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FBFK/Intuit Robert Lord 3200 Southwest Freeway, Suite 3200 HOUSTON, TX 77027			CHAMPAGNE, LUNA	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ALEXANDER S. RAN

Appeal 2020-001339
Application 13/893,958
Technology Center 3600

Before PHILLIP J. KAUFFMAN, CATHERINE SHIANG, and
BETH Z. SHAW, *Administrative Patent Judges*.

SHIANG, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant¹ appeals under 35 U.S.C. § 134(a) from the Examiner’s rejection of claims 1–5, 7–12, and 14–19, which are all the claims pending and rejected in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

¹ We use “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies Intuit Inc. as the real party in interest. Appeal. Br. 4.

STATEMENT OF THE CASE

Introduction

The present invention relates to “presence based mobile payments.”

Spec. ¶ 1. In particular,

embodiments of the invention provide a method and system for presence based mobile payments. Specifically, an owner or user of a mobile device registers an account with a mobile payment service. After registering, the user of the mobile device may desire to purchase an item. . . . The mobile device of the user is able to . . . authorize the mobile payment service to pay for the item.

Spec. ¶ 13. Claim 1 is exemplary:

1. A method for presence based mobile payment, comprising:

receiving, from a user, a request for registration with a mobile payment service;

registering, by the mobile payment service, the user based on the request, wherein registering includes receiving a plurality of information items identifying the user;

receiving, from a point of sale system (PoS), one or more of the information items from the plurality of information items, and a payment authorization for a transaction,

wherein the one or more information items is broadcast through an advertising channel by a mobile device to the PoS in accordance with a communication standard without pairing the PoS to the mobile device,

wherein the advertising channel is a channel of the communication standard and is used for identification of available nearby devices,

wherein the one or more information items broadcasted over the advertising channel includes a financial account of the user,

wherein the payment authorization authorizes payment from a payment account of the user, and

wherein at least one of the broadcasted information items changes each time the broadcast is sent out to avoid fraud; and facilitating, by the mobile payment service, payment for the transaction.

References and Rejections²

Claims Rejected	35 U.S.C. §	References
1-4, 7-11, 14-18	103	Ornce (US 2012/0203700 A1; published Aug. 9, 2012), McKenna (US 2010/0241527 A1; published Sept. 23, 2010)
5, 12, 19	103	Ornce, McKenna, AWAD (US 2013/0166399 A1; published June 27, 2013)

ANALYSIS³

We have reviewed the Examiner’s rejection in light of Appellant’s contentions and the evidence of record. We concur with Appellant’s contention that the Examiner erred in determining Ornce and McKenna collectively teach

the one or more information items is broadcast through an advertising channel by a mobile device to the PoS [point of sale system] in accordance with a communication standard without pairing the PoS to the mobile device,

² Throughout this opinion, we refer to the (1) Non-Final Office Action dated June 5, 2019 (“Non-Final Act.”); (2) Appeal Brief dated August 16, 2019 (“Appeal Br.”); (3) Examiner’s Answer dated October 9, 2019 (“Ans.”); and (4) Reply Brief dated December 6, 2019 (“Reply Br.”).

³ Appellant raises additional arguments. Because the identified issue is dispositive of the appeal, we do not address the additional arguments.

wherein *the advertising channel* is a channel of the communication standard and *is used for identification of available nearby devices*,

as recited in independent claim 1 (emphases added). *See* Appeal Br. 10–18; Reply Br. 2–9.

I

The Examiner cites McKenna’s paragraphs 12, 14, and 37–39 for teaching the italicized limitations. Non-Final Act. 4–5; Ans. 3.⁴

Specifically, the Examiner cites McKenna’s broadcast channel 303 for teaching the claimed “advertising channel” and finds:

See e.g. [0014]- *The subscriber is uniquely identified as part of the registration process, and can communicate with the Reverse Path Transaction Management System via the reverse path of the multicast channel in a secure, subscriber-specific manner.* [0037] *The multi-media content typically is encoded or encrypted to prevent non-subscribers from receiving the multi-media content.* [0012]- *The multicast or broadcast transmits information to subscribers who populate the target audience.)*

1) Since McKenna’s teaching prevents non-subscribers from receiving the multi-media content via the broadcast channel, it is understood that delivery of the broadcast is only to the identified subscribers/devices.

McKenna also teaches - “subscriber device 101, 102, which is used to transmit a registration request to the carrier’s operations center 304. The request is processed by the carrier to identify and authenticate the subscriber multi-mode device, verify the authorization of this subscriber to receive the requested service. and return a decryption key to the subscriber multi-mode device

⁴ The Answer includes a typographical error, as it marks each page as “Page 1.” *See* Ans. 1–7.

101, 102 to enable it to decrypt the multimedia content 303 that is being broadcast.”

2) Furthermore, identification of available devices is taught by McKenna (at least for the devices that have sent back transaction information).

Ans. 3; *see also* Non-Final Act. 2.

We agree with Appellant that the cited McKenna paragraphs do not teach the italicized limitations. *See* Appeal Br. 16–17; Reply Br. 3–4. In particular, the italicized limitations require both (i) “one or more information items is broadcast through an advertising channel by a mobile device to the PoS” and (ii) “the advertising channel . . . is used for identification of available nearby devices” (claim 1). Contrary to the above requirements, the cited McKenna paragraphs describe a broadcast channel 303 for broadcasting information from the serving multi-media content transmitter to subscriber devices:

[T]he wireless subscriber device 101 is connected to a broadcast channel 303 from the serving multi-media content transmitter 302, receiving this transmission on the forward path of the broadcast channel 303 along with other wireless subscriber devices 102. . . . If the subscriber wishes to purchase the advertised product or service, this can be done without having the subscriber disconnect or interrupt the multi-media content that is being delivered on the forward channel of the broadcast channel 303. The subscriber is one of a plurality of subscribers whose wireless subscriber devices 101, 102 are concurrently connected to the same broadcast channel 303, so all the subscribers are receiving the same multi-media content.

McKenna ¶ 38 (emphases added).

Further, the Examiner’s finding that “McKenna’s . . . delivery of the broadcast is only to the identified subscribers/devices” (Ans. 3) does not

adequately explain why McKenna teaches the italicized limitations. Nor is the Examiner’s finding that “identification of available devices is taught by McKenna (at least for the devices that have sent back transaction information)” (Ans. 3) sufficient, as the italicized limitations require more than “identification of available devices” (Ans. 3).⁵

II

In addition to mapping the disputed limitations (discussed above), the Examiner also determines “wherein the advertising channel is a channel of the communication standard and is used for identification of available nearby devices” states an intended use, and “is given little, if any, patentable weight.” Non-Final Act. 2; *see also* Ans. 1.

We agree with Appellant that the Examiner has failed to provide adequate support for the determination. *See* Appeal Br. 13. In particular, the Examiner has not provided any analysis explaining why the wherein clause constitutes intended use, and why it should not have patentable weight. *See* Appeal Br. 13; *In re Nuvasive, Inc.*, 842 F.3d 1376, 1382 (Fed. Cir. 2016) (the USPTO “must examine the relevant data and articulate a satisfactory explanation for its action including a rational connection between the facts found and the choice made”).

⁵ If prosecution reopens, we leave it to the Examiner to determine whether the Bluetooth Low Energy standard teaches “the advertising channel . . . is used for identification of available nearby devices.” *See* Ran Declaration dated February 26, 2019 ¶ 6 (“The Bluetooth Low Energy standard defines an advertising channel that provides an example of an initial communication channel that allows for the transmission of rich data between devices. The initial communication channel is the channel that is used to identify available nearby devices and that is used to create a formal connection between devices.”).

Because the Examiner fails to provide sufficient support for the rejection, we are constrained by the record to reverse the Examiner's rejection of claim 1. *See In re Warner*, 379 F.2d 1011, 1017 (CCPA 1967) (we will not resort to speculation or assumptions to cure deficiencies in the Examiner's fact finding or analysis).

For independent claims 8 and 15, the Examiner cites the same findings and conclusions as discussed above for claim 1. *See Non-Final Act. 5*. Therefore, for similar reasons, we are constrained by the record to reverse the Examiner's rejection of independent claims 8 and 15.

We also reverse the Examiner's rejection of corresponding dependent claims 2–5, 7, 9–12, 14, and 16–19. Although the Examiner cites an additional reference for rejecting some dependent claims, the Examiner has not shown the additional reference overcomes the deficiencies discussed above in the rejection of claim 1.

CONCLUSION

We reverse the Examiner's decision rejecting claims 1–5, 7–12, and 14–19 under 35 U.S.C. § 103.

Appeal 2020-001339
Application 13/893,958

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1-4, 7-11, 14-18	103	Ornce, McKenna		1-4, 7-11, 14-18
5, 12, 19	103	Ornce, McKenna, AWAD		5, 12, 19
Overall Outcome				1-5, 7-12, 14-19

REVERSED