The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 35

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SATYAN G. PITRODA

Appeal No. 2004-0297
Application No. 09/265,451

ON BRIEF

Before STAAB, MCQUADE, and NASE, Administrative Patent Judges.

MCQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Satyan G. Pitroda appeals from the final rejection (Paper No. 23) of claims 48 through 82, all of the claims pending in the application.

THE INVENTION

The invention relates to “a universal electronic transaction card (‘UET card’) for storing, transmitting and receiving personal, accounting and transactional information”

(specification, page 1). Representative claim 48 reads as follows:

48. A pocket-sized device for storing, transmitting, and receiving information, including personal information for a user of the pocket-sized device, account information for accounts with service institutions in which the user has an account, and transactional information for account with service institutions in which the user has an account, for a plurality of service institutions, comprising:

a. a housing, adapted to fit in a pocket or purse;

b. a processor, enclosed in the housing, the processor adapted to process personal information, account information and transactional information;

c. a touch-sensitive display, supported by the housing and coupled to the processor;

d. a memory, enclosed in the housing and coupled to the processor, the memory adapted to store personal information, account information, and transactional information, including a plurality of transaction records; and

e. a communication circuit enclosed in the housing and coupled to the processor, the processor being adapted to conduct electronic transactions for a plurality of accounts via the communication circuit.

THE PRIOR ART

The references relied on by the examiner to support the final rejection are:

Tamada et al. (Tamada)	5,017,766	May 21, 1991
Danielson et al. (Danielson)	5,227,614	Jul. 13, 1993
Nemirofsky	5,953,047	Sep. 14, 1999
Germain	Re. 36,346	Oct. 19, 1999
Hale et al. (Hale)	WO 86/03869	Jul. 3, 1986

THE REJECTIONS

Claims 48, 50 through 63, 66 through 72 and 74 through 82 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tamada in view of Danielson and Hale.

Claims 49 and 73 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tamada in view of Danielson and Nemirofsky.

Claims 64 and 65 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tamada in view of Danielson and Germain.

Attention is directed to the main and reply briefs (Paper Nos. 29 and 32) and to the final rejection and answer (Paper Nos. 23 and 30) for the respective positions of the appellant and the examiner regarding the merits of these rejections.

DISCUSSION

I. The 35 U.S.C. § 103(a) rejection of claims 48, 50 through 63, 66 through 72 and 74 through 82 as being unpatentable over Tamada in view of Danielson and Hale

Tamada, the examiner’s primary reference, discloses a multi-functional IC card which can be used as a credit card, a cash card, or the like. The following passage from the reference

describes the external features and internal circuitry of the card:

> FIG. 1 shows the outer appearance of a multifunctional IC card used, for instance, as a credit card, and being an example of a portable electronic apparatus according to the present invention. This IC card is designed such that it can be used both in on-line and off-line modes. For example, the IC card has a transaction function by means of which it can perform transactions in relation to a plurality of accounts (available as, e.g., a plurality of types of credit card and cash card), a time-piece function for displaying time-related data including the date and the time, a calculation function capable of executing at least four operations; and an electronic notebook function for storing and reading out addresses, names, phone numbers, and the like.
>
> FIG. 1 shows card main body 1 which can be constituted by, for example, a thin plastic board of rectangular shape. Card main body 1 includes contact section 3, which is electrically connected to integrated circuit (IC) 2 buried in main body 1, for electrically communicating with a terminal device (not shown) in the on-line mode, liquid crystal display section 4 for displaying input/output data, time-related data, and the like, and keyboard 5, all of these units being arranged at predetermined positions on the front surface of main body 1. Card main body 1 additionally contains battery 6 for supplying a power source voltage.
>
> Keyboard 5 includes account keys 7, 8, 9, and 10 for designating an account; numeric keys 11; addition key 12, subtraction key 13, division key 14, and multiplication key 15, these being the four-operation keys; decimal key 16; equal key 17; and the like.
>
> Account key 7 designates a first operation (processing) for a first account (e.g., account data of a first credit company), account key 8 designates a second operation for a second account (e.g., account data of a second credit company), account key 9 designates a third operation for a third account (e.g., account data of a first bank), and account key 10

designates a fourth operation for a fourth account (e.g., account data for a second bank).

Addition key 12 is used as a "next" key for advancing the display state of liquid crystal display section 4, and for mode-selection; subtraction key 13 is used as a "back" key for restoring display section 4 to its previous display state; and equal key 17 serves a dual purpose, being the used as "yes" key and also as the initialization key (power-on key).

Embossed data (not shown) is formed at a predetermined position of the rear surface of card main body 1 as card holder data.

FIG. 2 shows a circuit arrangement of the integrated circuit shown in FIG. 1. Communication control circuit 21, reset control circuit 22, and power source control circuit 23 are connected to contact section 3. In addition, battery check circuit 24 for checking whether the voltage of battery 6 is more than a predetermined value or not is connected to power source control circuit 23. Internal bus 38 is connected to program memory 28 for storing a control program, working memory 29 used for arithmetic operations, data memory 30 consisting of a nonvolatile memory such as an EEPROM for storing transaction data, timer circuit 31 used when time is counted during program execution, and timer circuit section 32 for generating time-piece data including time data and date data. This timer circuit section 32 includes timer circuits 322 and 323, and frequency divider 311. Oscillator 33 having a frequency of 32.768 kHz is connected to timer circuit section 32.

Display section 4 is connected to internal bus 38 through display control circuit 34 and display driver 35. Keyboard 5 is also connected to internal bus 38 through keyboard interface 36. In addition, confirmation data generating circuit 37 for generating the confirmation data of the input transaction data using key data based on DES (Data Encryption Standard) and CPU (Central Processing Unit) 27 for controlling the entire circuit shown in FIG. 2 are connected to internal bus 38.

Communication control circuit 21 is operated in the on-line mode. More specifically, serial data supplied from the terminal equipment (not shown) through contact section 3 is converted into parallel data and output to

> data bus 38. Otherwise, parallel data supplied from data bus 38 is converted into serial data and output to the terminal equipment through contact section 3 [column 2, line 31, through column 3, line 47].

Danielson discloses a pocket-size computer processing system which includes, among other features, a touch sensitive display (see, for example, element 17 in Figure 2).

Hale discloses a pocket-size personal terminal for performing a variety of financial and other transactions on-line. The terminal possesses the capability of generating a “review history trail” which displays a record of earlier transactions (see page 9 and Figure 5).

The manner in which the examiner applies Tamada, Danielson and Hale to reject claims 48, 50 through 63, 66 through 72 and 74 through 82 appears in the final rejection and answer, while the appellant’s position to the contrary appears in the briefs. As the appellant’s arguments frame the issues for review, we shall evaluate the rejection of each of the contested claims in the order argued in the main brief.

<u>Claim 48</u>

The appellant submits that the rejection of claim 48 is unsound because (1) Tamada relates to conventional transactions involving paper slips rather than electronic transactions of the

sort required by the claim, (2) Tamada and Hale fail to teach a memory adapted to store “transactional information” comprising a plurality of transaction records as disclosed[1] and claimed, and (3) the references do not establish any motivation or suggestion to combine them in the manner proposed. Given the scope of claim 48 and the fair teachings of the references, these arguments are not persuasive.

Although Tamada does disclose an off-line mode of operation involving the use of paper slips, this reference clearly teaches an alternative on-line mode of operation which would have suggested electronic transactions as defined in claim 48. Any lack of specificity on Tamada’s part in describing the on-line mode is more than compensated for by Hale’s disclosure of electronic transactions. Hale also clearly suggests a memory adapted to store transactional information comprising a plurality

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[1] The appellant’s specification defines “transactional information” as

> includ[ing] information relating to one or more individual financial transactions, such as credit card transactions, medical treatment payments, insurance payments, and the like. The transaction information includes various transaction details that may appear on a paper receipt for any given financial transaction, such as a subtotal, a tip, if any, a transaction total, the date and place of the transaction, and the user’s signature [page 5].

of transaction records as defined in the appellant's specification[2] and recited in claim 48. The definition of the term "transactional information" in the appellant's specification (see n.1, supra) is so broad and open-ended that it comprehends the review history trail records taught by Hale. Finally, the self-evident advantages and conveniences afforded by the electronic transactions disclosed by Tamada and Hale, the memory for storing transaction records taught by Hale, and the touch sensitive display disclosed by Danielson would have provide the artisan with ample suggestion or motivation to utilize these features in the pocket-sized device disclosed by Tamada. Accordingly, we shall sustain the standing 35 U.S.C. § 103(a) rejection of claim 48 as being unpatentable over Tamada in view of Hale and Danielson.

Claims 53 and 54

Claim 53 depends from claim 48 and requires the transactional information which the memory is adapted to store to include a plurality of images corresponding to receipts of transactions. Claim 54 depends from claim 48 and requires the

[2] Words which are defined in the specification must be given the same meaning when used in a claim. McGill, Inc. v. John Zink Co., 736 F.2d 666, 674, 221 USPQ 944, 949 (Fed. Cir.), cert. denied, 469 U.S. 1037 (1984).

account information which the memory is adapted to store to include a plurality of images of replicas of cards. As the applied references, including the portions of Tamada referred to by the examiner, do not teach, and would not have suggested, a device having these characteristics, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of claims 53 and 54 as being unpatentable over Tamada in view of Danielson and Hale.

Claim 77

Claim 77 depends from claim 48 and requires at least one of the transaction records to comprise a receipt. As indicated above, Hale would have suggested providing the Tamada device with a memory adapted to store transaction records such as those embodied by the history trail depicted in Hale's Figure 5. At least some of the individual records shown in Figure 5 (see 26-1, 26-3, 26-4), which display the transaction date, vendor and purchase price, constitute receipts as broadly recited in claim 77. The appellant's argument to the contrary rests on an improper reading of limitations from the specification into the claim. Thus, we shall sustain the standing 35 U.S.C. § 103(a) rejection of claim 77 as being unpatentable over Tamada in view of Danielson and Hale.

Claim 78

Claim 78 depends from claim 77 and requires the receipt to include a user authorization. Since the applied references, including the portions of Hale specified by the examiner, do not teach, and would not have suggested, this subject matter, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of claim 78 as being unpatentable over Tamada in view of Danielson and Hale.

Claim 71

Claim 71 is an independent claim which recites a pocket-sized device similar to that recited in independent claim 48. The appellant contends that the rejection of this claim is unsound because the applied references, and particularly Tamada, do not teach or suggest a device meeting the limitation in the claim requiring a communication circuit adapted to conduct electronic transactions with a merchant. For the reasons discussed above in connection with claim 48, such argument is not convincing. Therefore, we shall sustain the standing 35 U.S.C. § 103(a) rejection of claim 71 as being unpatentable over Tamada in view of Danielson and Hale.

Claim 81

Claim 81 depends from claim 71 and requires at least one of the transaction records to comprise a receipt. For the reasons discussed above in connection with claim 77, we shall sustain the standing 35 U.S.C. § 103(a) rejection of claim 81 as being unpatentable over Tamada in view of Danielson and Hale.

Claim 58

Claim 58 is an independent claim which recites a method of using a pocket-sized device of the sort at issue. The appellant contends that the rejection thereof is unsound because the applied references, and particularly Tamada, do not meet the limitation requiring the step of sending and receiving information including transaction information including at least one transaction record between the device and service institutions. For the reasons discussed above in connection with claim 48, this argument is not persuasive. Hence, we shall sustain the standing 35 U.S.C. § 103(a) rejection of claim 58 as being unpatentable over Tamada in view of Danielson and Hale.

Claim 79

Claim 79 depends from claim 58 and requires the transaction record to comprise a receipt. For the reasons discussed above in connection with claim 77, we shall sustain the standing 35 U.S.C.

§ 103(a) rejection of claim 79 as being unpatentable over Tamada in view of Danielson and Hale.

Claims 63 and 66

Claim 63 is an independent claim which recites a method of using a pocket-sized device of the type in question. The method requires the step of transmitting account information from the device to a point of sale terminal via the display of the device. Because the applied references, including the portion of Tamada pointed to by the examiner, do not teach, and would not have suggested, a method having this step, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of claim 63, and dependent claim 66, as being unpatentable over Tamada in view of Danielson and Hale.

Claim 67

Claim 67 is an independent claim which recites a method of conducting a credit card transaction. The appellant contends that the rejection thereof is unsound because the applied references do not teach, and would not have suggested, a method meeting the limitations in the claim requiring the steps of establishing an electronic communication between a universal electronic transaction card and a point of sale transaction system and transmitting a transaction record for a credit

transaction to the universal electronic transaction card. For the reasons discussed above in connection with claim 48, this argument is not persuasive. Accordingly, we shall sustain the standing 35 U.S.C. § 103(a) rejection of claim 67 as being unpatentable over Tamada in view of Danielson and Hale.

Claim 68

Claim 68 depends from claim 67 and requires the step of storing transactional information for a credit transaction in the universal electronic transaction card. For the reasons discussed above in connection with claim 48, this argument is not convincing. Therefore, we shall sustain the standing 35 U.S.C. § 103(a) rejection of claim 68 as being unpatentable over Tamada in view of Danielson and Hale.

Claims 69 and 70

Claim 69 depends from claim 67 and requires a step of establishing an electronic communication between the universal electronic transaction card and a point of sale transaction system that occurs before establishing an electronic communication between the point of sale transaction system and a service institution system. Claim 70 depends from claim 67 and requires a step of establishing an electronic communication between a point of sale transaction system and a service

institution system that occurs while electronic communication between the universal electronic transaction card and the point of sale transaction system is in effect. The appellant's contention that the rejection of these claims is unsound because Tamada and the other applied references do not disclose these sequences is not persuasive. The examiner's position that the references imply either sequence in order to complete the electronic transactions suggested by Tamada and Hale is eminently reasonable on its face. Therefore, we shall sustain the standing 35 U.S.C. § 103(a) rejection of claims 69 and 70 as being unpatentable over Tamada in view of Danielson and Hale.

Claim 80

Claim 80 depends from claim 67 and requires the transaction records to comprise a receipt. For the reasons discussed above in connection with claim 48, 67 and 77, we shall sustain the standing 35 U.S.C. § 103(a) rejection of claim 80 as being unpatentable over Tamada in view of Danielson and Hale.

Claims 50 through 52, 55 through 57, 59 through 62, 72, 74 through 76 and 82

We shall sustain the standing 35 U.S.C. § 103(a) rejection of dependent claims 50 through 52, 55 through 57, 59 through 62, 72, 74 through 76 and 82 as being unpatentable over Tamada in

view of Danielson and Hale since the appellant has not challenged such with any reasonable specificity, thereby allowing these claims to stand or fall with their respective parent claims 48, 58, 71 and 81 (see In re Nielson, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987)).

II. The 35 U.S.C. § 103(a) rejection of claims 49 and 73 as being unpatentable over Tamada in view of Danielson and Nemirofsky

We shall sustain the standing 35 U.S.C. § 103(a) rejection of dependent claims 49 and 73 as being unpatentable over Tamada in view of Danielson and Nemirofsky since the appellant has not challenged such with any reasonable specificity, thereby allowing these claims to stand or fall with their respective parent claims 48 and 71 (see In re Nielson, supra).

III. The 35 U.S.C. § 103(a) rejection of claims 64 and 65 as being unpatentable over Tamada in view of Danielson and Germain

As Germain does not overcome the above noted deficiencies of Tamada and Danielson with respect to parent claim 63, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of dependent claims 64 and 65 as being unpatentable over Tamada in view of Danielson and Germain.

SUMMARY

The decision of the examiner:

a) to reject claims 48, 50 through 63, 66 through 72 and 74 through 82 under 35 U.S.C. § 103(a) as being unpatentable over Tamada in view of Danielson and Hale is affirmed with respect to claims 48, 50 through 52, 55 through 62, 67 through 72, 74 through 77 and 79 through 82, and reversed with respect to claims 53, 54, 63, 66 and 78;

b) to reject claims 49 and 73 under 35 U.S.C. § 103(a) as being unpatentable over Tamada in view of Danielson and Nemirofsky is affirmed; and

c) to reject claims 64 and 65 under 35 U.S.C. § 103(a) as being unpatentable over Tamada in view of Danielson and Germain is reversed.

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

AFFIRMED-IN-PART

LAWRENCE J. STAAB Administrative Patent Judge	)	
	)	BOARD OF PATENT
	)	APPEALS AND
JOHN P. MCQUADE Administrative Patent Judge	)	INTERFERENCES
JEFFREY V. NASE Administrative Patent Judge	)	

JPM/kis

Appeal No. 2004-0297
Application No. 09/265,451

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