

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 28

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte OM P. GUPTA,
ROBERT C. RICKETSON,
JACK F. BAILEY,
CAROL C. SHILEPSKY, and
ARNOLD C. SHILEPSKY

Appeal No. 96-0125
Application 07/878,100¹

ON BRIEF

Before JERRY SMITH, FLEMING, and CARMICHAEL, Administrative
Patent Judges.

JERRY SMITH, Administrative Patent Judge.

¹ Application for patent filed May 4, 1992. According to appellants, the application is a continuation-in-part of Application 07/747,727, filed August 20, 1991.

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DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-26, which constitute all the claims in the application. An amendment after final rejection was filed on February 27, 1995 but was denied entry by the examiner [Paper #16]. A second amendment after final rejection was filed on April 13, 1995 and was entered by the examiner [Paper #19]. This amendment resulted in the withdrawal of a rejection under the second paragraph of 35 U.S.C. § 112.

The disclosed invention pertains to a method and apparatus for promoting the sale of products to a customer based upon the customer's buying habits. Specifically, the invention uses a rule-based method for communicating information regarding products within a store to the customer as the customer is indicating objects desired for purchase.

Representative claim 1 is reproduced as follows:

1. A system for promoting the sale of products to a customer, comprising at least one remote unit, said remote unit comprising:

a) means for inputting identification of a product desired by a customer;

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b) means for storing data representative of said product identification;

c) means for storing product specifications; and

d) processing means operatively connected to said means for inputting product identification, to said means for storing data representative of said product identification and to said means for storing product specifications, said processing means being programmed to select said identified product, a competing product to said identified product or a complimentary product to said identified product for promotion based upon rules for selecting a product for promotion in response to said data representative of said product identification wherein said processing means accesses said stored product specifications and promotes a product by displaying said store product specifications of said product selected for promotion to said customer.

The examiner relies on the following references:

Humble	4,825,045	Apr. 25, 1989
Vela et al. (Vela)	4,882,724	Nov. 21, 1989
Schneider	5,083,638	Jan. 28, 1992
		(filed Sep. 18, 1990)

"Ads On Wheels Roll Into Supermarkets," Chain Store Age Executive, Vol. 64, no. 9, pages 49 and 51 (September 1988)
(Chain Store)

Claims 1-26 stand rejected under 35 U.S.C. § 103. As evidence of obviousness the examiner offers the basic combination of Vela in view of Humble with respect to claims 1-3, 5, 7, 8 and 17-25. Chain Store is added to the basic combination with respect to claims 9-16 and 26. Schneider is added to the basic combination with respect to claims 4 and 6.

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Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs and the answers 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, the appellants' 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 answers.

It is our view, after consideration of the record before us, that the examiner has not established the obviousness of the invention as set forth in claims 1-26. Accordingly, we reverse. We also enter a new ground of rejection against independent claim 1 using our authority under 37 CFR § 1.196(b). This new rejection will be set forth in detail below.

We consider first the rejection of claims 1-3, 5, 7, 8 and 17-25 under 35 U.S.C. § 103 as being unpatentable over Vela in view of Humble. These claims stand or fall together [brief,

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page 4]. Therefore, we will consider independent claim 1 as representative of all the claims within this group.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part

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of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

Vela is related to the claimed invention in that a remote unit is attached to a customer's shopping cart for providing information to the customer as the customer traverses the shopping premises. Vela provides two kinds of information to the customer. First, in response to the selection of general items to be purchased as shown in Figure 12, Vela provides a floor display indicating where the items are located in the store [Figure 13]. Second, based on the location of the customer within the store, products are advertized to the customer which are in the same general area as the customer. The products promoted in Vela result from the location of the customer and are not selected based on the products desired by the customer.

Humble suggests a system for providing information and/or coupons to the customer at the point of checkout. At checkout the items actually purchased are scanned by a universal product code (UPC) reader. The products purchased result in the display of information about the products purchased, competing products or related products, and may result in the generation of coupons

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related to any of these products. In Humble, product identification and message information occur at the point where the customer is checking out from the store.

The examiner relies on Vela for teaching the invention of claim 1 except for the failure to teach the selection of competing or complementary products. The examiner relies on Humble for providing the motivation to promote other products and asserts that the modification of Vela to incorporate Humble's product promotion ideas would have been obvious to the artisan to increase flexibility and effectiveness [answer, pages 4-5]. The examiner also finds the rule-based selection process of claim 1 to be inherent in any computer run by a sequence of instructions.

Appellants argue that Vela does not suggest selecting the promoted product based upon the products actually selected by the customer. With respect to Humble, appellants argue that it is simply a checkout add-on system which provides information too late to affect the customer's purchases. Appellants insist that "[a]bsent the teachings of the Appellants' disclosure, there is no suggestion or teaching provided in the references to combine the references. Even if they were combined, neither teaches a rule-based system to present messages at the point of selection

tailored to the specific purchases of a specific consumer"

[brief, page 7].

Although appellants' arguments are not exactly commensurate in scope with the invention of claim 1, and although the examiner has given a reason why Humble's product promotion would be added to Vela's system, we agree with appellants that the teachings of Vela and Humble would not have been combined by the artisan to derive the invention of claim 1 absent a desire to achieve the claimed invention in hindsight.

The key feature of appellants' invention is that messages are sent to the customer promoting products based on rules for selecting a product in response to the data indicating the identification of a desired product. Vela never identifies a specific product and products are promoted only in response to the customer's location. The only basis the examiner has for delivering messages based on the products purchased is Humble's conventional system for conveying information to the customer after the customer is finished shopping. The examiner's rationale for incorporating Humble's teachings into Vela's system comes from appellants' disclosure and not from the suggestions of Vela or Humble.

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We note that the examiner has taken the position that any computer operating under control of a program is rule-based. Although the disclosure in this application attaches no special significance to the concept of a rule-based selection of data, it would be clear to the artisan that a rule-based selection system cannot refer to the general program under which a computer operates. Rather, claim 1 refers to the result of its programming instead of the programming per se. Vela does not use a rule-based method in delivering messages as asserted by the examiner.

For all the reasons discussed above, we do not sustain the rejection of claims 1-3, 5, 7, 8 and 17-25. Since neither Chain Store nor Schneider makes up for the deficiencies in the combination of Vela and Humble, we also do not sustain the rejection of dependent claims 4, 6, 9-16 and 26. Therefore the decision of the examiner rejecting claims 1-26 under 35 U.S.C. § 103 is reversed.

We make the following new ground of rejection using our authority under 37 CFR § 1.196(b). Claim 1 is rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of Humble as cited above. Notwithstanding our decision above that the

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collective teachings of Vela and Humble would not have been combined as proposed by the examiner, we nevertheless are of the view that the invention as broadly recited in claim 1 is broad enough to be suggested by the teachings of Humble by itself. As we noted above in our consideration of the examiner's rejection, appellants' arguments are not commensurate in scope with the invention as recited in claim 1. We shall address the breadth of claim 1 and provide our analysis as to why the invention of claim 1 would have been obvious in view of Humble.

Although claim 1 is written in "means plus function" form, claims undergoing examination are given their broadest reasonable interpretation consistent with the specification. In re Donaldson, 16 F.3d 1189, 1194, 29 USPQ2d 1845, 1850 (Fed. Cir. 1994) (in banc). Based upon the record developed in this case so far, we find nothing in claim 1 which patentably distinguishes over what Humble alone suggests.

Appellants apparently rely on the claim term "remote" to require that the unit be placed on a shopping cart. However, claim 1 does not require that the remote unit be remote from a checkout area. Appellants' argument that "remote" requires that the remote unit be at the point of selection is not commensurate

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in scope with claim 1. Claim 1 covers a unit that is remote from practically anything.

Humble's unit is contained at a checkout stand. There are typically a plurality of such units at a plurality of checkout stands as suggested by Humble. Any one of these units is remote from all the other units. Given the broadest reasonable interpretation of "remote," Humble suggests a remote unit. An item produced at checkout is an item "desired" by the customer, and Humble's device identifies the item. Humble's data store 16 stores data representative of the identified product. The Humble storage area also stores product specification information such as brand name and size. Finally, Humble's processing means provides promotional data about the selected product, a competing product or a complementary product as claimed [column 2, lines 40-65]. Humble also suggests a rule based system as recited in claim 1 [column 1, lines 49-53; column 3, lines 16-34]. Thus, Humble would appear to suggest every feature recited in claim 1 when claim 1 is given its broadest reasonable interpretation.

We recognize that the means plus function language of the claims requires a consideration of factual issues which have not been briefed in this case. Specifically, the apparatus

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corresponding to each of the claimed means should be interpreted from the disclosure and compared to the apparatus of Humble. On the present record we find that the means of claim 1 appear to be obvious within the meaning of 35 U.S.C. § 103 in view of the teachings of Humble. However, the structure which corresponds to each of the claimed means is a question of fact which can be disputed by appellants. This decision does not preclude appellants from submitting additional evidence and/or arguments which demonstrate that when claim 1 is interpreted consistent with the last paragraph of 35 U.S.C. § 112 that the corresponding structure and its equivalents is not rendered obvious by the teachings of Humble. Thus, our decision presents a rebuttable presumption that the apparatus of claim 1 is broad enough to be suggested by the structure of Humble.

We designate this rejection as a new ground of rejection because it represents a dramatic departure from the obviousness issue as argued by the examiner and appellants. For purposes of this new ground of rejection, we apply it only to independent claim 1 which we view as the broadest claim on appeal before us. We leave it to the examiner to consider the extent to which any

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of the other claims in this application may be subject to a rejection similar to our new rejection of claim 1.

In summary, the rejection of claims 1-26 under 35 U.S.C. § 103 as formulated by the examiner is reversed. We have entered a new ground of rejection of claim 1 under 37 CFR § 1.196(b).

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1977)). 37 CFR § 1.196(b) provides that "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

- (1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

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(2) Request that the application be
reheard under § 1.197(b) by the
Board of Patent Appeals and
Interferences upon the same record.

. . .

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

REVERSED
37 CFR § 1.196(b)

JERRY SMITH)
Administrative Patent Judge)
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MICHAEL R. FLEMING)
Administrative Patent Judge)
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