

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARGARET MORGAN WEICHERT, JOHN JOSEPH
MASCAVAGE III, DAVID L. HANSEN, MARK D. BAUMGART,
PETER M. KARAS, and RICHARD G. WILBER

Appeal 2008-1591
Application 10/262,053
Technology Center 3600

Decided: July 9, 2008

Before MURRIEL E. CRAWFORD, LINDA E. HORNER, and
MICHAEL W. O'NEILL, *Administrative Patent Judges*.

O'NEILL, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

Appellants' appeal under 35 U.S.C. § 134 (2002) from a final rejection of claims 1 to 19. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

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Appellants' invention relates to providing cash payments to merchants in exchange for goods or services offered by the merchant regardless of the type of payment instrument used to tender payment by their customers.
(Spec. ¶ 06.)

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

Vallee	US 6,014,646	Jan. 11, 2000
Kravitz	US 6,029,150	Feb. 22, 2000
Slater	US 6,098,053	Aug. 1, 2000
Moreau	US 2002/0069166 A1	Jun. 6, 2002
Pinell	EP 1 077 436 A2	Feb. 21, 2001

O'Mahony et al., *Electronic Payment Systems*, 61-122 (1997).

The Examiner rejected under 35 U.S.C. § 103(a):

1) claims 1, 2, and 14 as being unpatentable over Kravitz in view of Moreau.

2) claims 3 to 6 and 19 as being unpatentable over Kravitz and Moreau in view of Pinell.

3) claims 7 to 11 as being unpatentable over Kravitz, Moreau, and Pinell in view of Slater.

4) claim 12 as being unpatentable over Moreau in view of Slater.

5) claim 13 as being unpatentable over Moreau and Slater in view of Vallee.

6) claim 15 as being unpatentable over Kravitz and Moreau in view of O'Mahony et al.

7) claims 16 to 18 as being unpatentable over Kravitz and Moreau in view of O'Mahony et al., and further in view of Slater.

DECISION

We have carefully reviewed the rejections on appeal in light of the arguments of the Appellants and the Examiner. Because of this review, we have reached the conclusion that the applied prior art does not establish the *prima facie* obviousness of the claimed subject matter. Therefore, the rejections on appeal are not sustained. Our reasons follow.

For claim 1 (and 14), the disagreement between the Appellants and the Examiner is whether:

1) Kravitz discloses a process including the steps of receiving, at an ordering system, payment information relating to a payment instrument being used to provide payment for an Internet purchase of a good or a service; transmitting from the ordering system a message to a merchant that includes information on the good or service being purchased to permit the merchant to provide the good or service; and collecting funds from an account associated with the payment instrument; and

2) Moreau teaches the step of transmitting a money transfer request from the ordering system to a money transfer computer system operable to process requests to transfer monetary values to designated recipients independently of a banking account of the recipients, the money transfer request including information usable by the money transfer computer system to provide a cash payment to the merchant for the Internet purchase, so that a

cash payment is made rather than a deposit to a bank account of the merchant.

Regarding the process step involving receiving payment information at an ordering system related to the payment instrument used, the Examiner finds that Kravitz discloses this step at column 12, lines 45-56 (Ans. 4). For the step of transmitting a message to the merchant that includes information on the item purchased, the Examiner finds Kravitz discloses this step at column 12, lines 56-59. For the step of collecting funds from the account associated with the payment instrument, the Examiner finds Kravitz discloses this step at column 12, line 60 to column 13, line 12. For the step of transmitting a money transfer request whereby the request process is independent of banking accounts associated with either the customer or merchant and the request process includes information in order to provide a cash payment to the merchant, the Examiner finds Moreau teaches this process at various locations within Moreau, paragraphs 0028, 0032, 0036-37, and 0052-57.

The Appellants contend Kravitz discloses a system for purchasing goods where the merchant ships the goods after receiving an authenticated digital payment advice. Additionally, the Appellants contend the customer in Kravitz is not using a payment instrument. Further, the Appellants contend Kravitz discloses that the payments are not made in cash, but deposited into a bank account. (App. Br. 6.) The Appellants also contend the Examiner has mischaracterized Moreau. The Appellants' characterization of Moreau is after a customer orders a good, the customer visits a collection agent. The customer makes a payment to this agent. The payment is withdrawn from the agent's bank account and is deposited to the

merchant's bank account. In addition, the Appellants contend Moreau discloses a process where the customer visits an agent to make a payment, as compared to the Appellants' invention where the merchant visits an agent to collect cash. (App. Br. 6-7.)

We do not agree with the Examiner's findings. In our view, the Appellants' characterization reflects the proper scope and content of Kravitz and Moreau. From our reading of these references, we find that Kravitz and Moreau do not disclose or teach the claimed limitations at the particular portions where the Examiner has directed our attention to support the Examiner's rejections. Moreover, the Examiner has not provided an explanation or analysis as to how these portions satisfy or meet the claimed limitations. Instead, the Examiner has cited to these portions and baldly concluded these portions meet the claim limitations.

Our understanding of Kravitz, at the portions of the reference to which the Examiner has directed our attention, is in accord with the Appellants' characterization of Kravitz. Kravitz at column 12, line 45 to column 13, line 12 discloses the following process: initiating a payment sequence by sending a digital signal that identifies the purchased good and the price; a confirmation by the customer triggers sending a digital payment request to a customer's transfer application (CTA); receipt of the request and its acceptability causes execution of an intent to transfer funds from the customer's account to the merchant's clearing corporation (MCC); and at some point in time after the CTA performs checks to verify a merchant's standing, an actual transfer of funds occurs from the customer's bank to the MCC or an account held by the MCC at a bank. From our review of Kravitz and the lack of explanation by the Examiner, we fail to find where within

Kravitz, again, at the particular portions to which the Examiner has directed our attention: 1) the claimed steps the Examiner finds Kravitz discloses and 2) the structure within said portions of Kravitz that would meet the claimed limitations of an ordering system and a payment instrument recited in claim 1. While we do find that Kravitz describes the intent to transfer as having the characteristics of an exchange of cash, that being, such intent is instantaneous, final, and non-appealable, see column 12, lines 64-66, in which Kravitz does not disclose a cash payment made to a merchant regardless of the payment instrument used by the customer.

Similarly, our understanding of the portions of Moreau to which the Examiner has directed our attention for finding the step of transmitting a money transfer request whereby the request process is independent of banking accounts associated with either the customer or merchant is in accord with the Appellants' characterization of Moreau. From our review of these portions of the reference, Moreau discloses an explanation of an illustration of computers, paragraph 0028, a means of communication by a communication interface, paragraph 0028, consumers selecting a collection agent to tender payment, paragraphs 0036-37, and a sample transaction of the customer: ordering a good from a merchant, selecting and visiting a collection agent, tendering payment to the agent, the collection agent forwarding payment to the merchant, and the merchant shipping the good, paragraphs, 0052-0057. Again, based on our review of Moreau and the lack of an explanation by the Examiner, Moreau does not disclose the claimed limitation of transmitting the money transfer request from the ordering system to a money transfer computer system within the portions of Moreau to which the Examiner has directed our attention. In addition, Moreau does

not disclose the claimed limitations of an ordering system and a money transfer computer system operable to process the money transfer requests within the portions of Moreau to which the Examiner has directed our attention.

For claim 12, the disagreement between the Appellants and the Examiner is whether:

- 1) Moreau teaches the steps of receiving at a money transfer computer system a request to make a cash payment to a merchant independent from the bank account, and
- 2) Slater teaches transmitting from the transfer computer to the merchant a cash pick-up identifier; receiving at a money transfer location the identifier from the merchant; and making the cash payment to the merchant.

The Examiner finds that Moreau discloses the claimed steps of receiving a request to make a cash payment to a merchant, paragraph 0053, and transmitting to the merchant a cash pick-up identifier, paragraphs 0068 to 0073. In addition, the Examiner finds that Slater teaches the claimed steps of receiving the cash pick-up identifier and making the cash payment. (Ans. 12.)

The Appellants incorporate by reference their previous contentions with respect to Moreau and further contend neither Moreau nor Slater disclose or teach a money transfer system for making a cash payment to a merchant independently of a merchant's bank account. Moreover, the Appellants contend Slater, like Moreau, discloses making payments to a merchant's bank account. (App. Br. 7.)

We do not agree with the Examiner's findings. In our view, the Appellants' characterization reflects the proper scope and content of Moreau and Slater. From our review, we find that Moreau and Slater do not disclose or teach the steps at the particular portions where the Examiner has directed our attention. Moreover, the Examiner has not provided an explanation or analysis as to how these portions satisfy or meet the claimed limitations. Instead, the Examiner has cited to these portions and baldly concluded these portions meet the claim limitations.

Our understanding of Moreau, at the particular portions the Examiner has relied upon to meet the claimed steps, discloses a customer ordering or selecting a good, paragraph 0053, the merchant providing a transaction code to the consumer, the consumer presenting the transaction code and payment to a collection agent, the collection agent forwarding payment to the merchant, and the merchant, after receiving payment, shipping the good to the customer, paragraphs 0068-69. In addition, Moreau discloses if the consumer is going to pay with cash, another entity called a facilitator is involved in the transaction, paragraphs 0070-73. Our understanding of Slater, at the particular portions the Examiner has relied upon to meet the claimed steps, discloses the quick settlement of purchaser's and merchant's accounts, column 10, lines 59-67, and the time it takes to receive a credit from a debit because of gaining a float revenue, column 2, lines 64-67, leads to wait and uncertainty for the merchant because of float or insufficient funds, column 3, lines 1-11. Additionally, Slater discloses the system does not require an account relationship between the parties involved in the financial transaction, thus making the system have universally acceptable on-line transactions, column 4, lines 20-31.

Accordingly, based on our understanding of Moreau and Slater and the Examiner's lack of explanation in applying Moreau and Slater to the claimed limitations of claim 12, we fail to find Moreau and Slater disclose or teach the claimed limitations within claim 12.

On the record before us, Appellants have met the burden of establishing that the Examiner erred in rejecting under 35 U.S.C. § 103(a):

- 1) claims 1, 2, and 14 as being unpatentable over Kravitz in view of Moreau;
- 2) claims 3 through 6 and 19 as being unpatentable over Kravitz and Moreau in view of Pinell;
- 3) claims 7 through 11 as being unpatentable over Kravitz, Moreau, and Pinell in view of Slater;
- 4) claim 12 as being unpatentable over Moreau in view of Slater;
- 5) claim 13 as being unpatentable over Moreau and Slater in view of Vallee;
- 6) claim 15 as being unpatentable over Kravitz and Moreau in view of O'Mahony et al; and
- 7) claims 16 though 18 as being unpatentable over Kravitz and Moreau in view of O'Mahony et al., and further in view of Slater.

The decision of the Examiner is reversed.

REVERSED

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