be read as requiring that the “information” that is defined in the base claim contain the subset of the recited “retail customer identification” and another element; i.e., the total dollar amount associated with the transaction.

In any event, appellant does not relate the argued claim interpretation to the specific teachings of the reference. Deaton discloses use of a retail customer identification (e.g. col. 64, l. 56 - col. 65, l. 19). Deaton further discloses that the dollar amount associated with a transaction may be, other than the identification, the only item of interest at the time of the transaction (col. 65, ll. 20-25). Deaton teaches the

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invention of dependent claim 73, even with the unduly narrow interpretation that is asserted.

We have considered all of appellant's arguments, but are not persuaded that the examiner's finding of anticipation is in error. We sustain the rejection of claims 68-73, 75-83, 85-93, and 95-97 under 35 U.S.C. § 102 as being anticipated by Deaton.

We also sustain the rejection of claims 74, 84, and 94 under 35 U.S.C. § 103 as being unpatentable over Deaton. Appellant's Brief (at 35-36) relies on the arguments we have addressed with respect to claim 68. Appellant seems to reconsider the position, submitting new arguments in the Reply Brief. Even so, the new arguments do not traverse the examiner's position that the subject matter of representative claim 74 as a whole would have been obvious in view of Deaton and the artisan's knowledge of customer service, but instead submit that a sense of "customer service" is not a compelling reason to transmit a message that no benefit is to be credited to the retail customer. We might agree that a sense of "customer service" is not a "compelling reason" for the subject matter of claim 74, but the showing of a "compelling reason" is not the requisite standard for demonstrating prima facie obviousness. Moreover, appellant admits (Brief at 20) that the artisan had a knowledge of marketing concepts.

We also note that claim 74 recites that the central incentive system is "structured to transmit" a message to at least one of the retailer POS systems, the message being defined in the form of the negative limitation that "no benefit is to be credited to said retail customer." The claim does not require, for example, an express message on a

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destination display that “no benefit is to be credited to this customer,” or similar words. Deaton discloses subject matter within the scope of what the claim actually requires, at least at column 59, lines 32 through 53. Deaton teaches numerous messages from the host computer to the POS terminal display dealing with matters that do not credit a benefit to the retail customer. The messages thus fall within the meaning of messages that convey “no benefit” is to be credited to the customer.

CONCLUSION

The rejection of claims 68-73, 75-83, 85-93, and 95-97 under 35 U.S.C. § 102 and the rejection of claims 74, 84, and 94 under 35 U.S.C. § 103 over Deaton are 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). See 37 CFR § 1.136(a)(1)(iv).

AFFIRMED

JAMES D. THOMAS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
HOWARD B. BLANKENSHIP)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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ROBERT E. NAPPI)	
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