

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 Thomas Joseph Prorock

Appeal No. 2005-2468
Application No. 09/943,941

ON BRIEF

Before BARRETT, DIXON, and NAPPI, **Administrative Patent Judges**.
DIXON, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-4 and 9-14, which are all of the claims pending in this application.

We AFFIRM.

BACKGROUND

Appellant's invention relates to a method and system for providing incentive award information to a customer. A copy of the representative claim 1 under appeal is reproduced below.

1. A method for providing incentive award information to a customer, said method comprising:

obtaining customer information of a customer from an input device;

transmitting said customer information to a remotely located host computer, wherein said host computer locates incentive award information associated with said customer information;

in response to the receipt of a scanned product code at said input device, transmitting said scanned product code from said input device to said host computer;

determining within said host computer whether or not immediate purchase of a product associated with said scanned product code qualifies said customer for an award based on said located incentive award information;

in a determination that an immediate purchase of a product associated with said scanned product code qualifies said customer for an award, transmitting information related to an opportunity for receiving said award from said host computer to said input device and displaying said information related to said opportunity for receiving said award on said input device.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Sloane	5,918, 211	Jun. 29, 1999
Harms et al. (Harms)	6,070,147	May 30, 2000

Appeal No. 2005-2468
Application No. 09/943,941

Claims 1-4 and 9-14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sloane in view of Harms.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellant regarding the above-noted rejections, we make reference to the answer (mailed Jul. 1, 2005) for the examiner's reasoning in support of the rejections, and to the brief (filed Apr. 13, 2005) and reply brief (filed Jul. 13, 2005) for appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by appellant and the examiner. As a consequence of our review, we make the determinations which follow.

Only those arguments actually made by appellants have been considered in this decision. Arguments that appellants could have made but chose not to make in the brief have not been considered. We deem such arguments to be waived by appellants [see 37 CFR § 41.37(c)(1)(vii) effective September 13, 2004 replacing 37 CFR § 1.192(a)].

35 U.S.C. § 103

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 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A *prima facie* case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. **See In re Lintner**, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is *prima facie* obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. **See In re Fine**, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Rejections based on § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. **See In re Warner**, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), **cert. denied**, 389 U.S. 1057 (1968). Our reviewing court has repeatedly cautioned against

Appeal No. 2005-2468
Application No. 09/943,941

employing hindsight by using the appellant's disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings of the prior art. **See, e.g., Grain Processing Corp. v. American Maize-Prods. Co.**, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

When determining obviousness, “the [E]xaminer can satisfy the burden of showing obviousness of the combination ‘only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.’” **In re Lee**, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002), citing **In re Fritch**, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). “Broad conclusory statements regarding the teaching of multiple references, standing alone, are not ‘evidence.’” **In re Dembiczak**, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). “Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact.” **Dembiczak**, 175 F.3d at 999-1000, 50 USPQ2d at 1617, citing **McElmurry v. Arkansas Power & Light Co.**, 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993).

Further, as pointed out by our reviewing court, we must first determine the scope of the claim. “[T]he name of the game is the claim.” **In re Hiniker Co.**, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). Therefore, we look to the limitations as recited in independent claim 1. We find that appellant argues the

limitations of independent claims 1 and 10 together maintaining that Sloane does not teach or suggest the claimed determining step. (Brief at page 5.) Since appellant does not set forth any separate arguments for patentability, we will group all of the claims as standing or falling together with independent claim 1.

Appellant argues that in contrast to the teachings of Sloane, the claimed determining step determines whether or not an immediate purchase of a product will qualify the customer for an award based on the located incentive award information and that the determining step determines whether to send an alert to a customer or not by associating the customer's scanned product with the located incentive award information of the consumer wherein the determining step is not based on the consumer's scanned product alone. (Brief at page 5.) Here, we do not find that appellant's argument is commensurate in scope with the language of independent claim 1. From the express limitations of independent claim 1, we find that Sloane teaches the recited determining step and transmitting information relating to an opportunity for receiving an award and display of the information to the consumer. (See Sloane at column 8 and Figures 8(a)-(c).) From our review of the instant claim language and the corresponding disclosure, we find no express or implied limitation concerning the content incentive award or the incentive award information. Therefore, we give this limitation its broadest reasonable interpretation and find this to read on the

various incentives stored and transmitted to the user of the scanner in Sloane. Sloane discloses various embodiments including an initial disclosure of incentives depending on the consumer's history. (See Sloane at column 9 and Figure 10.) Sloane discloses various embodiments including transmission of additional promotional messages to the consumer based upon the product bar code information just received, messages that a competitive product or other products in the same product category as the scanned product, or a message that a discount is offered if a certain quantity of that product is purchased or a message that a discount is offered on a complimentary or related product. Moreover Sloane also discloses that the consumer may receive an immediate discount, or electronic credits or other promotional discounts that can be redeemed in subsequent visits to the store. (See Sloane at column 8 and Figures 8(a)-(c) and 9.) While we agree with appellant that Sloane is related to the incentive awards generally related to a specific product being scanned, we find that the instant claim language is broad enough to read on the determination and transmission taught by Sloane. Therefore, we do not find the argument persuasive.

Appellant argues that the determining step is not taught by Harms. (Brief at page 6.) We agree with appellant, but find that the examiner relies upon the teachings of Sloane for the determining and relies upon the teachings of Harms for the loyalty points and awards at a particular plateau. (Answer at pages 3-4.) We find that Sloane

Appeal No. 2005-2468
Application No. 09/943,941

alone teaches the invention recited in independent claim 1 as discussed above and that the teachings of Harms further teaches variations in awards and incentives that may be used to increase purchases.

Appellant argues that the examiner has not provided support for the examiner's assertion at page 5 of the answer that Sloane presents the user with status information regarding current purchases plus previous store purchases. (Reply Brief at page 2.) We find that at page 5 of the answer that the examiner maintains that Harms is relied upon to teach customer account information. While we agree that Harms does teach maintaining account information, we find that Sloane similarly teaches maintaining a history of purchases for the year to date at column 6, line 64 - column 7, line 3 and suggests the well known use of frequent shopping cards to identify the customer at column 5, lines 49-51. Therefore, we do not find the argument persuasive and cannot agree with appellant that the examiner's assertion is beyond the scope of Sloane's invention. Appellant again argues that Sloane does not teach or suggest the last two steps of the claimed method. (Reply Brief at page 2.) As discussed above, we disagree with appellant and find that Sloane teaches and fairly suggests these limitations. Therefore, we do not find the argument persuasive.

Appellant argues that there is no motivation to combine the teachings of Sloane and Harms. (Brief at page 6.) The examiner disagrees and maintains that both

teachings are directed to “loyalty programs and are strongly related.” (Answer at page 6.) We agree with the examiner that both references are related to aspects of marketing and influencing and potentially altering a consumer’s purchasing and that it would have been obvious to one of ordinary skill in the art to have looked to combine the two teachings. Appellant argues that Harms is related to different aspects of retail sales and there is no motivation for the combination. (Reply Brief at page 2.) We disagree and find that Harms discloses the use of real-time inter-activity at column 9, lines 16-17 and printing a balance on a receipt, issuing a reward at the point of sale by the retailer and use of prior purchases and purchase patterns at column 11, lines 8-60. As discussed above, we do not find this argument persuasive, and we will sustain the rejection of independent claim 1 and its dependent claims. Similarly, we will sustain the rejection of independent claim 10 and its dependent claims since no separate argument for patentability as been set forth.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-4 and 9-14 under 35 U.S.C. § 103 is AFFIRMED.

Appeal No. 2005-2468
Application No. 09/943,941

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

AFFIRMED

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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Appeal No. 2005-2468
Application No. 09/943,941

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