

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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 STEVEN B. SOLOMON,
KENNETH R. JOHNSEN, ANDREW F. ADAMS,
JULI C. SPOTTISWOOD, MICHAEL D. REYNOLDS,
JACK W. DOXEY, MASON WRIGHT,
KELLY R. MELVIN and BARBARA A. MINOR

Appeal No. 2005-2160
Application No. 09/470,582¹

ON BRIEF

Before HAIRSTON, BARRETT, 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 1, 2, 4-14, 16-26, 28-32, 34-38 and 40-46. Claims 3, 15, 27, 33 and 39 have been canceled.

We affirm-in-part.

¹ Application for patent filed December 22, 1999.

BACKGROUND

Appellants' invention is directed to computer-aided rebate processing by which information describing promotions and purchases of products are used to process rebate requests by associating purchases with promotions. According to Appellants, the sponsors of the rebate promotions may access and maintain the promotion information or access the consumer information as well as allow the consumers to interactively submit their information (specification, page 4). An understanding of the invention can be derived from a reading of exemplary independent claims 8 and 32, which are reproduced below:

8. An apparatus for rebate processing, comprising:

a first memory operable to store promotion information describing a plurality of promotions, the promotion information comprising, for each of the promotions, a promotion sponsor identifier, a promotion identifier, promotion requirements, and at least one disbursement option;

a second memory operable to store transaction information indicating a plurality of product purchases, the transaction information comprising, for each of the purchases, a consumer identifier, a rebate request status, and a promotion identifier matching to a selected one of the promotions; and

a processor operable to process rebate requests by associating the product purchases with the promotions using the promotion identifiers and determining whether selected transaction information for the purchases satisfies the rebate

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requirements for the promotions, the processor further operable to provide rebate updates to the consumers using the rebate request statuses and to generate promotion reports, a promotion report comprising selected promotion information for at least one of the promotions having a particular promotion sponsor identifier.

32. A computer-based interface for facilitating rebate processing, the interface operable to:

display a plurality of fields for entry by a user to create a promotion for a product bearing a rebate;

receive promotion information for the promotion, the promotion information comprising a product identifier and a plurality of disbursement options for receiving an authorized rebate, at least one of the disbursement options having a cash value to a recipient different than another one of the disbursement options;

communicate promotion information to a remote rebate processing center; and

receive a status of the promotion based on purchases of the product, the status indicating a number of rebate requests for the promotion and a number of authorized rebates fulfilled for each of the disbursement options for the promotion.

The Examiner relies on the following prior art references:

Finsterwald	6,039,244	Mar. 21, 2000 (filed Jan. 13, 1997)
Freeman al. (Freeman)	6,450,407	Sep. 17, 2002 (filed Apr. 17, 1998)

Claims 1, 2, 4-14, 16-26, 28-32, 34-38 and 40-46 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Finsterwald and Freeman.

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Rather than reiterate the opposing arguments, reference is made to the briefs and answer for the respective positions of Appellants and the Examiner. 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 (37 CFR § 41.37(c)(1)(vii)).

CLAIM GROUPING

Appellants indicate that the appealed claims stand or fall together as two groups (brief, page 4). Additionally, in the arguments section of the brief, Appellants provide separate arguments for each group and focus their arguments on independent claims 8 and 32. Therefore, in accordance with this grouping, and pursuant to 37 CFR § 1.192(c)(7), which was controlling at the time of filing the appeal brief, we will limit our consideration of the appealed claims to the rejection of claims 8 and 32 as the representative claims of their corresponding groups.

OPINION

With respect to claim 8, Appellants argue that Finsterwald merely provides a unique code to a buyer of a product which is canceled after the code is redeemed while claim 8 requires a memory that maintains a rebate request status for each of

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multiple purchases (brief, page 6; reply brief, page 3).

Appellants further point out that the instantaneous nature of Finsterwald's rebate operation teaches away from maintaining rebate request status on a purchase by purchase basis (brief, page 7). Regarding the teachings of Freeman, Appellants argue that maintaining payment records for potential audits does not show the claimed processor for generating promotion reports (brief, page 9).

In response to Appellants' arguments, the Examiner points to the database of Finsterwald for maintaining a database of pending rebate codes and the used codes and asserts that the stored information related to the status of the rebate code is the information on rebate request status (answer, page 9). The Examiner further argues that the claimed rebate request status requires no more than conveying to the consumer whether a rebate request is valid which reads on indicating valid rebate codes disclosed by Finsterwald (answer, page 10). Additionally, the Examiner argues that since Freeman provides the rebate issuer with a reconciliation as a report, it would have been obvious to send the collected data in Finsterwald to the sponsors or manufacturers in order to eliminate the need for each sponsor to store and use rebate information (answer, page 11).

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The initial burden of establishing reasons for unpatentability rests on the Examiner. In re Oetiker, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). The Examiner is expected to make the factual determination supported by teachings in a prior art reference or shown to be common knowledge of unquestionable demonstration, consistent with the holding in set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966). When an obviousness determination relies on the combination of two or more references, there must be some suggestion or motivation to combine the references. See In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). A motivation to combine prior art references may be found in the nature of the problem to be solved. Ruiz v. A.B. Chance Co., 357 F.3d 1270, 1276, 69 USPQ2d 1686,1690 (Fed. Cir. 2004). Also, evidence of a suggestion, teaching, or motivation to modify a reference may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, see Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996).

From our review of Finsterwald and Freeman, we remain unpersuaded by Appellants' arguments that any error in the

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Examiner's determination regarding the obviousness of the claimed subject matter has occurred. Both references are concerned with tracking and storing information regarding rebate processing. Finsterwald particularly uses rebate codes for providing rebate points to a customer's point-data bank (col. 9, lines 41-44) while the state of the customer's point account is made available to that customer (col. 10, lines 21-25). This is contrary to Appellants' argument (brief, page 7) that instantaneous nature of rebates in Finsterwald teaches away from storing a rebate request status for each purchase. In fact, although the rebate code is canceled after it is redeemed, the information regarding the rebate request and whether its points have been added to the consumer's point account is available to the consumer as a request status.

Freeman, similarly provides rebates to users and maintains records of such rebates in a database for audits by the manufacturers or the party that pays for the rebates (col. 11, lines 16-19) as well as for presenting a reconciliation to the rebate issuer (col. 11, lines 20-28). Freeman, as recognized by the examiner (answer, pages 12-13), does not explicitly mention generating a promotion report, but describes the information related to the promotion such as any refunds due to the issuer or

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sponsor in the rebate database and the reconciliation. Such report actually includes the identity of the sponsor described as "VENDOR ID" 143 in the affinity record of Figure 7. As such, the advantages of targeting a particular customer group described by Freeman (col. 17, lines 7-16) would have motivated one of ordinary skill in the art to process rebate requests and generate promotion reports for the rebate processing of Finsterwald in order to match rebates to customers' purchasing habits.

We also remain unconvinced by Appellants' assertion (brief, page 11) that no motivation exists for combining the two references. The fact that Finsterwald stores the rebate information and additional data concerning the purchase behavior of the customer in the customer point data bank for targeted offering of the products (col. 10, lines 1-9), shows the desirability of generating reports for the rebate sponsors. Freeman not only relates to rebate processing but also provides records of money rebates payments to users as well as advertisement information and associated rebates for use by the rebate sponsors. Therefore, as the Examiner has established a prima facie case of obviousness with respect to claim 8, we sustain the 35 U.S.C. § 103(a) rejection of claim 8, as well as

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claims 1, 2, 4-7, 9-14, 16-26, 28-31 and 40-46, grouped therewith as falling together (brief, page 4) over Finsterwald and Freeman.

Turning now to the rejection of claim 32, we note Appellants' arguments with respect to the claimed displaying a plurality of fields for entry by a user to create a promotion for a product and a plurality of disbursement options for a rebate (brief, page 14; reply brief, pages 4-5). The Examiner's only discussion of the user interface in claim 32 is premised on such features being "universally used ... for defining coupons" or "inherent ... that the user must enter the promotional data" (answer, pages 14-15). However, there is nothing in the cited portions of Finsterwald and Freeman indicating that the user entry creates a promotion for a product which may have a plurality of disbursement options. Therefore, the 35 U.S.C. § 103 rejection of independent claim 32 and claims 34-38, dependent thereon, over Finsterwald and Freeman cannot be sustained.

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CONCLUSION

In view of the foregoing, the decision of the Examiner rejecting claims 1, 2, 4-14, 16-26, 28-31 and 40-46 under 35 U.S.C. § 103 is affirmed but is reversed with respect to claims 32 and 34-38.

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 Sept. 13, 2004).

AFFIRMED-IN-PART

Kenneth W. Hairston)	
Administrative Patent Judge)	
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Lee E. Barrett)	APPEALS
Administrative Patent Judge)	AND
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