

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 BRENDA POMERANCE

Appeal No. 2006-1523
Application No. 09/793,687
Technology Center 3600

ON BRIEF

Before CRAWFORD, NAPPI and FETTNG **Administrative Patent Judges.**

NAPPI, **Administrative Patent Judge.**

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. §134(a) of the final rejection of claims 1 through 6, 8, 9, 11 and 14 through 26, claims 7, 10, 12 and 13 have been canceled. For the reasons stated *infra* we affirm in part the examiner's rejection of these claims.

Invention

The invention relates to an automated complaint resolution system. See page 3 of appellant's specification. Claim 1 is representative of the invention and reproduced below:

Rejections at Issue

Claims 1, through 6, 8, 9, 11 and 14 through 26 stand rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter. The examiner's rejection is set forth on pages 6 through 9 of the answer. Claims 1 through 3, 5, 6, 8, 9, 14 through 19 and 21 through 24 stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over Burchetta in view of Sloo. The examiner's rejection is set forth on pages 9 through 14 of the answer. Claims 4, 11 and 25 stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over Burchetta in view of Sloo, "Online Mediation Offered for Resolving E-Commerce Disputes" and Eisen. The examiner's rejection is set forth on pages 14 through 16 of the answer. Claims 20 and 26 stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over Burchetta in view of "Online Mediation Offered for Resolving E-Commerce Disputes" and Eisen. The examiner's rejection is set forth on pages 16 through 18 of the answer. We note the final rejection also contained several rejections based upon 35 U.S.C. § 112, however the examiner withdrew these rejections on appeal, see page 4 of the answer. Throughout the opinion we make reference to the briefs, the answer and the final Office action for the respective details thereof.

Opinion

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, appellant's arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

With full consideration being given to the subject matter on appeal, the examiner's rejection and the arguments of appellant and the examiner, and for the reasons stated *infra* we sustain the examiner's rejection of claims 1 through 3, 5, 6, 8, 9, 14

Appeal No. 2006-1523
Application No. 09/793,687

through 19 and 21 through 24 under 35 U.S.C. § 103 (a). However, we will not sustain the examiner's rejection of claims 1, through 6, 8, 9, 11 and 14 through 26 under 35 U.S.C. § 101, nor will we sustain the examiner's rejection of claims 4, 11, 20, 25 and 26 under 35 U.S.C. § 103.

**Rejection of claims 1, through 6, 8, 9, 11 and 14 through 26
under 35 U.S.C. § 101.**

Appellant argues, on page 15 of the brief, that each of the independent claims recites steps performed on a computer, an apparatus, thus the claims are drawn to statutory subject matter. On pages 1 and 2 of the reply brief, appellant argues that the examiner's rejection is improperly based upon a "technological arts" standard.

The examiner's rejection, on pages 6 through 9 of the answer, applies a technological arts standard. Further, on pages 8 and 9 of the answer, the examiner finds that the claims are drawn to subject matter which "produces a useful, concrete and tangible result" nonetheless the examiner maintains the rejection as the claims are not within the technological arts. On page 18 of the answer, the examiner states that the claims recite the limitation "at a computer" not "on a computer" as such the claims are broad and include the situation where a person sitting at a computer manually performs the steps, thus the examiner considers the claims to not be within the technological arts.

We disagree with the examiner's rationale. As stated in our recent precedential decision in *Ex parte Lungren*, 76 USPQ2d 1385 (Bd. Pat. App. & Int. 2005), "there is currently no judicially recognized separate 'technological arts' test to determine patent eligible subject matter under §101" *Lungren* at 76 USPQ2d 1388. The appropriate analysis for a rejection under §101 can be found in the *Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility*, 1300 Off. Gaz. Patent and Trademark Off. (O.G.) 142, 152 (Nov. 22, 2005). Thus, as the examiner's basis for rejecting the claims under §101 is based upon a "technological arts" test which is not judicially recognized, we will not sustain the examiner's rejection of claims 1 through 6, 8, 9, 11 and 14 through 26 under 35 U.S.C. § 101.

Rejection of claims 1 through 3, 5, 6, 8, 9, 14 through 19 and 21 through 24 under 35 U.S.C. § 103 (a) as being unpatentable over Burchetta in view of Sloo.

Rejection of claims 1 through 3, 5, 6, 8, 9, and 14 through 19.

Appellant's arguments, on pages 15 through 17 of the brief, group claims 2, 3, 5, 6, 9 and 14 through 19 together with claim 1. Appellant argues on page 17 of the brief that the combination of Burchetta and Sloo is "improper; Burchetta's system already has a procedure for computing a settlement account []and there is nothing in Burchetta that would motivate one of ordinary skill in the art to substitute a teaching from Sloo for Burchetta's carefully designed procedure." Further, appellant argues:

Burchetta has a complete system for obtaining a settlement amount, involving a computed procedure for arriving at an amount; this is *imposing* a solution rather than *suggesting* a solution. Sloo is not really concerned with how complaints are settled, but nevertheless provides an elaborate arbitration system for deciding complaints. Arbitration does not *suggest* a solution as required by claim 1, instead, arbitration *imposes* a solution. Accordingly, the references themselves do not show or suggest the invention of claim 1. [Emphasis added]

The examiner responds, on pages 19 through 27 of the answer, asserting that the motivation can be found in Sloo's teaching of providing the highest satisfaction levels to the parties when settling the claims. Further, on pages 20 through 26 of the answer, the examiner equates the teachings of Burchetta and Sloo with the invention as claimed in claim 1.

We concur with the examiner's rationale as set forth on pages 20 through 26 of the answer. "The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved." *In re Huston* 308 F.3d 1267, 1278, 64 USPQ2d 1801, 1810 (Fed. Cir. 2002, citing *In re Kotzab* 217 F.3d 1365, 1370, 55 USPQ 1313, 1317 (Fed. Cir. 2000)). When considering the motivation in the obviousness analysis "the problem examined is not the specific problem solved by the invention but the general problem that confronted the inventor before the invention was made." *In re*

Kahn, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). The examiner's rationale shows that the nature of the problem to be solved by Sloo provides the motivation to combine the reference. Further, we note that Sloo's explicit statements regarding the use of a negotiation system also provide motivation to combine the references as asserted by the examiner.

Sloo teaches a system for complaint resolution, which contains several options, one of which is "Negotiate the Complaint." See Sloo, column 7, line 42. Sloo teaches that the negotiations result in a settlement of either a monetary value or contract condition. See column 7, line 66 through column 8, line 5. Sloo however provides few details of how the negotiations are to be conducted. We consider this teaching of a negotiation option to provide suggestion to use Sloo's system with a negotiation to settlement system such as Burchetta. Thus, in addition to the reasons stated by the examiner, we find that Sloo provides explicit motivation to be combined with a system such as Burchetta's. Accordingly, we find ample evidence of record to support the examiner's finding of motivation to combine Sloo and Burchetta.

With regard to appellant's arguments directed to Burchetta and Sloo's systems not providing suggestions to the users, we concur with the examiner's analysis provided on pages 24 through 26 of the answer. We further note that in addition to the "imposed" solution referred to in appellant's arguments, we find that both Sloo and Burchetta provide suggestions to the user. Sloo teaches, in column 15, lines 34 through 36, "[t]he complaint handling apparatus could recommend best actions." We consider a recommendation to be a suggestion, and as such we find that Sloo teaches that the system provides suggestions to the user. Burchetta teaches that data from previous settlements may be tabulated and provided to the user as guidance in making demands or offers. See column 5, lines 51 through 65. We consider guidance to be a suggestion and as such Burchetta provides suggestions to the user.

On pages 2 and 3 of the reply brief, appellant argues that neither Burchetta nor Sloo teach the claimed feature of "at least two of historical information, advisory information and contra-party current position information."

We are not persuaded by appellant's arguments. Burchetta teaches a system where parties to a dispute enter their offers to settle the dispute, the offers are not disclosed to the other party. See column 1, lines 55 through 67. The offers from each party are compared to each other using pre-established conditions. See column 2, lines 18 through 40. The users can enter three offers, see column 4, lines 48 through 51. After each round the parties are notified of the result of the comparison. See column 9, lines 49 through 52. We consider the notification of the user that their offer was not accepted to be an indication of contra-party current position (an indication an offer is not accepted along with the knowledge of the amount of the refused offer, provides information concerning the contra-parties position). Further, as stated *supra*, the system also provides information related to prior settlements available to the users, i.e. historical information. Thus, we find that Burchetta teaches "at least two of historical information, advisory information and contra-party current position information."

For the forgoing reasons, appellant has not persuaded us of error in the examiner's rejection of claim 1. Accordingly, we sustain the examiner's rejection of claim 1 and the claims appellant grouped with claim 1, claims 2, 3, 5, 6, 9 and 14 through 19.

Rejection of claim 21

On pages 18 and 19 of the brief, appellant presents a separate argument directed to the rejection of claim 21. Appellant argues on page 18 of the brief:

Burchetta's system does not generate a complaint remedy offer as required by claim 21. Instead, under pre-established condition, Burchetta's system computes a settlement amount that is not one of the numbers entered by the users (column 4, lines 54-67). The parties cannot disagree with Burchetta's computed settlement amount, so it is not an offer.

Further, appellant argues that Sloo does not teach this limitation.

We are not persuaded by appellant's argument. We note that Burchetta compares each party's offer with the counter party's offer of the same number, i.e. each party's first offer is compared, if there is no match, each party's second offer is compared. See Column 4, lines 48 through 52. The parties can enter all of the offers at once or over

time. See Column 7, lines 29 through 35. If as discussed *supra* there is no match for the given round the system moves to the next round and the parties are notified. In the situation where the first party enters all three offers at once and the second party enters the offers at the beginning of each round, the first party's offers, will be stored in the computer, at the beginning of the second or third round, the computer will be generating an offer from the first party's previously entered data, to the second party on behalf of the first party. Thus, we find that Burchetta does generate a complaint remedy offer as required by claim 21 and we sustain the examiner's rejection of claim 21.

Rejection of claims 22 through 24.

Appellant's arguments, on pages 19 and 20 of the brief, group claims 22 through 24. Appellant states that Sloo teaches a "Request a Judge/Jury" option and that the monitoring of compliance teaching is directed to monitoring compliance with the judgments entered by the "Request a Judge/Jury" option. Appellant argues that a judgment is not an agreement that is voluntarily entered into and as such Sloo does not teach the limitation of "monitoring, at the computer, compliance by at least one of the complainer and the respondent with terms of the agreement."

While we concur with the appellant that Sloo teaches a "Request a Judge/Jury" option we do not find that one skilled in the art would consider Sloo's monitoring compliance as limited to just judgments from the judge and jury. Sloo states, in column 11, lines 45 through 53:

For example assume that a dispute was resolved using any of the *previous routines* described above, a judgment was rendered that required the subject to reimburse the complainant for damaged merchandise, and the subject failed to comply with the judgment. (emphasis added)

However, Sloo identifies one of the routines as "Negotiate the Complaint" as discussed *supra*. We consider that one skilled in the art would recognize that Sloo in referring to monitoring compliance with a "judgment" also includes monitoring compliance with a negotiated settlement from the "Negotiate the Complaint" routine. Thus, we find that Sloo does teach the limitation of "monitoring, at the computer, compliance by at least one

of the complainer and the respondent with terms of the agreement.” As appellant has not convinced us of error in the examiner’s rejection of claim 22 and the claims grouped therewith, we sustain the examiner’s rejection of claims 22 through 24.

Rejection of claims 4, 11, and 25 under 35 U.S.C. § 103 (a) as being unpatentable over Burchetta in view of Sloo, “Online Mediation Offered for resolving E-Commerce Disputes” and Eisen.

Appellant’s arguments, on pages 20 through 22 of the brief, group claims 4, 11 and 25 together. Appellant argues, on page 20 of the brief, that Burchetta teaches away from being modified to make use of emotional information. Appellant states that Burchetta teaches an advantage of the system is that it avoids direct communication between the parties and “[w]astful personality conflict[s], fruitless and unnecessary disagreements, posturing and positioning cannot occur.” Further, on page 21 of the brief appellant argues, “Online Mediation Offered for resolving E-Commerce Disputes” and Eisen both discuss mediation where there is a human mediator who receives the emotional information and performs the emotional management.

We concur with the appellant. Our reviewing court has said “[A] reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be lead in a direction divergent from the path that was taken by the applicant. The degree of teaching away will of course depend upon the particular facts; in general, a reference will teach away if it suggests that the line of development flowing from the reference’s disclosure is unlikely to be productive of the result sought by the applicant.” *In re Gurley*, 27 F.3d 551, 553, 31 USPQ2d 1130, 1131 (Fed. Cir. 1994) (citing *United States V. Adams*, 383 U.S. 39, 52, 148 USPQ 478, 484 (1966)). However, a reference that “teaches away” does not *per se* preclude a *prima facie* case of obviousness, but rather the “teaching away” of the reference is a factor to be considered in determining unobviousness. *Id* 27 F.3d at 552, 31 USPQ 2d at 1132. We find, as appellant asserts that one of the stated purposes of Burchetta is to deal exclusively with the bottom line, and prevent personality

conflicts, unnecessary disagreements, posturing and positioning. See column 5, lines 1 through 8. Claim 4 recites: “receiving emotional detail information.” Claims 11 and 25 contain similar limitations. We consider this to be information relating to the feelings of the user and not information directed to the contents of the offer. See for example appellant’s specification on page 14, lines 22 through 30. We consider this to be at odds with Burchetta’s teaching of dealing exclusively with the bottom line and avoiding the emotional aspects of negotiating. Further, we do not find that the disclosures of Sloo, “Online Mediation Offered for resolving E-Commerce Disputes” and Eisen present sufficient suggestion that Burchetta’s system should be modified in the face of the teaching away. Accordingly, we will not sustain the examiner’s rejection of claims 4, 11, and 25.

Rejection of claims 20 and 26 under 35 U.S.C. § 103 (a) as being unpatentable over Burchetta in view of “Online Mediation Offered for resolving E-Commerce Disputes” and Eisen.

Claim 20 recites the limitation “receiving, at a computer, emotional detail information from the complainer,” claim 26 is dependent upon claim 20. As discussed *supra*, with respect to claim 4, we find that Burchetta provides strong suggestion away from using such information and that we do not find that “Online Mediation Offered for resolving E-Commerce Disputes” and Eisen present sufficient suggestion that Burchetta’s system should be modified in the face of the teaching away. Accordingly, we will not sustain the examiner’s rejection of claims 20 and 26 for the reasons stated *supra* with respect to claim 26.

Conclusion

In summary, we sustain the examiner's rejection of claims 1 through 3, 5, 6, 8, 9, 14 through 19 and 21 through 24 under 35 U.S.C. § 103 (a). However, we will not sustain the examiner's rejection of claims 1, through 6, 8, 9, 11 and 14 through 26 stand rejected under 35 U.S.C. § 101, nor will we sustain the examiner's rejection of claims 4, 11, 20, 25 and 26 under 35 U.S.C. § 103. The decision of the examiner is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

MURRIEL E. CRAWFORD)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
ROBERT E. NAPPI)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
)	
)	
ANTON W. FETTING)	
Administrative Patent Judge)	

REN/vsh

Appeal No. 2006-1523
Application No. 09/793,687

BRENDA POMERANCE
LAW OFFICE OF BRENDA POMERANCE
260 WEST 52 STREET SUITE 27B
NEW YORK NY 10019