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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte PAULA BUZZARD

Appeal 2018-003092
Application 14/319,162
Technology Center 2400

BEFORE JAMES R. HUGHES, JENNIFER S. BISK, and
JAMES W. DEJMEK, *Administrative Patent Judges*.

DEJMEK, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant¹ appeals under 35 U.S.C. § 134(a) from a Final Rejection of claims 1–20. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm in part.

¹ Throughout this Decision, we use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42 (2016). Appellant identifies iHeartMedia Management Services, Inc. as the real party in interest. Appeal Br. 2.

STATEMENT OF THE CASE

Introduction

Appellant's disclosed and claimed invention generally relates to "providing access to a user-specific homepage." Claim 1. The Specification describes a system wherein a server computer system may provide a first interface to the user, at the user's computer, the first interface having a field for entering a telephone number of the mobile device to receive the ringtone. Spec. ¶ 5. After the mobile telephone number has been received by the server computer system, a password is generated and sent to the mobile device. Spec. ¶ 5. The user is instructed to enter the password into a second interface presented at the user's computer. Spec. ¶ 5. In a disclosed embodiment, if the user does not enter the password at the user's computer within a predetermined period of time after the password was sent to the mobile device, a follow-up message is sent to the user's mobile device from the server. Spec. ¶ 14. Alternatively, if the user had previously registered with the website, a cookie included on the user's computer may serve as a login with login information of the user. Spec. ¶ 36.

Claim 1 is exemplary of the subject matter on appeal and is reproduced below with the disputed limitations emphasized in *italics*:

1. A computer-based method of providing access to a user-specific homepage, comprising:

transmitting a phone number interface to a user computer in response to receiving an indication that a download selector has been activated;

receiving, from the phone number interface, an identifier associated with a mobile device;

transmitting a password to the mobile device associated with the identifier in response to the identifier associated with

the mobile device being received from the phone number interface;

determining whether the password transmitted to the mobile device has been used to complete registration of a user within a predetermined amount of time from transmission of the password to the mobile device;

if the password has been used to complete registration of the user within the predetermined amount of time, providing the user access to the user-specific homepage; and

if the predetermined amount of time has expired prior to the password being used to complete registration of the user, transmitting a follow-up message to the mobile device.

The Examiner's Rejections

1. Claims 1, 8, and 15 stand rejected under the doctrine of nonstatutory obviousness-type double patenting over the claims of U.S. Patent No. 8,769,652 B2 (issued July 1, 2014).² Ans. 3–6.

² In the Final Office Action, the Examiner provides a response to Appellant's arguments regarding the double patenting rejection and finds the arguments "not persuasive." Final Act. 2. However, no other formal statement of rejection under the doctrine of obviousness-type double patenting appears in the Final Office Action. We note that independent claims 1, 8, and 15 were rejected under the doctrine of obviousness-type double patenting in a Non-Final Office Action, mailed November 19, 2015 (*see* pages 4–7). It appears that the Examiner has maintained this rejection, finding Appellant's arguments not persuasive. *See* Final Office Action, mailed May 20, 2016 (*see* pages 2–3) and Non-Final Office Action, mailed September 9, 2016 (*see* page 2). Appellant provides arguments regarding the rejection under the doctrine of obviousness-type double patenting of claims 1, 8, and 15 and does not otherwise state being prejudiced as a result of the Examiner not including a formal statement of rejection under the doctrine of obviousness-type double patenting in the Final Office Action. *See* Appeal Br. 6–10. Accordingly, we consider the rejection of claims 1, 8, and 15 to stand rejected under the doctrine of nonstatutory obviousness-type

2. Claims 1–20 stand rejected under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over Yohai-Giochais (US 2008/0307317 A1; Dec. 11, 2008) and Kefford et al. (US 2003/0204726 A1; Oct. 30, 2003) (“Kefford”). Final Act. 4–9.

ANALYSIS³

Obviousness-type Double Patenting Rejection

Appellant disputes the Examiner’s conclusion that pending claims 1, 8, and 15 are not patentably distinct from the claims of U.S. Patent No. 8,769,652 (“the ’652 Patent”). Appeal Br. 6–10. In particular, Appellant asserts that claim 1 of the ’652 Patent recites transmitting a second interface from the computer server, whereas claim 1 of the instant application does not include a commensurate limitation. Appeal Br. 9. Further, Appellant argues claim 1 of the instant application recites “if the predetermined amount of time has expired prior to the password being used to complete registration of the user, transmit a follow-up message to the mobile device,” whereas claim 1 of the ’652 Patent does not. Appeal Br. 9. Appellant

double patenting over the claims of U.S. Patent No. 8,769,652. We remind the Examiner, however, of the requirements for a Final Rejection to “repeat or state all grounds of rejection then considered applicable to the claims in the application, clearly stating the reasons in support thereof.” 37 C.F.R. § 1.113(b).

³ Throughout this Decision, we have considered the Appeal Brief, filed July 6, 2017 (“Appeal Br.”); the Supplemental Appeal Brief, filed August 3, 2017 (“Supp. Appeal Br.”); the Reply Brief, filed January 30, 2018 (“Reply Br.”); the Examiner’s Answer, mailed November 30, 2017 (“Ans.”); and the Final Office Action, mailed February 27, 2017 (“Final Act.”), from which this Appeal is taken.

advances similar arguments regarding claims 8 and 15 of the instant application. *See* Appeal Br. 9–10.

“[D]ouble patenting is determined by analysis of the claims as a whole.” *Carman Indus., Inc. v. Wahl*, 724 F.2d 932, 940 (Fed. Cir. 1983) (internal quotation and citations omitted). In particular, “it is important to bear in mind that comparison can be made only with what invention is *claimed* in the earlier patent, paying careful attention to the rules of claim interpretation to determine what invention a claim *defines* and not looking to the claim for anything that happens to be mentioned in it as though it were a prior art reference.” *Gen. Foods Corp. v. Studiengesellschaft Kohle mbH*, 972 F.2d 1272, 1280 (Fed. Cir. 1992).

Here, we find that the claims of the ’652 patent define a method for registering a user at a server (i.e., providing access to a register-user web site). This is similar to the pending claims, which define a method for providing access to a user-specific homepage. We conclude that the claims of the ’652 patent and those of the pending application are not patentably distinct. As compared to independent claim 1 of the pending application, we note that the method of claim 1 of the ’652 patent also requires (i) transmitting a phone number interface to a user; (ii) receiving an identifier (e.g., phone number) associated with a mobile device, as supplied in the first interface); (iii) transmitting a password to the mobile device; (iv) determining that the user has used the password to complete registering access within a predetermined period of time; and (v) providing access to the registered-user web site. Moreover, claim 7 of the ’652 patent, which depends from claim 1, recites “receiving the password from the mobile device is performed after transmitting a follow-up message from the server

computer system to the mobile device if the password is not received within the predetermined period of time.”

Thus, we do not find Appellant’s arguments persuasive of Examiner error. That the claims of a reference patent are narrower (i.e., the claims recite an additional limitation, such as transmitting a second interface) than the pending application is of no moment in an obviousness-type double patenting analysis. *See In re Berg*, 140 F.3d 1428, 1432 (Fed. Cir. 1998) (describing the so-called “one-way” test in determining obviousness-type double patenting as “if the scope of the application and the patent claims is not identical, the court must ask whether the former defines merely an obvious variation of the latter”). Further, as described above, the invention defined by the claims of the ’652 patent include, *inter alia*, the transmission of a follow-up message to the mobile device if a predetermined amount of time has expired prior to the password being used to complete registration of the user. *See* 35 U.S.C. § 112(d) (“A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.”).

For the reasons discussed *supra*, we are unpersuaded of Examiner error. Accordingly, we sustain the Examiner’s rejection of independent claim 1 under the doctrine of obviousness-type double patenting. For similar reasons, we also sustain the Examiner’s rejection of independent claims 8 and 15 under the doctrine of obviousness-type double patenting.

Rejection under pre-AIA 35 U.S.C. § 103(a)

Appellant disputes the Examiner’s finding that Kefford teaches, *inter alia*, “determining whether the password transmitted to the mobile device

has been used to complete registration of a user within a predetermined amount of time from transmission of the password to the mobile device,” as recited in claim 1. Appeal Br. 12–16; Reply Br. 4–5. In particular, Appellant asserts Kefford’s disclosure of regenerating authentication replies that could have been generated within the past 60 seconds does not teach whether a password transmitted to a mobile device has been used within a predefined time period (e.g., 60 seconds) to complete registration of a user. Appeal Br. 14 (citing Kefford ¶ 47); Reply Br. 4–5.

We begin our analysis with a brief review of the relevant example described in Kefford. Kefford generally relates to the “secure transmission of information” by employing multi-level authentication techniques. Kefford ¶¶ 2, 7, 11–13, 17–18. Figure 4 of Kefford is illustrative and is reproduced below:

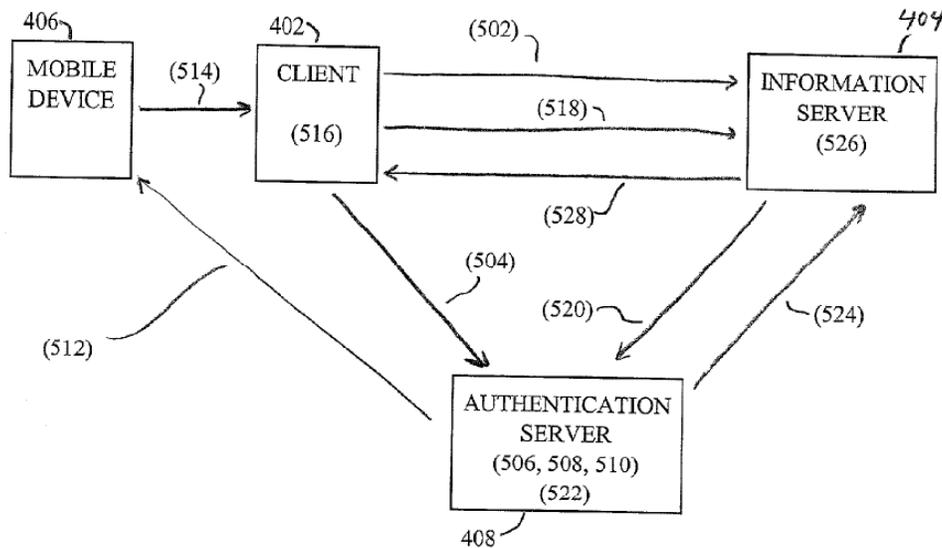


FIG. 4

Figure 4 of Kefford shows a block diagram of the disclosed system for providing a secure transmission of information. Kefford ¶¶ 23, 38. As

shown, the system comprises a client (402) (e.g., a user's computer), an information server (404), an authentication server (408), and the user's mobile device (406). Kefford ¶ 38. In a disclosed scenario, client (402) may send a request (502) to information server (404). Kefford ¶ 40. Kefford describes the request (502) may be a request for information (e.g., a one-time password (OTP) or request for access to a web site). Kefford ¶ 29. The request (502) may include the request, a unique ID (e.g., to identify a mobile device), and an encryption key. Kefford ¶¶ 12, 40. In addition to the information request (502) to information server (404), client (402) sends an authentication request (504) to authentication server (408). Kefford ¶ 41. Authentication request (504) contains an authentication request, unique ID, and an encryption key. Kefford ¶ 41. Authentication server (408) generates an encrypted authentication reply. Kefford ¶ 43. Authentication server (408) sends the encrypted authentication reply (512) to the user's mobile device (406). Kefford ¶ 43. The mobile device (406) may then transmit the received encrypted authentication reply (514) to the client (402). Kefford ¶ 44. Client (402) is able to decrypt the encrypted authentication reply using the encryption key. Kefford ¶ 45. After the authentication reply has been decrypted, client (402) may send the decrypted authentication reply (518) (along with a unique ID) to information server (404). Kefford ¶ 45. Kefford discloses that information server (404) "checks to make sure that the end user is who he says he is." Kefford ¶ 45. To perform this verification, information server (404) sends the received decrypted authentication reply (520) (with a unique ID) to authentication server (408). Kefford teaches that authentication server (408) can verify the authentication reply sent from information server (404) (which was sent to the information server (404) by

client (402)) by comparing the authentication reply with either a saved copy of the authentication reply (that was previously generated by authentication server (408)) or by regenerating the authentication reply. Kefford ¶¶ 45–47. In the scenario where authentication server (408) regenerates the authentication reply, Kefford teaches authentication server (406) can regenerate all authentication replies it could have produced within a defined time period (i.e., the previous 60 seconds). Kefford ¶ 47. Authentication server (406) sends a response (524) to information server (404) indicating whether the authentication reply sent from information server (404) was valid. Kefford ¶ 48. If the authentication reply is valid, information server (404) will provide (message 528) client (402) with the information originally requested in information request (502). Kefford ¶ 52.

Thus, Kefford teaches the requested information (e.g., request for access to a website) is provided after the user has been authenticated. Kefford's description of regenerating an authentication reply within 60 seconds of the originally generated authentication reply is not based on whether a password sent to a user's mobile device was used to complete registration of a user within a predetermined amount of time as claimed. Rather, as described above, Kefford teaches sending an encrypted user authentication reply to the mobile device. The mobile device provides the encrypted authentication reply to the client, where it is decrypted. The decrypted authentication reply is sent from the client to the information server, which additionally sends the decrypted authentication reply to the authentication server for verification. Kefford teaches if the decrypted authentication reply is received from the information server by the authentication within a predetermined amount of time (e.g., 60 seconds), the

authentication server may be able to regenerate the authentication reply for verification purposes. We agree with Appellant that decrypting an encrypted authentication reply at the client does not teach that completion of the registration process by a user within a predetermined period of time. As described by Kefford, a user would be able to complete the registration process (i.e., the original request for access to a web site) only after the user has been authenticated.

Because we find it dispositive that the Examiner has not shown by a preponderance of evidence that Kefford teaches or reasonably suggests the claimed determination that a password sent to a mobile device has been used to complete registration of a user within a predetermined period of time, we do not address other issues raised by Appellant's arguments related to these claims. *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").

For the reasons discussed *supra*, we are persuaded of Examiner error. Accordingly, we do not sustain the Examiner's rejection under pre-AIA 35 U.S.C. § 103(a) of independent claim 1. For similar reasons, we do not sustain the Examiner's rejection under pre-AIA 35 U.S.C. § 103(a) of independent claims 8 and 15, which recite commensurate limitations. In addition, we do not sustain the Examiner's rejection under pre-AIA 35 U.S.C. § 103(a) of claims 2–7, 9–14, and 16–20, which depend directly or indirectly therefrom.

CONCLUSION

We affirm the Examiner's decision rejecting claims 1, 8, and 15 under the doctrine of obviousness-type double patenting.

We reverse the Examiner's decision rejecting claims 1–20 under pre-AIA 35 U.S.C. § 103(a).

DECISION SUMMARY

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1, 8, 15		Obviousness-type Double Patenting	1, 8, 15	
1–20	103(a)	Yohai-Giochais, Kefford		1–20
Overall Outcome			1, 8, 15	2–7, 9–14, 16–20

TIME PERIOD FOR RESPONSE

No time period for taking any 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