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Ryan, Mason & Lewis, I.L.P 90 Forest Avenue Locust Valley, NY 11560			FIELDS, BENJAMIN S	
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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* MATTHEW HATHAWAY, DANA E. WOLF, and SKYE SPEAR

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Appeal 2011-006054  
Application 11/840,629  
Technology Center 3600

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Before ANTON W. FETTING, JOSEPH A. FISCHETTI and  
NINA L. MEDLOCK, *Administrative Patent Judges*.

MEDLOCK, *Administrative Patent Judge*.

DECISION ON APPEAL

## STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1-22. We have jurisdiction under 35 U.S.C. § 6(b).

## STATEMENT OF THE DECISION

We REVERSE.<sup>1</sup>

## BACKGROUND

Appellants' invention relates generally to credit cards and other types of payment cards, and more particularly to techniques for enhancing the security of such cards as well as transactions involving such cards (Spec., 1, ll. 4-6).

Claim 1, reproduced below, is representative of the subject matter on appeal:

1. A payment card comprising:
  - a processor for determining a dynamic account number;
  - a trigger source coupled to the processor; and
  - a display for outputting at least a portion of the dynamic account number under control of the processor responsive to the trigger source;wherein the dynamic account number is based at least in part on a seed stored in the payment card and an output of the trigger source; and
  - wherein at least a portion of the dynamic account number replaces a corresponding portion of a static account number associated with the payment card.

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<sup>1</sup> Our decision will make reference to Appellants' Appeal Brief ("App. Br.," filed November 8, 2010) and Reply Brief ("Reply Br.," filed February 3, 2011) and the Examiner's Answer ("Ans.," mailed December 3, 2010).

### THE REJECTION

The following rejection is before us for review:

Claims 1-22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Woronec (US 2007/0057037 A1, pub. Mar. 15, 2007) in view of Inskip (US 2006/0242698 A1, pub. Oct. 26, 2006) and further in view of Lindsay (US 2007/0250920 A1, pub. Oct. 25, 2007).

### ANALYSIS

#### *Independent claim 1 and dependent claims 2-14*

We are persuaded of error in the part of the Examiner by Appellants' argument that none of Woronec, Inskip, and Lindsay discloses or suggests "wherein the dynamic account number is based at least in part on a seed stored in the payment card and an output of the trigger source," as recited in claim 1 (App. Br. 5-8 and Reply Br. 2-5). The Examiner relies on Lindsay as disclosing this feature, and directs our attention to the Abstract, Figure 6, paragraphs [0024] and [0320], and claims 1-4 of Lindsay. However, we find nothing in the cited portions of Lindsay that discloses or suggests the display of a dynamic account number "wherein the dynamic account number is based at least in part on a seed stored in the payment card and an output of the trigger source," as recited in claim 1.

Lindsay discloses a password-based security system, including primary and secondary passwords for protecting assets (Abstract), and describes at paragraph [0024], on which the Examiner relies, that a synchronization device displays a one-time password ("OTP") that changes periodically. Figure 6 of Lindsay shows an OTP-enabled credit card 200, including an OTP display 206, and Lindsay describes that an OTP is

displayed when an OTP request button 204 (positioned on the card) is depressed (*see* Lindsay at para. [0126]). Lindsay describes at paragraph [0024] that a primary password is defined by modifying the characters of the OTP, e.g., by incrementing , truncating, transposing the characters, according to rules selected by the user and further describes the generation of the primary password at paragraph [0320]. However, we find nothing in these cited portions of Lindsay that discloses or suggests that the displayed OTP is “based at least in part on a seed stored in the payment card and an output of the trigger source.” At best, Lindsay discloses that the primary password has some relationship with the printed verification code of a credit card (or changing codes that are displayed electronically on the card or electromagnetically transmitted from the card) and may be generated using an algorithm that may depend “on the date, time, price to be charged, or other variable factors.” However, the primary password is not displayed on the card and is not a “dynamic account number,” as recited in claim 1.<sup>2</sup>

The Examiner asserts that “all such cards/devices contain the recited ‘seed’ of the instant claims” (Ans. 19). But the Examiner has provided no objective evidence or technical reasoning to support an inherency rejection. *See In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999) (An inherency-based rejection requires objective evidence or technical reasoning that makes clear that the allegedly inherent feature necessarily flows from the teaching

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<sup>2</sup> The Examiner maintains that Lindsay discloses an algorithm, and that the algorithm is itself a “seed,” as recited in claim 1 (*see, e.g.*, Ans. 5, 12, and 16). However, we agree with Appellants that a person of skill in the art would plainly understand from the Specification that the OTP algorithm and the seed are distinct components stored in memory in the payment card (App. Br. 7 and Reply Br. 3). *See, e.g.*, Spec., 8, ll. 3-21 and Fig. 2.

of the cited prior art, and that it would be so recognized by persons of ordinary skill in the art). Moreover, even accepting the Examiner's assertion as true, the Examiner has not established on this record that the cited references disclose or suggest that the displayed OTP is "based at least in part on . . . an output of the trigger source."

In view of the foregoing, we will not sustain the Examiner's rejection of claim 1 under 35 U.S.C. § 103. We also will not sustain the Examiner's rejection of dependent claims 2-14.

*Independent claims 15, 17, and 20 and dependent claims 16, 18, 19, 21, and 22*

Independent claims 15, 17, and 19 include language substantially similar to claim 1. Therefore, we will not sustain the Examiner's rejection of claims 15, 17, and 19 under 35 U.S.C. § 103(a) for the same reasons as set forth above with respect to claim 1. We also will not sustain the Examiner's rejection of dependent claims 16, 18, 19, 21, and 22.

#### DECISION

The Examiner's rejection of claims 1-22 under 35 U.S.C. § 103(a) is reversed.

REVERSED

JRG