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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* BRANT CANDELORE,  
STEVEN MARTIN RICHMAN, and FREDERICK J. ZUSTAK

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Appeal 2017-009525<sup>1</sup>  
Application 14/493,825  
Technology Center 2800

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Before ADRIENE LEPIANE HANLON, JEFFREY T. SMITH,  
and LILAN REN, *Administrative Patent Judges*.

Opinion for the Board filed by *Administrative Patent Judge* SMITH.

Opinion dissenting filed by *Administrative Patent Judge* HANLON.

SMITH, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from a non-final rejection of claims 1–20. We have jurisdiction under 35 U.S.C. § 6.

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<sup>1</sup> Appellant is the Applicant, Sony Corporation, which is also identified as the real party in interest. (App. Br. 2).

Appellant's invention is generally directed to "an apparatus [that] includes at least one processor and at least one computer readable storage medium [that] includes instructions which when executed by the processor configure the processor to receive a near field communication (NFC) interrogation signal (NFCIS) from a point of sale (POS) assembly." (Spec. 2.) Claim 1 illustrates the subject matter on appeal and is reproduced below:

1. Apparatus comprising:

at least one computer memory that is not a transitory signal and that comprises instructions

executable by at least one processor to:

receive a near field communication (NFC) interrogation signal (NFCIS) from a point of sale (POS) assembly;

responsive to receiving the NFCIS, send a wireless message to an authorization device indicating receipt of the NFCIS; and

respond to the NFCIS.

The Examiner maintains the following rejection from the Non-Final Office Action for our review:

Claims 1–20 rejected under 35 U.S.C. § 102(a)(1) as anticipated by Jain (US 2009/0065571 A1, pub. Mar. 12, 2009).

#### OPINION

The Examiner rejected claims 1–20 as anticipated by Jain. Appellant addresses several of the appealed claims under separate headings. We will address the claims as argued by Appellant. Any claim not separately argued will stand or fall with its respective independent claim. (*See generally* App.

Br.)

Having considered the respective positions advanced by the Examiner and Appellant in light of this appeal record, we affirm the Examiner's rejection for the reasons set forth in the Answer to the Appeal Brief and Non-Final Office Action appealed from, which we adopt as our own. We highlight and address specific findings and arguments for emphasis as follows.

The proper test of a publication as a § 102(b) bar is “whether one skilled in the art to which the invention pertains could take the description of the invention in the printed publication and combine it with his own knowledge of the particular art and from this combination be put in possession of the invention on which a patent is sought.” *In re Elsner*, 381 F.3d 1125, 1128 (Fed. Cir. 2004) (*citing In re LeGrice*, 301 F.2d 929, 936 (CCPA 1962)). In particular, in view of the publication, one must be able to make the claimed invention without undue experimentation. *Elsner*, 381 F.3d at 1128.

#### Claim 1

Appellant argues the portions of Jain cited by the Examiner failed to “say anything about either an ‘inquiry’ as alleged or an ‘interrogation’ as claimed.” (App. Br. 7). Appellant in the Reply Brief contends an interrogation signal in the context of the claimed invention is “an initial signal” that powers up an e-card to begin communication, typically by providing identifying information to an interrogator. (Reply Br. 2).

Appellant's arguments are not persuasive of reversible error. In the context of the claimed invention, the Specification does not indicate that the

interrogation signal is required to “power[] up” an e-card. According to the Specification, the apparatus includes “at least one processor and at least one computer readable storage medium [that] includes instructions which when executed by the processor configure the processor to receive a near field communication (NFC) interrogation signal (NFCIS) from a point of sale (POS) assembly.” (Spec. 2).

Appellant argues that paragraphs 23 and 24 of Jain describe the transaction card initiating a transaction with the POS in response to a request from the POS but never disclose that the transaction card sends a message to the mobile device. (App. Br. 10).

We agree with the Examiner. Claim 1 specifies “responsive to receiving the NFCIS, send a wireless message to an authorization device indicating receipt of the NFCIS.” Jain discloses the POS terminal communicates with the e-card i.e., providing an interrogation signal, requesting authorization for a transaction with the e-card and requests the mobile device to authorize the transaction, such occurrence meets the claimed invention. (Jain ¶¶ 21–22). Jain specifically states:

In another example, the mobile device **110** may comprise a smartphone that includes an input device, such as a keypad, touch screen, mouse, or other device that can accept information, and an output device that conveys information associated with a transaction with the offline store **102**, including digital data, visual information, or GUI **111**.

(Jain ¶ 21).

Appellant argues that paragraph 46 of Jain does not teach or suggest sending a signal from the smartcard to another device indicating receipt of the interrogation signal as required by claim 1. (App. Br. 13–14).

Appellant's arguments regarding paragraph 46 lack persuasive merit. Jain's paragraph 46 describes an alternative embodiment that does not detract from the teachings relied upon by the Examiner.

Claim 2

Appellant argues Jain's paragraph 40 does not describe the claim limitation requiring the message from the e-card to the authorization device [to] include a transaction amount. (App. Br. 14). This argument lacks persuasive merit. The claimed invention is directed to an apparatus. Appellant is attempting to base patentability on the subject matter which does not form part of the apparatus, *Catalina Marketing Int'l., Inc. v. Coolsavings.com, Inc.*, 289 F.3d 801, 809 (Fed. Cir. 2002), or the function or result of that structure. *In re Danly*, 263 F.2d 844, 848 (CCPA 1959); *In re Gardiner*, 171 F.2d 313, 315–16 (CCPA 1948). Language in an apparatus claim directed to the function, operation, intent-of-use, and materials upon which these apparatus components work that does not structurally limit the apparatus components or patentably differentiate the claimed apparatus from an otherwise identical prior art apparatus will not support patentability. *See, e.g., In re Rishoi*, 197 F.2d 342, 344–45 (CCPA 1952); *In re Otto*, 312 F.2d 937, 940 (CCPA 1963); *In re Ludtke*, 441 F.2d 660, 663–64 (CCPA 1971); *In re Yanush*, 477 F.2d 958, 959 (CCPA 1973). The message provided to the authorization device is variable and is not a structural item of the apparatus.

Claims 4 and 11

Appellant argues Jain ¶ 26 does not provide an indication of an interrogation signal or that the transaction card responds to the interrogation

signal only upon receipt of an authorization signal from an authorization device.

We adopt the Examiner's response to Appellant's argument. (Answer 6–7). Appellant is reminded that a reference is available for all that it teaches. As discussed above, Jain teaches mobile devices that have input and output means. Without an initial interrogation signal, the user of the mobile device would not have a notification that input such as a pin number was required.

Claims 8 and 12

Appellant argues Jain's paragraph 23 "says nothing about low-energy Bluetooth." App. Br. 15.

We adopt the Examiner's response to Appellant's argument. (Answer 7). It is not been disputed the Jain describes the suitability of utilizing Bluetooth for communication. Appellant has not explained why the disclosure of Bluetooth is patentably distinct from low-energy Bluetooth.

Claim 9

Appellant reiterates the argument presented when addressing claim 1, that Jain does not teach or suggest automatically reporting by an e-card the interrogation signal to a consumer electronic device. (App. Br. 15).

Appellant's arguments are not persuasive for the reasons set forth above and presented by the Examiner. (Ans. 7–8).

Claim 14

Appellant argues Jain fails to describe that the user interface is presented in response to receiving an interrogation notification from an e-card. (App. Br. 16).

Appellant's arguments are not persuasive for the reasons set forth

above and presented by the Examiner. (Ans. 9). As discussed above, Jain describes actions required by the user, to be inputted by a mobile device, based on notification received from the POS. ( Jain ¶¶ 22–23).

Claims 15, 17, and 18

Appellant’s arguments (App. Br. 16–17) are not persuasive for the reasons set forth above and presented by the Examiner. (Ans. 9–10). As discussed above, Jain describes actions required by the user, to be inputted by a mobile device, based on notification received from the POS. (Jain ¶¶ 22–23).

Accordingly, we affirm the Examiner’s 35 U.S.C. § 102(a)(1) rejection of claims 1–20 for the reasons given above and presented by the Examiner.

#### DECISION

The Examiner’s prior art rejection of claims 1–20 under 35 U.S.C. § 102(a)(1) is affirmed.

#### TIME PERIOD

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).

AFFIRMED

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* BRANT CANDELORE,  
STEVEN MARTIN RICHMAN, and FREDERICK J. ZUSTAK

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Appeal 2017-009525  
Application 14/493,825  
Technology Center 2800

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Before ADRIENE LEPIANE HANLON, JEFFREY T. SMITH,  
and LILAN REN, *Administrative Patent Judges*.

Opinion dissenting filed by *Administrative Patent Judge* HANLON.

I respectfully dissent from the majority opinion affirming the Examiner's decision to reject claims 1–20 under 35 U.S.C. § 102(a)(1) as anticipated by Jain.

“To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently.” *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997). Moreover,

the [prior art] reference must clearly and unequivocally disclose the claimed [invention] or direct those skilled in the art to the [invention] without *any* need for picking, choosing, and combining various disclosures . . . . Such picking and choosing may be entirely proper in the making of a 103, obviousness rejection, where the applicant must be afforded an opportunity to rebut with objective evidence any inference of obviousness . . . , but it has no place in the making of a 102, anticipation rejection.

*In re Arkley*, 455 F.2d 586, 587–88 (CCPA 1972).

A. Claims 1–13

The apparatus recited in claim 1 comprises, *inter alia*, a computer memory comprising instructions executable by a processor to:

receive a near field communication (NFC) *interrogation signal* (NFCIS) from a point of sale (POS) assembly;

*responsive to* receiving the NFCIS, send a wireless message to an authorization device indicating receipt of the NFCIS, and respond to the NFCIS.

App. Br. 18 (emphasis added).

The claimed processor may be contained in an e-card. *See* App. Br. 7 (labelling claim 1 “*e-card claim*”). The claimed authorization device may be a smart phone. *See* Spec. 24–25 (disclosing that e-card 50 receives an interrogation such as an NFC interrogation signal from a kiosk and the e-card, in turn, sends a notification to consumer electronics (CE) device 12 that it has been interrogated); Spec. 8 (disclosing that CE device 12 is a mobile computing device such as a smart phone).

Similarly, claim 9 recites a method comprising the steps of (1) receiving, at an e-card, a transaction *interrogation* from a POS apparatus and (2) automatically *reporting*, by the e-card, *the interrogation* to a CE device associated with the e-card. App. Br. 9 (emphasis added).

Relying on paragraphs 21–26 of Jain, the Examiner finds that Jain’s card 112, in response to receiving a NFCIS from a POS assembly, sends a wireless message to an authorization device 110 (i.e., a mobile device) indicating receipt of the NFCIS, as claimed. Final Act. 2; Ans. 2.

The Appellants argue that paragraphs 21–26 of Jain do not disclose an “interrogation” as claimed. App. Br. 7. The Appellants argue that

paragraph 46 of Jain “explicitly mentions an interrogation signal, meaning Jain contemplated such signals, but never ties that signal to the combination claimed.” App. Br. 7.

To address the Appellants’ argument, it is necessary to interpret the term “interrogation signal.” The terms “interrogation” or “interrogation signal” do not appear in paragraphs 21–26 of Jain, and the Examiner does not offer an interpretation of “interrogation” or “interrogation signal” in the rejection on appeal. *See* Final Act. 2; *see also* App. Br. 14 (“no claim construction of ‘NFCIS’ has been made of record to explain what other signal in Jain allegedly satisfies the claim language”); *see also* App. Br. 5–6. Nonetheless, the Examiner provides the following definition of “interrogation signal” in the Answer:

An interrogation signal for computing devices is to transmit a signal for *setting off an appropriate response*. For instance, if the POS terminal communicates with the e-card requesting authorization for a transaction which the e-card requests the mobile device to authorize the transaction, such occurrence meets the claim’s language “interrogation signal” receiving/notifying.

Ans. 5 (emphasis added).

In response, the Appellants argue:

The problem with the definition proffered in the Answer is that it has been entirely made up without any support to cover any signal that ‘sets off an appropriate response’. As a practical matter, the definition covers every electronic signal imaginable, since every signal “sets off” some kind of response at a receiver.

Reply Br. 2.

The Appellants argue that “both the instant specification (bottom of page 11) and Jain (paragraph 46) understand that an interrogation signal in

the context of e-cards is an initial signal, because it powers up the circuitry of the e-card.” Reply Br. 2.

The Appellants disclose:

In some embodiments, the bank card 50 includes a first electronic circuit that is configured to respond to interrogation signals from the kiosk 52 by using the signals to momentarily *power or excite the circuit 58 [in bank card 50]* to emit a short range NFC signal from an NFC element 60, such as an RFID tag.

Spec. 11, ll. 21–24 (emphasis added); *see also* Appellants’ Fig. 1 (showing circuit 58 in bank card 50).

Similarly, Jain discloses that “contactless smart card **214** operates independent of an internal power supply and captures energy from incident radio-frequency interrogation signals *to power the embedded electronics.*” Jain ¶ 46 (italics added).

Based on the foregoing, a preponderance of the evidence supports the Appellants’ interpretation of “interrogation signal.” Therefore, I interpret “interrogation signal” and “interrogation” recited in the claims on appeal as a signal that powers or excites electronics contained in an e-card. *See In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997) (during examination, “the PTO applies to the verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant’s specification”).

In the rejection on appeal, the Examiner relies on paragraph 23 and 25 and Figure 2 of Jain to support a finding that card 112 “receive[s] a near

field communication (NFC) interrogation signal (NFCIS) from a point of sale (POS) assembly.” Final Act. 2; Ans. 2.

As explained above, the term “interrogation signal,” however, does not appear in those portions of Jain. Nonetheless, the Examiner finds that Jain teaches that the transaction card “wirelessly receives [a] request from [a] POS device to execute a transaction.” Ans. 5 (citing Jain ¶ 23). In that regard, the Examiner finds that “[i]t is clear that the POS terminal sends signals to the e-card to *set off appropriate responses*, such as requesting PIN or other forms of authorizations.” Ans. 5 (emphasis added). The Examiner, however, does not find that the signals sent by the POS assembly are “interrogation signals” as that term is used in the claims on appeal (i.e., signals that power or excite electronics contained in the transaction card).

Moreover, even if the Examiner’s definition of “interrogation signal” were adopted, claim 1 also recites that “*responsive to receiving the NFCIS, [the processor in the e-card] send[s] a wireless message to an authorization device indicating receipt of the NFCIS.*”<sup>2</sup> App. Br. 18 (emphasis added). Similarly, claim 9 recites “*automatically reporting, by the e-card, the interrogation to a consumer electronics (CE) device associated with the e-card.*” App. Br. 19 (emphasis added).

The Appellants argue that the Examiner reversibly erred in finding that Jain teaches that the e-card, *responsive to receiving a NFCIS from a POS assembly*, sends a wireless message to an authorization device indicating receipt of the NFCIS as claimed. App. Br. 7.

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<sup>2</sup> See Reply Br. 3 (arguing that “even under the unduly broad and legally unsupportable definition of ‘interrogation signal[’] proffered in the Answer, Jain fails to teach the claimed ‘in response to’ link”).

In the rejection on appeal, the Examiner finds that “the transaction card communicates inquiry information to authorization [device] 110.” Final Act. 2, Ans. 2 (citing Jain ¶¶ 21–26); *see also* Jain ¶ 21 (disclosing that mobile device 110, such as a smart phone, is capable of communicating information with transaction card 112). The Examiner, however, does not identify any specific disclosure in Jain paragraphs 21–26 disclosing that the transaction card communicates with the mobile device *in response to* receiving a NFC interrogation signal and sends a message to the mobile device indicating receipt of the NFCIS, as claimed.

In the Answer, the Examiner finds:

[Jain] teaches that the transaction card may execute the following: wirelessly receives request from POS device to execute a transaction and/or to provide a response, present and receive information (e.g., PIN request, PIN) from the user GUI 111 (from the mobile device), execute authentication based on information received from the GUI 111, generate and/or present alert to the user through the GUI 111, generate and/or transmit wireless message alert to the financial institution, etc.

Ans. 5 (citing Jain ¶ 23, ll. 20+) (emphasis omitted).

That portion of Jain, however, does not disclose that the transaction card, *in response to* receiving the NFCIS, sends a wireless message to mobile device 110 indicating receipt of the NFCIS, as claimed. *See* App. Br. 10 (“paragraph 23 does not teach anything about the mobile device receiving or a transaction card sending to the mobile device a wireless message indicating receipt of an interrogation signal”). Rather, the disclosure of Jain relied on by the Examiner lists individual operations of the transaction card and does not describe any interaction or connection between the individual operations. *See* Jain ¶ 23 (disclosing that “[i]n some implementations, the transaction card **112** may execute one or more of the following”). To the

extent that the disclosure in Jain paragraph 23 supports a conclusion of obviousness, that issue is not before the Board on appeal.

The Examiner also finds:

[Jain] discloses that e-card (transaction card) *may* execute a transaction with the POS terminal *without* the aspect of the transaction being executed by the mobile terminal (see par. 0023, lines 3-6), *this is clearly an indication that the mobile terminal normally authorizes the transactions*. This is an indication that when the POS terminal communicates with the e-card regarding transactions, the e-card notifies the mobile terminal to authorize the transactions. For example, if a transaction between the POS and e-card requires a PIN, the e-card must communicate with the mobile device so that the PIN is entered via the graphical interface.

Ans. 5 (original emphasis omitted).

Jain discloses:

The transaction card **112** can include any software, hardware, and/or firmware configured to wirelessly execute transactions with the POS device **114**. For example, the transaction card **112** *may* execute a contactless transaction with the POS device **114** *independent of* the mobile device **110a**. In other words, the transaction card **112** may wirelessly execute transactions *without* aspects of the transaction being executed by the mobile device **110**.

Jain ¶ 23 (italics added).

The portion of Jain relied on by the Examiner does not expressly disclose that “when the POS terminal communicates with the e-card regarding transactions, the e-card notifies the mobile terminal to authorize the transactions” as found by the Examiner. *See* Ans. 5. Rather, Jain discloses that the transaction card *may* execute a transaction with the POS device *independent of* the mobile device. Jain ¶ 23.

The Examiner appears to rely on the word “may” as evidence that Jain inherently discloses the opposite of what is expressly disclosed. The term “may,” however, is “used to indicate possibility or probability.”

<http://www.merriam-webster.com>, Definition of “*may*” (last visited October 28, 2018). That is, Jain discloses that one possible use of transaction card 112 is to execute a contactless transaction with the POS device *independent* of the mobile device. Jain ¶ 23.

Based on the foregoing, a preponderance of the evidence does not support the Examiner’s finding that Jain’s transaction card receives a NFC interrogation signal from the POS assembly, and in response to receiving that signal, sends a message indicating receipt of the interrogation signal, or reports the interrogation, to mobile device 110. Thus, for the reasons set forth above, I would not sustain the anticipation rejection of claims 1–13.

B. Claims 14–20

Claim 14 reads as follows:

14. Non-transitory computer readable storage medium (NCRSM) including instructions executable by a processor to configure the processor to:

present on a display at least one user interface (UI) *in response to* receiving an interrogation notification from an electronic transaction card (e-card);

present on the display at least one user input prompt.

App. Br. 20–21 (emphasis added).

The Examiner finds that “in addition to limitations discussed above, the user authorization device 110 (i.e. cell phone, PDA, etc.) includes display through user interface 111 for receiving PIN (see par. 0023).” Final Act. 4; Ans. 4.

The Appellants argue that “the rejection plainly fails to allege where Jain teaches the UI of Claim 14, in which the UI is presented *in response to* receiving an interrogation notification from an electronic transaction card (e-card). App. Br. 16.

In response, the Examiner finds:

The prior art teaches that the transaction card may execute the following: wirelessly receives request from POS device to execute a transaction and/or to provide a response, present and receive information (e.g., PIN request, PIN) from the user GUI 111 (from the mobile device/CE), execute authentication based on information received from the GUI 111, generate and/or present alert to the user through the GUI 111, generate and/or transmit wireless message alert to the financial institution, etc. (See par. 23, line 20+). It is clear that the prior art teaches *presenting and receiving information from user through the GUI 111*.

Ans. 8–9 (italics added).

The Appellants argue that the Examiner’s findings “fail[] to address what is claimed, which is that a UI is presented on a display *responsive to* something (not addressed in the Answer) and not just responsive to anything, but to a specific signal – an interrogation notification from an e-card (also not addressed).” Reply Br. 5.

The Appellants’ argument is supported by the record. Notably, the disclosure of Jain relied on by the Examiner, lists individual operations of the transaction card and does not describe any interaction or connection between the individual operations. See Jain ¶ 23 (disclosing that “[i]n some implementations, the transaction card **112** may execute one or more of the following”).

For the reasons set forth above, I would not sustain the anticipation rejection of claims 14–20. To the extent that the disclosure in Jain

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paragraph 23 supports a conclusion of obviousness, that issue is not before the Board on appeal.