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7       UNITED STATES PATENT AND TRADEMARK OFFICE  
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10       BEFORE THE BOARD OF PATENT APPEALS  
11                   AND INTERFERENCES  
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14       *Ex parte KLAUS KURSAWE*  
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17                   Appeal 2008-3808  
18                   Application 09/683,972  
19                   Technology Center 3600  
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22       Decided: November 25, 2008  
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25       Before HUBERT C. LORIN, ANTON W. FETTING, and JOSEPH A.  
26       FISCHETTI, *Administrative Patent Judges*.  
27       FETTING, *Administrative Patent Judge*.

28                   DECISION ON APPEAL

29                   STATEMENT OF CASE

30       Klaus Kursawe (Appellant) seeks review under 35 U.S.C. § 134 of a final  
31       rejection of claims 1, 2, 4-7, and 9-20, the only claims pending in the application  
32       on appeal.

1        We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b) (2002).

2  
3        We AFFIRM.

4        The Appellant invented a way of informing the account holder about a status of  
5 his credit card account (Specification 1:¶ 0001).

6        An understanding of the invention can be derived from a reading of exemplary  
7 claim 1, which is reproduced below [bracketed matter and some paragraphing  
8 added].

9            1. A method of providing information (Z) indicative of an account  
10 status to an account holder via a device connected to a network,  
11 comprising the steps of:

12            [1] comparing an actual value (a) with a preset parameter at an  
13 account server,

14                  the preset parameter defined by the account holder;

15            [2] deriving the information (Z)

16                  in response to a transaction (n) that influences the actual value  
17 (a),

18                  the transaction (n) occurring between an account user and  
19 a purchasing entity; and

20            [3] providing the information (Z) to the account holder through the  
21 device,

22                  the device associated with the account holder;

23            [4] wherein the information (Z) includes an account balance.

25        This appeal arises from the Examiner's Final Rejection, mailed March 9, 2006.

26        The Appellant filed an Appeal Brief in support of the appeal on January 17, 2007.

Appeal 2008-3808  
Application 09/683,972

1 An Examiner's Answer to the Appeal Brief was mailed on August 13, 2007. A  
2 Reply Brief was filed on October 15, 2007.

PRIOR ART

4 The Examiner relies upon the following prior art:

Joao US 5,878,337 Mar. 2, 1999  
Camacho US 2003/0208684 A1 Nov. 6, 2003  
Stoutenburg US 6,827,260 B2 Dec. 7, 2004

REJECTION

6       Claims 1, 2, 4-7, and 9-20 stand rejected under 35 U.S.C. § 103(a) as  
7       unpatentable over Joao, Camacho, and Stoutenberg.

## ISSUES

9       The issue pertinent to this appeal is whether the Appellant has sustained its  
10      burden of showing that the Examiner erred in rejecting claims 1, 2, 4-7, and 9-20  
11      under 35 U.S.C. § 103(a) as unpatentable over Joao, Camacho, and Stoutenberg.

12 The pertinent issue turns on whether Joao and Camacho describe the  
13 limitations [1] – [3] of claim 1.

## FACTS PERTINENT TO THE ISSUES

15 The following enumerated Findings of Fact (FF) are believed to be supported  
16 by a preponderance of the evidence.

17 *Joao*

18           01. Joao is directed to providing notification and security in the use of a  
19           credit or debit card (Joao, col. 1, ll. 8-16).

- 1        02. Joao describes performing a test in order to determine if the maximum  
2              credit, charge or debit account limit has been exceeded and/or if the card  
3              has been depleted of its currency value (Joao, col. 5, ll. 40-51).
- 4        03. Joao describes programming so as to limit and/or restrict the amounts  
5              and/or types of transactions, and/or the goods and/or services which may  
6              be purchased with a card, the stores or service providers which may be  
7              authorized to accept the card, limits on the dollar amounts of  
8              transactions pertaining to each authorized vendor, seller and/or service  
9              provider, daily spending limits, and/or the geographical area or location  
10             to which authorized use may be limited, and/or authorized times for card  
11             usage (Joao, col. 7, ll. 48-64).

12        *Camacho*

- 13        04. Camacho is directed to detecting and reducing fraudulent use in e-  
14              commerce by using Personal Digital Identification (PDI) techniques  
15              (Camacho 1:¶ 0003). It does so by authenticating transactions conducted  
16              by an individual or agent by comparing biometric data and profiles to  
17              known templates previously provided to the system. If transaction  
18              authentication cannot be achieved, business rules of the apparatus are  
19              used to determine successive action (Camacho 1:¶ 0014).
- 20        05. Camacho describes accepting a purchase request from authorized  
21              electronic storefront sites. The request is first processed to ensure that  
22              business-filtering rules are applied to the transaction, which quickly  
23              identifies those transactions that warrant further authentication, or which  
24              may be immediately rejected by the system. After the request is  
25              evaluated, an Identity Manager ensures that the required information is

1 available to properly identify the consumer and ensure that registration  
2 information is available. After that, a Transaction Rules Manager then  
3 processes the request. For example, the Transaction Rules Manager may  
4 determine if authentication is required and, if so, what type should be  
5 requested of the consumer (Camacho 4:¶ 0042).

6 06. Camacho describes checking the monetary amount of a current  
7 transaction against the configurable System Maximum Allowable  
8 Amount. If the Transaction Monetary Amount does not exceed the  
9 System Maximum Allowable Amount, then processing continues by  
10 checking whether Consumer Imposed Registration Limits exist  
11 (Camacho 8:¶ 0078). If Consumer Imposed Registration Limits exist,  
12 then the monetary amount of the current transaction is tested, and if it  
13 exceeds the Per Transaction Limit, then a redirection request to a  
14 configurable dynamic web page is returned (Camacho 8:¶ 0079).

15 *Stoutenburg*

16 07. Stoutenburg is directed to facilitating transactions with one or more  
17 transaction systems (Stoutenburg, col. 1, ll. 26-29).

18 08. Stoutenburg describes sending an account balance with other  
19 information to a point of sale after entering account information  
20 (Stoutenburg, col. 33, ll. 48-55).

21 *Facts Related To The Level Of Skill In The Art*

22 09. Neither the Examiner nor the Appellant has addressed the level of  
23 ordinary skill in the pertinent arts of systems analysis and programming,  
24 financial transaction systems, financial transaction protocol design, and  
25 data communications. We will therefore consider the cited prior art as

1 representative of the level of ordinary skill in the art. *See Okajima v.*  
2 *Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (“[T]he absence of  
3 specific findings on the level of skill in the art does not give rise to  
4 reversible error ‘where the prior art itself reflects an appropriate level  
5 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)).

7 *Facts Related To Secondary Considerations*

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

10 PRINCIPLES OF LAW

11 *Claim Construction*

12 During examination of a patent application, pending claims are given  
13 their broadest reasonable construction consistent with the specification. *In*  
14 *re Prater* , 415 F.2d 1393, 1404-05 (CCPA 1969); *In re Am. Acad. of Sci.*  
15 *Tech Ctr.*, 367 F.3d 1359, 1364, (Fed. Cir. 2004).

16 Limitations appearing in the specification but not recited in the claim are not  
17 read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed.  
18 Cir. 2003) (claims must be interpreted “in view of the specification” without  
19 importing limitations from the specification into the claims unnecessarily).

20 Although a patent applicant is entitled to be his or her own lexicographer of  
21 patent claim terms, in *ex parte* prosecution it must be within limits. *In re Corr*,  
22 347 F.2d 578, 580 (CCPA 1965). The applicant must do so by placing such  
23 definitions in the Specification with sufficient clarity to provide a person of  
24 ordinary skill in the art with clear and precise notice of the meaning that is to be

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

7 *Obviousness*

8 A claimed invention is unpatentable if the differences between it and the  
9 prior art are “such that the subject matter as a whole would have been obvious at  
10 the time the invention was made to a person having ordinary skill in the art.” 35  
11 U.S.C. § 103(a) (2000); *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1729-30  
12 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 13-14 (1966).

13 In *Graham*, the Court held that that the obviousness analysis is bottomed on  
14 several basic factual inquiries: “[1] the scope and content of the prior art are to be  
15 determined; [(2)] differences between the prior art and the claims at issue are to be  
16 ascertained; and [(3)] the level of ordinary skill in the pertinent art resolved.” 383  
17 U.S. at 17. *See also KSR Int’l v. Teleflex Inc.*, 127 S.Ct. at 1734. “The  
18 combination of familiar elements according to known methods is likely to be  
19 obvious when it does no more than yield predictable results.” *KSR*, at 1739.

20 “When a work is available in one field of endeavor, design incentives and  
21 other market forces can prompt variations of it, either in the same field or a  
22 different one. If a person of ordinary skill can implement a predictable variation, §  
23 103 likely bars its patentability.” *Id.* at 1740.

24 “For the same reason, if a technique has been used to improve one device,  
25 and a person of ordinary skill in the art would recognize that it would improve

1 similar devices in the same way, using the technique is obvious unless its actual  
2 application is beyond his or her skill.” *Id.*

3 “Under the correct analysis, any need or problem known in the field of  
4 endeavor at the time of invention and addressed by the patent can provide a reason  
5 for combining the elements in the manner claimed.” *Id.* at 1742.

6 ANALYSIS

7 *Claims 1, 2, 4-7, and 9-20 rejected under 35 U.S.C. § 103(a) as unpatentable over*  
8 *Joao, Camacho, and Stoutenburg.*

9 *Claims 1, 2, 7, and 9-14*

10 The Appellant argues claims 1 and 11-13 as a group (App. Br. 6). The  
11 Appellant provides no separate arguments for the support of claims 2, 7, 9, 10, and  
12 14. Accordingly we treat claims 1, 2, 7, and 9-14 as a group.

13 Accordingly, we select claim 1 as representative of the group.

14 37 C.F.R. § 41.37(c)(1)(vii) (2007).

15 The Examiner found that Camacho described the comparison of limitation [1];  
16 Joao described deriving and providing information of limitations [2] and [3]; and  
17 Stoutenburg described the balance limitation [4] of claim 1 (Ans. 3-4). The  
18 Examiner implicitly found that one of ordinary skill understood the benefits of  
19 Camacho’s central decision making to Joao’s prior authorization, and the benefits  
20 of seeing Stoutenburg’s balance.

21 The Appellant contends that the only actual value described by Camacho that  
22 would describe limitation [1] relates directly to authentication of the requesting  
23 party (App. Br. 7:First full ¶). The Appellant infers from this that combining Jaoa  
24 with Camacho would result in deriving purchase information in response to a

1 transaction that influences authentication information (App. Br. 7:Bottom ¶). The  
2 Appellant concludes this would not result in claim 1, but the Appellant does not  
3 explain how it would differ from claim 1. The Appellant appears to clarify this in  
4 the Reply Brief by stating that a parameter associated with such a value would not  
5 be defined by the account holder (Reply Br. 2).

We disagree with the Appellant. As the Examiner replied, Camacho describes using business filtering rules and transaction rules such as company level rules which go beyond mere authentication (Ans. 6). Camacho compares values in each of a set of business filtering rules, identity manager, and a set of transaction rules (FF 05). This is done both to authenticate and to determine subsequent actions (FF 04). Among those parameters used are Consumer Imposed Registration Limits on the monetary amount (FF 06), which as the name implies, is customer imposed, i.e. defined. Such a rule would be consistent with Joao's comparison of monetary limits (FF 02), from which one of ordinary skill would predictably follow to derive and produce the information in limitations [2] and [3]. We also find that the transaction involved necessarily influences the monetary amount as required by limitation [2].

### *Claims 4, 16, and 18*

19       Claims 4, 16, and 18 are argued together. Claim 4 requires that the preset  
20 parameter comprises a limit. The Examiner found this in Joao (Ans. 5). The  
21 Appellant argues the preset parameter found by the Examiner would have to be one  
22 directed to authentication (App. Br. 8:Second full ¶). We disagree that this  
23 demonstrates Examiner error. As the Examiner replied, Joao describes using limits  
24 for such parameters (Ans. 8; FF 03). For such parameters to be used for Joao's  
25 tests, they would necessarily be preset.

1                           *Claims 5, 17, and 20*

2       Claims 5, 17, and 20 are argued together. Claim 5 requires that the preset  
3       parameter comprises a geographic region. The Examiner found this in Joao (Ans.  
4       5). Appellant argues the preset parameter found by the Examiner would have to be  
5       one directed to authentication (App. Br. 8:Bottom ¶). We disagree that this  
6       demonstrates Examiner error. As the Examiner replied, Joao describes using  
7       geographic areas for such parameters (Ans. 8; FF 03). For such parameters to be  
8       used for Joao's tests, they would necessarily be preset.

9                           *Claim 6*

10      Claim 6 is argued separately. Claim 6 requires setting multiple  
11     parameters for contemporaneous use. The Examiner found this in Joao (Ans. 5).  
12      Appellant argues the preset parameter found by the Examiner would have to be one  
13      directed to authentication and that Joao is devoid of multiple parameters for  
14      contemporaneous use (App. Br. 9:First full ¶). We disagree that this demonstrates  
15      Examiner error. As the Examiner replied, Joao describes using multiple such  
16      parameters (Ans. 8; FF 03). For such parameters to be used for Joao's tests, they  
17      would necessarily be preset. The Appellant does not provide any argument  
18      explaining the allegation that Joao is devoid of multiple parameters for  
19      contemporaneous use, and we find that such parameters, such as temporal and  
20      geographic parameters, to limit the amounts and types of goods are described by  
21      Joao (FF 03). The use of the term "and/or" by Joao implies contemporaneous use.

22                           *Claims 15 and 19*

23      Claims 15 and 19 are argued together. Claim 15 requires the limit be a  
24      spending limit. The Examiner found this in Joao (Ans. 6). Appellant argues the  
25      preset parameter found by the Examiner would have to be one directed to

1 authentication and that Joao is devoid of a preset spending limit parameter (App.  
2 Br. 9:First full ¶). We disagree that this demonstrates Examiner error. As the  
3 Examiner replied, Joao describes using spending amount parameters (Ans. 8-9; FF  
4 03). For such parameters to be used for Joao's tests, they would necessarily be  
5 preset. The Appellant does not provide any argument explaining the allegation that  
6 Joao is devoid of a preset spending limit parameter, and we find that such a  
7 parameter is described by Joao as limits on dollar amounts (FF 03).

8 The Appellant has not sustained its burden of showing that the Examiner erred  
9 in rejecting claims 1, 2, 4-7, and 9-20 under 35 U.S.C. § 103(a) as unpatentable  
10 over Joao, Camacho, and Stoutenberg.

## 11 CONCLUSIONS OF LAW

12 Joao and Camacho describe the limitations [1] – [3] of claim 1, as well as the  
13 remaining limitations argued by the Appellant. The Appellant has not sustained its  
14 burden of showing that the Examiner erred in rejecting claims 1, 2, 4-7, and 9-20  
15 under 35 U.S.C. § 103(a) as unpatentable over the prior art.

## 16 DECISION

17 To summarize, our decision is as follows:

- 18 • The rejection of claims 1, 2, 4-7, and 9-20 under 35 U.S.C. § 103(a) as  
19 unpatentable over Joao, Camacho, and Stoutenberg is sustained.

20 No time period for taking any subsequent action in connection with this appeal  
21 may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

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