

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

3
4 UNITED STATES PATENT AND TRADEMARK OFFICE

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6
7 BEFORE THE BOARD OF PATENT APPEALS
8 AND INTERFERENCES

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11 *Ex parte* JAMES C. CRONE

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14 Appeal 2006-2109
15 Application 10/680,678
16 Technology Center 3600

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19 Decided: June 25, 2007

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22 Before HUBERT C. LORIN, ANTON W. FETTING, and JOSEPH A.
23 FISCHETTI, *Administrative Patent Judges*.

24 Opinion for the Board by FETTING, *Administrative Patent Judge*.
25 Concurring Opinion by FISCHETTI, *Administrative Patent Judge*.
26 FETTING, *Administrative Patent Judge*.

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28 DECISION ON APPEAL

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31 STATEMENT OF CASE

32 This appeal from the Examiner's rejection of claims 1-20, the only claims
33 pending in this application, arises under 35 U.S.C. § 134. We have jurisdiction
34 over the appeal pursuant to 35 U.S.C. § 6.

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36 We AFFIRM.

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The Appellant invented a way for “facilitating charitable hunger relief by restaurant customers while promoting their health and providing documentation for charitable gift tax deductions” (Specification 1). The process operates by “selling a reduced-portion meal product to a customer at the price of a corresponding full-portion meal product, and collecting at least that price in funds from the customer. The price comprises a base amount corresponding to the cost of the reduced-portion meal product and an excess amount that is the difference between that cost and the price. The method further comprises transferring part of the excess amount and any additional funds donated by a customer to a charity on behalf of the customer. The part of the excess amount transferred to the charity may comprise the excess amount less an operating fee retained by the restaurant. The customer is provided a receipt memorializing the sale and documenting the charitable donation.” (Specification 3-4).

An understanding of breadth of the scope of the claimed invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. A method of improving customer health and facilitating charitable giving, by a restaurant, comprising:
 - selling a reduced-portion meal product to a customer at the price of a corresponding full-portion meal product;
 - collecting at least said price in funds from the customer, said funds comprising a base amount corresponding to said reduced-portion meal product and an excess amount; and
 - transferring part of said excess amount to a charity on behalf of the customer.

1 This appeal arises from the Examiner's Final Rejection, mailed February 2,
2 2005. The Appellant filed an Appeal Brief in support of the appeal on April 1,
3 2005, and the Examiner mailed an Examiner's Answer to the Appeal Brief on
4 April 27, 2005. A Reply Brief was filed on June 2, 2005. The appeal was
5 remanded by the Board of Patent Appeals and Interferences back to the Examiner
6 to reconsider a rejection under 35 U.S.C. § 101 on March 2, 2006. The Examiner
7 mailed a second Examiner's Answer to the Appeal Brief on March 27, 2006. A
8 second Reply Brief was filed on May 2, 2006. Generic references below to an
9 Examiner's Answer and a Reply Brief refer to the second submission of each
10 occurring in 2006.

11 PRIOR ART

12 The Examiner relies upon the following references as evidence of
13 unpatentability:

14 Helbling	US 5,724,518	Mar. 3, 1998
15 Burke	US 6,088,682	Jul. 11, 2000

16
17 REJECTIONS¹

18 Appellant seek review of the following Examiner's rejections.

19 Claims 1-6, 11-14, and 19-20 stand rejected under 35 U.S.C. § 103(a) as
20 obvious over Helbling.

21 Claims 7-10 and 15-18 stand rejected under 35 U.S.C. § 103(a) as obvious over
22 Helbling and Burke.

¹ The Examiner withdrew a rejection under 35 U.S.C. § 101 (Answer 2)

ISSUES

Helbling alone

The Examiner finds that Helbling discloses facilitating charitable giving by a restaurant, including: selling a reduced portion meal product (i.e., meal without a beverage, since beverages are free with donation) at a customer price higher than the reduced portion meal price (i.e., reduced meal price plus excess minimum donation amount), transferring the excess amount to a charity on behalf of the customer.

The Examiner finds that Helbling lacks the teaching of the customer price corresponding to the full-portion meal product price (i.e., reduced portion meal price plus beverage price) and transferring only part of the excess amount to charity.

The Examiner concluded that it would have been an obvious design choice at the time of the invention to have the customer price correspond to the full portion meal price (i.e., have the minimum donation amount equal the beverage price) in order for the charities to receive more money without the customers feeling like they've overpaid. (Final Rejection 3).

The Examiner further finds, specifically regarding claims 1, 4, 11, and 20, that it is well known in business for a company to receive a processing fee for work performed, and therefore, the Examiner concludes that it would have been obvious to one of ordinary skill in the art to transfer only part of the excess amount to charity. (Final Rejection 4).

The Appellant contends that Helbling does not teach or suggest full- or reduced-portion meal products. The Appellant argues that in rejecting claims 1 and 11, the Examiner constructed a purely hypothetical "full-portion meal"

1 including a beverage - which Helbling does not teach or suggest - and asserted that
2 Helbling discloses selling a "reduced-portion meal" that does not include a
3 beverage - which also finds no support in the disclosure of Helbling. The Appellant
4 concludes that this construction of Helbling can be arrived at only through the
5 teaching of claims 1 and 11, using impermissible hindsight. (Br. 10).

6 The Appellant further contends that there is no motivation to price the reduced-
7 portion meal at the price of a corresponding full-portion meal and that Helbling
8 explicitly teaches against it. The Appellant argues that even in 1996, the filing
9 date of the Helbling application, the price of a beverage in a fast food restaurant far
10 exceeded twenty-five cents. By suggesting a minimum donation level of a quarter,
11 the Appellant contends that Helbling teaches that the minimum donation must be a
12 token amount, as compared to the price of the reward, to encourage participation.
13 The Appellant concludes that making the minimum donation amount equal to the
14 price of the beverage, as the Examiner suggested, would discourage rather than
15 encourage participation, whereas the purpose of Helbling is to maximize
16 participation. As well known in retailing, if a customer does not perceive he is
17 getting something "free," or at the very least at a substantial discount, he will not
18 participate in a promotion. The Appellant cites *In re Gordon*, 733 F.2d 900 (Fed.
19 Cir. 1984) for the proposition that if a proposed modification would render the
20 prior art invention being modified unsatisfactory for its intended purpose, then
21 there is no suggestion or motivation to make the proposed modification. (Brief 11-
22 12).

23 The Appellant further contends that Helbling itself teaches away from retaining
24 a processing fee from the donation. The Appellant argues that, at its core, Helbling
25 relies on the generosity of the restaurant in providing a free beverage to customers

1 willing to make a charitable donation. Taken as a whole, the Appellant contends
2 that the entire Helbling system relies on the restaurant's largess, both in offering
3 free beverages to customers as an inducement, and in operating the system by
4 which customer charitable donations are tracked and transferred to the charities.
5 With the low minimum donation amount Helbling suggests - \$0.25 – the Appellant
6 argues that it is improbable that the restaurant would retain a processing fee from
7 the donation, particularly considering that the restaurant is providing the beverages
8 free of charge. The Appellant cites *In re Gurley*, 27 F.3d 551,553 (Fed. Cir. 1994),
9 for the proposition that a prior art reference that teaches away from the invention
10 cannot serve to create a prima facie case of obviousness. The Appellant further
11 argues that the mere fact that some businesses charge a fee for work performed - or
12 that it would be possible for a restaurant in Helbling to do so - provides absolutely
13 no motivation making the proposed modification. (Br. 12-14).

14 The Appellant next argues that since Helbling would lead a person of ordinary
15 skill in a direction divergent from the path taken by the Applicant - that is, reliance
16 on the philanthropy of a restaurant owner rather than the customer's healthy self-
17 interest - Helbling, considered as a whole, teaches away from the present invention
18 of claim 1, and thus cannot support a prima facie case of obviousness. (Br. 14-16).

19 The Appellant next contends that Helbling does not describe a reduced-portion
20 meal according the construction defined within the specification at p. 4. (Br. 16-
21 18).

22 In the Answer, the Examiner introduces the argument that, since the Appellant
23 argues these claims as a group, the Examiner selects claim 11 as representative,
24 and that claim 11 is to an apparatus that is capable of performing the process in

1 claim 1. (Answer 5). To this, the Appellant responds that claims 1 and 11 are
2 argued separately. (Reply Br. 1).

3

4 *Helbling and Burke*

5 The Examiner finds that Helbling lacks the specific teaching of the customer
6 providing a unique identifier, tracking customer donations across multiple sales,
7 and providing the customer with a summary of donations over a predetermined
8 period. To overcome this deficiency, the Examiner finds that Burke teaches a
9 similar means for facilitating charitable contributions including the use of a
10 magnetic stripe donor card that tracks customer donations and prints out periodic
11 reports. (Final Rejection 4).

12 The Examiner concludes that it would have been obvious to one of ordinary
13 skill in the art to modify Helbling to have the customer provide a unique identifier,
14 track customer donations across multiple sales, and provide the customer with a
15 summary of donations over a predetermined period, as taught by Burke, in order to
16 provide the customer with accurate records for tax purposes. (Final Rejection 5).

17 The Appellant contends that Helbling discloses a self-sufficient system that
18 does not need and would not benefit from the elaborate network disclosed in
19 Burke. Furthermore, Helbling, taken as a whole, makes it clear that customers are
20 enticed to contribute to charities by the offer of a free beverage by the restaurant,
21 not any tax deduction. The Appellant further argues that the suggested minimum
22 donation amount of \$0.25 strongly suggests that most customers would not
23 consider the minuscule tax savings to be worth the effort of receiving and
24 processing a statement of their token contributions. The Appellant also contends

1 that Burke does not provide any motivation for modifying the teaching of Helbling.
2 (Br. 19).

3 Thus, the issues pertinent to this appeal are

- 4 • Whether the rejection of claims 1-6, 11-14, and 19-20 under 35 U.S.C.
5 § 103(a) as obvious over Helbling is proper. This issue turns on whether the
6 full and reduced portion meals and prices and the amount donated to charity
7 of the claimed subject matter are shown by Helbling, or they would be
8 predictable variations of Helbling.
- 9 • Whether the rejection of claims 7-10 and 15-18 under 35 U.S.C. § 103(a) as
10 obvious over Helbling and Burke is proper. This issue turns on whether it is
11 proper to combine the teachings of Helbling and Burke.

12

13 FACTS PERTINENT TO THE ISSUES

14 The following enumerated Findings of Fact (FF), supported by substantial
15 evidence, are pertinent to the above issues.

16 *Specification*

17 01. The Appellant's disclosure states that "[e]ach reduced-portion meal
18 product comprises the same elements as its corresponding full-portion
19 meal product, but in reduced quantities." (Specification 4:22-23).

20 02. The Appellant's disclosure also states that "[a]lthough the present
21 invention has been described herein with respect to particular features,
22 aspects and embodiments thereof, it will be apparent that numerous
23 variations, modifications, and other embodiments are possible within the
24 broad scope of the present invention, and accordingly, all variations,

1 modifications and embodiments are to be regarded as being within the
2 scope of the invention. The present embodiments are therefore to be
3 construed in all aspects as illustrative and not restrictive and all changes
4 coming within the meaning and equivalency range of the appended
5 claims are intended to be embraced therein.” (Specification 12:10-17).

6 *Helbling*

7 03. Helbling is directed toward correlating charitable contributions,
8 especially in conjunction with the vending of food products including
9 beverages. (Helbling, col. 1, ll. 14-18).

10 04. Helbling accomplishes this by collecting a charitable contribution
11 from a patron at the cash register of a fastfood operation. The patron is
12 conditioned to make the contribution, in part, by awarding the patron a
13 free beverage, for example, which can be drawn by the patron.
14 (Helbling, col. 2, ll. 5-11).

15 05. Helbling’s system operates by a prospective donor, generally also a
16 patron of the fastfood establishment, selecting the food items offered by
17 the cashier at the register 10 who punches in the food items, registering
18 the charges. The patron is offered the opportunity to make a certain
19 minimum donation to a particular charity, e.g. twenty-five cents, and if
20 the donor is willing, the amount of the contribution, including any
21 additional amount the donor may choose, is punched into the cash
22 register by the cashier and appears on the display 12. The registration of
23 this contribution and collection of the equivalent amount from the patron
24 at the cash register is transmitted to the restaurant computer 13 and

1 increments the memory thereof with respect to the particular
2 contribution. (Helbling, col. 4, ll. 22-34).

3 *Burke*

4 06. Burke is directed toward extending the scope and impact of consumer
5 Point of Sale (POS) transactions. (Burke, col. 1, ll. 14-16).

6 07. In particular, Burke is concerned with current shopping situations
7 where a consumer makes a cash transaction and all activity ceases. In
8 most occurrences the transaction produces excess change that is often a
9 nuisance to the consumer. The fact that consumers often receive
10 troublesome and often unwanted coins or bills provides a unique
11 opportunity for consumers to save or charitably give at point of sale
12 counters. In addition, at point of sale counters consumers often have
13 funds over and above the amount they will dedicate to their spending
14 transactions. Providing consumers with a way to set aside such
15 discretionary funds would also provide consumers with a painless and
16 convenient way to save or give. (Burke, col. 1, ll. 20-30).

17 08. Burke provides a detailed description of how to implement a point of
18 sale system that sets aside discretionary consumer funds to save or give
19 (Burke, Figs. 8.4, 8.5 and 8.6, each composed of multiple subordinate
20 drawings).

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1 PRINCIPLES OF LAW

2 *Claim Construction*

3 The general rule is that terms in the claim are to be given their ordinary and
4 accustomed meaning. *Johnson Worldwide Assocs. v. Zebco Corp.*, 175 F.3d 985,
5 989, 50 USPQ2d 1607, 1610 (Fed. Cir. 1999). In the USPTO, claims are
6 construed giving their broadest reasonable interpretation.

7 [T]he Board is required to use a different standard for construing
8 claims than that used by district courts. We have held that it is error
9 for the Board to “appl[y] the mode of claim interpretation that is used
10 by courts in litigation, when interpreting the claims of issued patents
11 in connection with determinations of infringement and validity.” *In re*
12 *Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989); *accord In re Morris*, 127
13 F.3d 1048, 1054 (Fed. Cir. 1997) (“It would be inconsistent with the
14 role assigned to the PTO in issuing a patent to require it to interpret
15 claims in the same manner as judges who, post-issuance, operate
16 under the assumption the patent is valid.”). Instead, as we explained
17 above, the PTO is obligated to give claims their broadest reasonable
18 interpretation during examination.

19 *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364, 70 USPQ2d 1827, 1834
20 (Fed. Cir. 2004).

21 Although a patent applicant is entitled to be his own lexicographer of patent
22 claim terms, in *ex parte* prosecution it must be within limits. *In re Corr*, 347 F.2d
23 578, 146 USPQ 69 (CCPA, 1965). The applicant must do so by placing such
24 definitions in the Specification with sufficient clarity to provide a person of
25 ordinary skill in the art with clear and precise notice of the meaning that is to be
26 construed.

27 Although an inventor is indeed free to define the specific terms used
28 to describe his or her invention, this must be done with reasonable
29 clarity, deliberateness, and precision. "Where an inventor chooses to
30 be his own lexicographer and to give terms uncommon meanings, he

1 must set out his uncommon definition in some manner within the
2 patent disclosure" so as to give one of ordinary skill in the art notice
3 of the change. (Citation omitted).

4 *In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ 2d 1671, 1674 (Fed. Cir. 1994).

5 *Obviousness*

6 A claimed invention is unpatentable if the differences between it and the prior art
7 are "such that the subject matter as a whole would have been obvious at the time
8 the invention was made to a person having ordinary skill in the art." 35 U.S.C. §
9 103(a) (2000); *In re Kahn*, 441 F.3d 977, 985, 78 USPQ2d 1329, 1334 (Fed. Cir.
10 2006) (citing *Graham v. John Deere Co.*, 383 U.S. 1, 13-14, (1966)). In *Graham*,
11 the Court held that that the obviousness analysis begins with several basic factual
12 inquiries: "[(1)] the scope and content of the prior art are to be determined; [(2)]
13 differences between the prior art and the claims at issue are to be ascertained; and
14 [(3)] the level of ordinary skill in the pertinent art resolved." 383 U.S. at 17. After
15 ascertaining these facts, the obviousness of the invention is then determined
16 "against th[e] background" of the *Graham* factors. *Id.* at 17-18.

17 The Supreme Court has provided guidelines for determining obviousness based
18 on the Graham factors. *KSR Int'l v. Teleflex Inc.*, 127 S. Ct. 1727, 82 USPQ2d
19 1385 (2007). "A combination of familiar elements according to known methods is
20 likely to be obvious when it does no more than yield predictable results. *Id.* at 1731,
21 82 USPQ2d at 1396. "When a work is available in one field of endeavor, design
22 incentives and other market forces can prompt variations of it, either in the same
23 field or a different one. If a person of ordinary skill can implement a predictable
24 variation, §103 likely bars its patentability." *Id.* For the same reason, "if a
25 technique has been used to improve one device, and a person of ordinary skill in
26 the art would recognize that it would improve similar devices in the same way,

1 using the technique is obvious unless its actual application is beyond that person's
2 skill." *id.* "Under the correct analysis, any need or problem known in the field of
3 endeavor at the time of invention and addressed by the patent can provide a reason
4 for combining the elements in the manner claimed." *Id* at 1732, 82 USPQ2d at
5 1397.

6 *Nonfunctional Descriptive Material*

7 Descriptive material can be characterized as either "functional descriptive
8 material" or "nonfunctional descriptive material." Exemplary "functional
9 descriptive material" consists of data structures² and computer programs, which
10 impart functionality when employed as a computer component. "Nonfunctional
11 descriptive material" includes but is not limited to music, literary works and a
12 compilation or mere arrangement of data.

13 When presented with a claim comprising descriptive material, an Examiner
14 must determine whether the claimed nonfunctional descriptive material should be
15 given patentable weight. The Patent and Trademark Office (PTO) must consider
16 all claim limitations when determining patentability of an invention over the prior
17 art. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983). The
18 PTO may not disregard claim limitations comprised of printed matter. See
19 *Gulack*, 703 F.2d at 1384, 217 USPQ at 403; see also *Diamond v. Diehr*, 450 U.S.
20 at 191, 209 USPQ at 10. However, the examiner need not give patentable weight
21 to descriptive material absent a new and unobvious functional relationship between
22 the descriptive material and the substrate. See *In re Lowry*, 32 F.3d 1579, 1583-84,

² The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The

1 32 USPQ2d 1031, 1035 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338, 70
2 USPQ2d 1862, 1863-64 (Fed. Cir. 2004).

3 Thus, when the prior art describes all the claimed structural and functional
4 relationships between the descriptive material and the substrate, but the prior art
5 describes a different descriptive material than the claim, then the descriptive
6 material is nonfunctional and will not be given any patentable weight. That is, we
7 conclude that such a scenario presents no new and unobvious functional
8 relationship between the descriptive material and the substrate.

9

10 ANALYSIS

11 *Claims 1-6, 11-14, and 19-20 rejected under 35 U.S.C. § 103(a) as obvious over*
12 *Helbling.*

13 We note that the Appellant argue these claims as a group. Accordingly, we
14 select claim 1 as representative of the group.

15

16 Initially, we note that the steps in claim 1 do no more than sell a meal and
17 transfer part of the amount collected to a charity. Clearly, this is performed by
18 Helbling (FF 05). The only difference between Helbling's process and the
19 claimed process is the story that is spun to describe how the transaction is
20 explained to customers in the promotional campaign. A price of a meal is
21 nonfunctional and is merely a descriptive attribute of the meal. The amount of
22 funds that are transacted may be functional, but as both the claims and Helbling

New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).

1 show, a price is not necessarily the amount of funds transacted, and, in fact, the
2 price of the meal vended is not the amount transacted in both cases. Nonfunctional
3 descriptive material will not define the invention over the prior art (See *Ngai*,
4 *supra*). Further, although the transfer of funds is clearly functional, the destination
5 of the funds transfer as being directed towards charity is a field of use limitation,
6 and this claim limitation could be met by any transfer of funds to some different
7 entity.

8 We next note that claim 11 is broader in scope than claim 1, and that, as a
9 system claim, the claimed system must only be capable of performing the steps
10 indicated in the claim. Claim 11 does not positively recite actually performing the
11 recited steps.

12 The Appellant first contends that Helbling does not teach or suggest full- or
13 reduced-portion meal products. This raises the question of what a full- or reduced-
14 portion meal is. The Specification indicates that a reduced-portion meal product
15 comprises the same elements as its corresponding full-portion meal product, but in
16 reduced quantities (FF 01). However, there is no indication that this is meant to be
17 a definitive statement. It is therefore ambiguous as to whether this statement refers
18 to a lexicographic definition, or merely to an exemplary embodiment. Although an
19 applicant is entitled to be his own lexicographer, the applicant must do so by
20 placing such definitions in the Specification with sufficient clarity to provide a
21 person of ordinary skill in the art with clear and precise notice of the meaning that
22 is to be construed. (See *Paulsen, supra*). A statement at the end of the
23 Specification clarifies that the earlier statement regarding a reduced-portion meal
24 pertains to an embodiment only (FF 02). Thus, a full-portion and reduced-portion

1 meal are construed according to their usual and customary meaning of meals, that
2 being where one is larger in terms of overall volume than the other.

3 The Examiner finds that a meal without a beverage is a reduced portion meal of
4 a meal with a beverage, and that Helbling sells a meal without a beverage. The
5 Examiner treats Helbling's offer of a promotional beverage as a related, but
6 separate transaction. This is consistent with the operation of Helbling (FF 05).
7 Thus, we cannot say the Examiner erred in finding that Helbling does teach or
8 suggest full- and reduced-portion meal products.

9 Next, the Appellant contends that there is no motivation to price the reduced-
10 portion meal at the price of a corresponding full-portion meal and that Helbling
11 explicitly teaches against it. As we stated above, price is a nonfunctional
12 descriptive attribute that will not distinguish the invention over the prior art.
13 Further, pricing is an inherently subjective process, determined by the promotional
14 strategies employed, not by functional constraints, and therefore any embodiment
15 of a price is the functional equivalent of any other price. The level of a price is an
16 arbitrary number set by a vendor based on judgment, not on functional
17 relationships. We agree, that as a predictable variation (See *KSR, supra*), the
18 Examiner's suggestion that setting the minimum donation amount equal to the
19 beverage price would be an obvious promotional ploy because the customer would
20 feel that, although he might not be saving money, at least the price of the beverage
21 was contributed at no net outlay for the customer. Thus, we cannot say the
22 Examiner erred in finding that to require an outlay for the reduced-portion meal at
23 the price of a corresponding full-portion meal would be a predictable variation of
24 Helbling's promotional campaign.

1 As to teaching away and rendering unsuitable for intended purpose, the
2 Appellant is confusing the divergence of promotional campaigns with functional
3 incompatibility. Although the story behind the promotional campaign in Helbling
4 may differ from the Appellant's, the actual steps in implementing the campaigns
5 are fundamentally the same, both do no more than sell a meal and transfer part of
6 the amount collected to a charity. Thus, the procedure is essentially the same in
7 each and we cannot say that Helbling teaches away from the claimed invention or
8 that the claimed subject matter would render Helbling unsuitable for its intended
9 purpose.

10 The Appellant next contends that Helbling itself teaches away from retaining a
11 processing fee from the donation. The claim is broader than this, and encompasses
12 no retention of any fees, because a part is not necessarily less than the whole. That
13 is, a whole is part of itself. This is technically supported by basic set theory in
14 which a set is a subset of itself. Furthermore, even if the claim were construed
15 such that a part were less than the whole, we agree with the Examiner of the
16 notoriety of retaining an administrative fee, to the extent so retaining a fee would
17 be a predictable variation of Helbling.

18 Thus, the Examiner has shown that all of the claim elements, are shown by the
19 combination of Helbling and Burke, or they would be predictable variations of
20 Helbling and Burke, and that it would have been obvious to a person of ordinary
21 skill in the art to have combined Helbling and Burke to form the claimed subject
22 matter.

23
24 *Claims 7-10 and 15-18 rejected under 35 U.S.C. § 103(a) as obvious over Helbling*
25 *and Burke.*

1 JOSEPH A. FISCHETTI, concurring:

2 I concur with the majority and add the following analysis.

3 First, conspicuously absent from claim 1 is any reference to a device, such as
4 a computer, which effects the claimed process. We have previously held there is
5 no requirement for the Appellant to recite any such device, but mention it here
6 because it bears on the broad scope of claim 1. *Ex parte Carl A. Lundgren*, 2004
7 WL 3561262, 76 U.S.P.Q.2d 1385 (Bd.Pat.App. & Interf., 2004) “the Federal
8 Circuit has held that a process claim that applies a mathematical algorithm to
9 “produce a useful, concrete, tangible result without pre-empting other uses of the
10 mathematical principle, on its face comfortably falls within the scope of § 35
11 U.S.C. § 101...”, *citing to AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d
12 1352, 1358, 50 USPQ2d 1447, 1452 (Fed. Cir. 1999).

13 Second, also key to interpreting claim 1 is the meaning of “reduced meal
14 portion”. The excerpt in the Specification relied on by the Appellant to allegedly
15 establish a definition for “reduced meal portion” (*See*, Specification 4:22-24,
16 5:12:9-12) describes the feature in the context of, “For example...” and “...may
17 comprise...” (Specification 4: 23, 24), which we take as a reasonable indicator of a
18 description of plural embodiments rather than a definition of a particular claim
19 element. *In re Zletz*, 13 USPQ2d 1320, 893 F2d 319 (Fed. Cir. 1989)

20 Thus, without being constrained by a definition tied to the specification, and/or
21 by an electronic/mechanical device limitation, the term “reduced meal portion” in
22 claim 1 is open to broad reasonable interpretation which would include the known
23 mental process involved with a person giving to a charity, such as the Helbling
24 patron.

1 It is well understood that in dealing with a charity, giving is the underlying
2 function for the people involved with the process. For a majority of those people
3 who give, sacrifice is an integral part of this process. That is, taking less for
4 oneself in order to give more for another is how charity works.

5 The individual in *Helbling* could have ordered, or was capable of ordering
6 something of less value /size in order to give as his contribution to charity the
7 difference in price between what he really wanted to eat, e.g. a full portion meal,
8 and what he actually ordered, e.g., a reduced portion meal. *See, In re Schreiber*, 44
9 USPQ2d 1429 (CAFC 1973) at 1434. Thus, in *Helbling*, an actual order, for
10 example, of a single patty hamburger placed by the patron could be read as a
11 “reduced meal portion”, because the patron’s original intent could have been to
12 order a double cheeseburger, but on upon entering the fast food facility and seeing
13 the invitation to contribute, the patron changes his mind and buys less to
14 accommodate his intended contribution. The patron then contributes to the charity
15 based on what he would have otherwise have paid for the double cheeseburger
16 minus the price of the lesser sized single burger actually purchased, thereby
17 answering the limitations of claim 1.

18 I cannot see anything new or unobvious in an act of charity so unconstrained
19 by any other claim limitation which would take it out of the public domain.

20
21 JRG

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