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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MARK CARLSON and PATRICK STAN

Appeal 2017-011685
Application 13/786,716
Technology Center 3600

Before ROBERT E. NAPPI, ST. JOHN COURTENAY III, and
LARRY J. HUME, *Administrative Patent Judges*.

HUME, *Administrative Patent Judge*.

DECISION ON APPEAL

Pursuant to 35 U.S.C. § 134(a), Appellant,¹ Visa International Service Association, appeals from the Examiner's decision rejecting claims 1–20, which are all claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

¹ We use the word “Appellant” to refer to “Applicant” as defined in 37 C.F.R. § 1.42(a). Appellant identifies the real party in interest as Visa International Service Association, the assignee of the Application. Br. 2.

STATEMENT OF THE CASE²

The Invention

The claims are directed to systems and methods to process offers via mobile devices. *See Spec. (Title)*. In particular, Appellant’s disclosed embodiments and claimed invention “relate to the processing of transaction data, such as records of payments made via credit cards, debit cards, prepaid cards, etc., and/or providing information based on the processing of the transaction data.” *Spec. ¶ 3*.

Exemplary Claim

Claim 1, reproduced below, is representative of the subject matter on appeal (*emphases* added to dispositive prior-art limitation):

1. A method implemented in a mobile device, the method comprising:
 - providing the mobile device having:
 - a directional compass component configured to determine a current orientation of the mobile device;
 - memory storing data representing a set of offers, each of the offers associated with a merchant and having a benefit redeemable after a transaction between a user of the mobile device and the merchant; and
 - an audio/video rendering component;

² Our Decision relies upon Appellant’s Appeal Brief (“Br.,” filed Feb. 7, 2017); Examiner’s Answer (“Ans.,” mailed July 24, 2017); Final Office Action (“Final Act.,” mailed Sept. 7, 2016); and the original Specification (“Spec.,” filed Mar. 6, 2013) (claiming benefit of US 61/608,069, filed Mar. 7, 2012). Appellant did not file a Reply Brief in response to the factual findings and legal conclusions in the Examiner’s Answer. An Oral Hearing was conducted September 19, 2019, and a hearing transcript will be made of record in due course.

providing a mobile application running in the mobile device;

determining, by the mobile application running in the mobile device from the directional compass component, the current orientation of the mobile device;

selecting, by the mobile application, a geographical area defined at least in part by the current orientation of the mobile device;

selecting, by the mobile application, a subset of offers from the set of offers stored in the memory of the mobile device, based on locations of merchants associated with offers in the subset being in the geographical area defined by the current orientation of the mobile device; and

rendering, by the mobile device using the audio/video rendering component under control by the mobile application, a presentation of the subset of offers stored in the memory of the mobile device.

Prior Art

The Examiner relies upon the following prior art as evidence in rejecting the claims on appeal:

Ives	US 2007/028704 A1	Sept. 6, 2007
Wane	US 2009/0144164 A1	June 4, 2009
Khosravy	US 2010/0008255 A1	Jan. 14, 2010
Farrow	US 2010/0136898 A1	June 3, 2010
Winkler	US 2010/0167823 A1	July 1, 2010
Winters	US 2011/0087531 A1	Apr. 14, 2011
Mishra	US 2012/0252558 A1	Oct. 4, 2012
Klems	US 2012/0323664 A1	Dec. 20, 2012
Wilson	US 2013/0179264 A1	July 11, 2013

*Rejections on Appeal*³

R1. Claims 1, 2, 7, and 17–20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Farrow and Klems. Final Act. 3.

R2. Claims 9, 10, and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Farrow, Klems, and Khosravy. Final Act. 18.

R3. Claim 3 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Farrow, Klems, and Wane. Final Act. 20.

R4. Claims 4–6 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Farrow, Klems, and Winters. Final Act. 21.

R5. Claim 8 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Farrow, Klems, and Wilson. Final Act. 23.

R6. Claim 11 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Farrow, Klems, and Ives. Final Act. 24.

R7. Claims 13 and 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Farrow, Klems, and Mishra. *Id.*

³ We note the Examiner has withdrawn the rejection of claims 1–20 under § 101 as being directed to patent-ineligible subject matter. Final Act. 2.

R8. Claim 14 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Farrow, Klems, Mishra, and Winkler. Final Act. 26.

R9. Claim 16 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Farrow, Klems, Mishra, and Winters. *Id.*

ISSUES AND ANALYSIS

Based upon our review of the record, we find a preponderance of the evidence supports particular arguments advanced by Appellant with respect to independent claims 1, 17, and 18 for the specific reasons discussed below. We highlight and address specific findings and arguments regarding claim 1 for emphasis as follows.

1. § 103(a) Rejection R1 of Claims 1, 2, 7, and 17–20

Issue 1

Appellant argues (Br. 3–10) the Examiner’s rejection of claim 1 under 35 U.S.C. § 103(a) as being obvious over the combination of Farrow and Klems is in error. These contentions present us with the following issue:

Did the Examiner err in finding the cited prior art combination teaches or suggests “[a] method implemented in a mobile device” that includes, *inter alia*, the limitations of “selecting . . . a geographical area defined at least in part by the current orientation of the mobile device;” and “selecting . . . a subset of offers . . . based on locations of merchants associated with offers in the subset being in the geographical area defined by the current orientation of the mobile device,” as recited in claim 1?

Analysis

The Examiner relies upon Farrow as teaching or suggested most limitations of claim 1, in particular, the two dispositive “selecting” steps quoted in pertinent part above. Final Act. 5–7.

Appellant contends “Farrow and Klems merely passes the heading of the vehicle to the control section 90 of Farrow. There is no indication of how such a heading is used in the control section 90 of Farrow. The assertion of using the heading to define a geographical area in a combination of Farrow and Klems is not based on the actual teaching of Farrow and Klems.” Br. 7. We agree with Appellant’s argument, which we determine to be dispositive of this Appeal.

We agree with Appellant and disagree with the Examiner because neither the “geo-fence” of Klems (*see* Klems ¶ 53), nor the geographic filter of Farrow (*see* Farrow ¶ 47) relies upon the heading or orientation of the mobile device, as claimed. In particular, Klems discloses:

To implement proximity notifications, a geo-fence can be used. *A geo-fence is a virtual perimeter for a real world geographic area. The perimeter can be around a set location such as a building or store. For example, the system can be configured so that anytime the user's location is determined to be within the set virtual perimeter set around any location in which a coupon can be redeemed, the user can be sent a notification.* The user's location can be determined by the location of a mobile device that is location aware, such as a smartphone, for example. The location of the businesses can be determined by accessing a geo-location database, or the locations of businesses can be stored in the user's coupon wallet.

Klems ¶ 53 (emphasis added). Similarly, Farrow teaches:

Once a location of mobile device 30 is either identified or provided, the control section 90 correlates the location of the mobile device 30 with the items of information contained in information storage in step S8.40. In this embodiment, *the information may be tailored to only display items or locations within a certain distance from the mobile device 30. Thus, for example, movie theatres within a certain vicinity or region surrounding the mobile device 30 will be presented to the interface section 120.*

Farrow ¶ 47 (emphasis added).

We find that neither of these two references teach or suggest “selecting . . . a geographical area defined at least in part *by the current orientation of the mobile device,*” as recited in claim 1, and as similarly recited in each of independent claims 17 and 18 (emphasis added). Instead, the references operate to provide notifications based on proximity, i.e., the distance of the mobile device from merchants, independent of the orientation of the mobile device. Br. 7.

Appellant’s Figures 25 and 26 are provided below for reference:

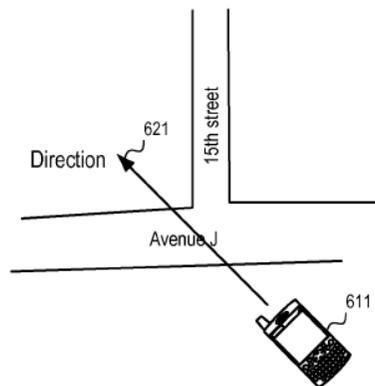


FIG. 25

“Figure 25 illustrates a mobile device pointing to a direction according to one embodiment.” Spec. ¶ 31.

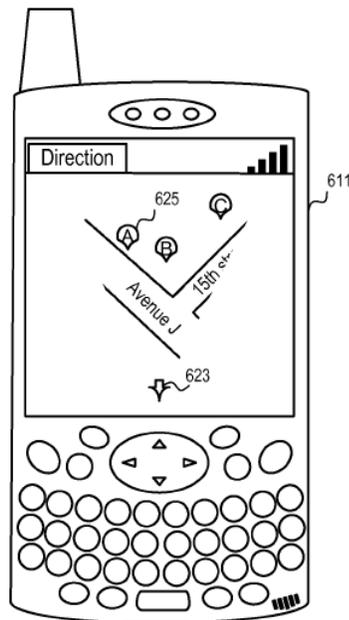


FIG. 26

“Figure 26 illustrates a presentation of offers on a map based on the direction pointed at by the mobile device illustrated in Figure 25.” Spec. ¶ 32.

We note these drawing figures provide contextual support for the recitation of “the geographical area defined by the current orientation of the mobile device.” Whether or not this disclosure provides an explicit *definition* for how the contested geographical area is defined, it is clear to us that the cited prior art does not teach or suggest anything similar to the recitation of the geographical area using either the current orientation or heading of the mobile device, particularly as depicted in Figures 25 and 26, and as recited in each of independent claims 1, 17, and 18. *See Toro Co. v. White Consolidated Industries Inc.*, 199 F.3d 1295, 1301 (Fed. Cir. 1999) (meaning of words used in a claim is not construed in a “lexicographic vacuum, but in the context of the specification and drawings.”).

For at least one dispositive reason advanced by Appellant, we reverse the Examiner's rejection of independent claim 1, and also the rejection of independent claims 17 and 18, which recite the disputed limitations in commensurate form. For the same reasons, we also reverse Rejection R1 of claims 2, 7, 19, and 20 that depend therefrom and stand therewith.⁴

2. § 103 Rejections R2–R9 of Claims 3–6 and 8–16

In light of our reversal of the rejections of independent claims 1, 17, and 18 in Rejection R1, *supra*, we also reverse obviousness Rejections R2 through R9 of claims 3–6 and 8–16 under § 103, which variously and ultimately depend from claims 1 and 18. On this record, the Examiner has not shown how the additionally cited secondary references (Khosravy, Wane, Winters, Wilson, Ives, Mishra, and Winkler) overcome the aforementioned deficiencies with Farrow and Klems, as discussed above regarding claim 1.

CONCLUSION

The Examiner erred with respect to obviousness Rejections R1 through R9 of claims 1–20 under 35 U.S.C. § 103(a) over the cited prior art combinations of record, and we do not sustain the rejections.

DECISION

We reverse the Examiner's decision rejecting claims 1–20.

REVERSED

⁴ Because we agree with at least one of the dispositive arguments advanced by Appellant, we need not reach the merits of Appellant's other arguments. *See Beloit Corp. v. Valmet Oy*, 742 F.2d 1421, 1423 (Fed. Cir. 1984) (finding an administrative agency is at liberty to reach a decision based on “a single dispositive issue”).