

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(2) is not binding precedent of the Board.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. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT L. BERLIN,
CRAIG A. BLOSZINSKY, WILLIAM E. BRUNER,
FRANCIS L. FITZPATRICK, JOSEPH E. HEIN,
DONALD R. JOHNSON, BARRY E. McCAA, and
BHARATH NATARAJAN

Appeal No. 96-3540
Application 07/815,654¹

ON BRIEF

Before BARRETT, FLEMING, and HECKER, **Administrative Patent Judges**.

HECKER, **Administrative Patent Judge**.

DECISION ON APPEAL

¹ Application for patent filed December 31, 1991.

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This is a decision on appeal from the final rejection of claims 1 through 12, all of the claims pending in the present application.

The invention relates to an automated payment method and system within a Computer Integrated Manufacturing (CIM) system. Referring to page 9 line 15 et seq. of the specification and figure 2B, a purchase order is created at 82, and released to a supplier at 84. A purchase order planned receipt list is then generated at 86. After an advanced ship notice is received from the supplier at 88 (listing each item), a comparison/validation is made at 90, comparing the items listed on the advanced ship notice to those items listed on the planned receipt list. If the items on each list match at 92 (figure 2C), an **automatic authorization** for payment is issued at 94 to a bank at 96. All of these processes are accomplished electronically and transmitted over a communications network using an Electronic Data Interchange (EDN).

A representative independent claim 1 is reproduced as follows:

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1. An automated payment method for utilization within a computer integrated manufacturing system which includes a plurality of trading partners linked via an electronic data interchange system, said method comprising the computer implemented steps of:

creating within said computer integrated manufacturing system a purchase order listing items to be purchased by a first trading partner from a second trading partner;

transmitting within said computer integrated manufacturing system an advanced shipment notice listing items to be delivered from said second trading partner to said first trading partner in anticipation of a planned shipment of such items in response to said purchase order;

comparing within said computer integrated manufacturing system items listed within said advanced shipment notice with items listed within said purchase order; and

automatically authorizing payment in response to a validation of said items listed within said advanced shipment notice.

The Examiner relies on the following reference:

Shavit et al. (Shavit)	4,799,156	Jan. 17,
1989		

Claims 1 through 12 stand rejected under 35 U.S.C. § 103 as being unpatentable over Shavit.²

² The Examiner's Answer incorporates by reference the final rejection (Paper No. 13) which in turn incorporates by reference the preceding rejection (Paper No. 10) as the "grounds of rejection". Both papers include a rejection under 35 U.S.C. § 101, however this rejection was withdrawn by the advisory action of Paper No. 15. Also, only those statements of grounds of rejection as appear in a single prior
(continued...)

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Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the brief (Paper No. 17) and answer (Paper No. 18) for the respective details thereof.

OPINION

We will not sustain the rejection of claims 1 through 12 under 35 U.S.C. § 103.

The Examiner has failed to set forth a *prima facie* case. It is the burden of the Examiner to establish why one having ordinary skill in the art would have been led to the claimed invention by the reasonable teachings or suggestions found in the prior art, or by a reasonable inference to the artisan, contained in such teachings or suggestions. *In re Sernaker*, 702 F.2d 989, 995, 217 USPQ 1, 6 (Fed. Cir. 1983).

In regard to the rejection of claims 1 through 12 under 35 U.S.C. § 103 as being unpatentable over Shavit, Appellants argue (1) that Shavit does not set forth an advanced shipment

²(...continued)
action may be incorporated by reference. An examiner's answer should not refer, either directly or indirectly, to more than one prior Office action (MPEP § 1208).

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notice, from the supplier, listing items to be delivered (Brief at the bottom of page 4, et seq.); (2) that Shavit does not compare the advanced shipment list with a purchase order list for validation (Brief at the top of page 5); and (3) that upon validation, Shavit does not **automatically** authorize payment (Brief at the bottom of page 5). These limitations are recited in both independent claims.

In response to argument (1), the Examiner, at the middle of page 4 of the Answer, cites Shavit at column 14, lines 17-27, which recites delivery notifications from the supplier. Column 16, lines 35-38, recite that such notifications may contain "invoices from the suppliers". Invoices are defined as "an itemized list of goods shipped usu. specifying the price and the terms of sale", **Webster's Ninth New Collegiate Dictionary (1986)**. Also note column 11, line 55, of Shavit for invoices. It is clear that, contrary to Appellants' argument, Shavit does teach an advanced shipment notice listing items to be delivered.

In response to argument (2), the Examiner states, at the bottom of page 5 of the Answer, that although Shavit does not

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recite a specific "items comparing step", normal business practice would be to compare the items listed on a supplier's notice of shipment (i.e., invoice) with the items listed on a purchase order. Shavit recites several instances of comparing items. Such a comparison would be inherent at column 26, lines 1-4, where orders are automatically confirmed against available inventory, and substitutes are suggested for an unavailable item. Note also, the validation procedures recited at column 13, lines 51-68 (cited by the Examiner in the final rejection at the end of paragraph 5, and in Paper No. 10, in the middle of page 4). We agree with the Examiner that comparison of such item lists is covered by Shavit.

In response to argument (3), the Examiner indicates that automatically authorizing payment is shown in Shavit at column 8, lines 55-66; column 14, lines 35-44 (middle of page 4 of the Answer). We are at a loss to find any **automatic** payment authorization, let alone the "automatically authorizing payment in response to a validation of said items listed" as claimed by Appellants. Although Shavit allows for payment

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authorization, no **automatic** authorization can be found as argued by Appellants.

We find that all claims recite the automatic payment authorization upon validation which is not found or suggested in the applied prior art. Therefore we have not sustained the rejection of claims 1 through 12 under 35 U.S.C. § 103.

Accordingly, the Examiner's decision is reversed.

REVERSED

LEE E. BARRETT))
Administrative Patent Judge))
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MICHAEL R. FLEMING)) BOARD OF PATENT
Administrative Patent Judge)) APPEALS AND
))
)) INTERFERENCES
STUART N. HECKER))
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