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14/744,816	06/19/2015	Robert John Suttie	15-0187	2012
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NCR Corporation 864 Spring Street NW Atlanta, GA 30308			SMITH, SLADE E	
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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* ROBERT JOHN SUTTIE and DAVID HEIGHTON

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Appeal 2019-002670  
Application 14/744,816  
Technology Center 3600

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Before JENNIFER D. BAHR, STEPHEN STAICOVICI, and  
LISA M. GUIJT, *Administrative Patent Judges*.

GUIJT, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant<sup>1</sup> seeks our review under 35 U.S.C. § 134(a) of the rejection of claims 1–14 and 17–20. 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 NCR Corporation as the real party in interest. Appeal Br. 3.

### THE INVENTION

Appellant's invention relates to a method and device, such as "an automated teller machine," which is "subject to attack from fraudulent individuals." Spec. ¶ 1. Claims 1, 9, and 14 are the independent claims on appeal. Claim 1, reproduced below, is illustrative of the subject matter on appeal.

1. A method, comprising:

rotating a drum within a housing through at least a first plurality of complete rotations in the same direction while a shutterable aperture on the housing remains shuttered; and

completing the rotation of the drum so that the drum has a first rotational position at which a slot extending through the drum has one end facing the aperture and has an opposing end facing away from the aperture.

### THE REJECTIONS

The Examiner relies upon the following as evidence in support of the rejections:

<b>NAME</b>	<b>REFERENCE</b>	<b>DATE</b>
Dickinson	US 4,660,833	Apr. 28, 1987
Yamada	US 5,199,697	Apr. 6, 1993
Narushima	US 6,048,060	Apr. 11, 2000
Allan	US 2014/0061222 A1	Mar. 6, 2014

The following rejections are before us for review:

- I. Claims 1, 8, 14, 19, and 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Allan and Dickinson.
- II. Claims 2, 4–6, 9, 11–12, and 18 stand rejected under 35 U.S.C. § 103 as being unpatentable over Allan, Dickinson, and Yamada.
- III. Claims 3, 7, 10, and 13 stand rejected under 35 U.S.C. § 103 as being unpatentable over Allan, Dickinson, Yamada, and Narushima.
- IV. Claim 17 stands rejected under 35 U.S.C. § 103 as being unpatentable over Allan, Dickinson, and Narushima.

#### OPINION

Appellant presents only one argument in contesting all of the rejections before us for review. *See* Appeal Br. 8–12. Thus, we discuss all of the rejections together. Appellant’s sole argument is that Dickinson is improperly relied on by the Examiner as analogous art in the rejection of claims 1–14 and 17–21. Appeal Br. 9–12. In support, Appellant contends that Dickinson “shows ‘a coin-operated slot machine,’” which is “not from the same field o[f] endeavor as the methods and device recited in the claims (e.g., an automated teller machine).” Appeal Br. 9; Reply Br. 2. Appellant also contends that Dickinson “is *not* reasonably pertinent to the problem addressed in [Appellant’s Specification], namely [that a] ‘fraudulent individual can insert a trap into an automated teller machine, with the intent of capturing deposit materials, such as cash, that are deposited while the trap is in place.’” Appeal Br. 9 (citing Spec. ¶ 1). In support, Appellant submits that

[b]ecause the real mechanism of slot machine of Dickinson is sealed, and inaccessible to everyone except the operator of the slot machine, a fraudulent individual **could not** set a trap in the slot machine of Dickinson, even if there was a motivation to do so. Therefore, Dickinson **cannot** address the problem solved by the present application, namely “a fraudulent individual can insert a trap into an automated teller machine, with the intent of capturing deposit materials, such as cash, that are deposited while the trap is in place.”

*Id.* at 12; *see also* Reply Br. 2 (“the Dickinson reference, which shows ‘a coin-operated slot machine’, is **not** reasonably pertinent to the problem faced by the inventor (foiling traps set in an automated teller machine”).

A reference qualifies as prior art for an obviousness determination when it is analogous to the claimed invention. *Innovation Toys, LLC. v. MGA Ent., Inc.*, 637 F.3d 1314, 1321 (Fed. Cir. 2011). “Two separate tests define the scope of analogous art: (1) whether the art is from the same field of endeavor, regardless of the problem addressed, and (2) if the reference is not within the field of the inventor’s endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved.” *In re Bigio*, 381 F.3d 1320, 1325 (Fed. Cir. 2004). The “field of endeavor” test asks if the structure and function of the prior art is such that it would be considered by a person of ordinary skill in the art because of similarity to the structure and function of the claimed invention as disclosed in the application.” *Id.* at 1325–26. “A reference is reasonably pertinent . . . if it is one which, because of the matter with which it deals, logically would have commended itself to an inventor’s attention in considering his problem.” *In re Clay*, 966 F.2d 656, 659 (Fed. Cir. 1992). “If a reference disclosure has the same purpose as the claimed invention, the reference relates to the same problem, and that fact supports use of that reference in an

obviousness rejection.” *Id.* Whether a prior art reference is “analogous” is a question of fact. *Id.* at 658.

Regarding the first prong of the analogous art test, we determine that Appellant’s field of endeavor is devices with slotted, rotatable drums, for example, automated teller machines. *See, e.g.*, Spec., Title (“Slotted Rotatable Drum and Method of Using Same”), ¶ 1 (“[a] device, such as an automated teller machine”); claim 1 *supra* (“a method comprising rotating a drum [having] a slot extending through the drum”). We also determine that Dickinson is in the field of endeavor of monitoring and diagnostics for rotating wheels, for example, amusement machines having reels. *See, e.g.*, Dickinson, Title (“Reel Monitoring and Diagnostic Device for an Amusement Machine”), 1:18–21 (“The invention particularly relates to the application of . . . diagnostic systems to amusement machines having rotating reel assemblies”). In other words, although both Appellant’s invention and Dickinson’s invention involve machines with similar structures (i.e., rotating wheels or drums), the functions of the machines are different: the invention’s drums are slotted and accessible to a user, functioning to dispense and collect currency, etc., while Dickinson’s wheels are not slotted or accessible to a player, but rather, function to determine and display the outcome of a wagering game. *See* Appeal Br. 11–12 (distinguishing the claimed invention from Dickinson’s invention based on collection ability and user accessibility). Thus, Dickinson would not be considered by a person of ordinary skill in the art because of similarity to the structure and function of the claimed invention as disclosed in Appellant’s Specification pursuant to prong one of the analogous art test.

However, regarding the second prong of the analogous art test, the problem addressed by Appellant is that “a fraudulent individual can insert a trap into an automated teller machine, with the intent of capturing deposit materials, such as cash, that are deposited while the trap is in place” or “attempt to gain access to the cash [within the machine] by inserting a trap that can prevent the cash from being presented to the customer and further preventing the cash from being withdrawn [from] the machine.” Spec. ¶ 1. Put another way, Appellant’s problem is that the rotating wheel or drum of a device is subject to tampering or interference by a person. Appellant’s solution is to provide a drum that “can detect and/or ensnare potential traps formed with hard and/or soft materials,” because “[i]f a trap prevents the drum from rotating, circuitry in the device can trigger an alert and take the device out of service.” *Id.* ¶ 10.

Dickinson addresses the similar problem of “unauthorized personnel . . . interrupt[ing] the randomness of a reel spinning operation or chang[ing] the stopping positions of the reels in between rounds of game play.” Dickinson 4:54–58; *see* Ans. 8, 9 (finding that Dickinson discusses the tampering of a device having wheels by a person). Dickinson proposes “constant[] monitor[ing] to assure” that such interference does not occur. Dickinson 4:54–58. Although Dickinson proposes a different solution, we determine that Dickinson is *reasonably pertinent* to Appellant’s problem of interference with the proper rotation of a drum, and would have commended itself logically to an inventor’s attention in considering Appellant’s problem.

Thus, we find that Dickinson is properly relied on by the Examiner as analogous art.

Appellant presents, for the first time in the Reply Brief, the additional argument that, in the event Dickinson is analogous art, “the Examiner failed to show a motivation to combine the references.” Reply Br. 2 (emphasis omitted); *cf.* Final Act. 4 (stating that the motivation for combining Allan and Dickinson is to diagnose whether Allan’s drum is in need of servicing or repair, in view of the teachings in Dickinson). Appellant’s argument, however, is untimely and Appellant does not present any persuasive evidence or explanation to show good cause why it should be considered by the Board at this time. *See* 37 C.F.R. § 41.41(b)(2) (“Any argument raised in the reply brief which was not raised in the appeal brief, or is not responsive to an argument raised in the examiner’s answer . . . will not be considered by the Board for purposes of the present appeal, unless good cause is shown.”); *Ex parte Borden*, 93 USPQ2d 1473, 1474 (BPAI 2010) (informative) (“[T]he reply brief [is not] an opportunity to make arguments that could have been made in the principal brief on appeal to rebut the Examiner's rejections, but were not.”).

Accordingly, we sustain the Examiner’s rejections of claims 1–14 and 17–20.

CONCLUSION

In summary:

<b>Claims Rejected</b>	<b>§</b>	<b>Reference(s)</b>	<b>Affirmed</b>	<b>Reversed</b>
1, 8, 14, 19, 20	103	Allan, Dickinson	1, 8, 14, 19, 20	
2, 4–6, 9, 11, 12, 18	103	Allan, Dickinson, Yamada	2, 4–6, 9, 11, 12, 18	
3, 7, 10, 13	103	Allan, Dickinson, Yamada, Narushima	3, 7, 10, 13	
17	103	Allan, Dickinson, Narushima	17	
<b>Overall Outcome</b>			1–14, 17–20	

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