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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
14/246,778	04/07/2014	Barry Sim Hochfield	106195-1164646 (RA-0011US)	1488
66945	7590	08/27/2020	EXAMINER	
KILPATRICK TOWNSEND & STOCKTON LLP/VISA Mailstop: IP Docketing - 22 1100 Peachtree Street Suite 2800 Atlanta, GA 30309			MANDEL, MONICA A	
			ART UNIT	PAPER NUMBER
			3621	
			NOTIFICATION DATE	DELIVERY MODE
			08/27/2020	ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte BARRY SIM HOCHFIELD, ANTHONY BRESLIN, and
MICHAEL PETERS

Appeal 2019-006268
Application 14/246,778
Technology Center 3600

Before JOHNNY A. KUMAR, LARRY J. HUME, and
SCOTT B. HOWARD, *Administrative Patent Judges*.

HOWARD, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from the Examiner's decision to reject claims 17–36. *See* Final Act. 1. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ 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 “Rambus Inc., parent of wholly owned subsidiary Ecebs Limited, assignee of the entire right, title and interest in the [instant] application.” Appeal Br. 3.

CLAIMED SUBJECT MATTER

The claims are directed “to a scheme to enable value transfers of commodities with multiple denominations using smartcards, including card-to-card transactions. In this context, the term ‘commodity’ is used to denote anything which is perceived as having a value, including, for example, a currency.” Spec. ¶ 2.

Claim 17, reproduced below, is illustrative of the claimed subject matter:

17. An electronic terminal that enables an offline transaction between first and second smartcards during an interval in which neither the electronic terminal nor the first or second smartcards is in communication with a central processing center at which respective first and second card-holder accounts for the first and second smartcards is maintained, the electronic terminal comprising:

a card-communications interface to enable information transfer with respect to each of the first and second smartcards;

a user-interface to enable reception of information from respective first and second card-holders of the first and second smartcards;

a processing unit; and

a memory to store program code which, when executed by the processing unit, causes the processing unit to (i) receive first and second authentication information corresponding to the first and second card-holders, respectively, via the user-interface, and (ii) communicate with the first and second smartcards via the card-communications interface to:

verify authorization for the offline transaction between the first and second smartcards based at least in part in the first and second authentication information;

read first and second electronic chequebooks from the first and second smartcards, respectively, the first and second electronic chequebooks indicating respective account balances of the first and second card-holder accounts;

write the first electronic chequebook to the second smartcard and the second electronic chequebook to the first smartcard;

provide information to the first and second smartcards indicative of an amount of value to be exchanged between the first and second smartcards pursuant to the offline transaction;

receive from the second smartcard a modified version of the first electronic chequebook including a record of an electronic cheque specifying that the amount of value is to be deducted from the first card-holder account at a later time when the first smartcard is in communication with the central processing center;

receive from the first smartcard a modified version of the second electronic chequebook including a record of an electronic cheque specifying that the amount of value is to be added to the second card-holder account at a later time when the second smartcard is in communication with the central processing center; and

write the modified version of the first electronic chequebook to the first smartcard and the modified version of the second electronic chequebook to the second smartcard to complete the offline transaction.

REFERENCES

The prior art relied upon by the Examiner as evidence is:

Name	Reference	Date
Gressel	US 6,609,114 B1	Aug. 19, 2003
Kawan	US 6,913,193 B1	July 5, 2005
Linehan	US 7,103,575 B1	Sept. 5, 2006

REJECTIONS²

Claims 17, 18, 20–28, and 30–36 are rejected under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over Kawan and Gressel.

Claims 19 and 29 are rejected under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over Kawan, Gressel, and Linehan.

OPINION

We have reviewed the Examiner’s rejection in light of Appellant’s arguments that the Examiner erred. In reaching this decision, we have considered all evidence presented and all arguments made by Appellant. We are not persuaded by Appellant’s arguments regarding the pending claims.

Claims 17–26

The Examiner finds Kawan teaches all of the limitations recited in claim 17 except for “writing the modified version of the first electronic chequebook to the first smartcard and the modified version of the second electronic chequebook to the second smartcard to complete the offline transaction.” Final Act. 8–9. The Examiner further finds that because Gressel teaches that “value is transferred between smart cards,” Gressel teaches the writing limitation identified above. *Id.* at 9 (citing Gressel 28:22–54); *see also* Ans. 3–5. The Examiner further finds because of a need for an audit trail of the transaction, a person having ordinary skill in the art

² In addition to the rejections identified below, the Examiner also rejected claims 17–36 as (1) directed to patent-ineligible subject matter and (2) on the ground of non-statutory obviousness type double patenting over claims 1–9 of US patent 8,694,437. Final Act. 2–7, 16–18. The Examiner withdrew those rejections in the Answer. Ans. 3.

would have modified Kawan to incorporate Gressel’s teaching. *Id.* (citing Gressel 28:22–54).

Appellant argues that “[t]he claim feature at issue is not simply ‘value is transferred between smart cards.’” Appeal Br. 12; *see also* Reply Br. 2–3. Although Appellant admits that Gressel teaches, *inter alia*, that “upon receipt of the cheque, SC2 signs and sends SC1 a receipt therefor,” Gressel does not teach or suggest “that SC2 sends a modified version of an electronic chequebook to SC1. In other words, Gressel completely avoids the swap in the writing of swapped checkbooks.” Appeal Br. 12.

Nonobviousness cannot be established by attacking the references individually when the rejection is predicated upon a combination of prior art disclosures. *In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). The test for obviousness is not whether the claimed invention is expressly suggested in any one or all of the references, but whether the claimed subject matter would have been obvious to those of ordinary skill in the art in light of the *combined teachings* of those references. *In re Keller*, 642 F.2d 413, 425 (CCPA 1981). The Examiner finds—and Appellant does not dispute³—Kawan teaches the first and second chequebooks and all of the limitations relating to the first and second chequebooks, including modifying the chequebooks, except for the final writing step. Final Act. 8–9. Because Appellant’s argument focuses solely on Gressel and does not address the combination of Kawan and Gressel—including Kawan’s use of modified

³ “If an appellant fails to present arguments on a particular issue — or, more broadly, on a particular rejection — the Board will not, as a general matter, unilaterally review those uncontested aspects of the rejection.” *Ex parte Frye*, 94 USPQ2d 1072, 1075 (BPAI 2010) (precedential).

chequebooks—we are not persuaded by Appellant’s arguments that the Examiner erred. To the contrary, we agree with the Examiner that a person having ordinary skill in the art would have modified Kawan in light of Gressel’s teaching of exchanging electronic cheques and receipts (*see* Gressel 8:45–53) to write the modified chequebooks to the respective smart cards to ensure that proper payment is made. *See* Final Act. 9; Ans. 3–5.

Accordingly, we sustain the rejection of independent claim 17 along with dependent claims 18 and 20–26, which are not argued separately.

With respect to dependent claim 19, Appellant merely contends that because Linehan does not cure the shortcomings of the other references applied against claim 17, the Examiner failed to make a prima facie case of obviousness for these claims. Appeal Br. 13. Because we determine that the rejection of claim 17 is not erroneous for the reasons discussed above, we sustain rejection of claim 19 for the same reasons.

Claims 27, 28, and 30–35

Although Appellant argues claims 27, 28, and 30–36 in a separate section, Appellant relies on substantially the same argument. *Compare* Appeal Br. 11–13, *with id.* at 15–17. Accordingly, for the reasons discussed above, we are not persuaded by Appellant’s arguments that the Examiner erred.

Accordingly, we sustain the rejection of independent claim 27 along with dependent claims 28 and 30–35, which are not argued separately.

With respect to dependent claim 29, Appellant merely contends that because Linehan does not cure the shortcomings of the other references applied against claim 27, the Examiner failed to make a prima facie case of obviousness for these claims. Appeal Br. 17. Because we determine that the

rejection of claim 17 is not erroneous for the reasons discussed above, we sustain rejection of claim 19 for the same reasons.

Claim 36

Although Appellant argues claim 36 in a separate section, Appellant relies on substantially the same argument. *Compare* Appeal Br. 11–13, *with id.* at 18–20. Accordingly, for the reasons discussed above, we are not persuaded by Appellant’s arguments that the Examiner erred.

Accordingly, we sustain the rejection of claim 36.

CONCLUSION

We affirm the Examiner’s rejection of claims 17–36 under 35 U.S.C. § 103(a).

DECISION SUMMARY

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
17, 18, 20–28, 30–36	103(a)	Kawan, Gressel	17, 18, 20–28, 30–36	
19, 29	103(a)	Kawan, Gressel, Linehan	19, 29	
Overall Outcome			17–36	

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. § 1.136(a)(1)(iv).

AFFIRMED