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KILPATRICK TOWNSEND & STOCKTON LLP/VISA  
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EXAMINER
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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* PAUL J. MATSUDA,  
SARAH E. PERRY, and TRACY L. WILK

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Appeal 2014-005066<sup>1</sup>  
Application 13/450,298<sup>2</sup>  
Technology Center 3600

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Before MICHAEL W. KIM, MATTHEW S. MEYERS, and  
ROBERT J. SILVERMAN, *Administrative Patent Judges*.

MEYERS, *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 40–60. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

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<sup>1</sup> Our decision references Appellants’ Appeal Brief (“Appeal Br.,” filed December 23, 2013) and Reply Brief (“Reply Br.,” filed March 11, 2014), the Examiner’s Answer (“Ans.,” mailed February 6, 2014), and Final Office Action (“Final Act.,” mailed May 28, 2013).

<sup>2</sup> Appellants identify Visa International Service Association as the real party in interest (Appeal Br. 3).

### CLAIMED INVENTION

Appellants' claimed invention relates generally "to systems and methods for conducting electronic commerce between individuals" (Spec. 1, ll. 10–11).

Claims 40 and 50 are the independent claims on appeal. Claim 40, reproduced below with added bracketed notations, is illustrative of the subject matter on appeal:

40. A method of integrating the shipping of goods with the purchase of the goods, the method comprising:

[a] recording, by a transaction server, a purchase price of the goods, a first account for an individual buyer and a second account for an individual seller, the seller and the buyer connecting to the transaction server over a network;

[b] receiving an indication of a chosen shipper by which to ship the goods from the seller to the buyer;

[c] receiving a tracking number identifying the goods to be shipped by the shipper; and

[d] receiving a notification from the shipper regarding a status of the goods associated with the tracking number.

### REJECTIONS

Claims 40–59 are rejected under 35 U.S.C. § 103(a) as unpatentable over Walker (US 6,240,396 B1, iss. May 29, 2001) and Hilbush (US 2010/0332284 A1, pub. Dec. 30, 2010).

Claims 60 is rejected under 35 U.S.C. § 103(a) as unpatentable over Walker, Hilbush, and Official Notice.

### ANALYSIS

We are persuaded by Appellants' argument that the Examiner erred in rejecting independent claims 40 and 50 as unpatentable over Walker and

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Hilbush “because Hilbush et al. cannot be relied upon as prior art” (Appeal Br. 10–11; *see also* Reply Br. 3).

We begin by noting that the present application is a continuation of U.S. Application No. 12/892,807, filed September 28, 2010, which is a continuation of U.S. Application No. 12/190,130, filed August 12, 2008, which is a continuation of U.S. Application No. 09/352,468, filed July 14, 1999. The ’468 application claims benefit of priority to U.S. Provisional Application no. 60/135,103, filed February 19, 1999.

We also note that the Hilbush reference, U.S. Application No. 12/876,740, filed September 7, 2010 is a division of U.S. Application No. 10/832,111, filed April 26, 2004, which is a continuation of U.S. Application no. 09/498,805, filed February 7, 2000. The ’805 application claims benefit of priority to U.S. Provisional Application no. 60/119,189, filed February 8, 1999.

On this record, we agree with Appellants that the Examiner has not met the burden of establishing that the Hilbush provisional application reasonably supports the portions of Hilbush cited by the Examiner in making the rejections of certain claim limitations. Although the Hilbush provisional application antedates the present application’s earliest effective filing date, the Hilbush reference, relied upon by the Examiner, constitutes prior art only for subject matter properly supported by the provisional application in accordance with 35 U.S.C. § 112, first paragraph. *See In re Giacomini*, 612 F.3d 1380, 1383–85 (Fed. Cir. 2010); *see also Ex parte Yamaguchi*, 88 USPQ2d 1606, 1609 (BPAI 2008) (precedential).

Here, the Examiner has not sufficiently shown that Hilbush’s provisional patent application provides such support through any factual

findings or reference to the provisional application. In this regard, the record indicates that the Examiner provided Appellants with a copy of the provisional application on May 28, 2013 “[i]n response to [A]pplicant’s argument that provisional application number 60/119,189 is not available to verify support of the reference relied upon” (Final Act. 6). However, in response to Appellants’ argument that after having reviewed the provision application, Appellants were unable to find support for “receiving a notification from the shipper regarding a status of the goods associated with the tracking number,” as recited by limitation [d] of independent claim 40, and similarly recited by independent claim 50 (Appeal Br. 11), the Examiner provided no response in the Examiner’s Answer (*see, e.g.*, Ans. 3–9). Thus, we agree with Appellants that on the record the Examiner has failed meet the burden of establishing that the Hilbush reference is prior art for the relevant subject matter.

In view of the foregoing, we do not sustain the Examiner’s rejection of independent claims 40 and 50 under 35 U.S.C. § 103(a). For the same reasons, we also do not sustain the Examiner’s rejections of claims 41–49 and 51–60.

#### DECISION

The Examiner’s rejections of claims 40–60 under 35 U.S.C. § 103(a) are reversed.

REVERSED