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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte RAJ RAO

Appeal 2017-011563
Application 14/664,390
Technology Center 3600

Before ERIC S. FRAHM, CARL L. SILVERMAN, and
MICHAEL J. ENGLE, *Administrative Patent Judges*.

ENGLE, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant appeals under 35 U.S.C. § 134(a) from a final rejection of claims 1 and 2. Claims 3–20 have been withdrawn. We have jurisdiction over the rejected claims under 35 U.S.C. § 6(b).

We AFFIRM-IN-PART.

Technology

The application relates to “a smart electronic wallet” that is “able to capture account numbers and other information encoded on . . . credit cards . . . and instead provide a single-reconfigurable transaction card in their place to dramatically reduce the number of cards” that “a consumer is obliged to carry.” Spec. 1.

Rejected Claims

Claims 1 and 2 are reproduced below with certain limitations at issue emphasized (*italics* for indefiniteness, underlining for obviousness, and **bold** for written description):

1. A system for establishing an interactive community of wallet device holders linked by a communication network, the system comprising:

a *system controller*; and

a plurality of wallet devices, each of the wallet devices being selectively linked to one another and to the system controller, each wallet device including:

a portable wallet body defining at least one compartment,

at least one proxy card removably stored within said portable wallet body, said proxy card being electronically reconfigurable to selectively *emulate a magnetic data encoding* of at least one of a plurality of predetermined account bearing transaction cards, and

a transaction card interface unit disposed within said wallet body, said transaction card interface unit including:

a user interface portion,

a card encoding portion actuated responsive to said user interface portion to selectively encode onto said proxy card account data corresponding to at least one of the predetermined account-bearing transaction cards, said proxy card being thereby readable as a substitute therefor,

a network interface unit, and

a processor coupled to said user interface portion and said network interface unit,

wherein said transaction card interface unit of each wallet device is actuatable to selectively access a plurality of community

interfaces through the user interface portion, each community interface being *configured for* one of a plurality of predetermined *interactive contexts* between wallet device holders or between a wallet device holder and the system controller.

2. The system of claim 1, further comprising **a *profile processor selectively linked to one or more of the plurality of wallet devices and providing a plurality of wallet device holder profiles***, each profile containing information of a wallet device holder.

Rejections

Claims 1 and 2 stand rejected under 35 U.S.C. § 112(a) for lack of written description. Final Act. 8.

Claims 1 and 2 stand rejected under 35 U.S.C. § 112(b) as indefinite. Final Act. 9.

Claims 1 and 2 stand rejected under 35 U.S.C. § 103 as obvious over US 2011/0047074 A1 (“Cai”; Feb. 24, 2011) and US 6,595,342 B1 (“Maritzen”; July 22, 2003). Final Act. 14.

ISSUES

1. Did the Examiner err in finding the following terms lacked written description:

a. “said proxy card being electronically reconfigurable to selectively emulate a magnetic data encoding of at least one of a plurality of predetermined account bearing transaction cards,” as recited in claim 1, and

b. “a profile processor selectively linked to one or more of the plurality of wallet devices and providing a plurality of wallet device holder profiles,” as recited in claim 2?

2. Did the Examiner err in concluding that the following terms rendered the claims indefinite:

a. “system controller,” “emulate,” and “configured for one of a plurality of predetermined interactive contexts between wallet device holders or between a wallet device holder and the system controller,” as recited in claim 1, and

b. “a profile processor selectively linked to one or more of the plurality of wallet devices and providing a plurality of wallet device holder profiles,” as recited in claim 2?

3. Did the Examiner err in finding Maritzen teaches or suggests “a plurality of wallet devices, each of the wallet devices being selectively linked to one another” and “said transaction card interface unit of each wallet device is actuable to selectively access a plurality of community interfaces through the user interface portion,” as recited in claim 1?

4. Is the Examiner’s withdrawal of claims 3–18 after Appellant’s restriction election appealable or only petitionable?

ANALYSIS

Written Description

A) Claim 1

Claim 1 recites “said proxy card being electronically reconfigurable to selectively emulate a magnetic data encoding of at least one of a plurality of predetermined account bearing transaction cards.”

The Examiner finds that the “Merriam-Webster dictionary defines the term [‘]encode[’] as a transitive verb to describe ‘1 a: to convert (something, such as a body of information) from one system of communication into

another; especially: to convert (a message) into code.’” Ans. 3. Based on this definition, the Examiner determines “there simply is no support in the Specification that discloses magnetic data converting at least one of a plurality of predetermined account bearing transaction cards into a code.” *Id.* Thus, the Examiner interprets “encoding” as a verb whose subject is “a magnetic data.”

However, we agree with Appellant “that ‘encoding’ is a noun, not a verb.” Reply Br. 2. More specifically, “encoding” here is used as a gerund. Thus, the phrase means “an encoding of magnetic data” and the rest of the limitation explains that the proxy card emulates that encoding. Appellant analogizes “a magnetic data encoding” to the phrase “an office building,” which normally means (A) a structure that is an office rather than (B) an office (subject) that is doing the action of building (verb) or (C) “a process of building an office.” *See id.*

Here, in this context, the proxy card emulates an encoding, such as an encoding of a credit card. The Specification describes in detail how a “reconfigurable transaction card employing the passive magnetic tape may be selectively re-encoded . . . to match the *encodings* copied from a traditional single-use transaction card belonging to the card-holder.” Spec. 25 (emphasis added). “In this manner, the smart wallet may be employed to copy magstripe contents from, for example: the cardholder’s VISA, MASTERCARD, AMERICAN EXPRESS, DISCOVERY, library card, BEST BUY gift certificate, gym pass, and the like” and “encode the contents of the selected transaction card onto the magnetic strip of the reconfigurable transaction card” such that the “reconfigurable transaction card may then be swiped through a reader and be indistinguishable from the single-use

transaction card.” *Id.* Thus, the Specification adequately supports a proxy card being electronically reconfigurable to selectively emulate an encoding (specifically, a magnetic data encoding) of at least one of a plurality of predetermined account bearing transaction cards (e.g., a credit card).

Accordingly, we do not sustain the Examiner’s rejection of claim 1 under § 112(a).

B) Claim 2

Claim 2 recites “a profile processor selectively linked to one or more of the plurality of wallet devices and providing a plurality of wallet device holder profiles.”

We agree with the Examiner that Appellant fails to show how this limitation is adequately supported by the Specification. Ans. 4. Appellant points to pages 58, 67, 70, and 71 of the Specification as well as Figures 22 and 23B, all of which mention a “profile” but none of which expressly disclose a “processor,” let alone a “profile processor” that is both “selectively linked” and “providing . . . profiles.” App. Br. 16. Similarly, Appellant points to the first full paragraph on page 88 of the Specification. *Id.* The cited text is the last paragraph before the claims and says that “[t]hese and related algorithms, and other necessary instructions, may be . . . executed using one or more processors.” Spec. 88. Yet Appellant fails to explain how this is sufficient to disclose “a profile processor” that is both “selectively linked” and “providing . . . profiles.”

For written description, “the test for sufficiency is whether the disclosure of the application relied upon reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date.” *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351

(Fed. Cir. 2010) (en banc). “[T]he hallmark of written description is disclosure.” *Id.* “And while the description requirement does not demand any particular form of disclosure, or that the specification recite the claimed invention *in haec verba*, a description that merely renders the invention obvious does not satisfy the requirement.” *Id.* at 1352 (citation omitted). Thus, “[i]t is not sufficient for purposes of the written description requirement of § 112 that the disclosure, when combined with knowledge in the art, would lead one to speculate as to modifications that the inventor might have envisioned, but failed to disclose.” *Lockwood v. Am. Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997). Here, although the Specification separately discloses a “profile” and a “processor,” Appellant fails to identify any part of the Specification that discloses “a profile processor” that is both “selectively linked” and “providing . . . profiles,” as required by claim 2.

Accordingly, we sustain the Examiner’s rejection of claim 2 under § 112(a).

Indefiniteness

A) “*system controller*” (claim 1) and “*profile processor*” (claim 2)

Claim 1 recites “a system controller” and claim 2 recites “a profile processor.”

The Examiner concludes that “the detailed specification along with the drawing[s] do not specifically disclose a system controller and profile processor” so therefore “the metes and boundary of the claim is unclear.”

Ans. 5. For example, the claimed “system controller” could “be a component of [the] retail website, a component of [the] desktop computer/laptop, a component of [the] wireless communication mobile device, or a component of the smart wallet.” *Id.*

We agree with Appellant, however, that “breadth is not indefiniteness.” *SmithKline Beecham Corp. v. Apotex Corp.*, 403 F.3d 1331, 1341 (Fed. Cir. 2005) (quotation omitted); *see also* App. Br. 17–18. To the extent the Examiner states that the Specification fails to disclose these limitations, that is a question of written description under § 112(a), not indefiniteness under § 112(b).

B) “emulate” and “contexts” (claim 1)

Appellant next disputes the Examiner’s definitions for two terms: “emulate” and “context.”

First, claim 1 recites “said proxy card being electronically reconfigurable to selectively *emulate* a magnetic data encoding of at least one of a plurality of predetermined account bearing transaction cards.”

The Examiner sets forth a dictionary definition that “defines [the] term ‘emulate’ as ‘1 a: to strive to equal or excel.’” Final Act. 12.

Appellant argues that “this definition is not the one commonly understood in the fields of networking and computing” and instead the same dictionary “also provides a second definition, ‘imitate,’ which reflects the common meaning in applicable fields.” App. Br. 19.

Second, claim 1 further recites “each community interface being configured for one of a plurality of predetermined *interactive contexts* between wallet device holders or between a wallet device holder and the system controller.”

The Examiner asks, “What exactly is ‘interactive contexts’ between wallet device holders . . . , especially when the specification does not describe [the] term ‘interactive contexts’.” Final Act. 12. The Examiner then sets forth a dictionary definition that “defines [the] term ‘context’ as

‘1: the parts of a discourse that surround a word or passage and can throw light on its meaning’.” *Id.*

Similar to “emulate,” Appellant argues “the selected definition is one that applies to the field of human language analysis” and does not apply “to the fields of networking and computing.” App. Br. 20. Appellant further notes that the same dictionary and unspecified other sources “recognize an equally valid and more plainly applicable definition: ‘the interrelated conditions in which something exists or occurs’.” *Id.*

“While the Board must give the terms their broadest reasonable construction, the construction cannot be divorced from the specification and the record evidence.” *In re NTP, Inc.*, 654 F.3d 1279, 1288 (Fed. Cir. 2011). “Construing individual words of a claim without considering the context in which those words appear is simply not ‘reasonable.’” *Trivascular, Inc. v. Samuels*, 812 F.3d 1056, 1062 (Fed. Cir. 2016).

Here, we agree with Appellant that the Examiner’s selection of the first dictionary definitions for “emulate” and “context” does not sufficiently consider the Specification, including the claims. The terms “emulate” and “context” have longstanding meanings in computing. *See, e.g.*, Reply Br. 3 (citing a 1988 magazine asking, “Can a Commodore 64 emulate MS-DOS?”). We further agree with Appellant that the use of these terms in their ordinary computing sense do not render claim 1 indefinite.

C) “*configured for*” (*claim 1*)

Claim 1 recites “each community interface being *configured for* one of a plurality of predetermined interactive contexts between wallet device holders or between a wallet device holder and the system controller.”

The Examiner determines that this limitation “merely describes a desired result[] . . . rather than how . . . each community interface is configured to result in such desired result.” Ans. 7. However, we agree with Appellant that “the phrase ‘configured for’ denotes an actual state of configuration that fundamentally ties the ‘predetermined interactive contexts between [components]’ to the . . . characteristics of the community interfaces.” App. Br. 21. As discussed above, breadth is not indefiniteness. Thus, the recitation “configured to,” although broad, does not render claim 1 indefinite.

D) “selectively linked” (claim 2)

Claim 2 recites “a profile processor *selectively linked* to one or more of the plurality of wallet devices.”

The Examiner determines that this limitation renders claim 2 indefinite because it inserts a method step (i.e., “a user selectively linking”) into a system claim. Ans. 7–8. However, we agree with Appellant that “the claim recites a selectively-enabled linkage between the profile processor and at least one of the wallet devices” and “not . . . a recitation of any method operation.” App. Br. 22.

Accordingly, we do not sustain the Examiner’s rejection of claims 1 and 2 under § 112(b).

Obviousness

A) “said transaction card interface unit of each wallet device is actuable to selectively access a plurality of community interfaces through the user interface portion” (claim 1)

Claim 1 recites “said transaction card interface unit *of each wallet device* is actuable to selectively access a plurality of community interfaces

through the user interface portion.” Claim 1 further recites that “each *wallet device* including . . . a transaction card interface unit . . . including . . . a user interface portion.” Thus, the claimed “transaction card interface unit” and “user interface portion” must both be part of the wallet device.

Appellant argues that the relied-upon portions of Maritzen “employ a web browser on a personal computer, separate from any wallet device.” App. Br. 24. However, we agree with the Examiner that Maritzen “discloses accessing of the community interface . . . using the wallet device . . . by tapping on the on-screen icon displayed on the transaction device, e.g. wallet device.” Ans. 9 (citing Maritzen 28:14–25). “For example, if the transaction device is used to trigger shopping activity, the user may tap on an on-screen icon being displayed *by the transaction device, e.g., digital wallet . . .*” Maritzen 28:21–24 (emphasis added). Thus, Maritzen teaches or suggests this limitation.

B) “a plurality of wallet devices, each of the wallet devices being selectively linked to one another” (claim 1)

Claim 1 recites “a plurality of wallet devices, each of the wallet devices being selectively linked to one another.”

The Examiner determines that “the claimed limitation of ‘wherein said transaction card interface unit of each wallet device is actuable to selectively access a plurality of community interfaces through the user interface portion’ *necessarily* reads on the each of the wallet devices being selectively linked to one another.” Ans. 8 (emphasis added). “By interacting with the issuing facility, [Maritzen’s] wallet device(s) registered to the issuing facility is *necessarily* linked to one another.” *Id.* at 9 (emphasis added).

The Federal Circuit has held that “[a] party must . . . meet a high standard in order to rely on inherency to establish the existence of a claim limitation in the prior art in an obviousness analysis—the limitation at issue necessarily must be present, or the natural result of the combination of elements explicitly disclosed by the prior art.” *PAR Pharm., Inc. v. TWi Pharms., Inc.*, 773 F.3d 1186, 1195–96 (Fed. Cir. 2014). “Inherency, 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.” *Id.* at 1195 (emphasis added, quotation omitted).

Here, we agree with Appellant that Maritzen’s disclosure of multiple wallet devices linked to a central issuing facility does not *necessarily* disclose a plurality of wallet devices “being selectively linked to one another.” Reply Br. 4–5. In the same way, absent further evidence, two users checking their bank accounts on a bank’s website does not necessarily mean that those two users are “selectively linked” to each other.

Accordingly, we do not sustain the Examiner’s rejection under § 103 of claim 1 and dependent claim 2.

Withdrawal of Claims 3–18 After Restriction Election

On June 10, 2015, the Examiner mailed a restriction requirement stating that claims 1–20 were directed to twelve different species, which the Examiner labeled Species A through L. However, the Examiner did not identify which claims fell under each species.

On August 10, 2015, Appellant submitted a response in which Appellant “elects Species D,” stating that Appellant “further believes that Claims 1-18 read on Species D.” Resp. to Restriction Requirement 2 (Aug.

10, 2015). Appellant also “requested that Claims 19-20 be withdrawn from consideration.” *Id.*

On October 19, 2015, the Examiner mailed a non-final office action stating that “[i]n regards to the applicant’s assertion that Claims 1-18 read on Species D, the examiner respectfully disagree[s]” because “claims 3-4 are directed to . . . Species E, claims 5-6 are directed to . . . Species F, claims 7-10 are directed to . . . Species G, claims 11-14 are directed to . . . Species H, claims 15-17 are directed to . . . Species I, while claim 18 is directed to . . . Species J.” Non-Final Act. 3 (Oct. 19, 2015). “As such, claims 3-20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected group(s).” *Id.*

On March 21, 2016, Appellant submitted an amendment noting that “the original Restriction Requirement of June 10, 2015 did not state that the Examiner believed Species D to only encompass Claims 1 and 2” and that having now had the Examiner identify those claims, “Applicant still elects Species D, but with traverse as to which claims are excluded from Species D [i.e., claims 3–18].” Amendment 15–16 (Mar. 21, 2016). Appellant then provided arguments in support of traversing the restriction for claims 3–18. *Id.* at 16.

On November 22, 2016, the Examiner mailed a final office action in which the Examiner stated that “[t]he applicant is reminded that it is the responsibility of the examiner in withdrawing claims not the applicant”; reiterated that “claims 3-18 are not member[s] of Species D”; and addressed Appellant’s arguments. Final Act. 2–3 (Nov. 22, 2016). The Examiner therefore maintained the Examiner’s withdrawal of claims 3–18. *Id.*

The present appeal is from that office action dated November 22, 2016.

Appellant argues that claims 3–18 “all elaborate on a disclosed element of Species D, and should be included in said species” and “should be therefore restored from withdrawal and considered on the merits.” App. Br. 25, 26. Appellant further argues that “the withdrawal without election” is “a question of claim interpretation,” which “is an appropriate subject for appeal.” Reply Br. 5.

We agree with the Examiner, however, that this “restriction matter is not a matter of appeal” but “rather is a matter of petition.” Ans. 10. By statute, “[a]n applicant for a patent, any of whose claims has been twice *rejected*, may appeal from the decision of the primary examiner to the Patent Trial and Appeal Board.” 35 U.S.C. § 134(a) (emphasis added). Here, however, claims 3–18 are *withdrawn*, not rejected. *See* Final Act. 1 (Nov. 22, 2016); Non-Final Act. 3 (Oct. 19, 2015). Such matters are petitionable, not appealable. *See, e.g.*, MPEP § 1002.02(c) (listing “[p]etitions from a final decision of examiner requiring restriction in patent applications under 37 CFR 1.144 and MPEP § 818.01(c)” as being “[d]ecided by the Technology Center Directors”).

DECISION

For the reasons above, we hold as follows:

Basis	Claims Rejected	Affirmed	Reversed
§ 112(a)	1, 2	2	1
§ 112(b)			1, 2
§ 103			1, 2
Overall		2	1

No time for taking subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 41.50(f).

AFFIRMED-IN-PART