Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte SI-WON KIM
and IN-SEONG BAIK

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Appeal No. 1999-1342
Application 08/568,232

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HEARD: APRIL 24, 2001

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Before THOMAS, KRASS, and BLANKENSHIP, Administrative Patent Judges.

THOMAS, Administrative Patent Judge.

DECISION ON APPEAL

Appellants have appealed to the Board from the examiner's final rejection of claims 1 and 3 through 13, which constitute all the claims remaining in the application.

Representative claim 3 is reproduced below:

3. An apparatus for use in conducting traffic-related business, comprising:

a driver's card for recording and reading out identification information about a driver and traffic-related information;

central processing means for storing identification information about a plurality of drivers and corresponding traffic-related information, and for processing information transmitted thereto;

portable terminal means for processing the identification information on a driver and fine payment information using said driver's card by selectively communicating on-line or off-line with said central processing means; and

interface means for outputting a result of the traffic-related business processed by said portable terminal means.

The following reference is relied on by the examiner:

Eisenmann	5,459,304	Oct. 17, 1995 (filing date of Sept. 13, 1994)

Claims 1 and 3 through 13 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner relies upon Eisenmann alone.

Rather than repeat the positions of the appellants and the examiner, reference is made to the briefs and the answer for the respective details thereof.

OPINION

From our study of the positions of the appellants, the examiner and the teachings and suggestions in Eisenmann, as well as the claimed subject matter of all claims on appeal, we sustain the rejection of claims 3 through 5, but reverse the rejection of claims 1 and 6 through 13.

Claim 1, in part, recites a data structure on an IC card comprising “an information area for direct payment transactions in which information related to a direct payment transaction is recorded.” The examiner's apparent view is that because the reference teaches prepayment transaction information recorded on the smart card shown in Figure 1 of Eisenmann, the reference implicitly in some manner teaches the claimed direct payment transaction data structure area of claim 1 on appeal. We do not agree with this reasoning of the examiner. We agree with appellants' view expressed at the top of page 10 of the principal brief on appeal that the examiner has apparently made a leap from the prepayment memory portion teachings attempting to establish a direct memory portion or that it would have been obvious on the basis of the prepayment portion to have provided for a direct payment portion. This essentially begs the question, in our view, as to the substance of this feature. There is no teaching according to the understanding of the data structure in Figure 1 and its associated discussion beginning at column 3 of Eisenmann or any other portion of this reference which may be construed to indicate even the desirability of providing for a direct payment feature as recited in claim 1 on appeal. As such, we reverse the rejection of claim 1.

A similar feature is recited in independent claim 7 on appeal of “imposing said fine and selecting one of a direct payment process, a prepayment process and a bank

payment process as a payment method for collecting said fine." In addition to not finding any teaching or suggestion in Eisenmann relating to the direct payment process recited in this claim, we reach a similar conclusion with respect to the alternative bank payment process feature as well. Because there is not taught in Eisenmann a plurality of payment methodologies, there is also no teaching or suggestion of selecting one among a plurality as required by this clause of claim 7 on appeal. As noted earlier, Eisenmann only teaches the optional prepayment process capability and not any of the other payment types including the direct payment and bank payment process types. The examiner's views, such as at page 11 of the answer, go well beyond a fair reading of the reference and its teachings and suggestions to speculate that it would have been obvious to have utilized essentially a direct payment methodology or one done with an ATM card. Therefore, we reverse the rejection of independent claim 7 and its dependent claims 8 through 13.

We reach an opposite conclusion with respect to independent claim 3 and sustain the rejection thereof. The pertinent portion of this claim argued by appellants is the recitation of a "portable terminal means for processing the identification information on a driver and fine payment information using said driver's card by selectively communicating on-line or off-line with said central processing means." The data

structure shown in Figure 1 of Eisenmann relates to his smart card which may be read by the associated computer terminal 106/107 in Figure 2 as well as a smart card microprocessor 408 within the police car of the Figure 4 showing, for example. The discussions in the corresponding columns of Eisenmann with respect to these associated figures clearly indicate there is a processing operation that occurs within the portable terminal means identified.

Appellants' arguments focus upon the language of "processing . . . fine payment information using said driver's card." The corresponding discussion of Figure 1 relating violation of record identifiers 135 in Figure 1 begins at column 4, line 7, and extends to line 41. This discussion indicates that these violation identifiers relate to particular motor vehicle code violations which normally have a corresponding fine associated therewith. The discussion between lines 26 and 30 indicates that "[e]ach violation identifier may optionally be associated with . . . a status field setting forth the legal status of the violation, i.e., awaiting trial, guilty verdict rendered with judgment satisfied, the guilty verdict rendered with judgment not satisfied . . . ." The satisfaction or non-satisfaction of the judgment identifiers clearly is a fine payment information data indicator to the extent broadly recited in claim 3 on appeal.

As to the capability of the terminal showings in Figures 2 and 4 to operate in an on-line manner, to the extent claimed there are clear showings and teachings relating to communication links on-line to central data base computer systems. To be able to read the violation record identifiers in field 135 in addition to the remaining information of the data structures and the card itself in Figure 1, the capability must inherently exist in the reference's teachings of the remote stand alone computer systems in Figures 2 and 4 to operate in an off-line manner to read and therefore “process” the information read. The discussion of the Figure 4 embodiment beginning in the middle of column 10 indicates that the mobile computer terminal 107 may be embodied in the form of a self-contained laptop computer to be utilized by the police officer in his or her vehicle.

Appellants' argument at page 13 of the Brief that “Eisenmann make [sic, makes] no mention of nor suggests that the smart card be used regarding payment of a fine” is misplaced. This is not what is recited in claim 3 on appeal. Merely the ability to process “fine payment information using said driver's card” is claimed and not that an actual fine payment is made using the card. Because Eisenmann teaches that computer terminals in Figures 2 and 4 have the capability of reading the information off the card, as well as communicating with a remote central computer, it is implicit that the ability exists to selectively communicate on-line or off-line with a central processing unit means to the

extent broadly recited in claim 3 on appeal. Appellants' arguments with respect to this claim between pages 14 and 16 of the Reply Brief initially repeat the positions in the corresponding discussion in the Brief. We obviously disagree with the appellants that Eisenmann has no ability to selectively communicate on-line or off-line. Moreover, the arguments in the paragraph bridging pages 15 and 16 relate to features not recited in claim 3 but which are disclosed. Such arguments are nonpersuasive of patentability. Because appellants present arguments only with respect to claim 3, group dependent claims 4 and 5 therewith and present no arguments with respect to claims 4 and 5, they all fall with our consideration of dependent claim 3. Because dependent claim 6 relates to features of direct payment that we have already addressed in our consideration of independent claims 1 and 7 on appeal, the examiner's rejection of claim 6 under 35 U.S.C. § 103 as being obvious over Eisenmann is also reversed.

In view of the foregoing, we have sustained only the rejection of claims 3 through 5, but have reversed the rejection of claims 1 and 6 through 13 on appeal. Accordingly, the decision of the examiner is affirmed-in-part.

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

AFFIRMED-IN-PART

James D. Thomas Administrative Patent Judge	))))) BOARD OF PATENT
Errol A. Krass Administrative Patent Judge	)) APPEALS AND)) INTERFERENCES
Howard B. Blankenship Administrative Patent Judge	))

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