

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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 CHRISTIAN-FRIEDRICH VON BROCKDORFF

Appeal No. 2003-2102
Application No. 09/254,723

Heard: March 18, 2004¹

Before MARTIN, RUGGIERO, and LEVY, Administrative Patent Judges.
LEVY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-3, which are all of the claims pending in this application.

¹ The examiner initially requested to be present during the Oral Hearing (Paper No. 20, mailed June 20, 2003). However, in an E-mail communication to Mrs. Eleanor Cook at the BPAI, the examiner waived his presence at the Oral Hearing.

BACKGROUND

Appellants' invention relates to cashless payment by means of a mobile radio apparatus. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced as follows:

1. A method for cashless payment, comprising the steps of:

establishing communication from a multifunction chipcard in a user terminal via a wireless connection to a mobile radio network;

entering a personal identification feature at the user terminal;

registering the user terminal with the mobile radio network and booking the user terminal into the mobile radio network;

setting up a call via the mobile radio network from the user terminal to a business terminal;

carrying out a credit rating check with a card number stored in the chipcard;

displaying an amount of money entered at the business terminal at the user terminal via the call; and

releasing the amount of money for payment if a positive result of the credit rating check occurs after a confirmation at the user terminal.

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

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| Vazvan | WO 96/13814 | May 9, 1996 |
| Heinonen et al. (Heinonen) | WO 96/25828 | Aug. 22, 1996 |

Claims 1-3 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Vazvan in view of Heinonen.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellant regarding the above-noted rejection, we make reference to the examiner's answer (Paper No. 17, mailed November 19, 2002) for the examiner's complete reasoning in support of the rejection, and to appellant's brief² (Paper No. 16, filed June 14, 2002) and reply brief (Paper No. 19, filed Jan. 28, 2003) for appellant's arguments thereagainst. Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the briefs have not been considered. See 37 CFR 1.192(a).

OPINION

In reaching our decision in this appeal, we have carefully considered the subject matter on appeal, the rejection advanced by the examiner, and the evidence of obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision,

² Supplemental brief.

appellant's arguments set forth in the briefs along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

Upon consideration of the record before us, we reverse, essentially for the reasons set forth by appellant.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings

by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole. See id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

The examiner's position is set forth on pages 4 and 5 of the examiner's answer. The examiner asserts (answer, page 4) that "Vazvan does not spell out that payment information may be derived from a wireless source, before actually paying the account." The examiner maintains (id.) that

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to derive payment information on an account prior to making a payment to the account because this would allow the user to get an account total before authorizing payment using the payment terminal.

The examiner additionally asserts (id.) that "Vazvan also does not clearly teach the use of a PIN number, and registering the portable terminal in the radio network. To overcome these

deficiencies of Vazvan, the examiner turns to Heinonen for a teaching of the use of a PIN number and the registering of the portable terminal in the radio network.

We note at the outset that appellant does not dispute the combinability of Vazvan and Heinonen, but rather asserts that the combined teachings of Vazvan and Heinonen does not teach or suggest the claimed invention. Specifically, appellant asserts (brief, page 4) that the step of carrying out a credit rating check is not considered by Vazvan. It is further argued that Vazvan and Heinonen are not concerned with a card number stored in a multifunction chip (brief, pages 4 and 6). It is additionally argued that Vazvan is not directed toward seeking confirmation for payment at the user terminal (id.). This argument is broadened by appellant in the reply brief (pages 1-5) to be that there is no teaching or disclosure in Vazvan or Heinonen of the claimed displaying step: where the claim requires that the amount of money entered at the business terminal is then displayed at the user terminal via the call from the user terminal to the business terminal.

From our review of Vazvan and Heinonen, we find, for the reasons which follow, that at least Heinonen discloses a multichip module having a card number stored therein. Heinonen

discloses (figure 3C and page 8) that an application module can have either plural application modules 19 or an application module and a SIM 19'. Heinonen further discloses (page 13) that a user can have many different bank accounts, and that they can be in different applications 18 or different modules. Because the mobile unit can be used as a phone (page 9) or to make cashless payments (page 13) we find that the chipcard or module having a SIM and application(s) constitutes a multifunction chipcard having an account number. Accordingly, the limitation of a multifunction chipcard having an account number stored therein is met by the prior art. We additionally find that Vazvan discloses (page 6) that

If the payer's account do [sic: does] not have enough credit (money) the portable terminal 8 may receive a "No effects" message 19, or the bank may pay the transaction's amount on behalf of the payer and then later charge the payer or his/her bank for the prepaid transaction.

From the disclosure of Vazvan, we find that Vazvan teaches payment of a bill by a bank even though the payer's account has insufficient funds. However, we do not agree with the examiner (answer, page 10) that this feature of Vazvan can be broadly interpreted as being functionally the same as appellant's claimed "credit rating check." There are many reasons why a bank may go ahead and release funds to complete a customer transaction,

without relying upon a check of the customer's credit report. For example, if the transaction total was \$200.00 and the customer had \$198.00 in the account, because of the small difference, the bank may go ahead and advance the \$2.00 to the customer without checking the customer's credit report. This does not mean that the bank has carried out a credit rating check, and will release the money for payment if a positive result of the credit rating check occurs. We additionally find that Vazvan does not inherently carry out a rating credit check, because inherency cannot be established by possibilities or probabilities. To be inherent, in Vazvan, it must necessarily follow from the operation of the reference that the credit check report occurs; which the examiner has failed to establish.

Moreover, even assuming, arguendo, that Vazvan discloses carrying out a credit rating check and releases the money for payment if a positive result of the credit rating check occurs, the combined teachings of Vazvan and Heinonen fail to suggest the claimed invention because the references, either alone, or in combination, fail to teach or suggest the claimed "displaying the amount of money entered at the business terminal at the user terminal via the call" for the reasons provided by appellant in the reply brief. From our review of Vazvan and Heinonen, we

agree with appellant (reply brief, pages 2 and 3) that in Vazvan, "the payment amount is entered into the mobile device and transmitted to the bank payment system. A payment amount is not entered into a business terminal and transmitted via a call to a user terminal." In addition, Heinonen discloses (page 17) that:

When the connection has been established, the user enters the identification number of the cash card, and the cash card application compares it to the previously saved identification number. If the identification number has been given right, and the application 18 has sufficient balance, the payment transaction is registered both in the cash register 21 and the application 18 of the mobile station 1, whereby the balance on the cash card is decreased correspondingly.

From the disclosure of Heinonen, we find no disclosure of a payment amount being transmitted to a user terminal prior to authorization of payment, but rather that if the application 18 has sufficient balance, the transaction is registered in both the cash register 21 and the application 18. Because neither Vazvan nor Heinonen discloses displaying, at the user terminal, an amount of money entered at the business terminal via the call to the business terminal, we find that the examiner's assertion of obviousness (answer, page 4) to be unsupported by evidence in the record.

From all of the above, we find that the examiner has failed to establish a prima facie case of obviousness of claim 1. Accordingly, the rejection of claim 1, and claims 2 and 3, dependent therefrom, is therefore reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-3 under 35 U.S.C. § 103(a) is reversed.

REVERSED

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| JOHN C. MARTIN |) | |
| Administrative Patent Judge |) | |
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| |) | BOARD OF PATENT |
| JOSEPH F. RUGGIERO |) | APPEALS |
| Administrative Patent Judge |) | AND |
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| STUART S. LEVY |) | |
| Administrative Patent Judge |) | |

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BELL, BOYD & LLOYD, LLC
P.O. BOX 1135
CHICAGO, IL 60690-1135