UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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*Ex parte* XINHONG YUAN, STAN J. SIMON, ROBERT W. PRATT,
GREGORY R. WHITEHEAD, and ATUL TULSHIBAGWALE

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Appeal 2008-0846
Application 09/907,788
Technology Center 2100

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Decided: October 23, 2008

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Before JEAN R. HOMERE, JAY P. LUCAS, and STEPHEN C. SIU, *Administrative Patent Judges*.

SIU, *Administrative Patent Judge*.

DECISION ON APPEAL

I. STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1-33 and 41-58. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

## A. INVENTION

The invention at issue involves generating records and digital receipts for transactions (Spec. 1). In particular, a digital receipt corresponding to a computer transaction is stored. The digital receipt includes a description of the transaction, tamper-proof evidence of the occurrence of the transaction, and a verification prompt. Activation of the verification prompt verifies the tamper-proof evidence without requiring further human interaction (*id*. 3).

## B. ILLUSTRATIVE CLAIM

Claim 1, which further illustrates the invention, follows:

1. A computer readable medium for serving as a record of an occurrence of a transaction, the computer readable medium storing instructions for:

receiving a request from a requesting user to create a digital receipt of the transaction;

generating tamper-proof evidence of the transaction; and

creating a digital receipt of the transaction suitable for display to humans, the digital receipt comprising:

a description of the transaction in a format understandable by humans;

a tamper-proof evidence of the occurrence of the transaction; and

a verification prompt for display to the requesting user, activated by interaction of the requesting user, for verifying the tamper-proof evidence without requiring further human interaction to identify the tamper-proof evidence.

### C. REJECTIONS

Claims 1, 3, 4, 5, 7, 8, 17, 18, 21-23, 32, 33, 41, and 48 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,915,022 ("Robinson") and U.S. Patent No. 5,487,422 ("Tysen"). Claims 6, 20, and 50 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Robinson, Tysen and U.S. Patent No. 6,327,656 ("Zabetian"). Claims 2, 9, 19, 24, 42, 49, and 51 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Robinson, Tysen, and U.S. Patent No. 6,584,507 ("Bradley"). Claims 10-14, 16, 25-29, 31, 43, 44, 45, 47, 52-54, and 56-58 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Robinson, Tysen, Zabetian, and Bradley. Claims 15, 30, 46, and 55 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tysen, Zabetian, Bradley, and U.S. Patent No. 6,192,381 ("Stiegmeier"). Claims 34-40 have been cancelled.

## II. CLAIM GROUPING

> When multiple claims subject to the same ground of rejection are argued as a group by appellant, the Board may select a single claim from the group of claims that are argued together to decide the appeal with respect to the group of claims as to the ground of rejection on the basis of the selected claim alone. Notwithstanding any other

> provision of this paragraph, the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately.

37 C.F.R. § 41.37(c)(1)(vii) (2006).[1]

Appellants argue all claims, including claims 1, 3, 4, 5, 7, 8, 17, 18, 21-23, 32, 33, 41, and 48, as a group (App. Br. 4-6)[2] and do not provide additional arguments in support of claims 2, 6, 9, 10-16, 19, 20, 24-31, 42-47, and 49-58. Therefore, we select claim 1 as the sole claim on which to decide the appeal of claims 1-33 and 41-58.

## III. ANALYSIS

Appellants assert that "Robinson specifically teaches away from the customer performing verification" because Robinson "repeatedly states that a recipient of a digital receipt . . . should not be allowed to decrypt and verify the receipt . . . See Robinson at col. 2:47-50; col. 2:58-63; col. 5:8-11 . . . col. 5:18-24 . . . col. 6:2-5"" (App. Br. 4). Appellants further assert that "even if the user in Robinson were to obtain such a public key and decrypt the receipt, this would be a mere decryption, not a verification" and that

[1] We cite to the version of the Code of Federal Regulations in effect at the time of the Appeal Brief. The current version includes the same rules.

[2] Appellants rely solely on arguments presented for independent claims 1, 18, 41, and 48 in support of all dependent claims 2-17, 19-33, 42-47, and 49-58.

"Robinson specifically teaches that verification occurs when the merchant decrypts the transaction record . . . and compares it with a version stored in the merchant database" (App. Br. 5). Thus, Appellants assert that the "user obviously does not have access to the merchant version of the receipt stored in the database, so cannot perform verification" (App. Br. 5).

Robinson discloses a "customer computer **96** communicates to merchant computer **98** that the customer wishes to place an order" (col. 3, ll. 45-47); the merchant computer generating "a confirmation number" (col. 4, ll. 16-17), and "a transaction record is created" (col. 4, l. 25). The transaction record "is encrypted" (col. 5, l. 12) and "is preferably not . . . decryptable by the customer" (col. 5, ll. 21-22). Thus, the transaction record of Robinson is "tamper-proof" (i.e., not decryptable) as recited in claim 1.

Robinson also discloses that "a customer may present the digital receipt back to the merchant for authentication of the transaction" (col. 8, ll. 29-31) "whenever he wishes to verify that a particular transaction took place" (col. 8, ll. 34-35). When the customer "presents a digital receipt page to the merchant computer" (col. 8, ll. 38-39), "the transaction record is decrypted by the merchant computer and the transaction information is extracted" (col. 8, ll. 45-47). This information "is compared to information previously stored on the database" and if "the information corresponds sufficiently . . . the digital receipt is verified" (col. 8, ll. 58-63). Thus,

Robinson discloses that a customer (i.e., "requesting user") requests verification of a transaction record by presenting a corresponding digital receipt page to the merchant computer. In response, the merchant computer verifies the digital receipt.

Claim 1 recites instructions on a computer readable medium creating a digital receipt of a transaction comprising a verification prompt that is activated by interaction of the requesting user for verifying tamper-proof evidence. Claim 1 does not recite the customer performing verification, decrypting or verifying the receipt. Rather, claim 1 merely requires that a verification prompt is activated by a requesting user and that verification of the tamper-proof evidence is performed without requiring further human interaction. Because Robinson discloses a customer activating a request for verification (i.e., a verification prompt is activated by the requesting user) and the verification (by the merchant computer) is performed without requiring further human interaction, we disagree with Appellants' contention that Robinson fails to disclose or suggest creating a digital receipt of a transaction containing a verification prompt activated by interaction of a requesting user for verifying tamper-proof evidence.

In addition, Tysen also discloses that a "recipient may check the authenticity of the received message **202** merely by clicking on the icon **304**" (col. 9, ll. 53-55). Hence, we agree with the Examiner that it would have been obvious to one of ordinary skill in the art, given the Robinson

disclosure of a requesting user activating and interacting with a system to verify evidence of a transaction, to check the authenticity of the transaction by interacting with a verification prompt for display (i.e., "by clicking on the icon").

Appellants also argue that "providing a receipt recipient with an ability to not only decrypt the receipt, but to also verify the receipt, as proposed by the Final Rejection through combination of Robinson and Tysen, would render Robinson unsatisfactory for its intended purpose of the customer presenting the receipt to the merchant for authentication of the transaction" (App. Br. 6).

As set forth above, Robinson discloses a system in which "a customer may present the digital receipt back to the merchant for authentication of the transaction" (col. 8, ll. 29-31) "whenever he wishes to verify that a particular transaction took place" (col. 8, ll. 34-35). Thus, the intended purpose of one aspect of the Robinson system is to enable a customer to verify or authenticate a transaction. Tysen discloses that a "recipient may check the authenticity of the received message **202** merely by clicking on the icon **304** in the get info box **302**" (col. 9, ll. 53-54). Hence, the intended purpose of this aspect of Tysen, like Robinson, is to enable a customer to check, verify, or authenticate a received message. Because both the systems of Robinson and Tysen share the same intended purpose of providing a customer or user with a method for authenticating or verifying data and both involve a

verification prompt for display to the requesting user (i.e., the customer presents the digital receipt back to the merchant in Robinson and the customer clicks an icon in a get info box in Tysen), we disagree with Appellants that Tysen renders Robinson unsatisfactory for its intended purpose.

It follows that Appellants have failed to demonstrate that the Examiner erred in rejecting claim 1. We therefore affirm the rejection of claim 1, and of claims 2-33 and 41-58, which fall therewith.

## VI. ORDER

In summary, the rejections of claims 1-33 and 41-58 under § 103(a) are affirmed.

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

AFFIRMED

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