

-The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 39

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RONALD A. KATZ

Appeal No. 2005-0007
Application 09/364,675

HEARD: March 8, 2005

Before HAIRSTON, BARRETT, and LEVY, Administrative Patent Judges.
HAIRSTON, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 24 through 39.

The disclosed invention relates to the use of a travel card to control a telephone system.

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Claim 24 is illustrative of the claimed invention, and it reads as follows:

24. A telephone system of a type controllable by cards, comprising:

a switching station including a switch processor capable of receiving call data from at least one dial-up communication source and a switching computer means capable of processing call data;

said switching computer means controlling said switch processor;

communication means capable of capturing call data received by said switch processor, said call data including automatic number identification and a personal identification number;

said communication means capturing call data at front side of the call data received by the switch processor and supplying said call data to the switching computer means, and capable of supplying processed data from switching computer means to the switching station;

said switching computer means being capable of obtaining data for at least one parameter related to the card in addition to said call data for the switching computer means to act upon in processing call data and determining from said data from the front side of the call data and additional parameter whether the attempted call is placed by a caller in good standing in accordance with parameters associated with the card;

said switching computer means capable of disallowing completion of a call through the switching station if determined from processing of call data and additional parameter by the switching computer means that the call is not placed by a caller in good standing; and

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said switching computer means capable of interrupting and terminating said call in progress through the switch processor if said switching computer means determines by data processing that an available account status associated with the travel card has been reached during the call.

The examiner did not use any prior art references in the rejection of record.

Claims 24 through 39 stand rejected under the first paragraph of 35 U.S.C. § 112 for lack of written description.

Reference is made to the briefs (paper numbers 29 and 33) and the answer (paper number 31) for the respective positions of the appellant and the examiner.

OPINION

We have carefully considered the entire record before us, and we will sustain the lack of written description rejection of claims 24 through 39.

Under the written description portion of the first paragraph of 35 U.S.C. § 112, the applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the claimed invention. Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1116-17 (Fed. Cir. 1991); In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983).

The examiner has listed a host of limitations in each of the claims on appeal that are allegedly not supported by the originally filed application (answer, pages 4 through 6). The examiner states, for example, that:

Claims 24-31 recite the use of "travel cards" for "handling telephone calls" in a "telephone system controllable by travel cards." However, appellant's specification contains no teaching or suggestion of using "travel cards" but, instead, discloses a lottery system to which a caller from a valid telephone number can participate using information on a lottery ticket. A travel card is a telephone credit calling card which is issued by a service provider and enables a caller to place long distance calls over any phone and to charge the call to the card's account. In contrast, appellant's specification is directed to a lottery system to which a caller from a valid telephone number can participate using information on a lottery ticket (see Figure 2; page 4, line 12-page 5, line 13; page 21, line []-page 23, line 21; page 34, Abstract). A travel card and a lottery ticket are separate, distinct entities which carry out completely different functions. A telephone travel card is issued by a telephone company to enable a customer to place a long distance call over any phone and to charge the call to the account of the account holder. The lottery ticket described in appellant's specification allows a user to participate in a lottery, not to place a call to a desired second party over any telephone. Therefore, the lottery ticket described in appellant's specification cannot be considered as a travel card as is defined in the telephony art. (Answer, page 4).

The examiner is also of the opinion (answer, page 5) that "Appellant's specification does not provide support for a [sic] using a caller's automatic number identification and a PIN number and a parameter relating to the card for determining whether the

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caller is in good standing, as recited in the independent claims 24, 31, 32 and 39."

Appellant argues (brief, pages 7 through 12) that the term "travel cards" is used in both the preamble as well as the body of the claims to merely indicate "an exemplary use and does not so limit the scope of the claims." Appellant additionally argues (brief, page 13) that a PIN number can be any one of the several forms of identification (e.g., social security number, driver's license number or credit card number) listed in appellant's specification.

At the outset, we agree with appellant's latter argument. A PIN number can be any sequence of alphanumeric characters to identify someone during a transaction. Since a PIN number can be virtually anything keyed into the system for recognition of the user by the system, we find that appellant's disclosed system uses the above-noted forms of identification as a PIN number as set forth in the claims on appeal. Thus, the mere fact that appellant's specification does not call the above-noted numbers a PIN number is not fatal to appellant's quest to label such numbers as PIN numbers.

Turning to appellant's only other argument on appeal, we find that the originally filed application is silent as to a "travel card," and that the lottery ticket disclosed by appellant is not described in the originally filed disclosure as a "travel card." Thus, any attempt by appellant to belatedly claim a "travel card" based upon the disclosure of a lottery ticket is improper under the written description portion of 35 U.S.C. § 112. Appellant's argument that the term "travel card" is merely an exemplary use and does not limit the scope of the claims in spite of the use of the term in both the preamble and the body of the claims is without merit in view of the Court's statement that "this term, appearing in every claim, does not simply refer to the prior art or to a possible use, but describes and limits the invention being claimed." Pitney Bowes, Inc. v. Hewlett-Packard Co., 182 F.3d 1298, 1306, 51 USPQ2d 1161, 1166 (Fed. Cir. 1999). In summary, the lack of written description rejection of the claims that recite the term "travel card" in both the preamble and the body of the claims (i.e., claims 24 through 31) is sustained.

Turning to claims 32 through 39, we find that these claims broadly recite a "card" in both the preamble and the body of the claim. The appellant correctly argues that the disclosed lottery

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ticket (Figure 2) is a card. On the other hand, we agree with the examiner that the lottery card is incapable of performing the card functions set forth in claims 32 through 39. For example, nothing in the disclosed invention indicates that a "parameter" is needed from the card before the system can determine whether the card holder is "in good standing." According to the disclosed invention, the determination of being "in good standing" is determined before any information is taken from the lottery card. With respect to the "available account" status associated with the card set forth in claims 32 through 38, we find that appellant's disclosure is completely silent as to such an account associated with the lottery card. Accordingly, the lack of written description rejection of claims 32 through 39 is sustained.

DECISION

The decision of the examiner rejecting claims 24 through 39 under the first paragraph of 35 U.S.C. § 112 is affirmed.

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

AFFIRMED

KENNETH W. HAIRSTON)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
LEE E. BARRETT)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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