

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CRIS T. PALTENGHE, ALNOOR B. MAMDANI,
CHARLES GOLVIN,
HENRY LICHSTEIN, DAVID SOLO,
JACK PAN and MELVIN M. TAKATA

Appeal No. 2003-0755
Application No. 09/190,993

ON BRIEF

Before RUGGIERO, GROSS, and LEVY, Administrative Patent Judges.
RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the final rejection of claims 14-24, which are all of the claims pending in the present application. Claims 1-13 have been canceled. An amendment filed May 8, 2002 after final rejection was approved for entry by the Examiner.

The disclosed invention relates to a virtual wallet system which includes a locally residing portion and a remotely residing server portion. The virtual wallet system interacts with the

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outside world through the local portion and/or the server portion with an interface provided for communication between the two portions of the wallet. According to Appellants (specification, pages 10 and 11), the virtual wallet system combines the portability and owner control features of a local wallet with the security and storage capability of a remotely located wallet.

Representative independent claim 14 is reproduced as follows:

14. A method of purchasing an electronic good using a virtual wallet, comprising the steps of:

exchanging first data from a local portion of the virtual wallet into a point of sale device wherein the first data includes a transactional amount;

receiving at a server portion of the virtual wallet an electronic voucher indicative of the electronic good purchased at the point of sale device;

storing the electronic voucher at the server portion of the virtual wallet; and

receiving a request for the electronic voucher at the server portion of the virtual wallet; and

providing the electronic good to a user upon receipt of the electronic voucher.

The Examiner relies on the following prior art:

Teicher	5,744,787	Apr. 28, 1998 (filed Sep. 25, 1995)
Biffar	5,903,880	May 11, 1999 (filed Jul. 19, 1996)
Williams et al. (Williams)	6,016,484	Jan. 18, 2000 (filed Apr. 26, 1996)

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Claims 14-24, all of the appealed claims, stand finally rejected under 35 U.S.C. § 103(a). As evidence of obviousness, the Examiner offers Williams in view of Teicher with respect to claims 14-22, and adds Biffar to the basic combination with respect to claims 23 and 24.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Brief (Paper No. 20) and the Answer (Paper No. 21) for the respective details.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the Examiner, the arguments in support of the rejection, and the evidence of obviousness relied upon by the Examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellants' arguments set forth in the Brief along with the Examiner's rationale in support of the rejection and arguments in rebuttal set forth in the Examiner's Answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 14-24. Accordingly, we affirm.

Appellants indicate (Brief, page 4) that the claims on appeal stand or fall together as a group. Consistent with this indication, Appellants' arguments are directed solely to features which are set forth in independent claim 14. Accordingly, we will select independent claim 14 as the representative claim for all the claims on appeal, and claims 15-24 will stand or fall with claim 14. Note In re King, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986); In re Sernaker, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983).

As a general proposition in an appeal involving a rejection under 35 U.S.C. § 103, an Examiner is under a burden to make out a prima facie case of obviousness. If that burden is met, the burden of going forward then shifts to Appellants to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

With respect to representative independent claim 14, the Examiner, as the basis for the obviousness rejection, proposes to modify the wallet emulation system disclosure of Williams.

According to the Examiner (Answer, page 3), Williams discloses the claimed invention except for the synchronization of the local and server wallet portions " . . . by receiving and storing at the server portion an electronic voucher indicative of the goods purchased and receiving a request for the electronic voucher at the server portion and providing the good to a user." To address this deficiency, the Examiner turns to the Teicher reference which, according to the Examiner, discloses a virtual wallet system with local and remote server portions and which describes the synchronization of the local and remote server portions by the storing and processing of a transaction voucher. In the Examiner's analysis (id.), the skilled artisan would have been motivated and found it obvious to have modified the system of Williams to include the synchronization feature taught by Teicher " . . . so that central accounts associated with the local electronic wallet can be debited for purchases made off-line with the local electronic wallet."

After reviewing the Examiner's analysis, it is our view that such analysis carefully points out the teachings of the Williams and Teicher references, reasonably indicates the perceived differences between this prior art and the claimed invention, and provides reasons as to how and why the prior art teachings would

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have been modified and/or combined to arrive at the claimed invention. In our opinion, the Examiner's analysis is sufficiently reasonable that we find that the Examiner has at least satisfied the burden of presenting a prima facie case of obviousness. The burden is, therefore, upon Appellants to come forward with evidence and/or arguments which persuasively rebut the Examiner's prima facie case of obviousness. Only those arguments actually made by Appellants have been considered in this decision. Arguments which Appellants could have made but chose not to make in the Brief have not been considered [see 37 CFR § 1.192(a)].

Appellants' arguments in response to the obviousness rejection initially assert that the Examiner has failed to establish a prima facie case of obviousness since all of the claimed limitations are not taught or suggested by the applied prior art references. After careful review of the applied prior art references in light of the arguments of record, we find Appellants' assertions to be unpersuasive. In our view, Appellants' arguments unpersuasively focus on the individual differences between the limitations of representative claim 14 and each of the applied references. It is apparent, however, from the Examiner's line of reasoning in the Answer, that the basis for the obviousness rejection is the combination of Williams and Teicher. One cannot show

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nonobviousness by attacking references individually where the rejections are based on combinations of references. In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981); In re Merck & Co., Inc., 800 F.2d 1091, 1096, 231 USPQ 375, 380 (Fed. Cir. 1986).

In other words, while Appellants contend (Brief, page 6) that, in contrast to the claimed invention, Williams does not disclose a system with local and remote server portions for carrying out the method steps of claim 14, the Examiner has relied on Teicher for providing a teaching of the voucher receipt and processing limitations of claim 14. Similarly, although Appellants argue (Brief, pages 7 and 8) that Teicher does not disclose locally and remotely residing virtual wallet portions, this teaching is clearly provided by Williams.

Further, we find to be without merit Appellants' assertions (Brief, page 7) that Teicher does not disclose the voucher processing features set forth in representative claim 14. We find no error in the Examiner's assertion that Teicher, in particular at column 10, lines 20-28, discloses the storing and processing of transaction orders, i.e., vouchers, at a wallet server including requests for the debiting of customer accounts and the transferring of funds to a merchant.

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Lastly, we find to be unpersuasive Appellants' generalized assertion (Brief, page 5) that the Examiner has not established proper motivation for the proposed combination of Williams and Teicher. As previously discussed, the Examiner's stated rationale for the proposed combination, i.e., the advantages of local and server wallet portion synchronization, is clearly suggested by Teicher and, in our view, would be clearly recognized and appreciated by the skilled artisan as an obvious enhancement to the system of Williams.

In view of the above discussion, since the Examiner's prima facie case of obviousness has not been overcome by any convincing arguments from Appellants, we sustain the Examiner's 35 U.S.C. § 103(a) rejection of representative claim 14, and claims 15-24 which fall with claim 14.¹

In summary, we have sustained the Examiner's 35 U.S.C. § 103(a) rejection of all of the claims on appeal. Therefore, the decision of the Examiner rejecting claims 14-24 is affirmed.

¹ Although the Examiner has added Biffar to the combination of Williams and Teicher to address the applications connector features of dependent claims 23 and 24, Appellants have made no separate argument for patentability of these claims, instead relying on arguments made with respect to independent claim 14.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

JOSEPH F. RUGGIERO)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
ANITA PELLMAN GROSS)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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STUART S. LEVY)	
Administrative Patent Judge)	

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KILPATRICK STOCKTON LLP
607 14TH STREET, N.W.
SUITE 900
WASHINGTON DC 20005