

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

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4 UNITED STATES PATENT AND TRADEMARK OFFICE

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6  
7 BEFORE THE BOARD OF PATENT APPEALS  
8 AND INTERFERENCES

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11 *Ex parte* JON R. STIEBER, THOMAS P. ADAMS, ROBERT L. ZWIEG, and  
12 WILLIAM R. KIRKMAN

13  
14  
15 Appeal 2006-2607  
16 Application 10/004,738  
17 Technology Center 3600

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20 Decided: February 27, 2007

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23 Before MURRIEL E. CRAWFORD, STUART S. LEVY and ANTON W.  
24 FETTING, *Administrative Patent Judges*.

25 ANTON W. FETTING, *Administrative Patent Judge*.

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28 DECISION ON APPEAL

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31 STATEMENT OF CASE

32 This appeal involves claims 2-9 and 15-21, the only claims pending in this  
33 application. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 134.

34  
35 We AFFIRM-IN-PART.

1 The appellants' invention relates to a cash handling machine networked to  
2 peripherals through a wireless communications network (Specification 1). An  
3 understanding of the invention can be derived from a reading of exemplary claim  
4 15, which is reproduced below.

5 15. A cash management system comprising:

6 a first cash handling device for processing notes including  
7 sorting of notes, totaling of notes received, and communicating note  
8 totals to at least one of: a second cash handling device, a visual  
9 display and communication through a network,

10 wherein said first cash handling device does not [sic, have] the  
11 capability to receive or dispense coins;

12 a second cash handling device for processing coins including  
13 sorting of coins, totaling of coins received, and communicating coin  
14 totals to at least one of: the first cash handling machine, a visual  
15 display and a network,

16 wherein said second cash handling device does not have the  
17 capability to receive or dispense notes; and

18 wherein said first cash handling device and said second cash  
19 handling device have respective circuits for communicating through a  
20 first wireless communication network operating according to a  
21 network standard for locally distributed wireless networks operating  
22 without servers; and

23 wherein the first cash handling device and the second cash  
24 handling device provide a cooperative cash management system in  
25 which the totals for notes and coins, respectively, are brought together  
26 through wireless communication from these respective devices within  
27 a range of no more than 100 meters from each other and are displayed  
28 on at least one of the first cash handling device, the second cash  
29 handling device or a third device operating as a visual display no more  
30 than 100 meters from one of the first the first cash handling device  
31 and the second cash handling device.

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1 This appeal arises from the Examiner's final rejection, mailed April 6, 2005.  
2 The Appellants filed an Appeal Brief in support of the appeal on September 29,  
3 2005, and the Examiner mailed an Examiner's Answer to the Appeal Brief on  
4 December 20, 2005. A Reply Brief was filed on January 17, 2006. A  
5 Supplemental Examiner's Answer was mailed on May 8, 2006. A second Reply  
6 Brief was filed on June 5, 2006.

7 PRIOR ART

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

10	Watanabe	US 4,733,765	Mar. 29, 1988
11	Richardson	US 6,028,764	Feb. 22, 2000
12	Amos	US 6,554,184 B1	Apr. 29, 2003
13			(filed May 5, 2000)

14 Amos shows a network of cash machines into which coins and bills may be  
15 deposited or withdrawn. Amos' network may include a wireless component.  
16 Watanabe shows a cash machine which ensures that bills and coins are not placed  
17 in the wrong device and that sorts coins and bills placed therein. Richardson is  
18 evidence of the notoriety of several modes of wireless communication and that  
19 wireless communication is an art recognized mode of linking two physically  
20 separate devices for data transfer.

21 REJECTIONS

22 We first note that the Examiner has referred, only indirectly to the prior Office  
23 action without fully restating the point relied on in the Answer, contrary to the  
24 requirements of *the Manual of Patent Examining Procedure (MPEP)* § 1207.02.  
25 Even more problematic, the Examiner did not even set forth the reasoning behind  
26 the rejection in that final Office action, but only set forth two actions prior to that

1 in the Final Rejection mailed April 21, 2004. We advise the Examiner that the  
2 technology known as cut and paste that could have put the Answer in compliance  
3 with the *MPEP*. “Judges are not like pigs, hunting for truffles buried in briefs.”  
4 *SmithKline Beecham Corp. v. Apotex Corp.*, 439 F.3d 1312, 1320, 78 USPQ2d  
5 1097, 1103 (Fed. Cir. 2006).

6 The Appellants contend that the Examiner acted improperly in making the  
7 most recent rejection final (Br. 7). However, this relates to a petitionable matter  
8 and not to an appealable matter. *See In re Schneider*, 481 F.2d 1350, 1356-57, 179  
9 USPQ 46, 51 (CCPA 1973) and *In re Mindick*, 371 F.2d 892, 894, 152 USPQ 566,  
10 568 (CCPA 1967). *See also the MPEP* § 1002.02(c), item 3(a) and § 1201. Thus,  
11 the relief sought by the Appellants would have been properly presented by a  
12 petition to the Commissioner under 37 C.F.R. § 1.181 instead of by appeal to this  
13 Board. Accordingly, we will not further consider this issue.

14 Claims 2-9 and 15-21 stand rejected under 35 U.S.C. § 112, second paragraph,  
15 as rendering the claimed subject matter indefinite.

16 Claims 2-9 and 15-21<sup>1</sup> stand rejected under 35 U.S.C. § 103(a) as obvious over  
17 Amos, Watanabe, and Richardson.

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<sup>1</sup>The Examiner stated that claims 2-9 and 15-29 (Answer 4) are rejected, but there are no claims in the application above claim 21. The Examiner indicated that claim 21 is included in the rejection, and the Appellants argued claim 21. Therefore, we treat this rejection as including claims 15-21.

1 ISSUES

2 The issues pertinent to this appeal are

- 3 • Whether the phrases “for processing notes including sorting,” “for  
4 processing coins including sorting,” and “are brought together,” in claim 15  
5 are indefinite.
- 6 • Whether the prior art motivates the combination of the applied art.
- 7 • Whether the art applied shows
  - 8 ○ wireless communication between two cash machines
  - 9 ○ local network with a range of about 100 meters controlling  
10 communication between two cash machines
  - 11 ○ a second network connected to the internet, LAN, or WAN
  - 12 ○ wireless technology relying on infrared, Bluetooth, piconet or a  
13 frequency hopping, spread spectrum range of frequencies in the range  
14 of 2.4 to 2.56 GHz.
  - 15 ○ two cash devices operating in a master-slave mode.

16 In particular, the Appellants contend that the claim 15 phrases the Examiner  
17 indicated as unclear are not indefinite (Br. 13-17), that the three references applied  
18 against the claims are disparate and therefore would not have been combined (Br.  
19 8-9), that Amos’s network would span a much larger range than the 100 meters in  
20 the claim (Br. 9-10), that the claim 15 subject matter calls for a more simple  
21 network than Amos (Br. 10), that only the inventors recognized the need for a local  
22 system handling plural cash machines wirelessly (Br. 11), and that the art fails to  
23 show the subject matter added by the dependent claims (Br. 11-13).



1       Therefore, each of Amos' ATM's has both a cash handling device for  
2 processing notes and a cash handling device for processing coins.

3       For bills and coins that have been deposited to be recycled automatically, the  
4 bills and coins must be separated by denomination, i.e., they must be sorted, so that  
5 the device can determine the locations of various denominations for subsequent  
6 distribution.

7       A person of ordinary skill in the art would understand Amos' accounting and  
8 inventory control of notes and coins to inherently encompass tracking the  
9 beginning inventories, receipts and distributions, and computing ending inventories  
10 of notes and coins, because these are among the conventions of generally accepted  
11 accounting principles.

12       These computations embrace totaling of notes and coins received. Similarly, a  
13 person of ordinary skill in the art would understand that such totals would be  
14 displayed for the purpose of auditing the recorded accounting results.

15       Amos' cash note accepting/dispensing device, by design of paper currency,  
16 cannot accept coins. Similarly, Amos' coin accepting/dispensing device, by design  
17 of metal coins, cannot accept paper currency.

18       Amos shows several embodiments that may be connected, beyond the ATM's,  
19 including personal computers and financial service institutions (col. 2, ll. 16-27).  
20 Such personal computers and financial service institutions would themselves  
21 separately be in communication with other networks, such as the internet.

22       Amos relies on communication by any network or networking architecture  
23 and/or protocols available to facilitate communications between multiple machines  
24 (col. 3, ll. 20-29).



1 not render claim 15 or the claims depending therefrom indefinite. Accordingly, we  
2 do not sustain the Examiner's rejection of claims 2-9 and 15-21 under 35 U.S.C.  
3 § 112, second paragraph, as rendering the claimed subject matter indefinite.

4  
5 *Claims 2-9 and 15-21 rejected under 35 U.S.C. § 103(a) as obvious over Amos,*  
6 *Watanabe, and Richardson.*

7 As regards independent claim 15, the above facts show that Amos describes a  
8 cash management system; a first cash handling device for processing notes  
9 including sorting of notes, totaling of notes received, and communicating note  
10 totals to at least one of: a second cash handling device, a visual display and  
11 communication through a network, wherein said first cash handling device does  
12 not have the capability to receive or dispense coins (the note accepting/distributing  
13 machine in one ATM); a second cash handling device for processing coins  
14 including sorting of coins, totaling of coins received, and communicating coin  
15 totals to at least one of: the first cash handling machine, a visual display and a  
16 network, wherein said second cash handling device does not have the capability to  
17 receive or dispense notes (the coin accepting/distributing machine in another  
18 ATM); and wherein said first cash handling device and said second cash handling  
19 device have respective circuits for communicating through a first wireless  
20 communication network (satellite communication) wherein the first cash handling  
21 device and the second cash handling device provide a cooperative cash  
22 management system in which the totals for notes and coins, respectively, are  
23 brought together through wireless communication from these respective devices  
24 and are displayed on at least one of the first cash handling device, the second cash

1 handling device, or a third device operating as a visual display (the inventory and  
2 accounting management features of Amos).

3 Although Amos does not show the network operating according to a network  
4 standard for locally distributed wireless networks operating without servers, it does  
5 show that any network system may be used. A network standard for locally  
6 distributed wireless networks operating without servers is a species that would be  
7 immediately envisaged within the taught genus of all network systems, because of  
8 its simplicity.

9 Watanabe serves to provide further evidence that an ATM such as that in Amos  
10 would sort its contents and safeguard physical entry of coins and notes to ensure  
11 each went to the proper device.

12 Richardson shows that such a simple network, coupled with wireless  
13 communication, was notoriously well known at the time of the invention and could  
14 operate within a range of no more than 100 meters from one of the first the first  
15 cash handling device and the second cash handling device. The actual limitation of  
16 separation of less than 100 meters does not affect the operation of the invention,  
17 but only serves to indicate the field in which the applicants envision practicing the  
18 invention. Whether the Appellants were the first to recognize a market for placing  
19 cash machines within such a range is moot because this range is a species of the  
20 genus of all ranges that wireless communications encompass, and Richardson  
21 suggests the advantages of such proximity in the choices of implementation modes  
22 available at the claimed ranges. Accordingly, this limitation is accorded minimal  
23 patentable weight, and is recognized as a limitation that the applied prior art must  
24 be capable of practicing.

1       It would have been obvious to a person of ordinary skill in the art to have  
2 applied Watanabe's ATM construction techniques to Amos because Watanabe  
3 shows implementation details of ATM's such as Amos. It would have been  
4 obvious to a person of ordinary skill in the art to have applied any of the wireless  
5 communication techniques of Richardson to Amos because Richardson  
6 demonstrates the notoriety of the wireless transmission taught by Amos, and also  
7 teaches several implementation details for such wireless transmission. Therefore  
8 we sustain the rejection of claim 15.

9       As regards claims 2 and 16, which add the limitation of a I/O device that  
10 communicates through the wireless network, Amos' keyboards and displays are  
11 such devices that operate through Amos' wireless network. Therefore we sustain  
12 the rejection of claims 2 and 16.

13       As regards claims 3, 4, and 18, which add the limitation of connection to a  
14 second network as well, Amos' alternate embodiments of personal computers and  
15 financial service institutions would provide such connections. Therefore we sustain  
16 the rejection of claims 3, 4, and 18.

17       As regards claims 5, 6, 7, 8, 9, 17, and 20, which add limitations of modes of  
18 wireless transmission of infrared, radio waves and Bluetooth, relying on the 2.4 to  
19 2.56 GHz spectrum, Richardson shows the notoriety of these modes, each of which  
20 are art recognized equivalents to one another. Each of these modes has its own  
21 strengths and weaknesses and would be selected according to routine optimization  
22 within the specific context of Amos' machines' placement. Therefore we sustain  
23 the rejection of claims 5, 6, 7, 8, 9, 17, and 20.

24       As regards claim 19, which adds the limitation of accepting unsorted batches of  
25 notes and coins, Watanabe specifically sorts the notes and coins that are deposited.

1 A batch is a quantity considered as a group (*Merriam Webster*). Therefore  
2 depositing a group of notes and coins, even one at a time, is a deposit of a batch.  
3 Therefore we sustain the rejection of claim 19.

4 Claim 21 was excluded from the rejection in all of the prior actions that  
5 rejected claims under this combination of art. This is the first instance of a  
6 rejection of claim 21 under this applied art. The Examiner has not provided any  
7 explanation as to how the art would read on claim 21. We can find no support in  
8 any of the applied references for a master-slave relationship between two cash  
9 machines connected by a wireless network.

10 Accordingly we sustain the Examiner's rejection of claims 2-9 and 15-20, but  
11 do not sustain the rejection of claim 21, under 35 U.S.C. § 103(a) as obvious over  
12 Amos, Watanabe and Richardson.

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#### DECISION

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To summarize, our decision is as follows:

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- The rejection of claims 2-9 and 15-21 under 35 U.S.C. § 112, second paragraph, as rendering the claimed subject matter indefinite is not sustained.

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- The rejection of claims 2-9 and 15-20 under 35 U.S.C. § 103(a) as obvious over Amos, Watanabe, and Richardson is sustained.

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- The rejection of claim 21 under 35 U.S.C. § 103(a) as obvious over Amos, Watanabe, and Richardson is not sustained.

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