UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte VERONICA MARTINEZ, MARC HITE, and LUKE KEISER

Appeal 2012-004395
Application 12/042,861
Technology Center 3600


MOORE, Administrative Patent Judge.

DECISION ON APPEAL

STATEMENT OF THE CASE


We REVERSE.

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1 Appellants state that the real party in interest is Securus Technologies, Inc., a wholly owned subsidiary of Securus Technologies Holdings, Inc. Appeal Br. 2.
Claimed Subject Matter

Claim 23, the only independent claim on appeal, is reproduced below.

23. A method comprising:

identifying at least one prospective third-party payer for a resident of a controlled environment facility;

detecting at least one campaign-triggering event; and

in response to the at least one campaign-triggering event, initiating a campaign to proactively contact the at least one prospective third-party payer prior to demand for service by the resident to encourage the at least one prospective third-party payer to establish a third-party payment account for payment for future service expected for the resident, the at least one prospective third-party payer contacted using an interactive voice response system.

Rejections

The Examiner relies on the following prior art references in rejecting the claims on appeal:

Gerstner   US 2005/0125321 A1   June 9, 2005
Falcone (‘Falcone ’992”) US 7,042,992 B1   May 9, 2006
Devaul   US 2006/0252999 A1   Nov. 9, 2006

Claims 23–28, 31–33, and 45 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Falcone ’992, Gerstner, Benson, Smith, Falcone ’546, and Devaul.
ANALYSIS

The Examiner’s Rejection relies on six different references that relate to several different technologies. Yet, the Examiner uses precisely the same rationale to justify combining each of these references.

The Examiner states the following rationale for why it would have been obvious to modify the teachings of Falcone ‘992 (which relates to telecommunications billing accounts, see Falcone ’992, 2:26–31) with the teachings of Gerstner (which relates to accounts at financial institutions, see Gerstner, Abstract):

The motivation to combine these references would be to provide a more efficient and effective telemarketing and/or advertising campaign system and method for businesses to tailor their products and services to better match the needs and requirements of their customers in controlled-environment facilities.

Ans. 6. The Examiner then states the same rationale to explain why it would have been obvious to modify the teachings of Falcone’992 with the teachings of Benson (which relates to determining the effectiveness of advertising campaigns, see Benson, Abstract). See id. 6–7. The Examiner uses the same rationale as a basis for: further combining the teachings of Falcone’992 and Benson, with those of Smith (which relates to web-based marketing campaigns, see Smith, Abstract); further combining the teachings of Falcone ’992, Gerstner, Benson, and Smith, with those of Falcone ’546 (which relates to providing services to parties placing blocked telephone calls, see Falcone ’546, Abstract); and further combining the teachings of Falcone, Gerstner, Benson, Smith, and Falcone ’546, with those of Devaul (which relates to monitoring of the human body, see Devaul, Abstract). See Ans. 7–9. Appellants argue that this type of generic and conclusory
rationale is insufficient to support an obviousness objection. Appeal Br. 15–16. We agree.

Although the standard for combining references is flexible, “rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” KSR Int’l Co. v. Teleflex Inc., 550 U.S. 398, 418 (2007) (quoting In re Kahn, 441 F.3d 977, 988 (Fed. Cir. 2006)). Here, the Examiner’s stated rationale is merely a paraphrase of the result Appellants are attempting to achieve. The Examiner has not articulated sufficient reasoning with a rational underpinning for combining the specific prior art references at issue. For example, even though Falcone ’992 and Gerstner relate to telecommunications accounts and financial institution accounts, and Devaul relates to monitoring of the human body, the Examiner’s stated rationale does not mention these technologies, much less explain why one of ordinary skill in the art would have found it obvious to combine the specific teachings of these references in the manner the Examiner relied on in the Rejection.

For the foregoing reasons, we do not sustain the Examiner’s rejection of independent claim 23.

Claims 24–28, 31–33, and 45 all depend from, and thus incorporate the limitations of, claim 23. Therefore, we also do not sustain the Examiner’s rejection of claims 24–28, 31–33, and 45
DECISION

For the foregoing reasons, we REVERSE the Examiner’s rejection of claims 23–28, 31–33, and 45.²

REVERSED

² Should there be further prosecution of this application (including any review for allowance), the Examiner may wish to review the claims for compliance under 35 U.S.C. § 101 in light of the recently issued preliminary examination instructions on patent eligible subject matter. See “Preliminary Examination Instructions in view of the Supreme Court Decision in Alice Corporation Pty. Ltd. v. CLS Bank International, et al.,” Memorandum to the Examining Corps, June 25, 2014.