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BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DOMINIQUE QUESSELAIRE, JEAN-PAUL MENGUS, and MICHEL LEGER

Appeal 2018-001060
Application 14/594,842[1]
Technology Center 3600

Before JENNIFER S. BISK, ALEX S. YAP, and
JASON M. REPKO *Administrative Patent Judges*.

YAP, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the final rejection of claims 1–8, which are all the claims pending in this application. (*See* Final Office Action (mailed January 9, 2017) ("Final Act.") 1.) We have jurisdiction under 35 U.S.C. § 6(b)

We reverse.

[1] According to Appellants, the real party in interest is Gemalto SA. (App. Br. 3.)

STATEMENT OF THE CASE

Introduction

According to the Specification, Appellants' invention relates to "electronic transaction systems and transaction terminals adapted to perform electronic transaction." (April 19, 2013 Specification ("Spec.") 1.) Claim 1 is illustrative, and is reproduced below (with minor reformatting):

> 1. A system for performing electronic transaction comprising:
>
> a payment terminal including:
>
> a human interface module comprising a keypad, a display, a card reader, a first processor, and an internal bus connecting the keypad, the display, and the card reader; and
>
> a host terminal, connected to the human interface module through a first connection, comprising:
>
> a second processor, a first memory, a power supply, and a first security module,
>
> wherein the first security module comprises a transaction terminal task manager and
>
> a second memory comprising a first cipher key and first identification data, wherein the first connection is established using the first cipher key and the first identification data; and
>
> a gateway or a remote server of a service provider, connected to the host terminal through a second connection over a telecommunications network, comprising a virtual terminal server, at least one communications interface and a second security module comprising a third memory, a second cipher key and second identification data, wherein the second connection is established using the second cipher key and the second identification data,
>
> wherein the human interface module receives a

> transaction request initiated using at least one selected from a group consisting of the keypad, the display, and the card reader, and wherein the human interface module transmits the transaction request to the first security module
>
> wherein the first security module processes the transaction request received by the human interface module and, using the transaction terminal task manager, schedules the execution of the transaction request as a plurality of transaction phases,
>
> wherein the human interface module executes, totally autonomously from the host terminal, one or more of the plurality of transaction phases, as scheduled by the first security module,
>
> wherein non-sensitive data is stored on the host terminal and sensitive data is stored on the gateway or remote server, and wherein the non-sensitive and sensitive data pertains to the plurality of transaction phases, and
>
> wherein the host terminal communicates with the gateway or remote server to receive data stored on the gateway or remote server, in connection with the transaction request.

Rejections on Appeal

Claims 1–8 stand rejected as failing to comply with the enablement requirement under 35 U.S.C. § 112, first paragraph.[2] (*See* Final Act. 5–9.)

Claims 1–8 stand rejected as failing to comply with the written description requirement under 35 U.S.C. § 112, second paragraph. (*See* Final Act. 9–12.)

[2] The Examiner withdrew this rejection in the Answer. (Ans. 2.)

Claims 1–8 stand rejected as being indefinite under 35 U.S.C. § 112, second paragraph. (*See* Final Act. 13–15.)

ANALYSIS

We have reviewed the Examiner's rejection in light of Appellants' arguments that the Examiner has erred. We are persuaded the Examiner erred in rejecting the claims on appeal.

"*transaction terminal task manager"*

The Examiner finds the term "transaction terminal task manager" of claim 1 lacks written description support because "[t]here is no disclosure of what constitutes a 'transaction terminal task manager' [and the term] is not known in the prior art". (Ans. 11; Final Act. 11; *see also* Ans. 10, 12–13.) According to the Examiner, "there is no disclosure of what a 'transaction terminal task manager' is, let alone how it is 'us[ed]' by the 'first security module' to 'schedule the execution of the transaction request as a plurality of transaction phases,' as claimed." (Ans. 13.) Appellants, however, contend that "the transaction terminal task manager within the e-scheduler (*i.e.*, security module) [] performs the scheduling of the transaction phases (*i.e.*, tasks) for execution [and because] scheduling these tasks is well known in the prior art, [the term] does not need detailed disclosure." (Reply 5.)

The purpose of the written description requirement is to "ensure that the scope of the right to exclude, as set forth in the claims, does not overreach the scope of the inventor's contribution to the field as described in the patent specification." *Reiffin v. Microsoft Corp.*, 214 F.3d 1342, 1345 (Fed. Cir. 2000). To that end, to satisfy the written description requirement, the inventor "must also convey with reasonable clarity to those skilled in the

art that, as of the filing date sought, he or she was in possession *of the invention*." *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563–64 (Fed. Cir. 1991). "One shows that one is 'in possession' *of the invention* by describing *the invention*, with all its claimed limitations." *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997) (emphases in original). It is not necessary for the **specification** to describe the claimed invention **ipsissimis verbis**; all that is required is that it reasonably convey to those skilled in the art that, as of the filing date sought, the inventor was in possession of the claimed invention. *Union Oil of California v. Atlantic Richfield Co.*, 208 F.3d 989, 997 (Fed. Cir. 2000); *Vas-Cath Inc. v. Mahurkar*, 935 F.2d at 1563–64; *In re Gosteli*, 872 F.2d 1008, 1012 (Fed. Cir. 1989); *In re Edwards*, 568 F.2d 1349, 1351–52 (CCPA 1978).

Here, we agree with Appellants that the transaction terminal task manager resides within the e-scheduler and performs the scheduling of the transaction tasks for execution. (Specification 2, 5; Reply 4–5.) We also agree with Appellants that because "scheduling these tasks is well known in the prior art, [] the transaction terminal task manager[, therefore,] does not need detailed disclosure." (Reply 5.) "It is not necessary that the application describe the claim limitations exactly, but only so clearly that persons of ordinary skill in the art will recognize from the disclosure that appellants invented processes including those limitations." *In re Wertheim*, 541 F.2d 257, 262 (CCPA 1976) (citation omitted); *see also Purdue Pharma L.P. v. Faulding, Inc.*, 230 F.3d 1320, 1323 (Fed. Cir. 2000) ("In order to satisfy the written description requirement, the disclosure as originally filed does not have to provide *in haec verba* support for the claimed subject matter at issue.").

"a second memory comprising a first cipher key"

The Examiner also finds that there is no written description support for "a second memory comprising a first cipher key" because "Appellants' finding that 'as described in paragraph [0028], ciphering means are cryptographic keys (i.e., cipher keys)' is in error." (Ans. 12; Final Act. 11.) However, "the disclosure as originally filed does not have to provide *in haec verba* support for the claimed subject matter at issue." *Purdue Pharma L.P.*, 230 F.3d at 1323. We agree with Appellants that "[i]n order to perform ciphering, a cipher key is required[; a]ccordingly, the ciphering means includes a cipher key to operate and the cipher key must be stored (*i.e.*, memory) at least temporarily during the ciphering." (Reply 4.)

"human interface module"

The Examiner further finds that the "human interface module" term of claim 1 lacks written description support because the "human interface module" cannot execute "autonomously from the host terminal, one or more of the plurality of transaction phases" as claimed. (Ans. 14–15.) According to the Examiner, because the transaction phases "are executed by the human interface module under the e-scheduler ES control (Spec., [0027]), and because the e-scheduler is part of the host terminal (see Appellants' figure 1), the disclosed transaction phases [] are not executed totally autonomously from the host terminal." (*Id*.) The Examiner, however, does not respond to the Appellants' contention that original claim 1, which is part of the original disclosures, provides written description support for "human interface module." Specifically, original claim 1 states, in part, "wherein the human interface module executes transaction phases under control of the security module, and executes security treatments, totally autonomously from the

host terminal, the security treatments including . . . ." We agree with Appellants this the cited portion of claim 1, which recites similar language as that in pending claim 1, provides written description support for "the human interface module executes, totally autonomously from the host terminal" of pending claim 1.

For the foregoing reasons, we are persuaded of Examiner error in the rejection of claim 1 and do not sustain the 35 U.S.C. § 112, first paragraph rejection of claim 1. The Examiner relies on the same arguments for the rejection of claims 2–8;[3] therefore, we also do not sustain the 35 U.S.C. § 112, first paragraph rejection of claims 2–8.

"first security module"

Claim 1 recites, in part, "a first security module, wherein the first security module comprises a transaction terminal task manager and a second memory . . . ." Claim 1 further recites that "the first security module processes the transaction request received by the human interface module and, using the transaction terminal task manager, schedules the execution of the transaction request as a plurality of transaction phases"

The Examiner finds that "a security module" is a means-plus-function term subjected to 35 U.S.C. § 112, sixth paragraph because the term "module" is a nonce word. (Ans. 17.) According to the Examiner, "a security module" is similar to the term "distributed learning control module" in *Williamson v. Citrix Online, LLC*, which the Federal Circuit found to be governed by § 112 sixth paragraph. 792 F.3d 1339 (Fed. Cir. 2015). The Examiner contends the term "'a security module' does not provide any

[3] The Examiner does not respond to Appellants further arguments regarding dependent claims 3 and 4. (*See* Ans. 16; App. Br. 12.)

indication of structure because it sets forth the same black box recitation of structure for providing the same specified function as if the term 'means' had been used." (Ans. 17.) The Examiner then concludes that the term "a security module" "is indefinite because the written description fails to clearly link or associate sufficient disclosed structure to the claimed function such that one of ordinary skill in the art would recognize what structure performs the claimed function." (Ans. 19; Final Act. 13–14.)

Appellants contend that 35 U.S.C. § 112, sixth paragraph does not apply because "the security module is described as physical hardware (*i.e.*, an analog to a Subscriber Identity Module SIM)" in the Specification and "[o]nce 'security module' is properly construed as a smart card, [] 'security module' *does* provide sufficiently definite structure (*i.e.*, a smart card *is* sufficiently definite structure) and thus 35 U.S.C. § 112, ¶ 6 should *not* be invoked." (Reply 2–3.)

We agree with Appellants that 35 U.S.C. § 112, sixth paragraph, does not apply to the claimed "security module." First, the term does not use the word "means" and, therefore, presumptively § 112, sixth paragraph does not apply. *See Williamson*, 792 F.3d at 1348. Second, based on the Specification, a person of ordinary skill in the art would understand "security module" to have a sufficiently definite meaning as the name for a structure. *Id.* To be sure, the term "module" alone can be nonce-word substitute for "means" and the prefix "security" does not impart structure to the term. But the Specification in this case leads us to construe "security module" to include a Subscriber Identity Module (SIM) card. For example, paragraph 26 of the Specification states that "[t]he hosting terminal HT is equipped with a security module or e-scheduler ES[, and t]he security

module ES is comparable to a Subscriber Identity Module SIM card *as currently used in the field of mobile telephony*." (Emphasis added.) The Specification, in paragraph 27, further states that "[t]he human interface module SPED executes these transaction phases under the e-scheduler ES control." Therefore, the Specification indicates that one of ordinary skill in the art would recognize that "a security module" refers to a structure (*i.e.*, "Subscriber Identity Module SIM card as currently used in the field of mobile telephony") that performs a function.

For the foregoing reasons, we are persuaded of Examiner error in the rejection of claim 1 and do not sustain the 35 U.S.C. § 112 rejection of claim 1. The Examiner relies on the same arguments for the rejection of claims 2–8; therefore, we also do not sustain the 35 U.S.C. § 112 rejection of claims 2–8.

DECISION

We reverse the decision of the Examiner to reject claims 1–8.

REVERSED