

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT A. CORDERY,
DAVID K. LEE, LEON A. PINTSOV,
FREDERICK W. RYAN, JR. and MONROE A. WEIANT, JR.

Appeal No. 2004-0831
Application 09/650,176

ON BRIEF

Before FRANKFORT, NASE and DIXON, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claim 35, the only claim remaining in this application. Claims 1 through 34 have been canceled.

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As noted on page 1 of the specification, appellants' invention relates to certification of users for electronic commerce, and more particularly, to a secure user certification system and method for electronic commerce that provides an accounting system for services provided. Independent claim 35, directed to a method for generating an electronic certificate, is representative of the subject matter on appeal and a copy of that claim can be found in Appendix A of appellants' brief.

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

Fischer '200	5,005,200	Apr. 2, 1991
Windel et al. (Windel)	5,680,463	Oct. 21, 1997

Claim 35 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Windel in view of Fischer '200.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejection, we refer to the examiner's answer (Paper No. 13, mailed June 3,

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2003) and to appellants' brief (Paper No. 11, filed April 10, 2003) and reply brief (Paper No. 14, filed August 4, 2003) for a full exposition thereof.

OPINION

Having carefully reviewed the obviousness issues raised in this appeal in light of the record before us, we have come to the conclusion that the examiner's rejection of claim 35 under 35 U.S.C. § 103 will not be sustained. Our reasoning in support of this determination follows.

In rejecting claim 35 under 35 U.S.C. § 103(a), the examiner has determined that Windel discloses a method for generating and evaluating a certificate or security imprint comprising providing a register having funds stored therein, and determining and deducting funds from the register based on a transaction, and assembling contents to be included in a postmark. What the examiner finds lacking in Windel is any disclosure or teaching concerning obtaining a message digest of a digital message or signing a postmark or certificate, as generally recited in

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claim 35 on appeal. To account for these differences, the examiner looks to Fischer '200, urging that this patent teaches a method for authenticating digitally represented data such as computer files, letters, graphic files, etc., wherein a digest of the object (e.g., a digital message) is created and a trusted authority is provided for digitally signing the object to certify its authenticity. The examiner then concludes that it would have been obvious to combine the systems of Windel and Fischer so as to gain certain advantages as set forth on page 4 of the answer, and presumably to result in the method set forth in claim 35 on appeal.

After a careful evaluation of the teachings and suggestions to be derived by one of ordinary skill in the art from the disparate systems described in Windel and Fischer '200, it is our opinion that the examiner has failed to meet his burden of establishing a *prima facie* case of obviousness. More particularly, we are of the view that the examiner's reasoning in support of the obviousness rejection before us on appeal (as expressed on pages 3-6 of the answer) is essentially based on

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appellants' own disclosure and teachings, uses claim 35 on appeal as a road map to seek out and combine disparate features from selected pieces of unrelated prior art, and relies upon impermissible hindsight to reconstruct the presently claimed invention.

Basically, we share appellants' views as aptly expressed in the brief and reply brief concerning the examiner's attempted combination of the Windel and Fischer '200 patents, and with regard to the failure of either of the applied patents to disclose or suggest a method for generating an electronic certificate for a digital message and using a register having funds stored therein for paying for "signing the electronic certificate contents," as specifically set forth in claim 35 on appeal. Windel discloses a system and method for applying a security imprint on a physical piece of mail as part of the postmark so that an evaluation can ultimately be made by a postal authority at a remote location as to whether an improper manipulation was undertaken upon mailing or at a postage meter machine. While the postage meter of Windel has a register having

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funds stored therein and determines and deducts a proper postage value from the register funds when a piece of mail is postmarked, we see nothing in Windel that relates at all to appellants' claimed method for generating an electronic certificate for a digital message, wherein the method includes the steps of obtaining a message digest of the digital message; assembling contents for the certificate, with said contents including the message digest; determining if sufficient funds are present in the register for signing the electronic certificate contents; and signing the electronic certificate, as in appellants' claim 35.

Even if we assume the security imprint of Windel is broadly a "certificate," as contended by the examiner, deducting of funds from the register in Windel is for the proper postage value determined for the particular mail piece being mailed, and not for the security imprint or "certificate" applied as part of the postmark on the physical piece of mail. Moreover, there is no signing of the security imprint or "certificate" in Windel, nor obviously any determining or deducting of funds in the register for signing the "certificate."

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Fischer '200 addresses a system and method involving a public key/signature cryptosystem with enhanced digital signature certification, wherein an electronic certificate including a digest of a digital message and other data is assembled into a certificate and signed by a trusted authority, with the certificate then being attached to the encrypted digital message for authentication purposes. However, there is no teaching or suggestion in Fischer '200 concerning a payment scheme for processing and signing the certificate, and no reason we can see for attempting to modify the postage meter and security imprint arrangement of Windel in view of the completely different system and method of Fischer '200.

Since neither the applied references nor the examiner provides an adequate factual basis to establish that the method of claim 35 on appeal would have been obvious to one of ordinary skill in the art at the time of appellants' invention, it follows that we will not sustain the examiner's rejection of claim 35 under 35 U.S.C. § 103(a).

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The decision of the examiner to reject claim 35 under
35 U.S.C. § 103(a), accordingly, is reversed.

REVERSED

CHARLES E. FRANKFORT)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
)	
JEFFREY V. NASE)	APPEALS AND
Administrative Patent Judge)	
)	INTERFERENCES
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JOSEPH L. DIXON)	
Administrative Patent Judge)	

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