

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 12/042,861¹
Technology Center 3600

Before PHILIP J. HOFFMANN, CARL L. SILVERMAN, and
SCOTT C. MOORE, *Administrative Patent Judges*.

MOORE, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134 of the final rejection of claims 23–28, 31–33, and 45. Appeal Br. 7, Ans. 3. We have jurisdiction under 35 U.S.C. § 6.

We REVERSE.

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:

Benson	US 2002/0191762 A1	Dec. 19, 2002
Smith	US 2003/0041050 A1	Feb. 27, 2003
Falcone (“Falcone ’546”)	US 2003/0086546 A1	May 8, 2003
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

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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.