

1 UNITED STATES PATENT AND TRADEMARK OFFICE

2
3
4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
6

7
8 *Ex parte* AXEL DOERWALD and
9 JOSEPH SMIRLIES
10

11
12 Appeal 2009-006268
13 Application 10/412,666
14 Technology Center 3600
15

16
17 Decided: March 5, 2010
18

19
20 Before LINDA E. HORNER, ANTON W. FETTING, and
21 BIBHU R. MOHANTY, *Administrative Patent Judges*.
22 FETTING, *Administrative Patent Judge*.

23 DECISION ON APPEAL
24

1

STATEMENT OF THE CASE

2

3

4

Axel Doerwald and Joseph Smirlies (Appellants) seek review under 35 U.S.C. § 134 (2002) of a final rejection of claims 1, 3-11, 13-17, 19-24, and 26-29, the only claims pending in the application on appeal.

5

6

We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b) (2002).

7

SUMMARY OF DECISION¹

8

We REVERSE.

9

THE INVENTION

10

11

12

The Appellants invented a method and system for enhancing customer loyalty by providing customer-specific information to a weigh station at which the customer is being served. Specification ¶ 0001.

13

14

15

An understanding of the invention can be derived from a reading of exemplary claims 1, 9, 14, and 17, which are reproduced below [bracketed matter and some paragraphing added].

16

17

18

19

1. A system for enhancing customer loyalty, the system comprising:

[1] an input module for receiving customer identification information for identifying a customer;

¹ Our decision will make reference to the Appellants' Appeal Brief ("App. Br.," filed October 15, 2008) and Reply Brief ("Reply Br.," filed January 12, 2009), and the Examiner's Answer ("Ans.," mailed November 12, 2008), and Final Rejection ("Final Rej.," mailed April 15, 2008).

1 [2] a weigh station comprising a weigh scale for determining
2 a weight of a product, and a weigh station display for
3 displaying information;

4 [3] a storage module for storing a plurality of customer
5 profiles for a plurality of customers wherein each customer in
6 the plurality of customers has an associated customer profile;

7 [4] an information retrieval module for receiving the
8 customer identification information from the input module and
9 for, when the customer is in the plurality of customers,
10 retrieving the associated customer profile, the information
11 retrieval module being linked for communication with the
12 storage module and the input module; and,

13 [5] an information processing means for, when the customer
14 is in the plurality of customers, providing associated customer-
15 specific information based on the associated customer profile to
16 the weigh station display, the information processing module
17 being linked for communication with the weigh station display
18 and the information retrieval module; wherein the customer-
19 specific information comprises, for each customer in the
20 plurality of customers, a unique associated customer identifier,
21 and the associated customer-specific information comprises
22 associated reward information, and the associated reward
23 information specifies at least one of an associated coupon and
24 an associated discount to be provided to the customer.

25

26 9. The system as defined in claim 8 further comprising a point-
27 of-sale station for obtaining associated purchase information
28 from the customer and for transmitting the associated purchase
29 information to the server, wherein the point-of-sale station is
30 connected to the server for communication therewith, and the
31 customer profile updating means is operable to update the
32 associated customer profile for the customer based on the
33 associated purchase information.

34

35 14. The system as defined in claim 13, wherein each weigh
36 station comprises an associated information receiving module

1 for receiving product identification information for the product,
2 and is operable to transmit the product identification
3 information for the product and the weight of the product to the
4 information processing module; and, the associated value is
5 based on the associated customer profile, the product
6 identification information and the weight of the product.

7

8 17. A method for providing customer-specific information for
9 a customer to a weigh station, the method comprising:

10 a) obtaining customer identification information for
11 identifying a customer to be served at the weigh station;

12 b) storing a plurality of customer profiles for a plurality
13 of customers wherein each customer in the plurality of
14 customers has an associated customer profile; and,

15 c) when the customer is in the plurality of customers,
16 retrieving the associated customer profile for the customer
17 using the customer identification information and providing
18 associated customer-specific information based on the
19 associated customer profile to a weigh station display, wherein
20 the associated customer profile comprises, for each customer in
21 the plurality of customers, a unique associated customer
22 identifier, the customer-specific information comprises
23 associated reward information, and the associated reward
24 information specifies at least one of an associated coupon and
25 an associated discount to be provided to the customer.

26

27

THE REJECTIONS

28 The Examiner relies upon the following prior art:

McCall et al. US 6,321,984 Nov. 27, 2001

29 Peter Bacque, *Weighty Issue High-Tech Checks Let Truckers Pass*
30 *Inspection Quickly*, Richmond Times Dispatch, January 11, 2001, at C1.

31

1 Claims 17, 19-24, and 26-29² stand rejected under 35 U.S.C. § 101 as
2 being directed towards non-statutory subject matter.

3 Claims 1, 3-11, 13-17, 19-24, and 26-29 stand rejected under 35 U.S.C.
4 § 103(a) as unpatentable over Bacque and McCall.

5 ISSUES

6 The issues pertinent to this appeal are:

- 7 • The issue of whether the Examiner erred in rejecting claims 17, 19-24,
8 and 26-29 under 35 U.S.C. § 101 as being directed towards non-
9 statutory subject matter turns on whether claim 17 recites a statutory
10 method or process claim under the machine-or-transformation test.
- 11 • The issue of whether the Examiner erred in rejecting claims 1, 3-11,
12 13-17, 19-24, and 26-29 under 35 U.S.C. § 103(a) as unpatentable
13 over Bacque and McCall turns on whether a person of ordinary skill in
14 the art would look to McCall to modify Bacque.

15 FACTS PERTINENT TO THE ISSUES

16 The following enumerated Findings of Fact (FF) are believed to be
17 supported by a preponderance of the evidence.

18 *Facts Related to the Prior Art*

19 *Bacque*

² The Examiner lists that claims 17-29 are rejected under 35 U.S.C. § 101. However, since claims 18 and 25 have been cancelled only claims 17, 19-24, and 26-29 stand rejected under this ground of rejection.

- 1 01. Bacque is directed to an intelligent transportation system
2 (Bacque 1:1).
- 3 02. The system comprises radio transponders to identify trucks, in-
4 pavement electromagnetic sensors, high-speed weigh-in-motion
5 scales set into the pavement, and a computerized vehicle database
6 (Bacque 2:1). The database indicates to station operators whether
7 a truck's credentials/taxes are paid and the safety record of the
8 company running the truck (Bacque 2:2). If a truck gets a clean
9 bill of health, the in-cab notification antenna messages the truck's
10 transponder to signal for a green light (Bacque 3:4). If the truck is
11 overweight or if taxes for the truck have not been paid, the
12 transponder signals for a red light (Bacque 3:5).
- 13 03. As trucks approach the weigh station, an antenna reads the
14 truck's two-way radio transponder and identifies the truck's
15 transponder's unique serial number like the Virginia Smart Tag
16 toll collection system (Bacque 2:4). The truck meanwhile runs
17 over the weigh-in-motion scale to collect the weight of the truck
18 and the transponder identification is associated to the collected
19 weight (Bacque 2:5-6).

20 *McCall*

- 21 04. McCall is directed to a promotional system utilized in
22 conjunction with a fuel dispenser that will allow promotional
23 discounts and other marketing type offerings to be provided to a
24 consumer based on the customer's purchasing habits (McCall
25 1:13-17).

1 particular machine or apparatus, or (2) it transforms a particular article into a
2 different state or thing.” *Id.* at 954 (citations omitted). The court explained
3 that “the use of a specific machine or transformation of an article must
4 impose meaningful limits on the claim’s scope to impart patent-eligibility”
5 and “the involvement of the machine or transformation in the claimed
6 process must not merely be insignificant extra-solution activity.” *Id.* at 961-
7 62 (citations omitted).

8 *Obviousness*

9 A claimed invention is unpatentable if the differences between it and
10 the prior art are “such that the subject matter as a whole would have been
11 obvious at the time the invention was made to a person having ordinary skill
12 in the art.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007); *Graham*
13 *v. John Deere Co.*, 383 U.S. 1, 13-14 (1966).

14 In *Graham*, the Court held that that the obviousness analysis is
15 bottomed on several basic factual inquiries: “[1] the scope and content of
16 the prior art are to be determined; [2] differences between the prior art and
17 the claims at issue are to be ascertained; and [3] the level of ordinary skill
18 in the pertinent art resolved.” *Graham*, 383 U.S. at 17. *See also KSR*, 550
19 U.S. at 406. “The combination of familiar elements according to known
20 methods is likely to be obvious when it does no more than yield predictable
21 results.” *KSR*, 550 U.S. at 416.

ANALYSIS

Claims 17, 19-24, and 26-29 rejected under 35 U.S.C. § 101 as being directed towards non-statutory subject matter

The Examiner found that claims 17, 19-24, and 26-29 recite a method claim of purely mental steps, not tied to another statutory class. Ans. 2-3. The Appellants contend the claimed method recites the steps of providing customer information to the weigh station display, where customer information is associated with reward information that specifies a coupon to be provided to the customer and that these steps cannot be performed purely mentally since there is no way to provide a coupon without the coupon being physically inputted into the weigh station display. Reply Br. 8.

We agree with the Appellants. Claims 17, 19-24, and 26-29 recite process or method steps that must be evaluated under the threshold machine-or-transformation test set forth in *Bilski*. See *Bilski*, 545 F.3d at 954. Independent claim 17 recites a method for providing information to a weigh station. Claim 17 further requires that the weigh station include a weigh scale and a weigh station display, where customer specific information is provided to the weigh station display. That is, claim 17 recites a manner of entering data to a weigh station and displaying the inputted information. As such, claim 17 requires a specific structure that captures, stores, and displays specific data. This specific structure ties the recited method to a particular machine, in that the method recites how to operate a weigh station with a weigh station display. Since there is a particular machine required, claim 17 satisfies the machine prong of the machine-or-transformation test and the transformation prong need not be evaluated.

1 Thus, we cannot say that claims 17, 19-24, and 26-29 should be rejected
2 under 35 U.S.C. § 101 as being directed towards non-statutory subject
3 matter. We appreciate the Examiner's analysis and identifying the issues for
4 us in this instance. This is one of those cases where looking at the claim as a
5 whole may lead to a different conclusion than analysis of the parts.

6
7 *Claims 1, 3-11, 13-17, 19-24, and 26-29 rejected under 35 U.S.C.*
8 *§ 103(a) as unpatentable over Bacque and McCall*

9 The Appellants contend that there is no valid reason that would have
10 prompted a person of ordinary skill in the relevant field to combine the
11 elements, as per claims 1, 3-8, 13, and 16. *See App. Br. 11-13 and Reply Br.*
12 *6-7.* The Appellants further contend that there is no reason to look to
13 McCall to modify Bacque to include the feature recited in claim 9 and its
14 dependent claims 10 and 11. *App. Br. 14-15.*

15 We agree with the Appellants. Bacque is concerned with a weigh station
16 system that collects weight information as truck operators pass through the
17 weigh station. FF 01-03. Bacque fails to describe coupon or reward
18 information to be provided to the customer, as acknowledged by the
19 Examiner. Ans. 6. The Examiner looks to McCall to describe this feature.
20 Ans. 6. Although McCall does describe coupon and reward information
21 based on customer specific transaction history (FF 04-05), McCall is not
22 concerned with any aspect of a weigh station or weigh station display.
23 Furthermore, McCall does not attempt to solve any problem that would be
24 associated with the input, computation, and display of any customer specific
25 information as it relates to an intelligent weigh station system. Therefore, a

1 person with ordinary skill in the art would not look to McCall to describe
2 reward and coupon information when considering solutions to weigh station
3 problems. As such, there is no evidence to support the combination of
4 Bacque and McCall, and the Examiner failed to establish a prima facie case
5 of obviousness. While the Examiner set the issue up well for us, in this case,
6 we must conclude that the reasons the Examiner articulated were based
7 solely on impermissible hindsight. The idea of applying promotional
8 techniques generally used in commercial sales transactions to modifying
9 behavior in the use of a weigh station requires more creativity than one of
10 ordinary skill would generally exhibit.

11 Since this issue is dispositive as to the rejections against these claims, we
12 need not reach the remaining arguments raised by the Appellants against
13 these rejections.

14 Thus, we cannot say that claims 1, 3-11, 13-17, 19-24, and 26-29 should
15 be rejected under 35 U.S.C. § 103(a) as unpatentable over Bacque and
16 McCall. As with the first rejection, we appreciate the Examiner's analysis
17 and identifying the issues for us in this instance. Again, this is one of those
18 cases where looking at the claim as a whole leads to a different conclusion
19 than analysis of the parts.

20
21 **CONCLUSIONS OF LAW**

22 Claims 17, 19-24, and 26-29 are directed to a statutory method under 35
23 U.S.C. § 101.

1 Claims 1, 3-11, 13-17, 19-24, and 26-29 are not unpatentable under 35
2 U.S.C. § 103(a) over Bacque and McCall.

3

4

DECISION

5 To summarize, our decision is as follows.

- 6 • The rejection of claims 17, 19-24, and 26-29 under 35 U.S.C. § 101 as
7 being directed towards non-statutory subject matter is not sustained.
- 8 • The rejection of claims 1, 3-11, 13-17, 19-24, and 26-29 under 35
9 U.S.C. § 103(a) as unpatentable over Bacque and McCall is not
10 sustained.

11

12

13

REVERSED

14

15

16

17 mev

18

19 Address

20 BERESKIN AND PARR LLP/S.E.N.C.R.L., s.r.l.
21 40 KING STREET WEST
22 BOX 401
23 TORONTO ON M5H 3Y2 CA CANADA