



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
**United States Patent and Trademark Office**  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
14/781,538	09/30/2015	Horatio Nelson HUXHAM	079900-0956760 (481US01)	1079
66945	7590	01/16/2020	EXAMINER	
KILPATRICK TOWNSEND & STOCKTON LLP/VISA Mailstop: IP Docketing - 22 1100 Peachtree Street Suite 2800 Atlanta, GA 30309			SHERR, MARIA CRISTI OWEN	
			ART UNIT	PAPER NUMBER
			3685	
			NOTIFICATION DATE	DELIVERY MODE
			01/16/2020	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

KTSDocketing2@kilpatrick.foundationip.com  
ipefiling@kilpatricktownsend.com

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

*Ex parte* HORATIO NELSON HUXHAM and ALAN JOSEPH O'REGAN

---

Appeal 2019-001401  
Application 14/781,538  
Technology Center 3600

---

Before LINZY T. McCARTNEY, SCOTT E. BAIN, and  
JULIET MITCHELL DIRBA, *Administrative Patent Judges*.

McCARTNEY, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant<sup>1</sup> seeks review under 35 U.S.C. § 134(a) of the Examiner's final rejection of claims 11, 13–19, and 26–34. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

---

<sup>1</sup> Appellant identifies the real party in interest as Visa International Service Association. Appeal Brief 3, filed June 25, 2018 (“Appeal Br.”).

## BACKGROUND

This patent application concerns “conducting transactions, such as financial transactions, using a mobile device.” Specification ¶ 2, filed September 30, 2015 (“Spec.”). Claim 11, the sole independent claim, illustrates the claimed subject matter:

11. A system for conducting a transaction based on account credentials associated with a consumer, the system comprising:

a mobile device of the consumer having an associated alias, the mobile device comprising:

a secure store integrated circuit including a first cryptoprocessor coupled to a first secure memory storing:

a mobile-based credential, the mobile-based credential being a decryption key corresponding to encrypted account credentials stored at a remotely accessible server as a server-based credential; and

a first set of instructions, which when executed by the first cryptoprocessor, causes the secure store integrated circuit to release the mobile-based credential in response to receiving a correct passcode associated with the mobile-based credential;

a secure accessing integrated circuit including a second cryptoprocessor coupled to a second secure memory storing a second set of instructions, which when executed by the second cryptoprocessor, causes the secure accessing integrated circuit to:

receive a request for the mobile-based credential from the remotely accessible server, the request being generated by the remotely accessible server in response to receiving the alias associated with the consumer from a merchant terminal;

prompt for entry of a passcode associated with the mobile-based credential;

receive the passcode associated with the mobile-based credential;

transmit the passcode to the secure store integrated circuit;

access the mobile-based credential from the secure store integrated circuit in response to the secure store integrated circuit verifying the passcode is correct; and

transmit the mobile-based credential to the remotely accessible server, the mobile-based credential being the decryption key decrypting the server-based credential stored at the remotely accessible server to obtain the account credentials for completing the transaction.

Appeal Br. 17–18.

## REJECTIONS<sup>2</sup>

Claims	35 U.S.C. §	References
11, 13–19, 26–32	112(a)	
11, 13–19, 26–34	112(b)	
11, 13–19, 27–32	103	McMillen, <sup>3</sup> Algazi, <sup>4</sup> Clark <sup>5</sup>
26	103	McMillen, Algazi, Clark, Janke <sup>6</sup>
33, 34	103	McMillen, Algazi, Clark, Nagai <sup>7</sup>

## DISCUSSION

### Section 112(a) Rejection

Claim 11 recites a “mobile device comprising” both “a first cryptoprocessor” and “a second cryptoprocessor.” Appeal Br. 17. The

---

<sup>2</sup> In the Final Office Action, the Examiner rejected the pending claims under § 101. Final Office Action 4–6, mailed January 24, 2018 (“Final Act.”). The Examiner withdrew this rejection in the Examiner’s Answer. Examiner’s Answer 3, mailed October 1, 2018 (“Ans.”).

<sup>3</sup> McMillen et al. (US 2012/0284195 A1; November 8, 2012).

<sup>4</sup> Algazi et al. (US 7,039,813 B2; May 2, 2006).

<sup>5</sup> Clark (US 2004/0020984 A1; February 5, 2004).

<sup>6</sup> Janke et al. (US 2007/0277070 A1; November 29, 2007).

<sup>7</sup> Nagai et al. (US 4,783,783; November 8, 1988).

Examiner found that the recited mobile device lacks adequate written description support and therefore rejected independent claim 11 and dependent claims 13–19 and 26–32 under § 112(a) as failing to comply with the written description requirement. *See* Final Act. 6–7.

Appellant contends that the Examiner erred because Figure 6 and paragraphs 11, 137, 138, and 141 of the written description provide the necessary support for this element. *See* Appeal Br. 11.

We agree with Appellant. The written description discloses a mobile device that includes a cryptographic module. *See, e.g.*, Spec. ¶ 11. The written description explains that the cryptographic module includes a secure accessing element (SAE) and a secure store element (SSE) that each have a cryptoprocessor. *See, e.g.*, Spec. ¶¶ 71, 137–138, 141. And Figure 6 shows a cryptographic module with its SAE and SSE and their associated cryptoprocessors. *See* Spec. Fig 6, items 602, 604, 618, 620. We thus agree with Appellant that the written description provides adequate support for the recited “mobile device comprising” both “a first cryptoprocessor” and “a second cryptoprocessor.” We therefore do not sustain the Examiner’s rejection of claims 11, 13–19, and 26–32 under § 112(a).

#### Section 112(b) Rejection

Claim 11 recites “corresponding to encrypted account credentials stored at a remotely accessible server,” “in response to receiving the alias associated with the consumer from a merchant terminal,” and “transmit . . . decrypting the server-based credential stored at the remotely accessible server to obtain the account credentials for completing the transaction.” Appeal Br. 17, 18. The Examiner determined that these limitations make it “unclear whether the claim is [drawn] to a mobile device or combination

mobile device, requestor device[,] and remote accessible server” and concluded that “[t]he scope of the claims is, therefore, rendered unclear.” Final Act. 8. The Examiner therefore rejected independent claim 11 and dependent claims 13–19 and 26–34 under § 112(b) as indefinite. *See* Final Act. 8.

Appellant contends that the Examiner erred because the “remotely accessible server” and “merchant terminal” recited in the identified limitations “are used to define the environment in which the mobile device operates and how the mobile device interacts with these devices in that environment” and “[t]he Federal Circuit has stated that ‘there is nothing wrong with defining . . . a device in terms of the environment in which it is to be used.’” Appeal Br. 12 (quoting *Moore U.S.A., Inc. v. Standard Register Co.*, 229 F.3d 1091, 1111 (Fed. Cir. 2000)).

We agree with Appellant. On its face, claim 11 is drawn to “[a] system for conducting a transaction based on account credentials associated with a consumer” that includes “a mobile device of the consumer having an associated alias.” Appeal Br. 17. The limitations identified by the Examiner recite components other than the mobile device, but reciting additional components alone does not make it unclear what claim 11 is drawn to, and the Examiner has not adequately explained why the identified limitations make claim 11 unclear. As argued by Appellant, these limitations, in combination with the other limitations recited in claim 11, define the environment in which the recited mobile device acts. We therefore do not sustain this rejection.

Claim 11 also recites “the request being generated by the remotely accessible server in response to receiving the alias associated with the

consumer from a merchant terminal.” Appeal Br. 17. Dependent claim 17 recites “wherein the account credentials are obtained by decrypting,” and dependent claim 30 recites “wherein the alias is variable over time.” Appeal Br. 19, 20. The Examiner determined that these limitations are “hybrid” limitations that improperly recite both an apparatus and steps for using the apparatus. *See* Final Act. 8–9 (citing *In re Katz Interactive Call Processing Patent Litig.*, 639 F.3d 1303 (Fed. Cir. 2011)). As a result, the Examiner rejected independent claim 11 and dependent claims 13–19 and 26–34 under § 112(b) as indefinite for this additional reason. *See* Final Act. 8–9.

Appellant argues that claim 11 recites functional limitations “describing the environment in which a device is used” and therefore “is not indefinite.” Appeal Br. 13. Appellant also contends that claims 11, 17, and 30 are distinguishable from the indefinite claims in *In re Katz* because those claims required user action and claims 11, 17, and 30 do not. *See* Appeal Br. 13–14.

We agree with Appellant. The language identified by the Examiner defines data related to the system; the language does not recite steps for using the system itself. For example, claim 11 recites “[a] system” that includes “a mobile device” with “a secure accessing integrated circuit” that “receive[s] a request . . . , the request being generated by the remotely accessible server in response to receiving the alias associated with the consumer from a merchant terminal.” *See* Appeal Br. 17. The “request being generated by the remotely accessible server in response to receiving the alias associated with the consumer from a merchant terminal” language that the Examiner determined is a hybrid limitation does not recite a step for using the system or an act that the system must take but instead defines a request

that the system receives. The limitations recited in claims 17 and 30 similarly define data related to the system. *See* Appeal Br. 17, 19, 20. These claims are also distinguishable from the claims in the *In re Katz* decision relied on by the Examiner. Unlike the claims here, the claims in *In re Katz* recited user acts that created confusion about when infringement occurred. *See In re Katz*, 639 F.3d at 1318. We therefore do not sustain this rejection.

#### Section 103 Rejection

As noted above, claim 11 recites a “mobile device comprising” both “a first cryptoprocessor” and “a second cryptoprocessor.” Appeal Br. 17. Because the Examiner found that this element lacks written description support, the Examiner interpreted this element to include a single cryptoprocessor. *See* Final Act. 7, 10–11. Based on this interpretation, the Examiner found a combination of McMillen, Algazi, and Clark teaches or suggests the recited mobile computing device. *See* Final Act. 10–11.

Appellant argues that claim 11 recites a mobile device that has two cryptoprocessors and the Examiner has not cited “any prior art showing the dual cryptoprocessor architecture as claimed.” Appeal Br. 14.

We agree with Appellant. Claim 11 explicitly recites a “mobile device comprising” both “a first cryptoprocessor” and “a second cryptoprocessor,” Appeal Br. 17, and the Examiner’s erroneous finding that the recited mobile device lacks written description support does not provide a basis for interpreting the mobile device to include only one cryptoprocessor. In any case, examiners generally must address all the limitations recited in a claim when determining whether the claim would have been obvious, including limitations that may lack written description support. *See Ex Parte Grasselli*, 231 U.S.P.Q. (BNA) 393, 394 (June 30, 1983), *aff’d mem.*, 738 F.2d 453

(Fed. Cir. 1984) (“All of these limitations of the claims must be considered regardless of whether or not they were supported by the specification as filed.”); Manual of Patent Examining Procedure § 2143.03 (II) (“When evaluating claims for obviousness under 35 U.S.C. 103, all the limitations of the claims must be considered and given weight, including limitations which do not find support in the specification as originally filed.”). The Examiner did not address whether the cited art teaches or suggests a mobile device that includes two cryptoprocessors as required by claim 11. *See* Final Act. 7, 10–11. We therefore do not sustain the Examiner’s rejection of claim 11 and its dependent claims under § 103.

CONCLUSION

<b>Claims Rejected</b>	<b>35 U.S.C. §</b>	<b>References</b>	<b>Affirmed</b>	<b>Reversed</b>
11, 13–19, 26–32	112(a)			11, 13–19, 26–32
11, 13–19, 26–34	112(b)			11, 13–19, 26–34
11, 13–19, 27–32	103	McMillen, Algazi, Clark		11, 13–19, 27–32
26	103	McMillen, Algazi, Clark, Janke		26
33, 34	103	McMillen, Algazi, Clark, Nagai		33, 34
<b>Overall Outcome</b>				11, 13–19, 26–34

REVERSED