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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte TOM GIACALONE, JOHN LONG, and TIM GUASTAFERRO

Appeal 2011-006944
Application 11/875,354
Technology Center 3600

Before BIBHU R. MOHANTY, MICHAEL W. KIM, 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, 3-22, and 24. We have jurisdiction under 35 U.S.C. § 6(b).

STATEMENT OF THE DECISION

We AFFIRM.¹

BACKGROUND

Appellants' invention relates generally to e-commerce and, more particularly, relates to a system and method for making third party pickup available to retail customers (Spec. 1, ll. 5-6).

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

1. A computer-readable storage media having stored thereon computer-executable instructions for making third party pickup available to a customer having an identity, the instructions performing steps comprising:

in response to a request received from the customer to authorize a third party to pickup an item ordered from a retailer: retrieving information associated with the customer from a public record;

using the information associated with the customer retrieved from the public record to form a plurality of questions;

¹ Our decision will make reference to the Appellants' Appeal Brief ("App. Br.," filed November 8, 2010) and Reply Brief ("Reply Br.," filed February 11, 2011) and the Examiner's Answer ("Ans.," mailed January 21, 2011).

generating a score for responses received from the customer to each of the formed plurality of questions when posed to the customer; and
authorizing the third party to pickup the ordered item in lieu of the customer at a pickup point associated with the retailer only when the generated score for responses received from the customer to each of the formed plurality of questions posed to the customer meets a defined threshold.

THE REJECTIONS

The following rejections are before us for review:

Claims 1, 3-20, and 24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Buettgenbach (US 2002/0032613 A1, pub. Mar. 14, 2002) in view of Honarvar (US 7,231,657 B2, iss. Jun. 12, 2007).

Claims 21 and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Buettgenbach in view of Honarvar and further in view of Official Notice.

ANALYSIS

Independent claims 1 and 24

Appellants argue claims 1 and 24 together (App. Br. 5-11). We select claim 1 as representative. Claim 24 stands or falls with claim 1. 37 C.F.R. § 41.37(c)(1)(vii).

We are not persuaded by Appellants' arguments that the Examiner erred in rejecting claim 1 under 35 U.S.C. § 103(a). Appellants argue at length that neither Buettgenbach nor Honarvar discloses or suggests authenticating a customer "in response to a request received from the customer to authorize a third party to pickup an item ordered from a

retailer,” as recited in claim 1 (App. Br. 7-11 and Reply Br. 2-4). Yet, as the Examiner observes, “a request received from the customer to authorize a third party to pickup an item ordered from a retailer” is not set forth as a positive limitation in claim 1. Nor does claim 1 positively recite that a third party picks up an item ordered from a retailer (Ans. 12-13). Instead, under the broadest reasonable interpretation of claim 1, the phrase “in response to a request received from the customer to authorize a third party to pickup an item ordered from a retailer” amounts to nothing more than a statement of intended use – it merely describes how, i.e., for what purpose, the authentication method is intended to be used, and does not in any way affect how the claimed method is performed. As such, Appellants’ arguments directed to the lack of any teaching in the cited references of authenticating an identity of a customer in response to a customer requesting authorization for a third party to pick up an ordered item are not commensurate with the scope of the claim.

The only positively recited limitations in claim 1 are the specific steps that comprise the authentication method, i.e., “retrieving information associated with the customer from a public record; using the information . . . to form a plurality of questions; generating a score for responses received from the customer to each of the formed plurality of questions . . .; and authorizing [a particular action] when the generated score for responses received from the customer to each of the formed plurality of questions posed to the customer meets a defined threshold.” And it is undisputed that each of those steps is disclosed by Honarvar.²

² Honarvar discloses a fraud detection and identity verification system and method that allows a vendor to create/configure a user authentication

Appellants acknowledge that paragraphs [0101] and [0102] of Buettgenbach disclose authenticating a customer in response to a [customer] request [for a third party, i.e., the Will-Call Center] to prepare an item for shipment, i.e., for returning items purchased in e-commerce to vendors” (App. Br. 9), and that teaching, as the Examiner observes, in combination with the authentication method of Honarvar fully satisfies the limitations of claim 1 (Ans. 12-13).

Moreover, even if the phrase “in response to a request received from the customer to authorize a third party to pickup an item ordered from a retailer” were given full effect, we agree with the Examiner that it would have been obvious to one of ordinary skill in the art, in order to provide another level of fraud protection to the customer, to modify Buettgenbach to provide authentication for additional processes, e.g., designating a pickup party, wherein the authentication process includes using information associated with a customer to form a plurality of questions, generating a score for responses received from the customer to each of the plurality of questions, and authorizing the pickup only when the generated score meets a defined threshold, as taught by Honarvar (Ans. 5 6).

process for users desiring to access/receive services from the vendor (*see, e.g.,* Honarvar, col. 1, ll. 20-27). Honarvar describes that information regarding the user is retrieved from publicly available data sources, e.g., credit history, governmental databases, and is used to generate authentication questions which are posed to the user (*see, e.g.,* Honarvar, col. 7, ll. 4-13; col. 13, ll. 20-36; and col. 32, l. 13 – col. 33, l. 19). The user’s responses to these questions are used to compute a confidence score, which, in turn, is used to determine whether the business transaction should be allowed to proceed, e.g., the business transaction is allowed if a selected confidence score threshold is met (*see, e.g.,* Honarvar, col. 33, ll. 30-35 and col. 39, ll. 45-52).

The Supreme Court has stated that in considering obviousness “the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U. S. 398, 418 (2007). The Court also has emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” and has affirmed that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* at 415-416.

Modifying Buettgenbach, as proposed by the Examiner (Ans. 5), to include an process for authenticating a user, as disclosed in Honarvar, in response to a customer request to authorize a third party pickup is, in our view, nothing more than a combination of prior art elements according to their established functions, and yields a predictable result. Therefore, it would have been obvious at the time of Appellants’ invention. *See KSR*, 550 U.S. at 416. The Examiner’s determination that one of ordinary skill in the art would have modified Buettgenbach in this way, in light of Honarvar, in order to provide additional fraud protection to the customer, also is adequately supported by rational underpinning.

For the foregoing reasons, we will sustain the Examiner’s rejection of claim 1 under 35 U.S.C. § 103(a). We also will sustain the Examiner’s rejection of claim 24, which stands or falls with claim 1.

Claims 3-22

Each of claims 3-22 ultimately depends from claim 1. Appellants did not present any arguments in support of the separate patentability of

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claims 3-22. Therefore, we also will sustain the Examiner's rejection of these claims under 35 U.S.C. § 103(a).

DECISION

The Examiner's rejection of claims 1, 3-22, and 24 under 35 U.S.C. § 103(a) 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).

AFFIRMED

Klh