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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 MICHAEL BUTZ, MANFRED GERDES, and
PATRICK CHRISTAIN SCHAEFER[1]
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Appeal 2018-001873
Application 12/988,678
Technology Center 3600

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Before CARL W. WHITEHEAD JR., JEREMY J. CURCURI and
SCOTT RAEVSKY, *Administrative Patent Judges*.

WHITEHEAD JR., *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant is appealing the final rejection of claims 1, 2, 6, 13, 15, 17, 18, 20 and 21 under 35 U.S.C. § 134(a). Appeal Brief 5. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

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[1] We use the word Appellant to refer to "applicant" as defined in 37 C.F.R. § 1.42(a). Appellant identifies Wincor Nixdorf International GmbH, as the real party in interest. Appeal Brief 3.

Introduction

According to Appellant, the invention is directed to "[D]ealing with self-service banking machines that can detect counterfeit bank notes. When the bank notes are deposited into the banking machine, (e.g., automatic teller machine - ATM), the bank notes are checked for authenticity." Specification 7.

Representative Claim

21. A banking system for detecting counterfeit bank notes, said system comprising:
a self-service terminal for receiving bank notes deposited by a user;
a remote server;
said self-service terminal requesting a transaction number from the server when bank notes are deposited by a user;
said remote server transmitting the transaction number to the self-service terminal and storing transaction details associated with the transaction number;
a removable cassette in the self-service terminal for receiving bank notes, said cassette having a memory carried thereon that is transported with the cassette along with the bank notes;
said self-service terminal being configured to verify the authenticity of the bank notes and to detect when counterfeit bank notes are deposited, said self-service terminal storing a serial number of the detected counterfeit bank notes and the transaction number receive from the remote server in the memory of the cassette when counterfeit bank notes are detected;
an electronic device, remote from self-service terminal, for reading information on the memory of the cassette after the cassette is removed from the self-service terminal,
said electronic device accessing the transaction details stored in the remote server by using the transaction number

> stored on the cassette memory when counterfeit notes have
> been detected and stored in the cassette; and
>   whereby transaction details relating to the deposit of
> counterfeit bank notes by a user can be obtained by the
> electronic device without requiring further communication with
> the self-service terminal.

References

Name	Reference	Date
Csulits et al.	US 8,162,125 B1	April 24, 2012
Ganesh et al.	US 2004/0199924 A1	October 7, 2004
Graef et al.	US 2010/0288831 Al	November 18, 2010

Rejection on Appeal[2]

Claims 1, 2, 6, 9, 13, 15, 17, 18, 20 and 21 stand rejected under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over Csulits, Ganesh and Graef. Final Action 2–13.

ANALYSIS

Rather than reiterate the arguments of Appellant and the Examiner, we refer to the Appeal Brief (filed May 22, 2017), the Final Action (mailed November 28, 2016) and the Answer (mailed September 20, 2017), for the respective details.

Appellant argues, "U.S. Patent No. 8,162,125 (Csulits '125) reference was filed on April 13, 2010, which is after Appellant's March 18, 2009 International filing date. Therefore, the Csulits '125 reference is not prior art and the 35 U.S.C. § 103 rejection is not proper." Appeal Brief 14.

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[2] Appellant argues the merits of claim 21. *See* Appeal Brief 16–17.

Appellant contends, "The Examiner primarily relies upon Csulits '125 to base all of his rejections. All of Appellant's claims call for, among other things, a removable cassette having a memory ('smart cassette')" while "The Examiner relies upon Csulits '125 as allegedly disclosing a 'smart cassette' stating at the end of page 6 of the Final Office Action." Appeal Brief 14. Appellant further contend, "None of the other references disclose a 'smart cassette.' However, the 'smart cassette' disclosure in Csulits '125 only first appeared as of the April 13, 2010 filing date of Csulits '125." Appeal Brief 15. Appellant argues, "The previous applications in the 'Related U.S. Application Data' of Csulits '125 did not disclose the 'smart cassette' idea." Appeal Brief 15.

The Examiner finds, "Csulits provides priority for a cassette in any number of the priority documents" for example Csulits is a continuation of Application 10/981,315, published as Hallowell et al. (U.S. 2005/0150738 A1) filed on November 2, 2004 wherein Hallowell '738[3] includes cassettes (118a-118f) as mentioned at paragraph 91 and illustrated in figures 1a and 1b. Answer 3.

Appellant contends, "The Graef reference was filed on June 30, 2010, which is also after Appellant's March 18, 2009 international filing date. Admittedly, the parent application No. 11/522,747 may be prior art but it was not relied upon by the Examiner." Appeal Brief 15. Appellant

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[3] "In FIGS. 1*a* and 1*b* each of the lower output receptacles 106*c*-106*h* includes a first portion designated as an escrow compartment 116*a*-116*f* and a second portion designated as a storage cassette 118*a*-118*f* (described in more detail below)." Hallowell ¶ 91.

concludes, "Therefore, Csulits '125, as well as Graef, are not prior art to the present application." Appeal Brief 16.

We do not find Appellant's arguments persuasive. The Examiner's position that Csulits qualifies as prior art because of Hallowell's lineage has not been challenged by Appellant and no Reply Brief has been filed. Further, with respect to Graef, the Examiner is not required to use Graef's parent application 11/522,747 in order to rely upon the parent application's filing date of September 18, 2006. Appellant does not challenge the validity of Graef's subject matter being entitled to the parent application's filing date. *See* Appeal Brief 15–15; Answer 3–4.

Appellant contends, "**the alleged combination fails to disclose the use of the cassette memory to store sufficient information, when a counterfeit bank note is detected, that a remote banking system can gather information about the counterfeit transaction from the cassette memory without returning to the self-service terminal (ATM)**." Appeal Brief 16.

Appellant argues, "Csulits '125 does not disclose a self-service terminal. Instead, it is directed to terminals for tellers which are not configured to be used by everybody. The complete system is restricted to special users." Appeal Brief 17. The Examiner finds that Csulits discloses, "According to some embodiments, teller systems and associated teller terminals can include a teller window, a vault system, an automatic teller machine (ATM) system, a home banking system, a depositor cash management system, a night teller, and/or a lock box." *See* Answer 5–6 (*citing* Csulits column 166, lines 26–30). The Examiner also finds, "According to some embodiments, the cash management feature can be

used to track currency at an ATM, sometimes called a virtual teller, at a bank vault, at a bank branch, at the Federal Reserve, etc. According to some embodiments, a virtual teller is an ATM that includes imaging capabilities." *See* Answer 6 (*citing* Csulits column 166, lines 58–63). On its face, we do not find Appellant's argument persuasive. The term *self-service* does not mean accessibility for everybody as Appellant contends because one would have to be authorized in some form to utilize the terminal and therefore *self-service* does not preclude tellers nor does it preclude *special users*. Accordingly, we find Applicant's self-service terminals read upon terminals accessible to authorized users including tellers, special users, etc. as disclosed by Csulits.

Claim 21 recites, "a removable cassette in the self-service terminal for receiving bank notes, said cassette having a memory carried thereon that is transported with the cassette along with the bank notes." Appellant argues that Csulits' cassettes are provided with bar codes wherein:

> The bar code just contains a general identification of the cassette. The bar code is used to access a database in which information is stored about the banknotes when filling the cassette. There is no teaching that the ATM writes information about detected counterfeit bank notes in a cassette memory, as claimed. Csulits' bar code is static; the ATM is Csulits cannot alter the contents of its bar code or change the content within the database.

Appeal Brief 20.

Csulits discloses that "the intelligent cassettes include respective barcodes instead of or in addition to memory devices." Csulits, column 184, lines 24–26. Csulits further discloses, "[T]he barcodes on intelligent cassettes are inputted into a document processing system such as the imaging MPS via, for example, a barcode reader." Csulits, column 184,

lines 27–29. Csulits discloses that in "response to a document being transported to a specific cassette, the imaging MPS is configured to tag the corresponding barcode (decoded barcode indicia) to a record associated with the document stored in a database." Csulits, column 184, lines 30–34.

> The Examiner further determines Csulits discloses:
>
> [I]n response to a customer withdrawing currency bills, the ATM images each currency bill and <u>creates a record for each currency bill and/or updates a record in memory associated with the currency bills being withdrawn to indicate a new expected location of the currency bill(s)</u>. The records can include an extracted serial number, image data, or a variety of other information, such as the information described in the Document Records and Data Files.

Answer 6–7 (*citing* Csulits, column 206, lines 16–24) (*emphasis added*).

The Examiner finds that Csulits discloses that a bank can determine if an alleged counterfeit bill was dispensed by the bank's ATM by searching the database of the created records of ATM transactions. Answer 6–7 (*citing* Csulits, column 206, lines 35–50). We do not find Appellant's arguments persuasive because it does not matter if Csulits' barcode is static because the barcode is used to identify an intelligent cassette memory or record wherein the intelligent cassette memory or record is not static.

The Examiner further determines, "Csulits does not need to teach a cassette with memory [although it does], because Graef (US 2010/0288831 A1) teaches a cassette (360, 362, 374, 376, 388, 394) with memory, i.e., in the form of a radio frequency device (rfid), as mentioned at paragraphs 228– 237, 241– 248, i.e., an intelligent/smart cassette, as mentioned at paragraphs 264–267, 307, 317." Answer 3.

Appellant contends that Ganesh "does not disclose that the transaction number is downloaded to a self-service terminal and also access to the transaction based on the identification stored on the cassette by the further system is not disclosed." Appeal Brief 21. Appellant also argues that, "Graef's RFID tag does not store any transaction id's which are in relation to counterfeit bank notes and which allow a remote system to access transaction data." Appeal Brief 21. The Examiner determines that, "Ganesh teaches the transaction number generation process used generally in commerce. Ganesh does not have to include the details of an ATM or ATM system network or a cassette with on-board memory. Those features are all taught by Csulits and Graef." Answer 8–9. The Examiner finds, "Ganesh is generally concerned with transaction processing." Answer 9 (*citing* Ganesh ¶ 1); *see* Ganesh Abstract ("A client process executing on a client may initiate a transaction request with a server. The server processes the transaction, commits the transaction, and writes transaction information associated with the transaction to memory without durably storing the transaction information."). The Examiner finds, "[R]egardless of what Graef's rfid tag stores, the fact that it is a memory which can store data is the main issue, of which said memory has predictable structure capable of and which functions to store data such as that taught by Csulits." Answer 11–12; *see* Graef ¶ 230 ("RFID tags are operative to store information therein representative of the canister and its content, such as cassette ownership, cassette serial number, and currency denomination.").

Appellant contends, "The Examiner's brief explanation for combining the references falls far short of the type of explicit analysis that is required by the Supreme Court in *KSR Int'l v. Teleflex Inc.,* 127 S.Ct. 1727 (2007)."

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Appeal Brief 21. The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. *See In re Kahn*, 441 F.3d 977, 987–88 (Fed. Cir. 2006), *In re Young*, 927 F.2d 588, 591 (Fed. Cir. 1991) and *In re Keller*, 642 F.2d 413, 425 (CCPA 1981). The Examiner can satisfy this test by showing some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *KSR Int'l. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) (*citing In re Kahn*, 441 F.3d at 988). We find the Examiner satisfied the test by supporting the legal conclusion of obviousness with rational underpinning. *See* Final Action 8–9. Subsequently, we do not find Appellant's arguments persuasive and we agree with the Examiner's findings. We sustain the Examiner's obviousness rejection of claims 1, 2, 6, 9, 13, 15, 17, 18, 20 and 21 not argued separately. *See* Appeal Brief 13.

CONCLUSION

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1, 2, 6, 9, 13, 15, 17, 18, 20, 21	103	Csulits, Ganesh, Graef	1, 2, 6, 9, 13, 15, 17, 18, 20, 21	

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). *See* 37 C.F.R. § 1.136(a)(1)(v).

AFFIRMED