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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MICHELLE FISHER

Appeal 2020-001049
Application 14/181,403
Technology Center 3600

Before RICHARD M. LEBOVITZ, FRANCISCO C. PRATS, and
JAMIE T. WISZ, *Administrative Patent Judges*.

LEBOVITZ, *Administrative Patent Judge*.

DECISION ON APPEAL

The Examiner rejected the claims under 35 U.S.C. § 112 as lacking a written description. Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from the Examiner's decision to reject the claims. 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 Michelle Fisher. Appeal Br. 2.

STATEMENT OF THE CASE

This appeal is related to Appeal No. 2020-001121 in U.S. Appl. Serial No. 14/223,505, which has been decided concurrently with this appeal.

Claims 1, 7, 12, 18, 20, 25–30, 37–50, 52–56, 58–63, and 65² stand rejected by the Examiner under 35 U.S.C. § 112(a) or 35 U.S.C. § 112 (pre-AIA), first paragraph, as failing to comply with the written description requirement. Ans. 3.

Independent claim 1 is representative. The claim is reproduced below, annotated with underlining and bracketed numbering to reference in the steps in the claim.

1. A method for processing a mobile payment transaction, comprising:

[1] maintaining a payment method at a management server;

[2] receiving, at the management server a payment account identifier from a point of sale terminal, wherein the point of sale terminal receives the payment account identifier from a non-browser based application the payment account identifier selected through user input via a mobile device display by the user using the non-browser based application to initiate a mobile payment transaction request, wherein the non-browser based application maintains the payment account identifier in a mobile device memory and is a mobile operating system based application with a graphical user interface that is preinstalled or downloaded and installed on the mobile device, wherein the graphical user interface includes a graphical icon, the mobile device comprising the mobile device display, a mobile device processor, the mobile device memory, a mobile device radio transceiver that supports voice and data interactions through a first communication channel device using

² Claims 64 and 66 were included in the statement of the rejection, but they are listed as cancelled in Claim Appendix of the Appeal Brief.

at least one of GSM and CDMA and a mobile device wireless fidelity (Wi-Fi) interface;

[3] transmitting to a transaction server information related to the payment account identifier and information related to the payment method that corresponds to the payment account identifier;

[4] receiving, at the management server, a mobile payment transaction verification from the transaction server which processes the mobile payment transaction using information related to the payment method corresponding to the payment account identifier, wherein a coupon is applied before the mobile payment transaction has been completed, wherein the transaction verification indicates that the mobile payment transaction has processed; and

[5] after the mobile payment transaction has processed, sending, from the management server a digital artifact to the non-browser based application for display within a non-browser based application generated screen using the mobile device display, wherein the digital artifact is displayed within the non-browser based application generated screen, the non-browser based application generated screen corresponding to a specific screen or area of the non-browser based application.

DISCUSSION

Did the Examiner meet the burden of establishing the inadequacy of the written description?

Appellant argues that the Examiner did not meet the burden of challenging the adequacy of the written description. Appeal Br. 12. We do not agree.

Pending claim 1 was amended extensively during prosecution.³ For example, on November 28, 2018, claim 1 was amended by adding limitations [1], [3], and [4].

³ Original claim 1, filed February 14, 2014, is reproduced below:

The Examiner identified the limitations of claim 1 not disclosed in the '403 Application.⁴ Final Act. 3–4. The Examiner described the method disclosed in the '403 Application. Final Act. 4–7. The Examiner specifically identified the difference between the method disclosed in the application and the claimed method:

The merchant processor processes the transaction using the payment method(s) selected at the mobile device (mobile wallet). In other words, the payment methods are selected at the mobile device (mobile wallet) and used to process the transaction by the merchant's online processor. This is in contrast to a management server receiving a payment account identifier, transmitting

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1. A method, comprising:
 - receiving a transaction confirmation from a payment application,, wherein the management server maintains plurality of user profiles and digital artifacts;
 - processing the transaction using the default payment method including redeeming a coupon during the transaction based on receiving input at the payment application running on the mobile device from a user to purchase an item selected at the mobile device, wherein the payment application is a mobile operating system platform based mobile application preinstalled or downloaded and installed on the mobile device, the mobile application maintaining payment account information by using the payment application in a mobile device memory included in a mobile device, the mobile device comprising a mobile device display, a mobile device processor, a mobile device radio interface, and a mobile device wireless fidelity (Wi-Fi) interface;
 - selecting a digital artifact based on correlating targeting parameters;
 - and
 - sending the digital artifact to the mobile application for [[a]] display within the specific payment application generated screen in response to a request from the mobile application for the digital artifact for display within the specific payment application screen, wherein the specific payment application generated screen corresponding to a specific screen, scene, or real estate property.

⁴ Application Serial No. 14/181,403 in this appeal is referred to as “the '403 Application.”

payment information associated with the payment account information to a transaction server, and receiving a transaction verification from the transaction server which processes the transaction.

Final Act. 6.

The Examiner addressed the disclosure in the '436 Application and concludes that “there is no support in Applicant’s specification (including applications incorporated by reference) that the management server receives payment account identifier from a non-browser based application via a POS terminal, provides payment method associated with a payment account identifier to a transaction server, and receives a transaction verification after processing the transaction.” Final Act. 8. Therefore, the Examiner clearly articulated why the written description was found to be deficient.

Did Appellant establish that the inventor had possession of the claimed method?

The '403 Application describes “a method and system for conducting an online payment transaction through a point of sale device.” '403 Application ¶ 4 (in section titled “Brief Summary of the Invention”).

In one implementation described in the '403 Application, “authorizations for payment transactions that are made through the point of sale device 104 are sent from the point of sale device 104 to an issuer authorization (e.g., management server 106) *through* the mobile communication device 102.” '403 Appl. ¶ 14 (emphasis in the original).

The management server is also described as sending “artifacts” to the mobile device, upon request, “based on user profile information and/or a transaction history (or payment trends) associated with a user of the mobile communication device.” '403 Appl. ¶ 16.

The '403 Application also describes a detailed online payment transaction, with reference to Figure 4. Figure 4 is reproduced below:

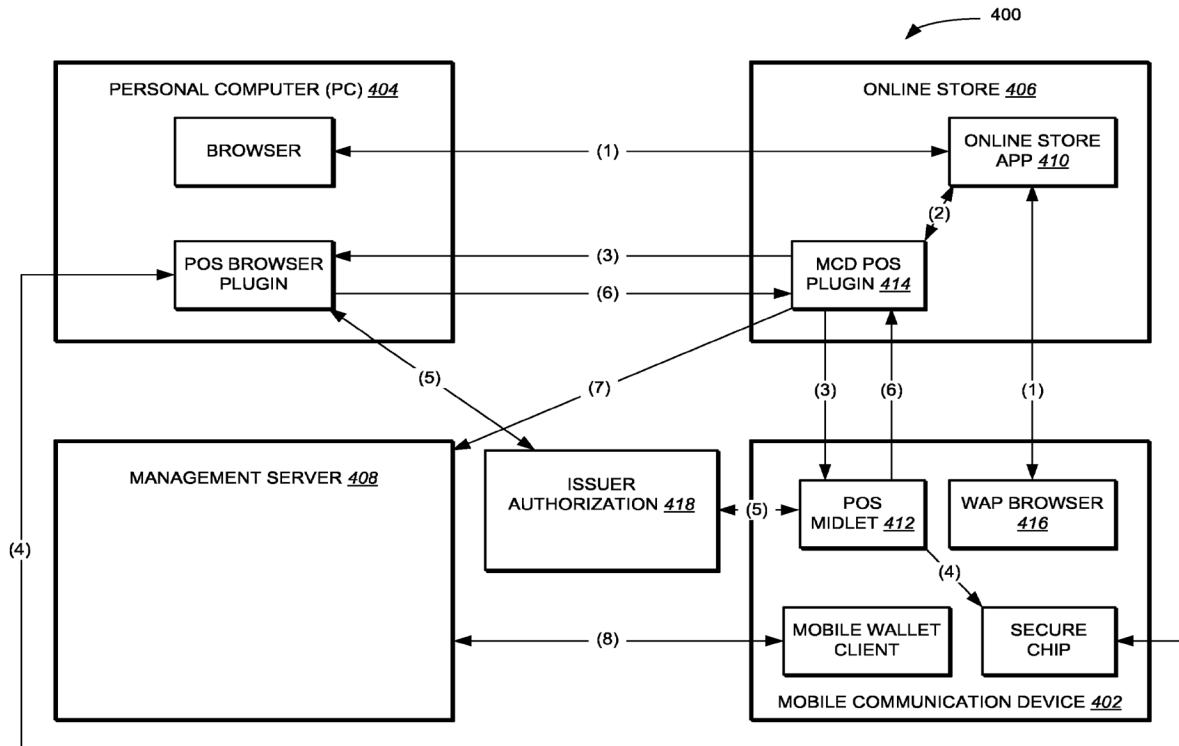


FIG. 4

Figure 4 is a diagram of the interactions between a mobile communication device, online store, personal computer, management server, and issuer authorization. These interactions are explained in more detail below.

In this embodiment shown in Fig. 4, a purchase is made from an online store using a mobile communication device, applying a coupon if available. '403 Appl. ¶ 23 (interaction "(1)"). The store sends the transaction information to the MCD POS (point of sale) vendor plugin (interaction "(2)") at the online store, which sends the transaction information to the "POS midlet 412" which resides on the mobile device (interaction "(3)"). '403 Appl. ¶ 24. The POS midlet on the mobile device forwards the

authorization to a payment entity (“issue authorization 418”), which authorizes the transaction and send the authorization back to the POS midlet on the mobile device. ’403 Appl. ¶ 25 (interaction “(5)”). The POS midlet on the mobile device forwards the authorization to the POS vendor plugin at the online store. ’403 Appl. ¶ 25 (interaction “(6)”). The POS vendor plugin “forwards the purchase transaction information to the management server 408 for later customer viewing (interaction (7)),” which allows the user to query the management server to obtain purchase information (interaction (8)). ’403 Appl. ¶ 25.

In sum, in different embodiments, the management server is also described in the ’403 Application as serving as a payment issuer authorization (’403 Appl. ¶ 14), sending “artifacts” to the user (’403 Appl. ¶ 16), providing the user with transaction/purchase information (’403 Appl. ¶ 25).

We turn now to the claim. In rejected claim 1, the management server receives a payment account identifier from the point of sale terminal (step [2]), transmits it to a transaction server (step [3]) which processes the payment and sends the authorization back to the management server (step [4]). The management server, after the transaction has been processed, sends a digital artifact to the mobile device (step [5]). As discussed by the Examiner and described above, the ’403 Application does not describe the interaction between the management server and a transaction server as recited in the claims (steps [2]–[4]). There is no transaction server in Figure 4 and none described in the ’403 Application.

In one disclosed embodiment, the management server can authorize payments ('403 Appl. ¶ 14), but there is no involvement of a transaction server as required by the claims.

In other embodiments described above, the management server has no role in transmitting the payment identifier to a transaction server, such as a payment entity ('403 Appl. ¶¶ 23–25), as required by the claim. Thus, the Examiner correctly found that the '403 Application as filed does not describe the role of the “management server” recited in the claim and its interaction with a transaction server. The role for the management server described in the '403 Application in these embodiments is for sending payment information and digital artifacts to the mobile device ('403 Appl. ¶¶ 16, 25), which is also recited in the claim (“after the mobile payment transaction has been processed, sending, from the management sever using the first communication channel, a digital artifact” to the mobile device).

Appellant contends that this deficiency in the written description is made up for by the '192 Application⁵ and the '436 Application,⁶ which are incorporated by reference in the '403 Application.⁷

To satisfy the written description requirement of 35 U.S.C. § 112, the inventor must “convey with reasonable clarity to those skilled in the art that,

⁵ US 2008/0052192 A1, published Feb. 28, 2008; listed in the '403 Application as Appl. No. 11/933,351.

⁶ US 2007/0156436 A1, published Jul. 5, 2007; listed in the '403 Application as Appl. No. 11/467,441.

⁷ 37 C.F.R. § 1.57(d) (emphasis added) states that “[e]ssential material’ may be incorporated by reference, but only by way of an incorporation by reference to a U.S. patent or U.S. patent application *publication*.” The '403 Application, as filed, does not refer to the U.S. patent application *publication* number, but only to the application serial number, and therefore does not comply with 37 C.F.R. § 1.57(d).

as of the filing date sought, he or she was in possession of the invention.” *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563–64 (Fed. Cir. 1991) (emphasis omitted). “One shows that one is ‘in possession’ of the invention by describing the invention, with all its claimed limitations.” *Lockwood v. Am. Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997). “A description which renders obvious the invention for which an earlier filing date is sought is not sufficient.” *Id.* at 107 F.3d at 1571–72 (Fed. Cir. 1997). The written description “need not recite the claimed invention in haec verba but [it] must do more than merely disclose that which would render the claimed invention obvious.” *ICUMed., Inc. v. Alaris Med. Sys., Inc.*, 558 F.3d 1368, 1377 (Fed. Cir. 2009). “[I]t is the specification itself that must demonstrate possession. . . . [A] description that merely renders the invention obvious does not satisfy the requirement.” *Ariad Pharmaceuticals, Inc. v. Eli Lilly and Co.*, 598 F.3d 1336, 1352 (Fed. Cir. 2010).

The issue in this rejection is whether the written description provides adequate evidence that the inventors had possession of a method comprising step [2] of the management server receiving a payment identifier from the point of sale terminal, step [3] of transmitting a payment identifier to a transaction server, and step [4] of receiving, at the management server, mobile payment transaction verification from the transaction server.

Appellant relies on the disclosures from the ’192 and ’436 Applications incorporated by reference in paragraph 3 of the ’403 Application. We agree that it is permissible to rely on essential material to a claim, incorporated by reference to a published patent application, to satisfy the § 112 written description requirement. Incorporation by reference provides “a method for integrating material from various documents into a

host document[] . . . by citing such material in a manner that makes clear that the material is effectively part of the host document as if it were explicitly contained therein.” *Advanced Display Sys., Inc. v. Kent State Univ.*, 212 F.3d 1272, 1282 (Fed. Cir. 2000). “To incorporate material by reference, the host document must identify with detailed particularity what specific material it incorporates and clearly indicate where that material is found in the various documents.” *Id.*

The ’403 Application states “[m]obile communication devices – e.g., cellular phones, personal digital assistants, and the like – are increasingly being used to conduct payment transaction, and references the ’192 and ’436 Applications which are said to be “incorporated herein by reference.” ’403 Appl. ¶ 3. Based on this statement, we agree that the skilled worker would understand that the payment transaction disclosure in these applications are incorporated by reference into the ’403 Application.

As explained above, the ’403 Application describes the payment transaction as being between the mobile device (“POS midlet”) and payment entity (“issue authorization 418).” ’403 Appl. ¶ 25; *see also id.* at 14 (“In one implementation, authorizations for payment transactions that are made through the point of sale device 104 are sent from the point of sale device 104 to an issuer authorization (e.g., management server 106) *through* the mobile communication device 102 (as shown in FIG. 1).”). *See also* Fig. 4 reproduced above. It must be established, therefore, that the inventor had “possession” of a method in which the payment transaction authorization is through the management and transaction servers as in steps [2]–[4] of the claim, instead of being *through* the mobile device as described in the ’403 Application. It is not enough that the “payment transaction” disclosure from

the '192 and '436 Applications is incorporated into the '403 Application; these disclosures, together with the '403 Application, must “describe” claim 1 with all its limitations in such a way that a person of ordinary skill in the art would have recognized that the inventors had conceived of the method which is now claimed.

With respect to step [2], Appellant explains:

Thus, since paragraph 0013 [of the '403 Application] discloses a management server receiving transaction information from a POS device, paragraph 25 [of the '436 Application] discloses the POS receives a transaction request from a mobile device, paragraph 33 [of the '436 Application] discloses the transaction request includes an identification code associated with a user, paragraph 0116 [of the '192 Application] discloses the management server storing a code, paragraph 0040 [of the '436 Application] discloses “For the embodiments described above, . . . software resident on the management server 180”, paragraph 41 [of the '436 Application] discloses, “In another embodiment, the piggybacked payload is sent, instead of to the transaction server 170, to the management server 180”, and Figure 1 [of the '436 Application] shows communication to/from management server and POS terminal, the ordinarily skilled artisan would appreciate the disclosure and “reasonable clarity” of “receiving at the management server a payment account identifier associated with a user from a point of sale terminal”.

Appeal Br. 25 (emphasis omitted).

Appellant has not provided adequate evidence to establish possession of a method comprising step [2] of rejected claim 1. Paragraph 14⁸ of the '403 Application states that “payment transactions that are made through the point of sale device 104 are sent from the point of sale device 104 to an

⁸ Appellant cites to paragraph 13 for this disclosure. Appeal Br. 22. However, in the original application, as filed, the disclosure appears in paragraph 14.

issuer authorization (e.g., management server 106) *through* the mobile communication device 102 (as shown in FIG. 1).” (Emphasis in the original.) The management server in this embodiment is therefore described as receiving the payment transaction “through” the mobile device, not from the point of sale terminal as recited in claim 1 (“receiving at the management server a payment account identifier associated with a user from a point of sale terminal”). The ’403 Application further explains, with reference to Figure 4, that the payment transaction moves between the mobile device and issue authorization, and then to the POS device.⁹ Appellant states that the ’403 Application describes “a management server receiving transaction information from a POS device” is correct (Appeal Br. 25), but it does not meet step [2] of “receiving at the management server a payment account identifier associated with a user from a point of sale terminal” to initiate processing of the purchase; rather only the transaction information is conveyed to the management server for later viewing by the user. *See supra* describing Fig. 4 (interactions (7, 8)). ’403 Appl. ¶ 25.

Appellant asserts that paragraph 41 of the ’436 Application describes sending a payment identifier to the management server. Appeal Br. 25. This paragraph further states that the payload is sent “to the management server 180, which can then associate the transaction and notify the transaction server 170, the POS terminal 150 and/or the POS terminal as needed.” ’436

⁹ The POS midlet on the mobile device forwards the authorization to a payment entity (“issue authorization 418”), which authorizes the transaction and send the authorization back to the POS midlet on the mobile device. ’403 Appl. ¶ 25 (interaction “(5)”). The POS midlet on the mobile device forwards the authorization to the POS vendor plugin at the online store. ’403 Appl. ¶ 25 (interaction “(6)”).

Application ¶ 41. Appellant did not explain why one of ordinary skill in the art, reading the '403 Application and the '436 Application, would understand that the inventors had conceived of and possessed a method comprising sending the payment identifier to the management server and then to a transaction server, *bypassing* the mobile communication device as described in the '403 Application (*see* description above and footnote 9). Appellant has not pointed to what in the cited applications tells the skilled worker to direct the payment transaction to management and transaction servers via the point of sale device instead of the mobile device.

Appellant's emphasis on "reasonable clarity" as the standard for meeting the written description requirement is incomplete because the inventor must "convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention." *Vas-Cath Inc.*, 935 F.2d at 1563–64 (emphasis added). Here, while it might be obvious to replace the steps in the method disclosed in the '403 Application with management and transaction servers as described in the '436 Application, Appellant has not established that the inventors had possession of this method. Obviousness is not the standard to meet the written description requirement. *Lockwood*, 107 F.3d at 1571–72; *ICU Med.*, 558 F.3d at 1377; *Ariad Pharmaceuticals*, 598 F.3d at 1352.

Appellant cites paragraph 116 of the '192 Application and paragraph 41 of the '436 Application as describing sending the payment transaction to the management server and the transaction server, but did not explain why the skilled worker, reading these disclosures would recognize that the inventors had possession of a payment method incorporating these steps (Appeal Br. 30), when the '403 Application's method for handling the

payment transaction is different. “[I]ncorporation by reference does not convert the invention of the incorporated patent into the invention of the host patent.” *Modine Mfg. Co. v. U.S. Int’l Trade Comm’n*, 75 F.3d 1545, 1553 (Fed. Cir. 1996). *See also Paice LLC v. Ford Motor Company*, 881 F.3d 894, 908 (Fed. 2018) quoting *Fifth Generation Comput. Corp. v. Int’l Bus. Machs. Corp.*, 416 Fed. Appx. 74, 80 (Fed. Cir. 2011) (“agreeing that certain prior art references were incorporated into the host patent but disagreeing ‘that every concept of the prior inventions is necessarily imported into every claim of the later patent’”).” Thus, while the ’192 and ’436 Application may describe aspects of claim 1, they are not necessarily part of the invention described by the ’403 Application. Appellant cited the incorporated disclosures, but failed to explain why the skilled worker would have recognized these steps as part of the invention of the ’403 Application.

With respect to step [3], Appellant explains

Thus, since paragraph 13 [of the ’403 Application] discloses that the POS terminal transmits transaction requests to a management server and in ONE embodiment the management server may authorize the transaction (which means in other embodiments others servers can authorize the transactions), . paragraph 0116 [of the ’192 Application] discloses that the management server stores a payment methods associated with a code, Figure 1 [of the ’436 Application] shows communication from the management server to the transaction server, paragraph 0040 [of the ’436 Application] discloses “For the embodiments described above, . . . software resident on the management server 180”, paragraph 41 [of the ’436 Application] discloses, “In another embodiment, the piggybacked payload is sent, instead of to the transaction server 170, to the management server 180, which can then associate the transaction and notify the transaction server 170”, it is implied that the management server can transmit transaction data to the transaction server for processing and the ordinarily skilled artisan would appreciate the disclosure and

“reasonable clarity” of “transmitting to a transaction server information related to the payment account identifier and information related to the payment method that corresponds to the payment account identifier”.

Appeal Br. 28–29 (emphasis omitted).

Appellant states that because “in ONE embodiment the management server may authorize the transaction,” this “means in other embodiments others servers can authorize the transactions.” Appeal Br. 28 (emphasis omitted). However, Appellant does not explain how the disclosure of a management server authorizing a transaction “means” that others servers can do the same. The test for written description is “possession” of the claimed invention with all its limitations, not whether a particular limitation would have been obvious to one of ordinary skill in the art. *Lockwood*, 107 F.3d at 1571–72.

Appellant further states in this paragraph that “it is implied” in paragraph 41 of the ’436 Application that “the management server can transmit transaction data to the transaction server for processing.” Appeal Br. 29. Appellant has not explained how an “implied” disclosure in a patent application incorporated by reference establishes that the inventor had possession of the claimed method with all its limitations.

Appellant also cited paragraph 25 of the ’436 Application as providing support for receiving transmitting step [3]. Appeal Br. 22. This paragraph is reproduced below:

The point-of-sale terminal 150 receives one of the transaction request signals from the mobile device 110 and transmits the one transaction request signal to the transaction server 170, typically using a communication channel 160 such as the internet. The transaction server 170 that receives the one transaction request signal from the point-of-sale terminal 150 verifies the

transaction, and forwards a transaction verification signal to the management server 180. The management server 180 that receives the transaction verification signal, identifies the user corresponding thereto, and provides as one of the transaction signals, a first transaction response signal back to the mobile device 110.

'436 Appl. ¶ 25.

In this embodiment, the point of sale terminal sends the transaction request to the transaction server. The transaction server verifies the transaction and forwards a signal to the management server, which sends a signal to the mobile device. This sequence of steps is different from the claimed steps where the management server – not a transaction server – receives a transaction request (“payment identifier”) in claim 1. It therefore appears that the '436 application discloses several different payment transaction embodiments. Appellant did not explain why the skilled worker would have recognized that the inventor had possession of a method comprising one of these embodiments, but not the other.

With respect to step [4] of “receiving, at the management server, a mobile payment transaction verification from the transaction server,” Appellant cites to paragraph 116 of the '192 Application and paragraph 41 of the '436 Application, but does not explain why the skilled worker would “appreciate” with “reasonable clarity” a method comprising this step. Appeal Br. 30.

Appellant’s argument that the '403 Application coupled with the disclosures from the '436 and '192 Applications describes all the limitations of the claimed method is cobbling disclosures from three applications in an attempt to establish written descriptive support for rejected claim 1. Appellant has not provided an adequate explanation of how these disparate

disclosures demonstrate the inventor has possession of the claimed invention.

Independent claims 12 and 20 comprise the same limitations as claim 1, and therefore have the same deficiencies in their written descriptive support. Dependent claims 7, 12, 18, 25–30, 37–50, 52–56, 58–63, 65 were not argued separately and therefore fall with claim 1. Appeal Br. 30; 37 C.F.R. § 41.37(c)(1)(iv).

CONCLUSION

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1, 7, 12, 18, 20, 25–30, 37–50, 52–56, 58–63, 65	112	Written Description	1, 7, 12, 18, 20, 25–30, 37–50, 52–56, 58–63, 65	

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