

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

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARK TWEED BOWMAN, JAMES M. DUNN,
EDITH HELEN STERN, BARRY EDWARD WILNER, and SUSAN YEE

Appeal No. 2000-2242
Application No. 08/977,541

ON BRIEF

Before KRASS, DIXON, and BARRY, *Administrative Patent Judges*.
BARRY, *Administrative Patent Judge*.

DECISION ON APPEAL

A patent examiner rejected claims 1-16. The appellants appeal therefrom under 35 U.S.C. § 134(a). We affirm.

BACKGROUND

to purchasers of goods," (Appeal Br. at 2), but are embodied as data administered and stored by businesses rather than by consumers.

A further understanding of the invention can be achieved by reading the following claims:

1. A method of using virtual trading stamp credits to conduct commerce on a public data communication network comprising:

presenting viewer selectable indicia to users of said network within displayable pages of material transferrable to said users through said network; each said selectable indicia representing, and being associated with interests of an enterprise constituting the sponsor of the stamp offer; said indicia being presentable in behalf of plural sponsors;

associating individual said indicia with miniature applications referred to hereafter as "applets", said applets being transferred to respective said network users along with information forming said displayable pages; said applets being useful to establish network links for transferring data between said users and stamp server sites on said network;

in response to each selection of a said stamp offer indicia, by a said network user instantly viewing a page containing respective indicia, linking the respective user to a respective stamp server operated in said network by a stamp management enterprise;

transferring data bidirectionally between said respective user and stamp server; and

constituting the only evidence of the respective user's entitlement to participate in said redemption program.

10. A stamp management system for managing issuance and redemption of virtual trading stamp credits within a public data communication network, said stamp management system comprising:

first elements, responsive to messages sent to said system from users of said network for identifying respective users; said messages being sent in response to acceptance by said users of offers of virtual trading stamp credit offers presented to said users at the direction of sponsors of respective offers;

second elements responsive to said messages for identifying a specific trading stamp offer accepted by each said user and indirectly identifying the sponsor of the respective offer;

third elements responsive to said messages for sending a displayable page of information to each said user, each said displayable page of information being pertinent to matters of interest to the sponsor of the stamp offer accepted by the respective user; and

fourth elements responsive to said messages for adding specific numbers of virtual trading stamp credits to client accounts maintained by said stamp management system for users identified by said first elements; the number of accrued virtual credits in said client accounts constituting abstractions having no monetary value per se, and also having no tangible counterparts external to said system.

Claims 1-9 and 12-16 stand rejected under 35 U.S.C. § 103(a) as obvious over

OPINION

At the outset, we recall that claims that are not argued separately stand or fall together. *In re Kaslow*, 707 F.2d 1366, 1376, 217 USPQ 1089, 1096 (Fed. Cir. 1983) (citing *In re Burckel*, 592 F.2d 1175, 201 USPQ 67 (CCPA 1979)). When the patentability of a dependent claim is not argued separately, in particular, the claim stands or falls with the claim from which it depends. *In re King*, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986) (citing *In re Sernaker*, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983); *In re Burckel*, 592 F.2d 1175, 1178-79, 201 USPQ 67, 70 (CCPA 1979)). Furthermore, “[m]erely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable.” 37 C.F.R. § 1.192(c)(7)(2002).

Here, the appellants stipulate, “[f]or purposes of this appeal, claims 1-9 and 16 stand or fall together as a single group, and claims 10-15 stand or fall together as another group.” (Appeal Br. at 7.) Therefore, claims 2-9 and 16 stand or fall with representative claim 1, and claims 11-15 stand or fall with representative claim 10.

First, the examiner asserts, "incorporation of the purchase subsystem 112 of Lotvin in Jovicic would make the system more user-friendly as such users would conveniently keep track of their purchases (col. 1, lines 53-67; Lotvin)." (Final Rejection at 5.) He adds, "[w]hen a central computer manages the accumulation of points the users are relieved from the administrative burden of coupon management (col. 1, lines 56-57)." (*Id.*) The appellants argue, "there is no reasonable basis for considering incorporation of any of Lotvin's teachings into Jovicic's system, and/or for considering one skilled in the art to be motivated towards [sic] such incorporation." (Appeal Br. at 10.)

"The presence or absence of a motivation to combine references in an obviousness determination is a pure question of fact." *In re Gartside*, 203 F.3d 1305, 1316, 53 USPQ2d 1769, 1776 (Fed. Cir. 2000) (citing *In re Dembiczak*, 175 F.3d 994, 1000, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999)). "[T]he question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination." *In re Beattie*, 974 F.2d 1309, 1311-12, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992) (quoting *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir.

at 999, 50 USPQ2d at 1617 (citing *Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996); *Para-Ordnance Mfg. v. SGS Imports Int'l, Inc.*, 73 F.3d 1085, 1088, 37 USPQ2d 1237, 1240 (Fed. Cir. 1995)).

Here, Jovicic allows a user to store coupons as data in a memory. Specifically, “coupons may take an entirely electronic form, providing for . . . optional electronic storage in the memory of the user's general computing device.” Col. 3, ll. 12-15. Although Jovicic allows a user to store the data in the memory, the primary reference does not detail how the stored data are then managed.

For its part, Lotvin, the secondary reference, discloses a subsystem for managing data stored in a memory. Specifically, after data representing “accumulated points are stored centrally,” col. 1, ll. 46-47, the secondary reference uses a purchase subsystem to manage the stored data. More specifically, “[t]he purchase subsystem at 112 provides necessary information to the child, such as the number of points accumulated by him and how many points may be redeemed, in addition to giving him the capability to transact a purchase. Available products together with their prices in

reference emphasizes that its “invention is not to be limited in scope by the specific embodiments described. . . .” Col. 21, ll. 46-47. Rather than providing an exclusive description of its invention, “various modifications of the invention in addition to those described,” *id.* at ll. 47-48, and “other applications of the disclosed system are also envisioned,” col. 1, ll. 38-39, by Lotvin. Because Jovicic allows a user to store the data in a memory, and Lotvin envisions applying its management of data stored in a memory to other applications, we find that the references would have suggested the desirability, and thus the obviousness, of making the combination.

Second, the examiner asserts, “Jovicic discloses a stamp management system in a public data communication network as claimed comprising: a first element for identifying a user upon an acceptance of an offer by the user (Fig. 4, 404, 408); [and] a second element for identifying a specific stamp accepted by the user (Fig. 4, 410-412). . . .” (Final Rejection at 3-4.) The appellants argue, “Lotvin does not involve a response to user messages representing acceptance of specific credit offers. . . .” (Appeal Br. at 11.)

reasonable construction. . . .” *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1668 (Fed. Cir. 2000). “Moreover, limitations are not to be read into the claims from the specification.” *In re Van Geuns*, 988 F.2d 1181, 1184, 26 USPQ2d 1057, 1059 (Fed. Cir. 1993) (citing *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)).

Here, representative claim 1 specifies in pertinent part the following limitations: “in response to detection at said respective server that said respective user has selected a specific one of said indicia, adding virtual trading stamp credit points to a client account. . . .” Similarly, representative claim 10 specifies in pertinent part the following limitations: “responsive to messages sent to said system from users of said network for identifying respective users; said messages being sent in response to acceptance by said users of offers of virtual trading stamp credit offers. . . .” Giving the representative claims their broadest, reasonable construction, the limitations require responding to a user message representing acceptance of an offer for credit.

combination of references.” *In re Merck & Co.*, 800 F.2d 1091, 1097, 231 USPQ 375, 380 (Fed. Cir. 1986) (citing *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981)). “Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art.” *Cable Elec. Prods., Inc. v. Genmark, Inc.*, 770 F.2d 1015, 1025, 226 USPQ 881, 886-87 (Fed. Cir. 1985) (quoting *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981)).

Here, the rejections are based on combinations of references that include Jovicic. We find that the primary reference responds to user messages representing acceptance of Jovicic’s electronic coupons, which are offers for credit toward purchase of a product. Specifically, “[o]nce the user viewing the display 116 selects an **electronic coupon 300 being displayed**, such as by entering user input at the keyboard 114, the Internet Coupon Server 124 may ask the user to choose if the coupon is to be mailed electronically, Internet Coupon Server 124 prompts the user to input an electronic mail address 418. When electronic mail address is imputed, [sic, inputted] Internet Coupon Server 124 mails the coupon electronically to the addressee 420.” Col. 8, ll. 10-17 (emphasis added). “[T]he user may choose to e-mail the coupon

Third, the examiner asserts, "[t]he purchase subsystem 112 of Lotvin can be . . . used for managing accumulated points and/or credits (col. 6, lines 63-65; col. 10, lines 18-36; col. 21, lines 21-24)." (Final Rejection at 4.) Admitting that "data stored in association with Jovicic's coupons arguably are intangible," (Appeal Br. at 13), the appellants argue, "the coupons themselves are tangible documents printed at the user site . . . [and] have specific monetary value as a discount on purchase of that product, . . ." (*Id.*)

"Claims are not interpreted in a vacuum, but are part of and are read in light of the specification." *Slimfold Mfg. Co. v. Kinkead Indus., Inc.*, 810 F.2d 1113, 1116, 1 USPQ2d 1563, 1566 (Fed. Cir. 1987) (citing *Hybritech Inc. v. Monoclonal Anti-bodies, Inc.*, 802 F.2d 1367, 1385, 231 USPQ 81, 94-95 (Fed. Cir. 1986); *In re Mattison*, 509 F.2d 563, 565, 184 USPQ 484, 486 (CCPA 1975)).

Here, representative claim 1 specifies in pertinent part the following limitations: "total credit points accrued in said respective client account constituting an intangible abstraction associated with a redemption program allowing such points to be used in

counterparts external to said system.” Regarding the “monetary value” of the credits, the specification discloses that the credits can be redeemed for “goods, services, etc. . . .” (Spec. at 4.) Reading claims 1 and 10 in light of the specification, while giving the representative claims their broadest, reasonable construction, the limitations require intangible data that can be redeemed for goods, services, or the like.

The question of obviousness is “based on underlying factual determinations including . . . what th[e] prior art teaches explicitly and inherently. . . .” *In re Zurko*, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001) (citing *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966); *In re Dembiczak*, 175 F.3d 994, 998, 50 USPQ 1614, 1616 (Fed. Cir. 1999); *In re Napier*, 55 F.3d 610, 613, 34 USPQ2d 1782, 1784 (Fed. Cir. 1995)). “A *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art.” *In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) (quoting *In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976)).

277 (CCPA 1968). Accordingly, “[a]ll of the disclosures in a reference must be evaluated for what they fairly teach one of ordinary skill in the art.” *In re Boe*, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966)). Although one embodiment of Jovicic may disclose printing tangible coupons, the coupons need not be printed. Instead, **“the coupons may take an entirely electronic form**, providing for optional electronic redemption at the retail outlet, and optional electronic storage in the memory of the user's general computing device” Col. 3, ll. 11-15 (emphasis added). Furthermore, the electronic coupons have no cash value of their own but are merely “redeemable [for a] product discount. . . .” Col. 1, l. 6.

We further find that Lotvin's electronic points are intangible data that can be redeemed for goods, services, or the like. The examiner's assertion that “Lotvin does not require a user to maintain the hard copies of the accrued credits,” (Final Rejection at 4), is uncontested. Furthermore, rather than assigning a cash value to the point, the reference discloses that the points merely “can be redeemed towards [sic] the purchase of goods and services. . . .” Abs., ll. 11-12. Therefore, we affirm the rejection of claim 10 and of claims 11-15, which fall therewith.

lines 60-64) by incorporating the Java Applets of Judson (col. 8, lines 1-21)." (Final Rejection at 7.) The appellants argue, "[t]he features of these references, considered together in any manner, could not constitute a reasonable basis for attributing motivation to those skilled in the art to combine them. . . ." (Appeal Br. at 13.)

Jovicic "comprises an electronic coupon communication system, comprising a network node for selecting, receiving and printing electronic coupons **over** a public computer network such as **the Internet**. . . ." Col. 3, ll. 39-42 (emphasis added). For its part, Judson recognizes a problem plaguing users of the Internet. Specifically, "[t]here is a finite time period between the time the user initiates the link and the return of the web page. Even when the web page is returned quickly, there is an additional time period during which formatting information must be processed for display on the display interface." Col. 1, ll. 34-37. "[O]ften the user will have to wait many seconds before being able to see the in-line image and/or begin using the web page. This problem will be exacerbated when the next generation browser technology (such as Netscape Navigator 2.0) becomes more widely implemented because such browsers are being designed to handle much more complex download formats (for more interactive,

Specifically, “[i]t is thus a primary object of the invention to enhance the operation of a web browser by causing the display of some useful information to the user during the period of user ‘downtime’ that otherwise occurs between linking and downloading of a hypertext document identified by the link. Such information may include, without limitation, advertisements, messages, fill-in forms, notices from a service provider, notices from another Internet service (such as receipt of an e-mail message), or some third party notice.” *Id.* at 59-67.

“This enables the support of complex ‘mini’ web pages that are displayed and accessible to the viewer during otherwise nonproductive periods when the browser is busy processing links to other documents or web sites.” Col. 2, l. 65 - col. 3, l. 2.

“Many other beneficial results can be attained by applying the disclosed invention in a different manner or modifying the invention. . . .” Col. 3, ll. 5-8. Because Jovicic employs the Internet and Judson solves a problem plaguing users of the Internet, we find that we find that the references would have suggested the desirability, and thus the obviousness, of making the combination. Therefore, we affirm the rejection of claim 1 and of claims 2-9 and 16, which fall therewith.

CONCLUSION

arguments or authorities not included therein are neither before us nor at issue but are considered waived. No time for taking any action connected with this appeal may be extended under 37 C.F.R. § 1.136(a) (2002).

AFFIRMED

ERROL A. KRASS
Administrative Patent Judge

JOSEPH L. DIXON
Administrative Patent Judge

LANCE LEONARD BARRY
Administrative Patent Judge

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