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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte OLGA MILOSAVLJEVIC, MARK DE VINCENZI,
and
JAMES PETERSON

Appeal 2011-012007
Application 09/880,170
Technology Center 3600

Before: JOSEPH A. FISCHETTI, MEREDITH C. PETRAVICK, and
MICHAEL W. KIM, *Administrative Patent Judges.*

KIM, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

This is an appeal from the final rejection of claims 1, 2, 4, 5, 7, 9, 11-20, 36, 39-41, and 43-48. We have jurisdiction to review the case under 35 U.S.C. §§ 134 and 6 (2002).

The invention relates to retirement income planners. More particularly, the invention relates to forecasting a customer's income, managing order of withdrawal, forecasting likelihood that assets at retirement will provide needs for retirement, and providing ability to perform alternative analysis by changing various retirement goals in retirement (Spec. 1:10-14).

Claim 1, reproduced below, is further illustrative of the claimed subject matter.

1. A method for using a desktop including a display for forecasting a likelihood that a customer's assets held in a plurality of different types of customer accounts at retirement meet in-retirement goals, including, but not limited to, an annual income withdrawal goal, an estate goal, and a years in retirement goal, comprising:

inputting said income withdrawal goal, said estate goal, said years in retirement goal, and a current asset allocation, and identifying one of said in-retirement goals as a priority goal;

performing an analysis based on said in-retirement goals and said current asset allocation;

forecasting, by using results of said analysis, said likelihood that said customer assets at retirement meet said priority goal;

providing an in-retirement income stream withdrawal strategy, wherein said income stream withdrawal strategy provides tax advantages and wherein said income stream withdrawal strategy provides for a first time period and said income stream withdrawal strategy avoids withdrawal of assets from tax deferred accounts during the first time period, and said income stream withdrawal strategy providing for withdrawal

from one or more tax deferred accounts during a second time period;

providing, using the display, a findings overview report based on said analysis, wherein the findings overview report includes the in-retirement goals, and the likelihood that the priority goal will be met if the in-retirement income stream withdrawal strategy is followed, wherein the likelihood is displayed as a percentage, and the findings overview report further including an asset drawn down schedule which shows a predicted end of year account balance for each of the plurality of different types of customer accounts if the in-retirement income stream withdrawal strategy is followed;

projecting annual snapshot cash flows from said current asset allocation and determining if a gap exists between said projected cash flows and said income goal; and

providing, using the display, a current performance planning table, wherein said table allows for assessing approximate current yield and total return information in order to determine which holdings of said assets provide cash flow versus growth required to meet said in-retirement goals, and further wherein said current performance planning table includes information on each asset's annual income, 1-year and 5-year total returns, and current value.

Claims 1, 2, 4, 5, 7, 9, 11-20, 36, 39-41, and 43-48 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Corrin (US 2002/0035527 A1, pub. Mar. 21, 2002) in view of Tracey Longo, *The First Cut Is The Cheapest: Retirement distributions can come from many sources IRAs, 401(k)s, and so on. Knowing where to start can prolong earnings growth*, Financial Planning. New York, 1-4 (Apr. 1, 1999) (hereinafter "Longo").

We AFFIRM and enter NEW GROUNDS of rejection pursuant to 37 C.F.R. § 41.50(b).

ISSUES

Did the Examiner err in asserting that claims 1, 2, 4, 5, 7, 11-20, 36, 39-41, and 43-48 are properly rejected based on 35 U.S.C. § 103(a) as being unpatentable over Corrin in view of Longo. For claim 1, the issue turns on whether Corrin discloses a current performance planning table and a findings overview report. For claim 46, the issue turns on whether Corrin discloses the limitations listed for claim 1 and additionally discloses a summary findings report. For claim 9, the issue turns on whether the combination discloses the withdrawal strategy further comprising designating when and how to withdraw from taxable, 401K, traditional IRA, and Roth IRA accounts.

ANALYSIS

Independent Claim 1

We are not persuaded the Examiner erred in asserting that a combination of Corrin and Longo renders obvious independent claim 1 (App. Br. 6-12; Reply Br. 2-6). Appellants assert that the table in Corrin does not disclose

providing, using the display, a current performance planning table, wherein said table allows for assessing approximate current yield and total return information in order to determine which holdings of said assets provide cash flow versus growth required to meet said in-retirement goals, and further wherein said current performance planning table includes information on each asset's annual income, 1-year and 5-year total returns, and current value,

as recited in independent claim 1, because (1) Corrin only displays results for portfolios, and not assets (App. Br. 7-9; Reply Br. 4-5), and (2) Corrin

does not display “current performance planning table includ[ing] information on each asset’s annual income, 1-year and 5-year total returns, and current value” (App. Br. 10). However, paragraphs [0144] and [0346] of Corrin disclose displaying at least an Expected Returns Table, a Quarterly Returns Chart, and a Calculate Returns Table. Even if Corrin does not disclose the information specifically set forth in independent claim 1, the information contained in the recited current performance planning table is merely an arrangement of data, and the Appellants are essentially asserting that content of data elements is distinguishable from the content disclosed in Corrin’s tables. The United States Patent and Trademark Office (USPTO) need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. *See In re Gulack*, 703 F.2d 1381, 1386 (Fed. Cir. 1983; *In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004); and *In re Lowry*, 32 F.3d 1579, 1583-84 (Fed. Cir. 1994). In the instant case, that the recited current performance planning table includes information on each asset’s annual income, 1-year and 5-year total returns, and current value is merely data that is being provided. The specifics of the assets do not provide any functional relationship to the method step of “providing, using the display, a current performance planning table,” and thus is directed to non-functional descriptive material. The asset information is analogous to printed matter, since they are simply directed to the underlying data in the table. *See In re Lowry*, 32 F.3d at 1583.

A similar analysis is also applicable to the alleged absence of (1) likelihood that a priority goal will be met is displayed as a percentage and (2) an asset drawn down schedule from the investment advisory report

displayed at paragraphs [0010] and [0011] of *Corrin* (App. Br. 10-11; Reply Br. 6-8).

Appellants assert that

the specific limitations regarding the asset drawn down schedule can be used in forecasting and investment strategy. As such, it is not just “information/data which can easily be included in an investment advisory report of *Corrin* without altering/changing the system of *Corrin*” as claimed on page 12 of the final Office Action. *Corrin* is drawn to a different investment strategy than the claimed method, as *Corrin* attempts to evaluate “the investor’s current saving and investment strategy” in preparation for retirement. *Corrin* ¶ [0028]. Changing the “information/data” would change the strategy, and thus *Corrin* teaches away from such modifications

(App. Br. 12). However, altering a strategy does not itself constitute a teaching away, especially absent any showing by Appellants that the *Corrin* reference criticizes, discredits, or discourages using additional information/data in evaluating an investor’s current saving and investment strategy. “The prior art’s mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed.” *In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004).

As several of our findings and rationales differ from those set forth by the Examiner, we denominate this a NEW GROUND of rejection under 35 U.S.C. § 103(a). See 37 C.F.R. § 41.50(b).

Independent Claim 46

We are not persuaded the Examiner erred in asserting that a combination of *Corrin* and *Longo* render obvious independent claim 46

(App. Br. 12-13; Reply Br. 9-10). In addition to the arguments raised by the Appellants for the rejection of claim 1, which we have already addressed above, Appellants additionally assert that Corrin does not disclose ““providing, using a computer, a summary of findings report, wherein the summary of findings report shows the likelihood for meeting the estate goal, a best case estate result, a worst case estate result, and an expected case estate result”” (App. Br. 12). Again, paragraphs [0010] and [0011] of Corrin disclose providing investors with an investment advisory report, and the contents of the report constitute non-functional descriptive material.

As several of our findings and rationales differ from those set forth by the Examiner, we denominate this a NEW GROUND of rejection under 35 U.S.C. § 103(a). *See* 37 C.F.R. § 41.50(b).

Dependent Claim 9

We are not persuaded the Examiner erred in asserting that a combination of Corrin, Longo, and Official Notice render obvious dependent claim 9 (App. Br. 13-14; Reply Br. 10-11). Appellants assert that Corrin teaches away from being modified to include “designating when and how much to withdraw from taxable, 401K, traditional IRA, and Roth IRA accounts,” as recited in dependent claim 9, because Corrin discloses that “most investors do not want to be bothered with entering volumes of data into a software program or web site” (Reply Br. 11). We are unclear as to how an aversion to data entry teaches away from implementing a withdrawal strategy.

DECISION

The decision of the Examiner to reject claims 1, 2, 4, 5, 7, 9, 11-20, 36, 39-41, and 43-48 is AFFIRMED.

This decision contains several new grounds of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides that “[a] new ground of rejection . . . shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that the Appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED; 37 C.F.R. § 41.50(b)

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