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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* RAMMOHAN VARADARAJAN and AMBARISH MALPANI

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Appeal 2014-009346  
Application 13/103,797<sup>1</sup>  
Technology Center 3600

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Before HUBERT C. LORIN, BIBHU R. MOHANTY, and  
BRADLEY B. BAYAT, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Rammohan Varadarajan and Ambarish Malpani (Appellants) seek our review under 35 U.S.C. § 134 of the final rejection of claims 1–13, 39–46, and 51.<sup>2</sup> We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We REVERSE.

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<sup>1</sup> The Appellants identify CA, Inc. as the real party in interest. App. Br. 3.

<sup>2</sup> Claims 14–25 and 47–50 are canceled. Claims 26–38 are withdrawn from consideration. App. Br. 34–42, Claims Appendix.

## THE INVENTION

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

1. A method of using a one-time password for a transaction between a user and a merchant, comprising:

generating the one-time password by an electronic device;

performing an authentication process of the user by an authentication server in response to a request from the user to use the one-time password, the user is authenticated based on information other than the one-time password;

authorizing the use of the one-time password for the transaction in response to successfully authenticating the user by the authentication server;

determining that the use of the one-time password is not authorized for the transaction in response to authentication of the user by the authentication server failing;

receiving the one-time password in combination with an account number at an electronic device of the merchant;

sending a first electronic message to the authentication server, wherein the first electronic message comprises the one-time password, and wherein the first electronic message requests a determination whether the one-time password is authorized for use in the transaction based on successful verification of the user;

sending a second electronic message to the electronic device of the merchant, wherein the second electronic message includes a determination whether the transaction should be approved, the determination is based in part on whether the authentication server indicates the one-time password is authorized for use in the transaction based on successful verification of the user.

### THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Sakata	US 2009/0094230 A1	Apr. 9, 2009
Cox	US 2009/0104888 A1	Apr. 23, 2009

The following rejections are before us for review:

1. Claims 1–13, 39–46, and 51 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.
2. Claims 1–7, 12, 13, 39–41, 44–46, and 51 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Cox.
3. Claims 8–11, 42, and 43 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Cox and Sakata.

### ISSUES

Did the Examiner err in rejecting claims 1–13, 39–46, and 51 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement; claims 1–7, 12, 13, 39–41, 44–46, and 51 under 35 U.S.C. § 102(b) as being anticipated by Cox; and claims 8–11, 42, and 43 under 35 U.S.C. § 103(a) as being unpatentable over Cox and Sakata?

## ANALYSIS

*The rejection of claims 1–13, 39–46, and 51 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.*

The Examiner finds that said claimed subject matter is not adequately described in the Specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor at the time the application was filed had possession of it (Final Act. 9–10; Ans. 2–3, 16–18). According to the Examiner, the limitation that “the user is authenticated based on information other than the one-time password” in claims 1 and 39, and a similar limitation in claim 51, is unsupported by the Specification.

The Appellants contend that the Specification supports these limitations in paragraphs 32, 35, 48–53, 59, and Figures 1, 4A, 4B, 5, and 6 (Appeal Br. 11). According to the Appellants, the key used to sign a challenge described in paragraph 48 constitutes the “information other than the one-time password” (OTP).

We agree with the Appellants. Paragraph 48 of the Specification describes a challenge that is used to authenticate the user, and provides that “[i]n some embodiments, the challenge may be comprised of at least a portion of the OTP itself,” and “[t]his challenge may be sent to the user to sign 430 using a key that is not generally know, but is known to the user.” It is clear from this disclosure that the challenge and the key can be distinct from the OTP and are used in the authentication process. We further note that paragraph 45 of the Specification describes that “the OTP could be generated after the user is authenticated,” which indicates that the user authentication was performed prior to OTP generation based on information other than the OTP.

*The rejection of claims 1–7, 12, 13, 39–41, 44–46, and 51 under 35 U.S.C. § 102(b) as being anticipated by Cox.*

The independent claims are claims 1, 39, and 51. Independent claim 1 includes the limitation that “the user is authenticated based on information other than the one-time password” (App. Br. 34, Claims Appendix). Claims 39 and 51 contain similar limitations.

The Examiner finds the above limitations in paragraphs 77 and 82 and in blocks 530–534 of Figure 6 of Cox (Final Act. 10–11; Ans. 3–4, 18–19).<sup>3</sup>

We have reviewed the cited passages but can find no express description of authenticating a user based on information other than the one-time password (OTP).

The cited passages also do not inherently describe the authentication as claimed. Said passages describe a *request* for authentication that includes additional information other than the OTP, but not performing the authentication based on that additional information in the request. The user authentication in Cox is based on a comparison of two OTPs; the user is authenticated if and only if the OTPs match (block 534). Although it is possible that the additional information in the request could be employed somehow to accomplish the authentication, “[i]nherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.”

*Hansgirg v. Kemmer*, 102 F.2d 212, 214 (CCPA 1939), quoted in *Cont’l Can Co. USA, Inc. v. Monsanto Co.*, 948 F.2d 1264, 1269 (Fed. Cir. 1991).

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<sup>3</sup> The Examiner has also indicated that this limitation “does not have a patentable weight” but has not provided any explanation. Ans. 19, 23, 26.

*The rejection of claims 8–11, 42, and 43 under 35 U.S.C. § 103(a) as being unpatentable over Cox and Sakata.*

This rejection of the dependent claims is not sustained for the reasons discussed above with respect to the independent claims. In particular, we find that the independent claims include limitations not described in Cox. Since no other position with regard to said claim limitations has been taken, the rejections are not sustained because a prima facie case of obviousness has not been made out in the first instance by a preponderance of the evidence.

#### CONCLUSIONS

The rejection of claims 1–13, 39–46, and 51 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement is reversed.

The rejection of claims 1–7, 12, 13, 39–41, 44–46, and 51 under 35 U.S.C. § 102(b) as being anticipated by Cox is reversed.

The rejection of claims 8–11, 42, and 43 under 35 U.S.C. § 103(a) as being unpatentable over Cox and Sakata is reversed.

#### DECISION

The decision of the Examiner to reject claims 1–13, 39–46, and 51 is reversed.

REVERSED