

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. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID L. FISHER JR, MATTHEW H. RADCLIFFE,
CRISTINA CASIMIRO-GARCIA, and
JORGE ARTURO RIVERA

Appeal No. 2001-1137
Application No. 08/984,053

ON BRIEF

Before JERRY SMITH, DIXON, and LEVY, **Administrative Patent Judges**.
DIXON, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 22-29, 37, and 40-50, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

Appellants' invention relates to a method and apparatus for formatting smart cards and card readers. An understanding of the invention can be derived from a reading of exemplary claim 22, which is reproduced below.

22. A method for configuring a software tool interface, between a card and a card reader, comprising:

accessing one of a plurality of card configuration records for configuring a software tool interface to communicate with the card;

accessing one of a plurality of reader configuration records for configuring the software tool interface to communicate with the card reader; and

configuring the software tool interface, between the card and card reader, for communicating with the card and card reader based upon the respective accessed card and card reader configuration records.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Zuppichich

WO 96/36051

Nov. 14, 1996

Clark et al., "BITS: A Smartcard Protected Operating System," **COMMUNICATIONS OF THE ACM**, Vol. 37, No. 11, pp. 66-70 and 94, Nov. 1994. (Clark)

Claims 22-29, 37, and 40-50 stand rejected under 35 U.S.C. § 103 as being unpatentable over Zuppichich in view of Clark.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejections, we make reference to the examiner's

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final rejection (Paper No. 12, mailed Mar. 16, 2000) and the examiner's answer (Paper No. 18, mailed Aug. 29, 2000) for the examiner's reasoning in support of the rejections, and to appellants' brief (Paper No. 17, filed Aug., 3, 2000) and reply brief (Paper No. 19, filed Oct., 16, 2000) for appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by appellants and the examiner. As a consequence of our review, we make the determinations which follow.

Appellants argue that Zuppich merely teaches operating on different cards, but only on a single type of card reader. (See brief at page 10.) Appellants argue that in contrast to Zuppich, the claimed invention requires the software tool interface be configured to communicate with different card readers and different cards. (See brief at page 11.) Appellants argue that Clark does not remedy the deficiency in Zuppich and does not teach access to card reader configuration records or configuring the software tool to communicate with both cards and card readers in the system of Zuppich. (See brief at page 11.) We agree with appellants and do not find that either Zuppich or Clark teach or suggest configuring a software tool to communicate with both cards and card readers.

The examiner incorporates the statement of the rejection from the final rejection (final rejection at pages 2-5) and maintains that Zuppich teaches accessing a plurality of card reader configuration records when the system selects a protocol for the established card type. The examiner does not provide a specific teaching for this limitation, but appears to rely on the fact that high level language commands from a host program are translated into low level protocol for the appropriate card type. (See final rejection at page 2.) We disagree with the examiner and find that this is merely a translation of the commands to a different form and not an accessing of a plurality of reader configurations. The examiner appears to not appreciate the difference between selecting between a number of separate and distinct types of card readers as one facet of the claimed invention and also selecting between a number of separate and distinct types of card as the other facet of the claimed invention. If Zuppich merely teaches the adaptation of the configuration of the single reader to multiple different types of cards, this only teaches one of the two facets of the claimed invention.

Furthermore, the examiner's reliance on Clark to teach accessing one of a plurality of card configurations is misplaced with respect to the use of card configurations records. While a smart card is envisioned by Clark to be a CPU to be used with any computing station in the future, we do not find that it teaches or suggests using both card configurations and card reader configurations to configure a software

tool. While we find that both Zuppich and Clark teach adapting a single type of card reader, neither teaches nor fairly suggests the adapting for different card readers.

The examiner maintains that the claim merely recites the concept of matching the proper set of protocols to read a particular type of card in the method of Zuppich. (See answer at page 3.) The examiner maintains that once the proper set of protocol is selected, the card reader has a specific configuration to communicate with the selected card. (See answer at page 3.) The examiner maintains that appellants fail to realize that cards are read through card readers and questions whether appellants realize that the reader used must be configured to communicate with the different cards. While we agree with the examiner that a specific reader type must be configured to different cards, this does not address the limitations recited in the language of independent claim 22. Independent claim 22 requires “accessing one of a plurality of reader configuration records for configuring the software tool interface to communicate with the card reader.” Since neither Zuppich and Clark have a plurality of (different) card readers, there would not be a plurality of reader configuration records to access one of the plurality. Therefore, we find that the combination of Zuppich and Clark does not teach or fairly suggest the invention recited in independent claim 22, and dependent claims 23-29. Similarly, we find that independent claims 37, 40, 42 and 50 contain similar limitations which are not taught of fairly suggested by the combination of Zuppich and Clark.

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Therefore, we will not sustain the rejection of claims 37, 40, 42 and 50 and their dependent claims.

CONCLUSION

To summarize, the decision of the examiner to reject claims 22-29, 37, and 40-50 under 35 U.S.C. § 103 is reversed.

REVERSED

JERRY SMITH)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JOSEPH L. DIXON)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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STUART S. LEVY)	
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