

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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

Appeal No. 2006-0597
Application No. 09/682,876

HEARD: March 23, 2006

Before WARREN, WALTZ, and FRANKLIN, **Administrative Patent Judges**.
WALTZ, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on an appeal from the primary examiner's final rejection of claims 76 through 93, which are all of the claims pending in this application. We have jurisdiction pursuant to 35 U.S.C. § 134.

According to appellant, the invention is directed to a method of distributing incentive vouchers over the Internet to cause customers to come into participating dealers or "resellers" (Brief, page 2). Further details of the invention may be gleaned from the

preferred embodiment illustrated in Figure 2 and independent claim 76, a copy of which may be found in Appendix A of appellant's Brief.

The examiner has relied upon the following references as evidence of obviousness:

Scroggie et al. (Scroggie)	6,185,541	Feb. 06, 2001
Stewart et al. (Stewart) (filed Nov. 3, 1999)	6,259,405	Jul. 10, 2001

The claims on appeal stand rejected under 35 U.S.C. § 103(a) as unpatentable over Stewart in view of Scroggie (Answer, page 3). This is the only ground of rejection before this merits panel for review on appeal. The examiner has *objected* to the amendment dated August 25, 2004, under 35 U.S.C. § 132 because it introduces "new matter" into the disclosure (Answer, page 3). However, although this "objection" is listed under "(9) Grounds of Rejection," the examiner has not recited any rejection of any pending claims under the statutory basis of 35 U.S.C. § 112, first paragraph, for lack of written description, i.e., as based on a specification which contains "new matter" (*id.*). **See Vas-Cath Inc. v. Mahurkar**, 935 F.2d 1555, 1563, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). Similarly, for some unexplained reason, the examiner responds to appellant's arguments concerning an objection to an amendment that allegedly introduced "new matter" into ¶[0045] of the specification (Answer,

pages 23-24), although no objection or rejection on this basis has been made in the Answer (see the Answer, pages 1-12). We note that the examiner has indicated that "this rejection was made in the May 25, 2004 response to the April 5, 2004 amendment" but does not repeat any such rejection in the Answer (Answer, page 23). Rejections not repeated by the examiner in the Answer are considered as dropped or withdrawn. **See *Paperless Accounting v. Bay Area Rapid Transit Sys.***, 804 F.2d 659, 663, 231 USPQ 649, 652 (Fed. Cir. 1986). We also note that appellant expresses his uncertainty about "this ground of rejection" (Reply Brief, page 1).

These actions by the examiner in the Answer are consistent with the final Office action dated Nov. 1, 2004, where the examiner "objected to" the amendment dated Aug. 25, 2004, because it introduced "new matter" into the disclosure but no ground of rejection was made (final Office action, page 2). Similarly to the Answer, the examiner in the final Office action only discusses the "new matter rejection" involving ¶[0045] of the specification in the "Response to Arguments" (page 13) section but fails to set forth or repeat any rejection.

"A rejection of claims is reviewable by the Board of Patent Appeals and Interferences, whereas an objection and requirement to delete new matter is subject to supervisory review by petition

under 37 CFR 1.181." **Manual of Patent Examining Procedure (MPEP)**, § 2163.06, II, 8th ed., Rev. 3, August 2005, p. 2100-190. Thus it is our opinion that there is no accompanying rejection with the objections stated in the Answer and thus these objections are not subject to review by this merits panel of the Board. It is our further opinion that appellant has recourse to petition for supervisory review of the examiner's action (i.e., objections) under 37 CFR § 1.181.

We reverse the examiner's rejection on appeal essentially for the reasons stated in appellant's Brief, Reply Brief, and those reasons set forth below.

OPINION

With regard to the rejection of claim 76, the examiner finds that Stewart discloses a method of distributing a voucher (discount/offer) to a prospective customer who visits a website on the Internet, which method comprises at least six steps (Answer, pages 3-4). The examiner further finds that Stewart discloses a user entering the desired producer, product selection information, and the user's personal ID data and location data (such as an address or geographic location)(Answer, page 4). The examiner notes that in the United States the address is required to contain a postal code (zip code)(*id.*). The examiner further notes that

Stewart teaches many methods for determining the user's location (Answer, pages 4-5). The examiner applies Scroggie for the disclosure of a similar method to that of Stewart of distributing a voucher in which the user is required to enter his or her zip code, since many features of the system are location-dependent (Answer, page 5). From these findings, the examiner concludes that it would have been obvious to one of ordinary skill in the art at the time of appellant's invention to use a postal code or zip code if the general location of the user was desired information, as taught by Scroggie, in order to provide a "quick method of targeting general area advertisements or promotions" in the method of Stewart (*id.*).

The initial burden of establishing a *prima facie* case of obviousness rests with the examiner. *See In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The examiner finds that Stewart discloses a method which generates a voucher redeemable only at a reseller selected by the system (Answer, page 4, citing col. 27, ll. 26-37). However, as correctly argued by appellant (Brief, pages 19-20), the generation of a voucher by the method of Stewart is an *unsolicited* offer by a seller (see col. 26, l. 42-col. 27, l. 37). The examiner has failed to establish how this voucher system of Stewart meets the limitation of claim 76 on appeal, where the website generates a voucher having a time

limit for redemption and having a producer's purchase incentive on the purchase of the "only one selected product at the only one selected reseller." In other words, the voucher system taught by Stewart offers unsolicited offers to the user while the website of the claimed method ties in the voucher to the originally selected product desired by the user.

The examiner finds that, in the method of Stewart, the system "will then select one reseller (local hotel) which can provide the desired product or service based on the user's location and/or demographic information" (Answer, page 4). As also correctly argued by appellant (Brief, page 24), the customer or user in Stewart directly selects the reseller through preferences or a mouse click while in the claimed invention the website selects the reseller from a plurality of resellers based on the selection of the product *and* the postal address code. See Stewart, Figure 9A; col. 13, ll. 22-25; and col. 22, ll. 37-56).

We note that the examiner states that "Official Notice *could* be taken" that it is "old and well known" to receive the producer and product selections from the customer before requesting the customer's personal contact information and postal address code (Answer, page 14, italics added). Despite the statement that official notice "could be taken," the examiner lists four

references as support for this "Official Notice" (*id.*). However, since these references are not listed in the prior art of record or the statement of the rejection (Answer, page 2, ¶(8), and page 3, ¶(9)(b)), we will not consider these references as part of the examiner's evidence of obviousness. **See *In re Hoch***, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970).

Finally, although appellant admits that zip codes would inherently have been part of the mailing address required by Stewart (Reply Brief, page 10), the examiner has not established why one of ordinary skill in this art would have based the selection of a reseller on the postal address code to determine the closest marketing territory when the system of Stewart depends only on "mobile" users (Brief, page 23; Reply Brief, page 10). The examiner's citations from Stewart (Answer, page 4) do not establish any correlation of a reseller with the postal address code *and* a marketing territory.

For the foregoing reasons and those stated in the Brief and Reply Brief, we determine that the examiner has not established a prima facie case of obviousness in view of the reference evidence. Accordingly, we need not consider the Declaration under 37 CFR § 1.132 filed by Mark R. Duchow (Reply Brief, pages 8-9). **See *In re Geiger***, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987).

Therefore we do not sustain the examiner's rejection of the claims on appeal under § 103(a) over Stewart in view of Scroggie.

The decision of the examiner is reversed.

REVERSED

CHARLES F. WARREN)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
THOMAS A. WALTZ)	APPEALS
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)	INTERFERENCES
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)	
)	
BEVERLY A. FRANKLIN)	
Administrative Patent Judge)	

TAW/sld

QUARLES & BRADY LLP
411 E. WISCONSIN AVENUE
SUITE 2040
MILWAUKEE, WI