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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* JAY S. WALKER, ANDREW S. VAN LUCHENE,  
DANIEL E. TEDESCO, and JOSHUA D. ROGERS

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Appeal 2019-001277  
Application 13/619,743  
Technology Center 3600

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Before RICHARD M. LEBOVITZ, ULRIKE W. JENKS, and  
JOHN E. SCHNEIDER, *Administrative Patent Judges*.

LEBOVITZ, *Administrative Patent Judge*.

DECISION ON APPEAL

The Examiner rejected the claims under 35 U.S.C. § 103 as obvious. Pursuant to 35 U.S.C. § 134(a), Appellant<sup>1</sup> appeals from the Examiner's decision to reject the claims. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

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<sup>1</sup> We use the word "Appellant" to refer to "applicant" as defined in 37 C.F.R. § 1.42. Appellant identifies the real party in interest as Groupon, Inc. Appeal Br. 2.

## STATEMENT OF THE CASE

Claims 1–23 stand finally rejected by the Examiner under pre-AIA 35 U.S.C. § 103(a) as obvious in view of Smith et al. (WO 97/28510, published Aug. 7, 1997) (“Smith”) and Van Luchene et al. (US 6,687,679 B1, issued Feb. 3, 2004) (“Van Luchene”). Final Act. 2.

Claim 1, which is representative, is reproduced below (bracketed numbering has been added for reference to the claim limitations):

1. A method comprising:

[a] determining, by a license plate scanning unit, an account number based on an identification of a license plate of a vehicle that is physically present at a location of a merchant;

[b] determining, by the processor, an identity of an account holder associated with the license plate number;

[c] in response to determining the identity of the account holder associated with the license plate number, displaying an indication of the identity of the account holder;

[d] in response to displaying the indication of the identity of the account holder, receiving confirmation via a user interface that the account holder is physically present at the location of the merchant;

[e] retrieving frequent shopper data associated with the account holder;

[f] determining, by a processor, based on the frequent shopper data, information identifying an identifier representing an item or service of at least one previous order associated with the account holder and one or more contractual terms of the at least one previous order associated with the account holder;

[g] displaying the identifier and the one or more contractual terms of the at least one previous order associated with the account holder;

[h] receiving an instruction from the account holder to purchase the item or service according to the contractual terms of the at least one previous order; and

[i] consummating the purchase in accordance with the received instruction.

## REJECTION

The Examiner found that Smith described all the steps recited in claim 1, but not [a] “determining, by a license plate scanning unit, an account number based on an identification of a license plate of a vehicle that is physically present at a location of a merchant” and [b] “determining, by the processor, an identity of an account holder associated with the license plate number.” Final Act. 3–5.

The Examiner found that Smith describes “determining an account number based on an identification of an account holder associated with an account number,” but does not specifically disclose using a license plate number to determine the account number. *Id.* However, the Examiner found that Van Luchene discloses using a scan of a license plate to determine an account number. *Id.* The Examiner determined that it would have been obvious to one of ordinary skill at the time of the invention to use the license plate identification unit of Van Luchene in the invention of Smith because “there are a limited number of predictable ways to identify a user and performing license plate identification is one such predictable way.” *Id.*

## Discussion

Appellant contends that the pending claims are not obvious over the combination of Smith and van Luchene. Appellant’s arguments are addressed below.

1. “[H]ow would one even *use* a license plate reader in connection with a device having the form factor of a vending machine?”

Appellant states that Smith is directed to a system for electronic ordering and vending systems. Appeal Br. 8. In contrast, Appellant states

that Van Luchene “describes a wholly unrelated system that may in some embodiments include a license plate reader system 500.” *Id.* at 9. Appellant asks “how would one even *use* a license plate reader in connection with a device having the form factor of a vending machine?” *Id.*

This argument is not persuasive. The license plate reader from Van Luchene was cited by the Examiner as an identification method that could be used in Smith’s method to identify account holders in Smith’s method. Final Act. 2. Appellant questions how the license plate would be used with a vending machine. Appeal Br. 9. To the extent that a vending machine is used in Smith’s method, the method would work like this: the license plate reader scans and identifies the user, the user confirms their identity and presence at the merchant (step [d] of claim 1; Final Act. 4), and then walks to where the vending machine is situated to obtain the item. Appellant raised the question without explaining why one of ordinary skill in the art could not use the two together. Thus, this argument is unavailing.

2. Are the publications analogous prior art to the claimed invention?

Appellant correctly stated that the cited prior art must be analogous to the claimed invention and faults the Examiner for not making such a finding. Reply Br. 3 (fn. 1). We find this argument to have no merit because Smith, Van Luchene, and the claimed invention relate to sales and therefore are analogous and pertinent to each other. Thus, even if an error was made by the Examiner in the statement of the legal analysis, Appellant did not demonstrate that this error should result in reversal of the rejection.

3. Is there a legally sufficient rationale to support the obviousness rejection?

Appellant contends that the Examiner did not articulate sufficient reason that would have prompted one of ordinary skill in the art to modify Smith in the manner asserted. Appeal Br. 9–10. Appellant argues “why would a person having ordinary skill in the art waste the time to jettison a perfectly good account holder identification method in favor of the proffered license plate mechanism from Van Luchene?” *Id.* at 10. Appellant asserts that “[n]o rationale appears in the record and Appellant is aware of no evidence suggesting that that the proffered combination would produce any actual benefit to the Smith system.” *Id.*

This argument is not persuasive. The Examiner stated that the “rational[e] for including such an identification unit is that there are a limited number of predictable ways to identify a user and performing license plate identification is one such predictable way.” Final Act. 3. The Examiner’s rationale is legally sufficient. As held in *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 417 (2007):

[I]f a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill. . . . [A] court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions.

Thus, the license plate scanner had been used in Van Luchene to improve identification, and thus it would have obvious have used it for its “established function[ ]” in Smith’s system. Appellant’s argument, particularly in the Reply Brief, indicates that other identification means are

disclosed in Smith and known in the prior art. Reply Br. 4–5. However, the fact that other ways of identifying an account holder are known, does make the use of Van Luchene’s method in Smith’s method any less obvious when it is being used for its established function.

4. Is there a reasonable expectation of success?

An obviousness determination requires finding both that a skilled artisan would have been motivated to combine the teachings of the prior art and that the skilled artisan would have had a reasonable expectation of success in doing so. *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1367 (Fed. Cir. 2016). Appellant contends that “there are many reasons to think that the proffered combination would *not* be expected to succeed.” Appeal Br. 11. We address Appellant’s arguments below.

A. “[M]any different people might be authorized to drive a given vehicle (e.g., two or more members of a family), and a license plate would presumably only identify some fraction of those people.” Appeal Br. 11.

While it is true that the occupant of the car is not necessarily the account holder associated with the license plate, this does not mean that the method would not be expected to work. The claim requires [b] determining “an identity of an account holder associated with the license plate number,” [c] displaying the identity of the account holder, and then [d] “receiving confirmation via a user interface that the account holder is physically present at the location of the merchant.” Thus, in step [d] of the claim, there is confirmation that the account holder is at the merchant location. If the driver of the car is not the account holder associated with the license plate, the account holder does not confirm they are “physically present at the

location of the merchant.” The claimed method therefore expressly covers instances where the driver is not the account holder by requiring confirmation of the presence of the account holder.

B. “[I]t is not clear that a *private entity* would even be allowed access to license plate identification records, which are typically handled by state governments.” Appeal Br. 11. “How would one go about acquiring the necessary access rights to the data?” *Id.*

The claim does not require that the license plate information be obtained from a state government source. Account holders can voluntarily provide their license plate in order to participate in the license plate scanning method of identifying account holders. Ans. 5.

Appellant responds that “[e]ven if the pending claims do not require obtaining license plate identification records by a private entity, it is nevertheless true that a typical operator of the order kiosk of Smith is a private entity, a fact that reduces motivation of a person having ordinary skill in the art to combine the order kiosk.” Reply Br. 6. Appellant does not explain why the “motivation” to use license plate identification would be reduced because Smith is a private entity. There is no indication that Van Luchene’s method is not a private entity and yet it used license identification. Thus, Appellant’s own argument is defeated by the teaching in Van Luchene.

C. “Smith contemplates use of its vending machine system ‘with pharmaceutical preparations’ in which case ‘[t]he device may be utilized to order/vend prescription pharmaceuticals’ . . . In such high profile use cases, identifying the wrong person even within a family could create significant medical liabilities.” Appeal Br. 11–12.

The claim does not require that the “item or service” purchased is a pharmaceutical preparation. However, when the item is a pharmaceutical drug, Appellant has not identified a step in the method that would not succeed when an account holder makes the purchase of the drug. While it may be true that an error in the method could create medical liability, Appellant has not identified a specific reason as to why the claimed method would be susceptible to errors that would lead to medical liability. Appellant also has not explained how the existence of a “liability” would mean that that claimed method would not succeed to buy a drug.<sup>2</sup>

D. “[I]n situations where the user does not have a car, a license plate reader would not serve any purpose; how could there be a reasonable expectation of success then?” Appeal Br. 12.

The first step of the claim recites [a] “determining, by a license plate scanning unit, an account number based on an identification of a license plate of a vehicle that is physically present at a location of a merchant.” Thus, if a “user” does not have a car, the method could not be used by them. To say that the method lacks a reasonable expectation of success for this reason is like saying a method for treating a headache would not succeed if the patient did not have a headache.

E. “[A]s a practical matter, there is unlikely to be a location at which a license plate reader could be disposed. A vending machine could be placed anywhere, and typically vending machines are located within buildings (to this end, a climate controlled environment is likely required for the

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<sup>2</sup> Appellant has not explained how their claim avoids such liability. Consequently, Appellant’s own argument raises the question of whether the claim lacks enablement. *In re Wands*, 858 F.2d. 731, 737 (Fed. Cir. 1988).

pharmaceutical and printer cartridge embodiments contemplated in Smith). But Van Luchene’s license plate reader requires ‘a roadway 512 such as a drive-thru alley in a fast food restaurant,’ which would frustrate any attempt at using the proffered combination in a climate-sensitive environment.”  
Appeal Br. 12.

This argument does not persuade us that the Examiner erred. First, Smith does not require a local vendor. Smith expressly teaches that in a “preferred embodiment,” a “local vending ability” is provided, but Smith does not limit the method to this embodiment. Smith 3: 32–34. Smith does not even limit its method to using a vender: “A preferred embodiment of the present invention comprises a device and system incorporating features of the present invention so that a user may obtain desired products from the device either by having the product vended immediately or *ordered from a host controller for later delivery.*” Smith 11:12–17 (emphasis added). -  
Second, Appellant has not provided evidence that a climate controlled environment is necessarily for a vender.

### Summary

For the foregoing reasons, the rejection under 35 U.S.C. § 103 of claim 1 is affirmed. The rejection of claims 2–23, which were not separately argued, is also affirmed. 37 C.F.R. § 41.37(c)(1)(iv).

### CONCLUSION

In summary:

<b>Claims Rejected</b>	<b>35 U.S.C. §</b>	<b>Reference(s)/Basis</b>	<b>Affirmed</b>	<b>Reversed</b>
Claims 1–23	103	Smith, Van Luchene	Claims 1–23	

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**TIME PERIOD**

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)(iv).

**AFFIRMED**