UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SABUROU IKEDA

Appeal 2007-4043
Application 09/893,706
Technology Center 3600

Decided: June 30, 2008

Before WILLIAM F. PATE, III, MURRIEL E. CRAWFORD, and HUBERT C. LORIN, *Administrative Patent Judges*.

CRAWFORD, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

Appellant appeals under 35 U.S.C. § 134 (2002) from a final rejection of claims 1 to 20 and 23. Claims 21 and 22 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

Appellant invented an electronic toll payment system for a highway toll and a transportation management system (Specification 1).

Claim 1 under appeal reads as follows:

> 1. A toll payment system which comprises:
> a portable telephone on a car of a contractor of electronic toll payment service;
> base stations connected with said portable telephone; and
> a server connected with said base stations,
> wherein said server comprises:
> a first memory for storing locations of said base stations;
> a second memory for storing names of contractors or their car numbers and unit toll for each section along a highway;
> a driving route identification unit for identifying a driving route of said portable telephone on the basis of said locations of said base station which are connected with said portable telephone;
> a toll calculation unit for calculating a toll on the basis of said unit toll and the identified driving route; and
> a toll charging unit for charging said portable telephone the calculated toll.

The Examiner rejected claims 1 to 20 and 23 under 35 U.S.C. § 103(a) as being unpatentable over Treyz in view of Hassett.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Hassett	US 6,653,946 B1	Nov. 25, 2003
Treyz	US 6,711,474 B1	Mar. 23, 2004

Appellant contends that Treyz does not disclose a second memory for storing names of contractors or their car numbers.

Appellant also contends that Hassett does not disclose a toll calculation unit for calculating a toll on the basis of the unit toll that serves plural vehicles.

ISSUES

The first issue is whether the Appellant has shown that the Examiner erred in finding that Treyz discloses a second memory for storing names of contractors or their car numbers.

The second issue is whether the Appellant has shown that the Examiner in finding that Hassett discloses a toll calculation unit for calculating a toll on the basis of the unit toll that serves plural vehicles.

FINDINGS OF FACT

Treyz discloses a toll payment system which comprises a portable telephone, which is part of a personal computer 14, in a car of a person who has contracted for toll services (col. 45, ll. 50 to 54; col. 54, ll. 46 to 52). Base stations 56 are connected with the personal computer 14 (col. 11, ll. 3 to 10). A server on the contractor's personal computer 14 is connected with the base stations via a wireless connection (col. 17, l. 66 to col. 18, l. 3; Figure 2). The server includes a first memory for storing locations of the base stations (col. 11, ll. 51 to 56; col. 44, ll. 15 to 22). The server also includes a second memory on a digital camera 170 (Figure 3). Treyz discloses that the digital camera 170 is capable of capturing license plate images and may be placed in any suitable location (col. 78, ll. 8 to 32). Treyz discloses that tolls may be collected using the server (col. 54, ll. 31 to 52). A toll calculation unit at a toll collection facility for calculating the toll and the identified driving route is implicit and certainly suggested by the Treyz disclosure because the toll must be calculated before it is collected.

Hassett discloses a toll calculation unit for calculating a toll on the basis of a unit toll and the identified route (col. 4, ll. 31 to 33).

ANALYSIS

We are not persuaded of error on the part of the Examiner by the Appellants argument that Treyz does not disclose a second memory for storing names of contractors or their car numbers. Specifically, Appellants argue that the digital computer disclosed in Treyz captures images of the license plate of a car that may be tailgating the driver and thus the digital computer does not store images of *contractors* or the car numbers or names of the *contractors.*

We agree with the Examiner that the driver of the vehicle is a contractor as broadly claimed because this person has entered into a contract with the electronic payment service and that the license plate number of the driver is a car number. In addition, we agree with the Examiner that the memory of the digital camera is capable of storing the license plate number of the drivers or contractors because the camera as disclosed can be placed in any location which would include a location in which the driver's license plate number can be captured.

We note that the phrase is claim 1 of "for storing names of contractors or their car numbers" is a statement of intended use. The manner or method in which a machine is to be utilized is not germane to the issue of patentability of the machine itself. *In re Casey*, 370 F.2d 576, 580 (CCPA 1967). A statement of intended use does not qualify or distinguish the structural apparatus claimed over the reference. *In re Sinex*, 309 F.2d 488, 492 (CCPA 1962). There is an extensive body of precedent on the question of whether a statement in a claim of purpose or intended use constitutes a limitation for purposes of patentability. *See generally Kropa v. Robie*,

187 F.2d 150, 155-59 (CCPA 1951) and the authority cited therein, and cases compiled in 2 *Chisum, Patents* § 8.06[1][d] (1991). Therefore, as the digital camera of Treyz is capable of storing the car license numbers of the driver, Treyz meets this limitation of claim 1.

We are also not persuaded by Appellant's argument that Hassett does not disclose a toll calculation unit for calculating a toll on the basis of the unit toll that serves plural vehicles. Firstly, as Treyz discloses that a toll charge can be collected through the system, a toll calculation unit is implicit and certainly suggested by the Treyz disclosure alone. In addition, Treyz is being relied on for teaching a toll payment system that serves plural vehicles. Hassett is relied on for specifically teaching a toll calculation unit for calculating a toll on the basis of unit toll and identified driving route.

We are likewise not persuaded of error on the part of the Examiner by Appellant's arguments that Hassett does not disclose collection of tolls using a portable telephone or that Treyz does not disclose how the tolls are calculated, because the rejection is based on the combined teachings of Hassett and Treyz. In this regard, Treyz teaches collecting tolls using a portable telephone, and Hassett discloses that the tolls are collected based on the unit toll and identified driving route.

In view of the foregoing, we will sustain the Examiner's rejection as it is directed to claim 1. We will also sustain the Examiner's rejection as it is directed to claims 2 to 20 and 23 because the Appellant has not argued the separate patentability of these claims.

The decision of the Examiner 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) (2007).

AFFIRMED

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