

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN CHERMESINO

Appeal 2008-3759
Application 10/756,632
Technology Center 3600

Decided: December 3, 2008

Before MURRIEL E. CRAWFORD, HUBERT C. LORIN, and
JOSEPH A. FISCHETTI, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

John Chermesino (Appellant) seeks our review under 35 U.S.C. § 134 of the final rejection of claims 1-7, 9-19, 21, and 22. Claims 8 and 20 have been cancelled. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM.¹

THE INVENTION

“Embodiments of the present invention relate to retail purchase. More specifically, embodiments of the present invention relate to a self-service shopping environment.” (Specification 1:4-6.)

Due to the recognized difficulties with current self-checkout systems, most self-checkout lines are manned by at least one employee who advises customers what to do and helps fix any errors or issues as they arise.

Accordingly, a more efficient way of progressing a customer through a shopping experience is desirable.

(Specification 2:20-25.)

In general, embodiments of the present invention allow customers to buy an item or items at several locations throughout a store without having to proceed to a central checkout line. In one embodiment, a customer logs in to a computing system prior to shopping and receives a mobile personal identifier. The system then recognizes the customer throughout the store. When the customer is ready to purchase an item, the customer scans an item at one of the plurality of scanning kiosks located throughout the store. Prior to, or during the scanning of the item, the scanning kiosk will also receive a transfer of data from the mobile personal identifier carried by the

¹ Our decision will make reference to the Appellant’s Appeal Brief (“App. Br.,” filed Jun. 21, 2007) and Reply Brief (“Reply Br.,” filed Nov. 16, 2007), and the Examiner’s Answer (“Answer,” mailed Sep. 13, 2007).

customer. The mobile personal identifier will provide the scanning kiosk with the appropriate data necessary to perform a purchase (e.g., payment information). In one embodiment, if the customer has a plurality of items to shop for and desires to defer payment until the shopping is complete, the system will also maintain an electronic shopping cart for the customer. When a customer completes the shopping and has scanned and accepted all items at any or all of the plurality of scanning kiosks, and completes the purchase, the customer then returns the mobile personal identifier and departs the store with goods in hand.

(Specification 5:17-34.)

Claim 1, reproduced below, is illustrative of the subject matter on appeal.

1. A method for self-service shopping, said method comprising:
 - receiving a user profile at a mobile personal identifier, wherein said mobile personal identifier is a user's personal handheld mobile device;
 - receiving to said mobile personal identifier directions to an item;
 - providing an alert from said mobile personal identifier when said mobile personal identifier has reached the location of said item;
 - receiving an item description at one of a plurality of second computing systems located throughout a shopping environment;
 - receiving said user profile at said one of said second computing systems from said mobile personal identifier; and

performing a transaction utilizing said user profile and said item description at said one of said second computing systems, wherein said transaction is a self-service shopping transaction.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

| | | |
|-----------|-----------------|---------------|
| Matsumori | US 6,179,206 B1 | Jan. 30, 2001 |
| O'Hagan | US 6,314,406 B1 | Nov. 6, 2001 |
| Tracy | US 5,979,757 | Nov. 9, 1999 |
| Fano | US 6,317,718 B1 | Nov. 13, 2001 |

New Plastic-Payment System Arrives, 6 CTS Accounting Software Survey 7 (Oct. 13, 1987) (Hereinafter referred to as "New System").

The following rejections are before us for review:

1. Claims 1, 9-13, 15, 16, 17, 19, and 21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Matsumori and O'Hagan.
2. Claims 2, 4-7, 14, and 18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Matsumori, O'Hagan, and Tracy.
3. Claim 3 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Matsumori, O'Hagan, and New System.
4. Claim 22 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Matsumori, O'Hagan, and Fano.

ISSUES

The issue is whether the cited prior art suggests or discloses the claimed "personal handheld mobile device." The issue turns on the meaning to be given the "personal handheld mobile device." Does the claimed

“personal handheld mobile device” cover the customer ID card described in Matsumori?

FINDINGS OF FACT

We find that the following enumerated findings of fact (FF) are 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).

Claim construction

1. Claim 1 calls for a “user’s personal handheld mobile device.”
2. The Specification does not provide a definition for “user’s personal handheld mobile device.”
3. The ordinary and customary meaning of “user” is “[o]ne that uses.” (See *The American Heritage® Dictionary of the English Language: Fourth Edition*, 2000 (www. Bartleby.com.)(Entry for “user.”))
4. The ordinary and customary meaning of “personal” is “[o]f or relating to a particular person.” (See *The American Heritage® Dictionary of the English Language: Fourth Edition*, 2000 (www. Bartleby.com.)(Entry for “personal.”))
5. The ordinary and customary meaning of “handheld” is “[c]ompact enough to be used or operated while being held in the hand or hands.” (See *The American Heritage® Dictionary of the English Language: Fourth Edition*, 2000 (www. Bartleby.com.)(Entry for “hand-held.”))

6. The ordinary and customary meaning of “mobile” is “[c]apable of moving or of being moved readily from place to place.” (*See The American Heritage® Dictionary of the English Language: Fourth Edition, 2000* (www. Bartleby.com.)(Entry for “mobile.”))
7. The ordinary and customary meaning of “device” is “[a] contrivance or an invention serving a particular purpose, especially a machine used to perform one or more relatively simple tasks.” (*See The American Heritage® Dictionary of the English Language: Fourth Edition, 2000* (www. Bartleby.com.)(Entry for “device.”))
8. There is no evidence in the record showing what those of ordinary skill in the art would understand the phrase “user’s personal handheld mobile device” to mean.
9. There is no evidence on the record that one of ordinary skill in the art would attribute to the phrase “user’s personal handheld mobile device” a meaning different from the one the Examiner has given it.

The scope and content of the prior art

10. Matsumori relates to an electronic shopping system employing a customer ID card.
11. O’Hagan relates to a customer information network.
12. Tracy relates to a system for presenting item information using a portable data terminal.
13. Fano relates to a system using PDA and GPS enabled information gathering agent to create customized offer information.

14. New System relates to a method of making transactions involving the use of a card.

Any differences between the claimed subject matter and the prior art

15. The claimed subject matter appears to combine in a single method steps and elements separately disclosed in the cited prior art.

The level of skill in the art

16. Neither the Examiner nor the Appellant has addressed the level of ordinary skill in the pertinent art of self service shopping. We will therefore consider the cited prior art as representative of the level of ordinary skill in the art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (“[T]he absence of specific findings on the level of skill in the art does not give rise to reversible error ‘where the prior art itself reflects an appropriate level and a need for testimony is not shown’”) (Quoting *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985)).

Secondary considerations

17. There is no evidence on record of secondary considerations of non-obviousness for our consideration.

PRINCIPLES OF LAW

Claim Construction

During examination of a patent application, a pending claim is given the broadest reasonable construction consistent with the specification and should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004).

[W]e look to the specification to see if it provides a definition for claim terms, but otherwise apply a broad interpretation. As this court has discussed, this methodology produces claims with only justifiable breadth. *In re Yamamoto*, 740 F.2d 1569, 1571 (Fed. Cir. 1984). Further, as applicants may amend claims to narrow their scope, a broad construction during prosecution creates no unfairness to the applicant or patentee. *Am. Acad.* 367 F.3d at 1364.

In re ICON Health and Fitness, Inc., 496 F.3d 1374, 1379 (Fed. Cir. 2007). Limitations appearing in the specification but not recited in the claim are not read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed. Cir. 2003).

Obviousness

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 127 S. Ct. at 1734 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”) The Court in *Graham* further noted that evidence of secondary considerations “might

be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” 383 U.S. at 17-18.

ANALYSIS

The rejection of claim 1, 9-13, 15, 16, 17, 19, and 21 under § 103(a) as being unpatentable over Matsumori and O’Hagan.

The Appellant argued claims 1, 9-13, 15, 16, 17, 19, and 21 as a group (App. Br. 8-11). We select claim 1 as the representative claim for this group, and the remaining claims 9-13, 15, 16, 17, 19, and 21 stand or fall with claim 1. 37 C.F.R. § 41.37(c)(1)(vii) (2007).

The Appellant makes a single argument.

Appellant respectfully submits that the “user’s personal handheld mobile device” words of the claim must be given their plain meaning. As such, the words of the present Claims 1, 9 and 17 plainly and clearly teach away from a customer loyalty club card, a customer ID card, a driver's license, a passport or any other form of ID.

(App. Br. 10.)

The Examiner relied on the disclosures at col. 3, ll. 20-24 and 48-56, col. 4, ll. 13-16, col. 5, ll. 17-25 of Matsumori as evidence that Matsumori described the claimed “user’s personal handheld mobile device.” (Answer 4.) These disclosures describe a customer ID card.

Accordingly, the Examiner has construed the claim to cover the Matsumori’s device and Appellant is challenging that. Thus, the issue is whether, after giving claim 1 the broadest reasonable construction in light of the Specification as it would be interpreted by one of ordinary skill in the art at the time the application was filed, the method of claim 1 broadly covers

using a “user’s personal handheld mobile device” of the kind disclosed in Matsumori. We have carefully reviewed the record and agree with the Examiner that Matsumori’s customer ID card meets the claimed “user’s personal handheld mobile device.” We disagree that the record supports the Appellant’s view that the claimed method teaches away from Matsumori when the claim phrase “user’s personal handheld mobile device” is given its plain meaning.

The Appellant correctly argues that terms in a claim must be considered and given their plain meaning and must be interpreted as they would be understood by one of ordinary skill in the art. (App. Br. 8 and Reply Br. 3.) The Appellant also correctly suggests that terms in a claim must be interpreted in light of the Specification. (App. Br. 9 and Reply Br. 3.)

[A]s an initial matter, the PTO applies to the verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant's specification.

In re Morris, 127 F.3d 1048, 1054 (Fed. Cir. 1997). The Appellant also correctly argues that appellants can be their own lexicographer. (Reply Br. 3.) (Although in *ex parte* prosecution, this must be within limits. *In re Corr*, 347 F.2d 578, 580 (CCPA 1965). To be their own lexicographer, applicants must place such definitions in the Specification with sufficient clarity to provide a person of ordinary skill in the art with clear and precise notice of

the meaning for a term that is to be construed. *See also In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994) (although an inventor is free to define the specific terms used to describe the invention, this must be done with reasonable clarity, deliberateness, and precision; where an inventor chooses to give terms uncommon meanings, the inventor must set out any uncommon definition in some manner within the patent disclosure so as to give one of ordinary skill in the art notice of the change.)).

However, where, as here, the Appellant provided no definition for the phrase “user’s personal handheld mobile device” in the Specification and submitted no evidence of what one of ordinary skill would understand the phrase to mean, the Examiner was correct to construe the phrase as broadly as would be reasonable to one of ordinary skill in the art at the time the application was filed, giving the terms in the phrase their ordinary and customary meaning. “[T]he broadest reasonable interpretation rule “serves the public interest by reducing the possibility that claims, finally allowed, will be given broader scope than is justified.’ *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004) (quoting *In re Yamamoto*, 740 F.2d 1569, 1571-72 (Fed. Cir. 1984)).” *In re Bigio*, 381 F.3d 1320, 1324 (Fed. Cir. 2004). In that regard, we find the Examiner’s construction of the claim so as to broadly encompass using Matsumori’s customer ID card to be a reasonable one.

The Appeal and Reply Briefs do not explain why Matsumori’s customer ID card would not qualify as a “user’s personal handheld mobile device.” The Appellant suggests that there is a substantial difference. But that difference is never explained. In equating Matsumori’s customer ID card with a “user’s personal handheld mobile device,” the Examiner has

taken the position that Matsumori's customer ID card contains the structure, characteristics, and functions possessed by the claimed "user's personal handheld mobile device." Nowhere in the briefs does the Appellant explain in what way Matsumori's customer ID card cannot fall within the scope of the claimed "user's personal handheld mobile device."

In construing a claim, we first look to the words of the claims, and these words are generally given their ordinary and customary meaning. *See Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996). From a layperson's perspective, it is readily apparent that Matsumori's customer ID card is a device which belongs to a user, is personal, is held in the hand and thus handheld, and is mobile. (See FF 3-7.) Accordingly, looking at the collection of words "user's personal handheld mobile device" and giving each word its ordinary and customary meaning, Matsumori's customer ID card would appear to be a "user's personal handheld mobile device." The Appellant has not explained why that would not be so.

The Appellant suggests that those of ordinary skill in the art would know the difference. But there is no evidence in the record showing what those of ordinary skill in the art would understand the phrase "user's personal handheld mobile device" to mean. (FF 8.) There is no evidence that one of ordinary skill in the art would attribute to the phrase a meaning different from the one the Examiner has given it. (FF 9.) We can find no evidence supporting the Appellant's suggestion of what one of ordinary skill would understand elsewhere in the record. *See generally, In re Glass*, 474 F.2d 1015, 1019 (CCPA 1973). Accordingly, there is no evidence in the record that one of ordinary skill in the art would understand the phrase "user's personal handheld mobile device" to exclude Matsumori's customer

ID card. The Appellant's attorney's arguments in the briefs to the contrary cannot take the place of evidence in the record. *In re Pearson*, 494 F.2d 1399, 1405 (CCPA 1974); *In re De Blauwe*, 736 F.2d 699, 705 (Fed. Cir. 1984); *Meitzner v. Mindick*, 549 F.2d 775, 782 (CCPA 1977), *cert. denied*, 434 US 854 (1977), and *In re Schulze*, 346 F.2d 600, 602 (CCPA 1965). *See also In re Walters*, 168 F.2d 79, 80 (CCPA 1948):

Although it is asserted in the brief of counsel for appellant that 'the result of using an oil modified alkyd resin coating on a loading coil core was revolutionary' and that 'It marked the greatest advance in loading coil manufacture in many years, 'there is no evidence of record to substantiate that assertion, nor any evidence of record of comparative tests to show superiority of the coating compositions claimed here over the ceramic coating material disclosed in the patent to Gillis. Furthermore, statements of counsel in a brief cannot take the place of evidence.

The Appellant further directs our attention to the Specification in order that we may construe the claim in light of the Specification. The Appellant argues that the construction the Appellant is urging for the phrase "user's personal handheld mobile device," that is, a construction which would exclude Matsumori's customer ID card from the claim's scope, is supported in the Specification. The Appellant directs our attention to page 11, line 38 through page 12, line 5 (App. Br. 8-9 and Reply Br. 3) and pages 12 and 13 (Reply Br. 3).

We have reviewed the Specification and the passages therein that the Appellant has specifically directed us to read. The passage at page 11, line 38 through page 12, line 5, discuss an "embodiment" of the invention.

“[P]articlar embodiments ... in the specification will not generally be read into the claims.” *Constant v. Advanced Micro-Devices*, 848 F.2d 1560, 1571 (Fed. Cir. 1988). Furthermore, that passage does not give the phrase “user’s personal handheld mobile device” a meaning, let alone a meaning inconsistent with its ordinary and customary meaning. The passage states: “the mobile personal identifier *may be* a personal device *such as* a mobile phone, GPS receiver, or PDA” (Specification 11:39-12:1.) (Emphasis added.) This passage does not support the Appellant’s position that the phrase “user’s personal handheld mobile device” should be given a construction which would exclude Matsumori’s customer ID card from the claim’s scope. By exemplifying what the phrase may encompass, one of ordinary skill in the art reading the claim in light of the Specification would understand the Appellant to be intending to give the claim phrase a broad scope and not one confined to mobile phones, GPS receivers, or PDAs, or devices with similar communication capabilities. Moreover, in drafting the claim, the Appellant chose to use the broader “user’s personal handheld mobile device” rather than use more narrow terms to clearly refer to these types of devices. The relevant passages on pages 12 and 13 of the Specification describe embodiments of the invention and therefore these passages also fail to support the Appellant’s narrow construction of the claim phrase “user’s personal handheld mobile device.” We have carefully reviewed the remaining disclosure of the Specification but have not found a definition or discussion which would lead one of ordinary skill in the art to understand the claim phrase “user’s personal handheld mobile” to be of a scope that would exclude Matsumori’s customer ID card. Although the Appellant urges us to give the claim phrase “user’s personal handheld

mobile” a narrow meaning in light of the Specification, we can find nothing in the Specification to support it.

The appellants urge us to consult the specification and some of the cited prior art, including Brown, and interpret the disputed language more narrowly in view thereof. When read in light of this material, according to applicants, the “true” meaning of the phrase emerges. We decline to attempt to harmonize the applicants' interpretation with the application and prior art. Such an approach puts the burden in the wrong place. It is the applicants' burden to precisely define the invention, not the PTO's. *See* 35 U.S.C. § 112 ¶ 2 (“The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.”). While it is true that the claims were not rejected on the ground of indefiniteness, this section puts the burden of precise claim drafting squarely on the applicant.

The problem in this case is that the appellants failed to make their intended meaning explicitly clear. Even though the appellants implore us to interpret the claims in light of the specification, the specification fails to set forth the definition sought by the appellants. Nowhere in the technical description of the invention does the application use or define the phrase “integrally formed.” The phrase briefly appears in the “Summary of the Invention” and again in a description of the “advantages of the present invention.” In neither case is a drawing referenced or a precise definition given.

In re Morris, 127 F.3d 1048, 1056 (Fed. Cir. 1997).

Accordingly, we do not find that the Appellant has shown error in the Examiner's construction of the claim. Given the record, the Examiner's construction of the claim appears to be reasonable. In light of that construction, the Examiner's reliance on Matsumori as evidence of a prior art disclosure of a "user's personal handheld mobile," as required by the claim, and notwithstanding that it describes a customer ID card, appears to be both logical and sound. Accordingly, we find no error in the Examiner's claim construction analysis that forms the basis for the Examiner's prima facie case of obviousness.

There being no other arguments challenging the rejection, we affirm the rejection of claim 1. Because claims 9-13, 15, 16, 17, 19, and 21 stand or fall with claim 1, we affirm the rejection of those claims as well.

The rejection of claims 2, 4-7, 14, and 18 under § 103(a) as being unpatentable over Matsumori, O'Hagan, and Tracy.

The Appellant (App. Br. 12) relied on the arguments challenging the rejection of claim 1 in rejecting claims 2, 4-7, 14, and 18. For the same reasons we found those arguments unpersuasive as to error in the rejection of claim 1, we reach the same conclusion as to the rejection of these claims.

The rejection of claim 3 under § 103(a) as being unpatentable over Matsumori, O'Hagan, and New System.

The Appellant (App. Br. 12) relied on the arguments challenging the rejection of claim 1 in rejecting claim 3. For the same reasons we found those arguments unpersuasive as to error in the rejection of claim 1, we reach the same conclusion as to the rejection of this claim.

The rejection of claim 22 under § 103(a) as being unpatentable over Matsumori, O'Hagan, and Fano.

The Appellant (App. Br. 12) relied on the arguments challenging the rejection of claim 1 in rejecting claim 22. For the same reasons we found those arguments unpersuasive as to error in the rejection of claim 1, we reach the same conclusion as to the rejection of this claim.

CONCLUSIONS OF LAW

We conclude that the Appellant has not shown that the Examiner erred in rejecting claims 1, 9-13, 15, 16, 17, 19, and 21 under 35 U.S.C. § 103(a) as being unpatentable over Matsumori and O'Hagan; claims 2, 4-7, 14, and 18 under 35 U.S.C. § 103(a) as being unpatentable over Matsumori, O'Hagan, and Tracy; claim 3 under 35 U.S.C. § 103(a) as being unpatentable over Matsumori, O'Hagan, and New System; and, claim 22 under 35 U.S.C. § 103(a) as being unpatentable over Matsumori, O'Hagan, and Fano.

DECISION

The decision of the Examiner to reject claims 1-7, 9-19, 21, and 22 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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Application 10/756,632

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