

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RONALD LOURIE

Appeal 2008-1463
Application 09/884,868
Technology Center 3600

Decided: September 8, 2008

Before MURRIEL E. CRAWFORD, JENNIFER D. BAHR, and DAVID B.
WALKER, *Administrative Patent Judges*.

WALKER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant seeks our review under 35 U.S.C. § 134 of the Examiner's final rejection of claims 1-5. We have jurisdiction under 35 U.S.C. § 6(b)(2002). We affirm.

Appellant claims an anonymous transaction method that enables an individual to make purchases in a secure manner, with minimal risk, and without sacrificing convenience (Specification 9:2-4). Claim 1, reproduced below with disputed claim limitations in bold typeface, is representative of the subject matter on appeal.

1. An **anonymous method of transaction**, said method comprising:

providing a card of predetermined denominational value having an indicia of identification associated with said card and said value;

providing an electronic means for transmitting information;

issuing said card to a consumer
anonymously in exchange for payment by said consumer of said predetermined denominational value associated with said card;

presenting said card to a merchant as transactional payment to said merchant for a transaction of goods or services, wherein said transactional payment by said consumer to said merchant is less than or equal to said predetermined denominational value associated with said card;

verifying said card by transmitting with said electronic means said indicia of identification and the amount of said transactional payment by said consumer to said merchant, to a card issuing authority;

issuing with said electronic means an approval code from said card issuing authority to said merchant;

completing said transaction with said merchant by providing said goods or services to said consumer; and

transferring funds from said card issuing authority to said merchant in the amount of said transactional payment from said consumer to said merchant

THE REJECTION

The Examiner relies upon the following as evidence in support of the rejection:

Risafi

US 6,473,500 B1

Oct. 29, 2002

Claims 1-5 stand rejected under 35 U.S.C. § 102(e) as anticipated by Risafi.

ISSUE

The dispositive issue is whether the Examiner erred in rejecting claims 1-5 as anticipated by Risafi. The issue turns on the construction of “anonymous[-ly].”

Rather than repeat the arguments of Appellant or the Examiner, we make reference to the Briefs and the Answer for their respective details. Only those arguments actually made by Appellant have been considered in this decision. Arguments which Appellant could have made but chose not to make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2007).

FINDINGS OF FACT

We find the following enumerated findings to be supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

1. The plain meaning of “anonymous” is “having an unknown or unacknowledged name: *an anonymous author*.” See anonymous. *The American Heritage® Dictionary of the English Language, Fourth Edition* (Houghton Mifflin Company, 2004).
2. Appellant’s Specification describes an anonymous transaction. According to the Specification, “[t]he transaction would involve only the exchange of the card and the payment, with no communication of personal information. In other words, the transaction is completely anonymous.” (Specification 9:20-22).
3. The Specification provides no lexicographic definition of “anonymous” or “anonymously.”
4. Risafi discloses a system for using a prepaid card that permits a card user to purchase a card through an agent at a retail establishment via a terminal, select a PIN, have the card activated at the point of purchase, use the card to purchase goods and services, and reload the card for future use (Risafi, abstract).
5. Risafi describes a known method of using a prepaid card where the value of the card can be stored either in the memory of the card itself or in a central host, which can be accessed using information stored on a magnetic stripe on the back of the card. Verification of the

- identity of the purchaser of the card typically is not required. (Risafi, col. 1, l. 54 – col. 2, l. 8).
6. Risafi teaches that “the card is more secure than a cash card because a PIN or verified signature *may* be required in order to use it” (Risafi, col. 7, ll. 51-53) (emphasis added).
 7. Risafi also notes that “[i]t is noteworthy that card **100** does not necessarily include card user **10**’s name” (Risafi, col. 11, ll. 16-17).

PRINCIPLES OF LAW

We determine the scope of the claims in patent applications “not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction ‘in light of the specification as it would be interpreted by one of ordinary skill in the art.’” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316 (Fed. Cir. 2005) (en banc) (*quoting In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004)). We must be careful not to read a particular embodiment appearing in the written description into the claim if the claim language is broader than the embodiment. *See Superguide Corp. v. DirecTV Enterprises, Inc.*, 358 F.3d 870, 875 (Fed. Cir. 2004)(“Though understanding the claim language may be aided by explanations contained in the written description, it is important not to import into a claim limitations that are not part of the claim. For example, a particular embodiment appearing in the written description may not be read into a claim when the claim language is broader than the embodiment”). The challenge is to interpret claims in view of the specification without unnecessarily importing limitations from the specification into the claims.

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See E-Pass Techs., Inc. v. 3Com Corp., 343 F.3d 1364, 1369 (Fed. Cir. 2003).

We remind appellants that it is their burden to precisely define the invention, not that of the examiner. *In re Morris*, 127 F.3d 1048, 1056 (Fed. Cir. 1997). Appellants always have the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. *In re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969).

“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. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 827 (1987).

ANALYSIS

The Appellant argues claims 1-5 as a group. We treat claim 1, the only independent claim, as representative.

The Appellant and the Examiner dispute the meaning of the term “anonymous[-ly]” as used in the bolded portions of claim 1 above. The Appellant argues that the Specification provides a definition of the term “anonymous[-ly]” as it applies to the step of issuing a card (Br. 4; Reply Br. 4; quoting Specification 9-10). The quoted portion of the Specification reads: “The transaction would involve only the exchange of the card and the payment, with no communication of personal information. In other words, the transaction is completely anonymous” (Finding of Fact 2). The Appellant argues that the Examiner’s definition of anonymous in the Final

Office Action (which relies on the same section of the Specification) is erroneous (Br. 3-4). According to the Examiner:

Therefore, prior art will be interpreted to disclose applicant's

. . . *anonymous* method of transaction. . .

. . . *issuing* said card to a consumer *anonymously* in exchange for payment by said consumer of said predetermined denominational value associated with said card . . .

where prior art discloses purchasing a card by providing payment in cash, or

where prior art discloses prepaid card(s) where verification of a purchaser's identify is not required, or

where an individual purchases a prepaid card at a card dispensing device.

(Final Office Action 4; Answer 3-4).

The Appellant argues that use of information personal to the purchaser, such as a PIN, may not rise to the level of verification of personal identification (thereby meeting the Examiner's definition of anonymity), but would not be anonymous in the sense used in the claimed invention, because it would include the use of information personal to an individual (Br. 4). According to the Appellant, the key is not if a device is used, but rather whether there is an exchange of personal information (*Id.*). Appellant argues that using a PIN is contrary to completing a transaction with no communication of personal information, which he argues is part of the definition of anonymous given in the Specification (Br. 5). Appellant argues that Risafi consistently teaches issuing the card along with a PIN (citing Risafi, Abstract; col. 3, ll. 58-68; col. 4, ll. 17-22; col. 6, ll. 40-45).

According to Appellant, Risafi does not indicate anywhere that the card can be used without a PIN (Br. 5).

The Examiner found that Risafi discloses issuing a card to a consumer anonymously as required by claim 1 at column 1, line 54 – column 2, line 8, and also points to references to card dispensing devices at column 6, lines 38-58, and references to purchasing cards via cash payments in support of that finding (Answer 4). The Appellant concedes that the pre-paid cards of Risafi, column 1, line 54 – column 2, line 8, can be issued without the exchange of personal information, but argues that those cards otherwise fail to meet the limitations of claim 1 (Br. 5). In particular the Appellant argues that prepaid cards do not utilize the required verification step, issuance of an approval code step, or the transfer of funds from a card issuing authority step (*Id.*). We need not reach this argument because we find, as discussed more fully below, that a card can be issued to a customer anonymously even when a PIN is employed.

The Examiner found that Risafi provides a PIN number and no personal information, and applied the ordinary meaning and broadest reasonable interpretation of “anonymous[-ly],” because the Appellant provides no explicit definition of the term in the Specification (Answer 6). We agree with the Examiner (Finding of Fact 5). The passage cited by the Appellant as a definition uses the term “anonymous,” but does not appear to be a lexicographic definition (Findings of Fact 2 and 3).

Neither the Appellant nor the Examiner proffers a dictionary definition, but the Appellant’s definition is narrower than the ordinary meaning of the term, which we find to be “having an unknown or unacknowledged name” (Finding of Fact 1). This definition is consistent

with the passage of the Specification cited by the Appellant (Finding of Fact 2) and represents the broadest reasonable interpretation in light of the Specification as it would be interpreted by one of ordinary skill in the art. As such, we find the use of a PIN, which communicates no name or identity of a user, would not preclude an anonymous transaction. Moreover, Risafi teaches that the card is more secure than a cash card because a PIN or verified signature *may* be required in order to use it (Finding of Fact 6), implying that the use of a PIN is optional. Risafi also notes that “[i]t is noteworthy that card **100** does not necessarily include card user **10**’s name” (Finding of Fact 7).

Without a clear lexicographic definition in the Specification (Finding of Fact 3), we decline the Appellant’s invitation to read limitations from the Specification into the claims, where the claim is broader than the example in the Specification. *See Superguide Corp.*, 358 F.3d at 875. The Appellant’s entire argument relies on his definition of “anonymous[-ly],” which we find to be inconsistent with the broadest reasonable interpretation. We find no error in the Examiner’s claim interpretation of “anonymous[-ly],” which is consistent with the broadest reasonable construction of the terms in light of the specification as it would be interpreted by one of ordinary skill in the art.

The Appellant therefore has not shown error in the Examiner’s rejection of claim 1. Claims 2-5 are not argued separately and, thus fall with claim 1. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2007). *See also Young*, 927 F.2d at 590.

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CONCLUSIONS

We conclude that Appellants have not shown that the Examiner erred in rejecting claims 1-5 under 35 U.S.C. § 102(e) as anticipated by Risafi.

DECISION

The decision of the Examiner to reject claims 1-5 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). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

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