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Jenkins, Wilson, Taylor & Hunt, P.A.
3015 Carrington Mill Boulevard
Suite 550
Morrisville, NC 27560

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SITTNER, MICHAEL J

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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 PRADEEP KUMAR and
MIKEL ROBERT DELAGRANGE

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Appeal 2020-002332
Application 12/406,916
Technology Center 3600

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Before JAMES P. CALVE, NINA L. MEDLOCK, and
ROBERT J. SILVERMAN, *Administrative Patent Judges*.

CALVE, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant[1] appeals from the decision
of the Examiner to reject claims 1–25. Appeal Br. 1. We have jurisdiction
under 35 U.S.C. § 6(b).

We REVERSE.

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[1] "Appellant" refers to "applicant" as defined in 37 C.F.R. § 1.42. Appellant
identifies Mastercard International Incorporated as the real party in interest.
See Appeal Br. 1.

CLAIMED SUBJECT MATTER

Claims 1, 13, and 25 are independent. Claim 1 is reproduced below.

1.   A method for providing an electronic value certificate to a mobile device, the method comprising:

receiving, at a merchant server, electronic certificate selection information and a mobile device phone number;

generating, at the merchant server, electronic value certificate data using the electronic certificate selection information and the mobile device phone number, wherein the electronic value certificate data comprises an electronic certificate number, an electronic coupon amount, an electronic value certificate authorization code, an electronic value certificate image, electronic value certificate personalization data, or electronic value certificate validity information;

receiving, at an over air (OTA) provisioning server, the mobile device phone number and the electronic value certificate data generated at the merchant server;

determining that the mobile device phone number is associated with a near field communications (NFC) enabled mobile device;

establishing a communications link, via the OTA provisioning server, with the NFC enabled mobile device corresponding to the mobile device phone number;

provisioning the electronic value certificate data on the NFC enabled mobile device over the communications link via OTA communications, wherein provisioning the electronic value certificate data on the NFC enabled mobile device comprises triggering a wallet client application that initiates a downloading process to receive the electronic value certificate from the OTA provisioning server; and

transferring the electronic value certificate from the NFC enabled mobile device to a recipient mobile device via the OTA provisioning server, wherein transferring the electronic value certificate includes

deleting the electronic value certificate from the NFC enabled mobile device in response to a control short message sent to the NFC enabled mobile device by the OTA provisioning server, issuing the electronic value certificate to the recipient mobile device, and recording by the merchant server a transfer of ownership of the electronic value certificate from a user of the NFC enabled mobile device to a user of the recipient mobile device, wherein recording the transfer of ownership includes disassociating the electronic value certificate from the wallet application of the NFC enabled mobile device.

Appeal Br. 16–17 (Claims App.).

REJECTION

Claims 1–25 are rejected under 35 U.S.C. § 103(a) as unpatentable over Michaelis (US 2008/0262928 A1, pub. Oct. 23, 2008), Khan (US 7,469,151 B2, iss. Dec. 23, 2008), Slavin (US 2007/0241189 A1, pub. Oct. 18, 2007), and Barrett (US 2006/0180664 A1, pub. Aug. 17, 2006).

ANALYSIS

Regarding independent claims 1, 13, and 25, the Examiner finds that Michaelis receives electronic certificate selection information at a merchant server and Khan receives a mobile device phone number and generates at the merchant server electronic value certificate data using electronic certificate selection information and a mobile device phone number, receives at an over the air (OTA) provisioning server electronic value certificate data, identifies the mobile device phone number as a near field communication (NFC) enabled mobile device, establishes communications between the OTA server and NFC enabled mobile device, and provides the electronic value certificate data on the NFC phone as a client wallet application. Final Act. 2–6.

The Examiner finds that Michaelis and Khan teach the transfer of an e-coupon by an OTA server to an NFC enabled device of an end-user from a merchant device, but that neither reference teaches transferring/sharing of an e-coupon certificate from an end user of an NFC enabled device to a user of a different destination mobile device via the OTA server and removing the shared coupon (certificate) from the wallet of the sharing device as part of the recording of the coupon transfer. *Id.* at 8. The Examiner relies on Slavin to teach transferring of an electronic value certificate from an NFC enabled mobile device to a recipient mobile device via an OTA provisioning server by issuing the electronic value certificate to the recipient mobile device and recording by the merchant server a transfer of ownership of the certificate from the NFC enabled mobile device to the recipient mobile device wherein recording the transfer of ownership includes disassociating the certificate from the wallet of the NFC enabled mobile device as claimed. *Id.* at 8–11. The Examiner also finds that Barrett deletes an electronic value certificate from an NFC enabled mobile device in response to a control short message sent to the NFC enabled mobile device by an OTA server. *Id.* at 11.

Appellant agrees that Slavin teaches a method in which electronic wallet 114 in mobile device 112 shares an electronic coupon with a mobile device of another end user. Appeal Br. 11. However, Appellant argues that there is no action by content delivery server 102 or another server such as an OTA server to record the transfer of ownership or disassociate the electronic coupon from the wallet application of a sending NFC enabled mobile device as claimed. *Id.* Appellant argues that paragraphs 59 and 60 of Slavin teach coupon redemption by a NFC enabled mobile device at a point of sale (POS) system rather than a transfer of a certificate between mobile devices. *Id.*

Paragraphs 59 and 60 of Slavin do not teach a transfer of ownership of an electronic value certificate from a wallet application of an NFC enabled mobile device to a recipient mobile device via an OTA provisioning server. Nor does Slavin disassociate an electronic value certificate from a wallet of an NFC enabled mobile device upon a merchant server recording a transfer of ownership of the electronic value certificate from a user of the NFC enabled mobile device to a user of the recipient mobile device as claimed.

Paragraphs 59 and 60 describe a process for *redeeming* an electronic coupon at *POS system* 118 rather than transferring an electronic coupon from one mobile device to another as claimed. Slavin ¶ 59. Wallet 114 on mobile device 112 checks the validity of the coupon before permitting the coupon's barcode to be provided to POS system 118. *Id.* ¶¶ 59, 60. "If the coupon is not valid, the wallet continues to inhibit provision of the barcode to POS system 118 until the coupon is removed from the wallet or another validity event renders the coupon valid again." *Id.* ¶ 60.

Nor does the redemption of a coupon at POS system 118 result in a merchant server recording a transfer of ownership and disassociating the coupon from the sending mobile device 112 or deleting the coupon from the sending mobile device in response to a control short message as claimed. Instead, a valid coupon is retained so "the wallet again permits the coupon's barcode to be provided to POS system 118." *Id.* No instruction is provided to mobile device 112 to disassociate/delete the coupon after a redemption. If the coupon is invalid, the coupon remains in the wallet until a validity event renders it valid or it is removed at some later time. *Id.* However, an invalid coupon is not transferred as claimed. Thus, no transfer of ownership occurs and any subsequent removal does not result from such a transfer as claimed.

Slavin teaches an embodiment in which content delivery server 102, which is similar to the claimed OTA server, enables mobile device 112 to *share* a coupon with mobile device 116. *Id.* ¶¶ 144–181, Figs. 8, 9. This sharing does not transfer ownership of the coupon from mobile device 112 to recipient mobile device 116 as claimed. Nor does it result in deletion or disassociation of the coupon from the donor mobile device 102 as claimed.

Slavin instead teaches that a user may share a coupon with other users as many times as sharing is permitted for the coupon. *Id.* ¶¶ 146, 147, 172. Thus, the sharing mobile device 112 retains ownership of the coupon after sharing it with mobile device 116. Ownership does not transfer to mobile device 116 so that a coupon is deleted from wallet 114 of mobile device 112 in response to a control short message sent by content delivery server 102 (the OTA provisioning server). After sharing the coupon, mobile device 112 retains a coupon and shares the coupon with other mobile devices until the permitted number of transfers is reached. *See id.* ¶¶ 149–165. Nor does a merchant server record a transfer of ownership of the coupon as claimed.

When a coupon cannot be shared, content delivery server 102 sends a message to mobile device 112 that "no additional coupons can be shared." *Id.* ¶ 149. Thus, "[i]f the limit [for sharing] has been reached or exceeded, then the Content Delivery Server 102 returns a message to device 112 via message format such as SMS explaining that no additional coupons can be shared." *Id.* This message does not result from a coupon *transfer*. Nor does it result in the deletion of a coupon from the mobile device after a transfer as claimed. Paragraph 60 teaches only that a *nontransferred* coupon may be removed from a mobile phone wallet at a later time rather than in response to a transfer or a message from an OTA server as claimed. *See* Reply Br. 3.

Slavin teaches that n-use coupons, which can be used a fixed number of times before becoming invalid, are tested for validity before use. Slavin ¶ 100. "If the use count has reached 0, the coupon is invalid and validity test logic 604 places it in set 614 of coupons known to be invalid." *Id.* ¶ 106. An invalid coupon is discarded and not transferred between mobile devices. *See id.* ¶ 104; Ans. 5. It is not deleted in response to a message after being transferred. Unredeemable coupons or tokens may be removed (*id.* ¶¶ 218–21), but removal does not occur after a transfer as claimed. Nor is an invalid or unredeemable coupon disassociated from a wallet of a mobile device after a transfer of ownership is recorded as claimed. The Examiner's finding that Slavin fully teaches the claimed features of disassociating/deleting a coupon from a wallet of a mobile device when Slavin's server sends a message (a command) to the wallet that results in removal of the coupon from the wallet (*see* Ans. 5) does not address the claimed requirements that removal occurs after a transfer is made in response to a message from an OTA server, and disassociation occurs after a merchant server records a transfer of ownership of the coupon from one mobile device to another mobile device.

Thus, we do not sustain the rejection of claims 1–25.

CONCLUSION

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/ Basis	Affirmed	Reversed
1–25	103(a)	Michaelis, Khan, Slavin, Barrett		1–25

REVERSED