

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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PATRICIA A. RECKTENWALD, JAMES M. BRABSON,
MICHAEL E. LEROY, FRANK J. LOPUSZYNSKI, ANTHONY J. FERNANDES,
TERRANCE L. MCGINNIS, PAUL J. WASSON and PHILIP L. THACER

Appeal No. 1999-1780
Application No. 08/651,630

ON BRIEF

Before CALVERT, STAAB, and NASE, Administrative Patent Judges.
STAAB, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection of claims 1-54, all the claims pending in the application. Upon further consideration (see page 2 of the answer), the examiner has allowed claims 1-27, 51 and 52, leaving for our consideration only the rejections of claims 28-50, 53 and 54.

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Appellants' invention pertains to a system and method which may be used by a customer for the pick up and/or drop off of items. More specifically, and with reference to appellants' Figure 1, the system includes a plurality of sale registers 106 where transactions are recorded and a customer receipt is generated, a "merchandise pick up" (MPU) kiosk 104 where a customer inputs information indicating a readiness to pick up an item, for example, an item previously purchased at one of the registers 106, a work station 108 where items to be picked up are stored, a "hold for merchandise" (HFM) database 112 for recording, storing and transmitting transaction information, and a communication channel 102 for electrically connecting the various components of the system to each other to transmit information therebetween. As explained in more detail in the specification, appellants' system can be used to pick up merchandise, to drop off merchandise for repair, or to return or exchange merchandise. A further understanding of the subject matter at issue in this appeal can be derived from a reading of independent claims 28, 37 and 46, copies of which appear in the appendix to appellants' main brief.

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The references relied upon by the examiner in support of the rejections made in the final rejection are:

Lohrey et al. (Lohrey)	4,803,348	Feb. 7, 1989
Yehuda	5,245,163	Sept. 14, 1993
Rivalto	5,482,139	Jan. 9, 1996

Claims 28-32, 35-41, 44-47, 53 and 54, stand rejected under 35 U.S.C. § 102(b) as being anticipated by Lohrey.

Claim 48 stands rejected under 35 U.S.C. § 103 as being unpatentable over Lohrey in view of Rivalto.

Claims 33, 34, 42, 43, 49 and 50 stand rejected under 35 U.S.C. § 103 as being unpatentable over Lohrey in view of Yehuda.

Reference is made to appellants' main and reply briefs (Paper Nos. 9 and 13) and to the examiner's answer (Paper No. 12) for the respective positions of appellants and the examiner regarding the merits of these rejections.

The anticipation rejection based on Lohrey

Anticipation is established only when a single prior art reference discloses, either expressly or under the principles of inherency, each and every element of the claimed invention. See

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In re Paulsen, 30 F.3d 1475, 1478-79, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994) and *In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990). Anticipation by a prior art reference does not require either the inventive concept of the claimed subject matter or recognition of inherent properties that may be possessed by the reference. See *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 633, 2 USPQ2d 1051, 1054 (Fed. Cir.), *cert. denied*, 484 U.S. 827 (1987). Nor is it required that the reference teach what the applicant is claiming, but only that the claim on appeal "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference. See *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), *cert. denied*, 465 U.S. 1026 (1984).

Lohrey pertains to an automated customer interface system for services involving drop off and pick up. A brief explanation of the Lohrey interface system is found in the abstract, which reads as follows:

A system for [an] automated, attendant-free customer interface for services such as laundry and dry cleaning processing or rental of items such as videotapes [which] enables customers to order services

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and pick up processed orders using a general purpose, undedicated credit card. A retrieval device upon appropriate command retrieves a customer's processed order and brings it to a customer interface panel door [28], which opens to enable the customer to pick up his processed order. Included in the customer interface panel are a card reader [16] for reading the customer's credit card, a display [20] for presenting information and instructions to the customer, a menu of services [30] for selection by the customer and a keyboard [32] or other input device to select desired services. A printer [46] is included for printing a receipt and/or a transaction record. The system includes a computer [56, 58] at each remote machine facility outlet for handling functions associated with the credit card reader, instructing the retrieval device to retrieve orders, for operating a display, for handling the customer input device, and for creating a transaction record. The general purpose computer can also provide for networking between the central plant [50] and a larger number of remote automated customer interface facilities, and a telephone, modem and auto dialer preferably are included at each automated facility for computer communication with the central plant.

Independent claim 28

Independent claim 28 is directed to an item processing kiosk comprising, *inter alia*,

customer identifying means for identifying a customer in response to data supplied directly by the customer;

item identifying means for identifying an item from a database based upon the identification of the customer by the customer identifying means, wherein the item is to be picked up by the customer; [and]

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displaying means for displaying the identified item to the customer

We find that the credit card reader 34 of Lohrey constitutes a "customer identifying means" for identifying a customer in response to data supplied directly by the customer, as called for in claim 28. We further find that the kiosk-like retail outlet structure 10 of Lohrey inherently includes an "item identifying means" for identifying an item to be picked up from a database based upon the identification of the customer by the "customer identifying means," as called for in claim 28, in that when a customer comes to Lohrey's kiosk to, for example, pick up laundry or dry cleaning that had previously been dropped off for cleaning, the item retrieval device of the kiosk (column 5, lines 56-68) that retrieves items from the kiosk's storage area for delivery to the customer must inherently interact with some means that identify and associate a particular item in the storage area with a particular customer's order. In this regard, see column 9, lines 61-66, and column 10, lines 31-40. The examiner has not pointed out, and it is not apparent to us, where Lohrey discloses that the kiosk thereof includes "display means" for displaying to the customer the particular item called

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for in claim 28, namely, the item identified by the claimed "item identifying means" from a database based upon the identification of the customer by the claimed "customer identifying means." While the display means 20 of Lohrey can display instructions (column 5, lines 50-55) or items dropped off (column 6, lines 50-60), these items do not correspond to the identified item that the claimed display means displays. For this reason, we conclude that the examiner has not established a *prima facie* case of anticipation of claim 28 based on Lohrey.

We therefore shall not sustain the standing anticipation rejection or of claim 28, of claims 29-32, 35, 36 and 53 that depend from claim 28.

Independent claim 37

Independent claim 37 is directed to an item processing method, and includes the step of

displaying selections allowing a customer to choose whether the customer is picking up an item, returning an item for exchange or refund, or dropping off an item for servicing.

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We find that the customer service panel illustrated in Figure 2 of Lohrey performs the step of displaying selections allowing the customer to choose whether to pick up an item or drop off an item for servicing. In this regard, note the selection buttons labeled "DROP OFF" and "PICK UP" that are located on the right side of the customer service panel above the telephone speaker 44. See also, column 7, lines 10-19. The examiner has not pointed out, and it is not apparent to us, where Lohrey discloses displaying among the selections available to the customer the option of "returning an item for exchange or refund," which we regard as being a third service choice different and distinct from the pick up or drop off service choices disclosed by Lohrey. We note the examiner's position (answer, page 6) that since the services listed in the claim are connected by the alternative "or," Lohrey does not have to disclose each and every one of the listed service choices; however, we simply disagree with the examiner on this point. Furthermore, the examiner's position (answer, page 6) that the disclosure of Lohrey "would suggest to one skilled in the customer service art other normal customer services such as item exchange or refund" is inappropriate in that the issue before us

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here is one of anticipation under 35 U.S.C. § 102(b). In light of the above, we conclude that the examiner has not established a *prima facie* case of anticipation of claim 37 based on Lohrey.

We therefore shall not sustain the standing anticipation rejection of claim 37, or of claims 38-41, 44, 45 and 54 that depend from claim 37.

Independent claim 46

Independent claim 46 is directed to an item processing kiosk comprising:

identifying means for identifying, in response to data supplied directly by a customer, the customer and an item to be dropped off by the customer; and

message transmitting means, responsive to the identifying means, for electronically transmitting a message to an item holding area in order to notify a holding area attendant of the identified item, wherein the message provides a notification to the holding area attendant of the customer and the item.

We find that the customer interface panel illustrated in Figure 2 of Lohrey, which includes credit card reader 34, constitutes an "identifying means" for identifying, in response to data supplied directly by a customer, the customer and an item to be dropped off by the customer. We further find that the central processing plant 50 of Lohrey's system, where items

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dropped off at the kiosks are taken by a route driver for processing, may be fairly considered a "holding area" within the broad meaning of that terminology, and that this "holding area" is attended by attendants. In this regard, we do not agree with appellants' argument (reply brief, page 6) to the effect that claim 46 requires the holding area to be located in close proximity to the kiosk. We also find that the transaction record 68 recorded at the kiosk and stored in the memory of the kiosk's computer (column 10, lines 31-40) constitutes data identifying the customer (via the customer's credit card number) and the item dropped off (via the listing of garment/services input by the customer) (see Figure 5). In addition, we find that the transaction record 68 is electronically transmitted to the central processing plant from time to time via modem communication (column 11, lines 1-4).

Based on these findings, we conclude that Lohrey anticipates claim 46. More specifically, we consider that the "identifying means" limitation of claim 46 "reads on" the customer interface panel of Lohrey, and that the "message transmitting means" limitation of claim 46 "reads on" the

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general purpose computer 84 of Lohrey's kiosk that stores transaction record 68 (see Figure 5 and column 10, lines 31-40) and then transmits said transaction record 68 to the central processing plant via a modem (see column 11, lines 1-7). The central processing plant 50 of Lohrey constitutes "an item holding area" in that the items dropped off by the customer are delivered thereto by the route driver for processing and then held for delivery back to the kiosk for pick up by the customer. Moreover, the transaction record 68 clearly comprises data matching the identity of the customer with the item dropped off (see Figure 5).

Accordingly, we shall sustain the standing rejection of claim 46 as being anticipated by Lohrey. We shall also sustain the standing rejection of claim 47 as being anticipated by Lohrey since appellants have not argued this dependent claim apart from base claim 46.

The obviousness rejections

Claim 48

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Claim 48 depends from claim 47 which in turn depends from claim 46. Claim 47 requires that the "identifying means" of claim 46 constitutes means "for identifying the item [to be dropped of] from a database." Claim 48 further requires that

the database [of claim 47] contains identifications of items linked to customers with respect to past transactions, and wherein the item identified by the item identifying means is from the database.

In rejecting claim 48 as being unpatentable over Lohrey in view of Rivalto, the examiner found (answer, page 4) that Lohrey shows all the features of appellants' claimed invention except the database of customer histories. The examiner also implicitly found that Rivalto discloses a database of customers' past purchasing history and the use thereof to improve strategic product promotional plans. Based on these teachings, the examiner determined that it would have been obvious to provide the device of Lohrey with means to store customer histories for advertising and promotional purposes.

Our difficulty with this rejection is that it does not take into account that the cumulative effect of claims 46-48 is that "the item identified" by the item identifying means of claim 48 that is from the database of past customer transactions and

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"[the] item to be dropped off" of claim 46 are one and the same item. Thus, even if we were to agree with the examiner that it would have been obvious as a general proposition to provide Lohrey with means to store customer histories for advertising and promotional purposes, such would have tracked categories of items (e.g., shirts, suits) rather than specific items. Thus, it does not necessarily follow that "[the] item to be dropped off" of claim 46 would be an item from that database of past transactions. Hence, even if Lohrey were to be modified in the manner called for by the examiner, the claimed subject matter would not necessarily result. For this reason, the standing rejection of claim 48 cannot be sustained.

Claims 33, 34, 42, 43, 49 and 50

Claims 33, 34, 42, 43, 49 and 50 have been rejected by the examiner as being unpatentable over Lohrey in view of Yehuda.

Claim 49 depends from claim 46 and adds that the kiosk of the base claim includes displaying means for displaying an identification of the customer and the position of the customer in a queue. Claims 33 and 42 depend from claims 28 and 37, respectively, and contain similar limitations. Concerning the rejection of these dependent claims further in view of Yehuda,

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the examiner maintains that it would have been obvious to provide the device of Lohrey with a queue control means like that of Yehuda to provide for orderly control if a number of customers desire to use the device of Lohrey at the same time. Appellants do not dispute that it would have been obvious as a general principle to provide a queue control means in Lohrey in view of Yehuda's teachings. Instead, appellants argue (reply brief, pages 8-9) that the modified Lohrey device would not result in the claimed subject matter because there is no teaching in either applied reference of providing a display means for displaying an identification of the customer *and the position of the customer in a queue*.

Appellants' argument is well taken. The examiner has not pointed out, and it is not apparent to us, where Yehuda teaches or suggests that *the position of the customer in the queue* should be displayed on a display means. Instead, Yehuda merely teaches that a variety of parameters, such as number of on-line clerks, number of clerks to be added or subtracted, current queue waiting time, current queue line length, and average servicing time, should be displayed. In that the examiner has

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not established that the claimed subject matter of any of claims 33, 42 or 49 as a whole would have been obvious in view of the teachings of the applied references, the standing rejection of claims 33, 42 and 49, as well as of claims 34, 43 and 50 that depend, respectively, therefrom cannot be sustained.

Summary

The rejection of claims 28-32, 35-41, 44-47, 53 and 54 as being anticipated by Lohrey is reversed as to claims 28-32, 35-41, 44, 45, 53 and 54, but is affirmed as to claims 46 and 47.

The rejection of claim 48 as being unpatentable over Lohrey in view of Rivalto is reversed.

The rejection of claims 33, 34, 42, 43, 49 and 50 as being unpatentable over Lohrey in view of Yehuda is reversed.

The decision of the examiner is affirmed-in-part.

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

Affirmed-in-part

IAN A. CALVERT)	
Administrative Patent Judge)	
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)	
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)	BOARD OF PATENT
LAWRENCE J. STAAB)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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Administrative Patent Judge)	

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JUDGE STAAB

APPEAL NO. 1999-1780

APPLICATION NO. 08/651,630

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DECISION: **AFFIRMED IN PART**

PREPARED: Sep 18, 2002

OB/HD

PALM

ACTS 2

DISK (FOIA)

REPORT

BOOK