

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HIROSHI OGINO

Appeal No. 2007-1672
Application No. 09/966,540
Technology Center 3600

Decided: August 3, 2007

Before MURRIEL E. CRAWFORD, HUBERT C. LORIN, and
STUART S. LEVY, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is an appeal from a decision of the Examiner rejecting claims 1-29. 35 U.S.C. § 134 (2002). We have jurisdiction under 35 U.S.C. § 6(b) (2002).

The Examiner has finally rejected

- Claims 7-13 and 15-17 under 35 U.S.C. § 112, second paragraph.
- Claims 1-4, 6-11, 13, 14, and 26 under 35 U.S.C. § 102(e) over Buckley (US 6,446,871).
- Claims 5 and 12 under 35 U.S.C. § 103(a) over Buckley in view of Ausems (US 6,434,403).
- Claims 15, 17, 18, 20-25, 27, and 29 under 35 U.S.C. § 103(a) over Buckley in view of Walker (US 6,163,771).
- Claims 16, 19, and 28 under 35 U.S.C. § 103(a) over Buckley and Walker in view of Peckover (US 6,119,101).

We AFFIRM.

The claims set forth Appellant's invention which relates to a transaction device comprising a sensor module for receiving product identification through a product tag and a communication module to transmit the product identification and device identifier associated with the transaction device to a product server through a privacy server. The privacy server conceals the identity of the user of the transaction device (Specification 5:[0016]-[0017]).

We have carefully reviewed the record.¹

Claims 7-13 under 35 U.S.C. § 112, second paragraph.

The claim at issue is claim 7:

¹ The record includes Appellants' Appeal Brief, filed Mar. 9, 2006, the Examiner's Answer, mailed Jun. 14, 2006, and Appellants' Reply Brief, filed Aug. 17, 2006.

7. An electronic transaction device comprising:
 - a sensor module configured to receive a product identification for a product through a product tag associated with the product;
 - a wireless module configured to transmit through a privacy system, the privacy system comprising a secure mechanism for correlating an identifier of the electronic transaction device with a user authorized to use the electronic transaction device; and a communication module configured to communicate the transaction device identifier and the product identification through the wireless module and the privacy system to perform a transaction for the product without providing an identification of a user of the transaction device.

A. ISSUE

The issue is whether the Examiner has made out a prima facie case that claim 7 does not comply with the second paragraph of 35 U.S.C. § 112 for being indefinite.

B. FINDING OF FACTS

The record supports the following findings of fact (FF) by a preponderance of the evidence.

1. The Examiner explains the basis for the rejection as follows:

“Claim 7 recites, a 'privacy system comprising a secure mechanism' ...” However, claim 7 is dedicated to a transaction device that does not comprise or contain a ‘privacy system.’”

(Answer 5).

2. The Examiner argues that “Appellant describes the device as a ‘privacy system that interacts with the claimed electronic transaction device’ (Remarks, 11-16-04, page 8). However, this description of the transaction device clearly contradicts the device as it appears in Appellant’s Specification (Specification, figure 5 and page/paragraphs 11/39-13/44)” (Answer 4 and 10).

C. PRINCIPLE OF LAW

The test for compliance with the second paragraph of 35 U.S.C. §112 is whether the claims set out and circumscribe a particular area with a reasonable degree of precision and particularity when read in light of the application disclosure as they would be interpreted by one of ordinary skill in the art. *In re Moore*, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971).

D. ANALYSIS

As best we understand it, the Examiner is arguing that while the body of the claim calls for a combination of transaction device and privacy system, the preamble directs the claim to the device alone. The Examiner appears to find the claim is internally inconsistent. We disagree.

The claim is drawn to a transaction device. The preamble clearly states that it is directed to “[a]n electronic transaction device comprising.” This is followed by the three elements that comprise the device: a sensor module, a wireless module, a communication module. The body of the

claims clearly states that the wireless module is “configured to transmit through a privacy system, the privacy system comprising a secure mechanism for correlating an identifier of the electronic transaction device with a user authorized to use the electronic transaction device.”

Accordingly, the claimed device interacts with the security system, it does not include it.

We are satisfied that claim 7 sets out and circumscribes a particular area with a reasonable degree of precision and particularity when read in light of the application disclosure as it would be interpreted by one of ordinary skill in the art.

E. CONCLUSION OF LAW

For the foregoing reason, we reverse the rejection of claims 7-13 under 35 U.S.C. § 112, second paragraph.

Claims 1-4, 6-11, 13, 14, and 26 under 35 U.S.C. § 102(e) over Buckley.

Appellant states that the claims stand or fall together, with claim 1 being representative (Appeal Br. 3). Claim 1 reads as follows:

1. A transaction device comprising:
 - a sensor module configured to receive a product identification for a product through a product tag; and
 - a communication module configured to transmit the product identification and a device identifier associated with the transaction device to a product server through a privacy server to obtain product

information from the product server without providing an identification of a user of the transaction device.

A. ISSUE

The issue is whether Appellant has shown error in the rejection.

B. FINDING OF FACTS

The record supports the following findings of fact (FF) by a preponderance of the evidence.

1. The Examiner found that

... Buckley et al. clearly disclose a transaction device (figure 3E; column/line 4/48-5/8) comprising a sensor module (e.g. barcode reader) (column 5, lines 9-37; column 6, lines 12-19) and a communication module (figures 4 and 5), that are configured to receive (e.g. product information) (figure 9; column 8, lines 27-44) and transmit data to servers (figures 4, 5, 8 and 9; column 9, lines 8-64 or inherently DNS, caching, and/or proxy servers), respectively. The device also receives data from servers based on the product identification (figures 4, 5, 8 and 9; column 10, lines 14-65), makes requests to purchase a product without providing an identifier of the user (column/line 5/62-6/13), stores retrieved product data (figure 9; column 10, lines 7-39; column/line 10/55-11/26).

(Answer 6).

2. Appellant did not dispute the Examiner's characterization of what Buckley discloses.

3. Appellant argued that “Buckley is completely silent on whether or not the user’s identity is revealed during the request” (Appeal Br. 4).
4. The Examiner did not dispute that Buckley does not explicitly mention *not* revealing the user’s identity. The Examiner responded as follows:

... Appellant asserts that Buckley et al. do not teach obtaining product information from the product server without providing an identification of a user of the transaction device. Buckley et al. disclose an interactive data transfer system comprising a pen, a data well, and a remote computer ('871, abstract; figures 2A, 3A-C and 4). Specifically, Buckley et al. teach a user scanning a barcode with a pen and storing the scanned barcode in pen memory ('871, column 6, lines 13-18). When the pen is ready to send the scanned barcodes over the internet ('871, figure 4), the pen interfaces with a data well and downloads the barcodes to the well ('871; figures 3A-E; column 6, lines 58-67) which sends the barcodes to a computer ('871, figure 3A) for transfer to a remote internet server ('871, figure 4). For example, Buckley et al. apply teaching scanning a product identifier (e.g. encyclopedia, newspaper, or item barcode) to obtain product information (e.g. encyclopedia information, ads, catalog website for placing an order for an item) ('871, figures 4, 5, and 9; column 9, lines 8-25; column 11, lines 45-50; column 12, lines 37-51). In each instance, the information conveyed from the pen to the data well to the computer to the internet server is the only barcode, hence Buckley et al. explicitly teach obtaining product information from a product server through a privacy server ('871, figure 5) without providing an identification of a user of the transaction device (i.e. pen and data well).

(Answer 11-12).

C. PRINCIPLE OF LAW

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

D. ANALYSIS

The issue is whether Buckley teaches the claimed communication module, i.e.,

a communication module configured to transmit the product identification and a device identifier associated with the transaction device to a product server through a privacy server to obtain product information from the product server without providing an identification of a user of the transaction device.

(Claim 1). Appellant did not argue that Buckley teaches a communication module configured to transmit product identification and a device identifier associated with the transaction device to a product server through a privacy server to obtain product information from the product server. Rather, Appellant argued that Buckley’s module does not teach a communication module configured to transmit the information “without providing an identification of a user of the transaction device.”

There is no dispute that Buckley does not disclose a communication module configured to provide the identification of a user. In fact, there is no mention of providing the identification of a user anywhere in the reference. On the other hand, Buckley does not expressly teach a communication module configured *not* to provide the identification of a user. We agree with

Appellant that the Examiner is taking the position that Buckley *inherently* teaches a communication module configured *not* to provide the identification of a user. In that regard, when a reference is silent about an asserted inherent characteristic, it must be clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). However, we find the Examiner has provided a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of Buckley and that it would be so recognized by persons of ordinary skill. *See Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Int. 1990).

As the Examiner has argued (FF 1 and 4), Buckley discloses an interactive data transfer system comprising a pen, a data well, and a remote computer and teaches obtaining product information from a product server through a privacy server (see Fig. 5). There is no indication that identification of a user of the transaction device (i.e., pen and data well) must or would be provided. One of ordinary skill would use the Buckley system without any expectation of having to provide his/her identification. One of ordinary skill would use the Buckley system in the manner described and the most efficient way of doing that would be to do it as described in the reference, which is without adding an additional step of providing his/her identification. We see no reason why one of ordinary skill using the Buckley device would include a step of providing identification when one of ordinary skill would have no reason to do so. We find that the normal

operation of the Buckley system, as it would be understood by persons of ordinary skill reading the Buckley patent, reasonably supports the determination that the absence of a step to provide his/her identification necessarily flows from the teachings of Buckley and that it would be so recognized by persons of ordinary skill. Accordingly, we find that the Buckley device is inherently configured to transmit the information “without providing an identification of a user of the transaction device.” We find that there are no differences between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. *Scripps Clinic & Research Found. v. Genentech Inc.*, 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991).

Accordingly, in our view, the Examiner has made out a prima facie case of anticipation for the claimed subject matter over Buckley. Since the Examiner has established a prima facie case of anticipation based on inherency, the burden shifts to the Appellant to prove that the subject matter shown to be in the prior art does not possess the characteristics of the claimed invention. *See In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985); *In re King*, 801 F.2d 1324, 1327, 231 USPQ 136, 138 (Fed. Cir. 1986). In that regard, Appellant has not shown that one of ordinary skill would *not* read Buckley as disclosing a transaction device comprising a communication module configured *not* to provide the identification of a user.

E. CONCLUSION OF LAW

For the foregoing reasons, we affirm the rejection of claims 1-4, 6-11, 13, 14, and 26 under 35 U.S.C. § 102(e) over Buckley.

Claims 5 and 12 under 35 U.S.C. § 103(a) over Buckley in view of Ausems.

Claims 15, 17, 18, 20-25, 27, and 29 under 35 U.S.C. § 103(a) over Buckley in view of Walker.

Claims 16, 19, and 28 under 35 U.S.C. § 103(a) over Buckley and Walker in view of Peckover.

The Appeal Brief addresses these rejections but argues in support of the patentability of claims 5, 12, 15-25, 27- and 29 for the same reason used in support of the patentability of claims 1-4, 6-11, 13, 14, and 26, namely that the prior art fails to show a device which does not reveal the user's identity (Appeal Br. 4-5). Since we have found that Appellant has failed to show that the Examiner erred in rejecting claims 1-4, 6-11, 13, 14, and 26 under 35 U.S.C. §102(e) over Buckley on the ground that Appellant did not show that one of ordinary skill would *not* read Buckley as disclosing a transaction device comprising a communication module configured *not* to provide the identification of a user, we likewise find that Appellant has failed to show that the Examiner erred in rejecting claims 5 and 12; 15, 17, 18, 20-25, 27, and 29; and, 16, 19, and 28, under 35 U.S.C. § 103(a) over Buckley in view of Ausems, Walker and Peckover, respectively.

No other arguments having been made, we affirm the rejections under 35 U.S.C. § 103(a).

DECISION

The decision of the Examiner to reject claims 7-13 under 35 U.S.C. § 112, second paragraph, is reversed.

The decision of the Examiner to reject claims 1-4, 6-11, 13, 14, and 26 under 35 U.S.C. § 102(e) over Buckley, claims 5 and 12 under 35 U.S.C. § 103(a) over Buckley in view of Ausems, and claims 15, 17, 18, 20-25, 27, and 29 under 35 U.S.C. § 103(a) over Buckley in view of Walker, and claims 16, 19, and 28 under 35 U.S.C. § 103(a) over Buckley and Walker in view of Peckover is affirmed.

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

AFFIRMED

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