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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte GREGORY T. BYRD, MICHAEL G. MCINTOSH,
NATARAJ NAGARATNAM, and ANTHONY J. NADALIN

Appeal 2020-003413
Application 11/849,210
Technology Center 3600

Before ST. JOHN COURTENAY III, LARRY J. HUME, and
PHILLIP A. BENNETT, *Administrative Patent Judges*.

BENNETT, *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 1, 5–9, 11–13, and 17–20. Claims 2–4, 10, and 14–16 are cancelled. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

¹ We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42(a). Appellant identifies the real party in interest as International Business Machines Corp. Appeal Br. 3.

CLAIMED SUBJECT MATTER

The claims are directed to trusted statement verification for data privacy. More specifically, the claimed subject matter is in “the field of data privacy and identity management in a computer communications network, and more particularly to data parsimony in pseudonymous e-commerce transactions.” See Spec. ¶ 1. Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A method for trusted statement verification for data privacy within a voucher service data processing system communicatively coupled to one or more end users computing devices and one or more voucher consumers computing devices, the method comprising:

deducing, by a processor of a computer in the voucher service data processing system, a claim from an attribute of personal data assigning a specific value to a variable and received from an end user from an end user computing device by locating the claim as having have been mapped to the attribute;

receiving, by the processor of the computer, a request from a voucher consumer computing device issued via an exposed application programming interface over a computer communications network to vouch for an assertion based upon the attribute of personal data, the assertion asserting the variable to have a value of a particular range;

comparing the assertion to the claim to determine whether the specific value is within the particular range; and

providing a voucher in the form of a secure token over the computer communications network to the voucher consumer computing device for the assertion on behalf of the end user upon determining that the specific value is within the particular range without revealing the specific value to the voucher

Appeal Br. 12–13 (Claims App.).

REFERENCES²

The Examiner relies on the following references as prior art:

Name	Reference	Date
Sweeney	US 2002/0169793 A1	Nov. 14, 2002
Korosec	US 2003/0056113 A1	Mar. 20, 2003
Prafullchandra	US 2007/0261116 A1	Nov. 8, 2007

REJECTION

Claims 1, 5–9, 11–13 and 17–20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Korosec, Sweeney, and Prafullchandra. Final Act. 2.

ISSUE

Given the findings made in Board’s prior Decision on Appeal dated February 2, 2018 (“the Prior Decision”), and in light of the record currently before us, has the Examiner erred in finding Korosec teaches or suggests: *“receiving, by the processor of the computer, a request from a voucher consumer computing device issued via an exposed application programming interface over a computer communications network to vouch for an assertion based upon the attribute of personal data,”* as recited in claim 1?

ANALYSIS

The Prior Decision

In the Prior Decision, the Board reversed the Examiner’s obviousness rejection of claims 1, 5–9, 11–13, and 17–20. That rejection relied the same references currently before us. In so doing, the Board determined that “the

² References are identified according to their first named author or inventor only.

claims require that the same device that receives the voucher also makes a prior request for the voucher.” Prior Decision 10. The Board further explained:

The Examiner relies on Korosec’s input component 130 and output device 250 for providing a request for a voucher. Final Act. 5 (citing Korosec ¶¶ 30, 41); Ans. 4. Although the processor communicates a voucher to the output device for a claim based on an attribute, Korosec does not disclose that the output device provides a request to a processor for the voucher. *See* Korosec ¶¶ 30, 41, Fig. 5. The Examiner does not rely on Sweeney or Prafullchandra to remedy the argued deficiency. We, therefore, do not sustain the Examiner's rejection under § 103(a) of independent claim 1 and claims 5–8, which depend therefrom.

Independent claims 9 and 13 contain similar language and requirements as independent claim 1. For similar reasons as for independent claim 1, we do not sustain the Examiner's rejection under § 103(a) of independent claims 9 and 13 and claims 11, 12, and 17–20, which depend therefrom.

Prior Decision 10–11. The prior decision affirmed the decision to reject the claims under 35 U.S.C. § 101.

The Current Rejection

Subsequent to the Prior Decision, Appellant reopened prosecution by filing a Request for Continued Examination. Appellant narrowed the claims by an amendment that added a new limitation. Appellant also persuaded the Examiner to withdraw the patent-eligibility rejection under § 101. Final Act. 2. However, the Examiner set forth a new rejection under 35 U.S.C. § 103(a) relying upon the same Korosec, Sweeney and Prafullchandra combination addressed in the Prior Decision. Final Act. 2–4. The Examiner finds that Korosec teaches most of the limitations of claim 1, including the disputed “receiving” limitation. Final Act. 3–4 (citing Korosec, Figs. 4, 5; ¶¶ 60, 67). We note that in the rejection before us on appeal, the Examiner

relies on portions of Korosec not previously relied upon in rejecting the claims.

Our Review

Appellant asserts that the Examiner does not map “the actual claim language” and if he had, his mapping would have “directly contradicted the findings of the Board in the Decision on Appeal: Korosec does not disclose that the output device provides a request to a processor for the voucher.” Appeal Br. 9–10. Appellant argues the Prior Decision has a *res judicata* effect on the issue of whether the cited references teach or suggest the claimed invention, and that “under the doctrine of claim Preclusion, the Examiner is barred from ‘relitigating’ the same issue already decided by the Honorable Board.” *Id.* at 10–11.

We disagree with Appellant’s argument that *res judicata* applies in this instance. At the outset, we note that the Examiner represents the Patent and Trademark Office, and is not a party to this *Ex parte* (single party) proceeding. Moreover, with the approval of the Supervisory Patent Examiner (SPE), the Examiner can reopen prosecution after a Board decision, as necessary, to ensure that only valid patent claims are issued by the USPTO. *See* MPEP § 1207.04 (“Reopening of Prosecution After Appeal”). Furthermore, because the Examiner is not a party to this *Ex parte* proceeding, and because of the Examiner’s ability to reopen prosecution with SPE approval, the doctrine of waiver is inapplicable to the Examiner. Further, the doctrine of *res judicata* in an *Ex parte* proceeding precludes the Appellant (Applicant) from “seeking a claim that is not patentably distinct from a claim that was previously rejected if the rejection was affirmed on appeal and the decision on appeal became final.” MPEP § 2190(II).

That is not the case here.

As applicable to Appellant's contention, the predecessor court to our reviewing court rejected a claim of *res judicata* in a similar situation:

Appellants' contention that the prior board decision reversing a rejection under 35 USC 103 over Borkowski et al. in a parent application should have been "res judicata" to the examiner in this case is unpersuasive. This court stated in *In re Craig*, 56 CCPA 1438, 411 F.2d 1333, 162 USPQ 157 (1969), that the policy and purpose of the patent laws preclude the applicability of any doctrine akin to the judicially-developed doctrine of "res judicata" to bar the granting of patents on inventions that comply with the statute. *The same policy and purpose precludes reliance on any such doctrine to force the granting of patents on inventions that do not comply with the statute.*

In re Borkowski, 505 F.2d 713, 718 (C.C.P.A. 1974) (emphasis added).

As noted above, the Examiner relies on additional portions of Korosec not previously relied upon. In accordance with the precedent of our reviewing court, we do not agree with Appellant that, as a matter of claim preclusion or *res judicata*, the Examiner's rejection must be reversed.

Nevertheless, we are persuaded by Appellant's other arguments (Appeal Br. 9–10, Reply Br. 2) that the Examiner erred by not addressing the findings made in the Prior Decision which gave rise to the reversal of the Examiner's obviousness rejection. Specifically, we agree with Appellant that the Examiner's additional citations to the same Korosec reference suffer from the same deficiencies identified in the Prior Decision. The Prior Decision concluded that "the claims require that the same device that receives the voucher also makes a prior request for the voucher." Prior Decision 10. The Prior Decision found that the output device in Korosec relied upon as receiving the voucher did not make a prior request for the voucher. *Id.*

Here, the newly cited sections of Korosec, paragraphs 60 and 67, do not cure the above-noted deficiency. Paragraph 60 merely describes that identification validation may be based on age, and paragraph 67 describes that the age determination consider whether the age falls within a particular age range. While these disclosures in Korosec may well teach “the assertion asserting the variable to have a value of a particular range,” they do not demonstrate that the “same device that receives the voucher also makes a prior request for the voucher.” The Examiner provides no evidence or explanation that addresses this aspect of the prior decision.

Therefore, on this record, we find a preponderance of the evidence supports Appellant’s arguments regarding the contested claim limitation of “*receiving, by the processor of the computer, a request from a voucher consumer computing device issued via an exposed application programming interface over a computer communications network to vouch for an assertion based upon the attribute of personal data, the assertion asserting the variable to have a value of a particular range,*” as being improperly construed and mapped by the Examiner. *See* Appeal Br. 9–10, Reply Br. 2.

Accordingly, we reverse the Examiner’s obviousness rejection of each independent claim 1, 9, and 13 on appeal. Because we have reversed all independent claims on appeal, for the same reasons, we reverse the rejection of all dependent claims on appeal.

CONCLUSION

We reverse Examiner’s rejection under 35 U.S.C. § 103(a).

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DECISION SUMMARY

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1, 5-9, 11-13, 17-20	103	Korosec, Sweeney, Prafullchandra		1, 5-9, 11-13, 17-20

REVERSED