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Mastercard International Incorporated c/o Buckley, Maschoff & Talwalkar LLC 50 Locust Avenue New Canaan, CT 06840			KERITSIS, DENNIS G	
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**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

Application Number: 14/802,210

Filing Date: 17 Jul 2015

Appellant(s): Radu, Cristian

Nathaniel Levin (Reg. No. 34,860)

For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 03/02/2020.

**(1) Grounds of Rejection to be Reviewed on Appeal**

Every ground of rejection set forth in the Office action dated 10/10/2019 from which the appeal is taken is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading “WITHDRAWN REJECTIONS.” New grounds of rejection (if any) are provided under the subheading “NEW GROUNDS OF REJECTION.”

**WITHDRAWN REJECTIONS**

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner. Paragraphs 42, 46, 48, and 49 of Final Rejection (10/10/2019) under §112(b) are withdrawn. With respect to paragraph 42, the claim recites a typo of a semicolon, not a comma.

**(2) Response to Argument**

**I. Summary of Claimed Subject Matter**

According to Appellant, the “present invention is concerned with security measures related to transactions performed by digital wallets.” (Br. at 2.) Examiner respectfully disagrees. Claims are given their broadest reasonable interpretation in light of the specification. (MPEP 2111.) As such, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Therefore, for the purposes of claim construction, the claims are not, as Appellant submits, related to either “using digital wallets” nor “security measures.” (Br. at 2–3.) Instead, the claims on review are directed towards mathematical operations, e.g. “generating [] cryptographic key[s]” and “using [] cryptographic key[s].” Claims (08/12/2019) at Claim 9, fourth and sixth elements.

Additionally, Appellant contends that the Examiner “concedes that the subject matter just describe is novel and unobvious.” Examiner respectfully disagrees. Given that there is “considerable speculation about the meaning of the terms employed in a claim or assumptions that must be made,” a

rejection under §103 is not appropriate. MPEP 2173.06(II) (citing *In re Steele*, 305 F.2d 859, 134 USPQ 292 (CCPA 1962)).

## II. Argument

### **II (A). Ineligible subject matter under §101**

#### II (A) (1). 2A Pong 1, answering to (A) and (D)

(A)

Appellant performs steps of Pong One and Two out of order. Br. at 8 (“initially discuss...‘Prong Two’ of Step 2A”). Therefore, as a matter of procedure, Examiner should be affirmed because Prong Two is the *additional* elements test. See 2019 Revised Patent Subject Matter, 84 Fed. Reg. 50 (Jan. 7th 2019). Without first identifying what the elements are under Step 2A Prong One, Prong Two’s requirement of *additional* elements cannot be performed. Examiner has previously requested the Appellant comport with the procedural requirements. See Final Rejection (10/10/2019) at 9 (“Applicant [does not] outline any *specific* claim language that imposes meaningful limits, also called additional elements.”) (emphasis in original).

(D)

After discussing Prong Two, Appellant now comes and discusses, out of order, whether the claims are directed towards an abstract idea. (Br. at 9–10.) 2019 Revised Patent Subject Matter, 84 Fed. Reg. 50 instructs that Appellant should “evaluate whether the claim recites a judicial exception [...] [and] [i]dentify the specific limitation(s) in the claim under examination[.]” An Examiner’s error cannot be found nor can any specific limitations be identified from the claim. Therefore, as Appellant has not comported with procedure, the Examiner should be affirmed. Instead, Appellant submits that “[a]s is made clear from the specification...the **claimed** subject matter arises from the technological field....” (Br. at 10.) Appellant has not identified what this “claimed” subject matter specifically is.

Appellant goes on to points to FIG. 2 to support that “the claimed subject matter arises from the technological field of providing security....” (Br. at 10, n.12.) First, the evidence produced (Fig. 12, pointing to no items within the drawing) is of little probative value. Second, the Examiner can find no explanation related to this evidence. This attorney argument cannot replace the evidence of record.

II (A) (2). 2A Pong 2, answering to (B)

Appellant contends that the instant claims “impose[] meaningful limits on the alleged abstract idea of ‘authenticating a transaction’ and would not monopolize it.” (Br. at 8.) Appellant submits that “this highly specific sequence of transaction processing steps...would [] not cover any transaction authentication process that does not include this exact sequence of steps.” (Rm. at 8.) The Examiner can find no citation to authorities that would support this proposition of specificity. (MPEP 1205.02.)

Authorities hold otherwise. Examiner contends that claim specifics will not save the claim from being directed towards an abstract idea. See *Affinity Labs of Tex. v. DIRECTV, LLC*, 838 F.3d 1253, 1263 (“[Appellant] asserts that [the claim] was novel....[but] it does not avoid the problem of abstractness.”); see also MPEP 2106.05(f), subsections 1, 2. Additionally, it is the respectful opinion of the Examiner that Appellant conflates an analysis between §101 and §103. Br. at 8–9 (“Many, many types of authentication processes would not be covered by claim 9[.]”).

II (A) (3). 2B Pong 2, answering to (C)

Appellants submit that the Examiner has erred in procedure in view of the *Berkheimer Memo*. (Br. at 9.) The Examiner rejection is based on the New Subject Matter Guidance. See 2019 Revised Patent Subject Matter, 84 Fed. Reg. 50 (Jan. 7th 2019).

**II (B). Written Description under §112(a), answering (A) to (F)**

(A) to (F)

Appellant attempts to produce evidence. (Br. at 10–11). However, this is not submitted in a timely fashion. The Examiner has not erred in establishing a *prima facie* case. See MPEP 2163.04 (holding that “[a] simple statement such as ‘Applicant has not pointed out where the new (or amended) claim is supported...’ may be sufficient where the claim is a new or amended claim, the support for the limitations is not apparent, **and applicant has not pointed out where the limitation is supported.**”) (quoting *Hyatt v. Dudas*, 492 F.3d 1365, 1370, 83 USPQ2d 1373, 1376 (Fed. Cir. 2007)) (emphasis added). In Remarks (08/12/2019), the Examiner found no citations to the Specification in view of the substantial amendments, see Claims (08/12/2019). In response, Examiner submitted 112(a) rejections accordingly with the pithy statements. See Final Rejection (10/10/2019) at paras. 32-37. Lastly, Appellant’s Remarks (11/25/2019) do not remedy the issue as these are submitted *after* prosecution has been closed. See Remarks (11/25/2019) at 3, 4. The Examiner will not comment on propriety of the substance as the Examiner rejection is based on procedure. The Board is not a place of initial examination.

(D)

Under the same line of reasoning, Examiner’s statement, see Final Rejection (10/10/2019) at 34, is sufficient to establish a *prima facie* case pursuant to MPEP 2163.04. However, without conceding to the propriety of the issue and without turning the Board into a place of initial examination, Examiner will address “the questioned ‘performing’ functions.” (Br. at 11.) For example, Appellant points to page 6, lines 18-29 to support the function of “performing.” (Br. at 11.) Specifically, the Spec. does not disclose “performing” and Appellant has not outlined exactly what is “performing.” This cannot be meet Appellant burden of persuasion requirement. Ultimately, this language of “performing” along with the ancillary limitations in the respective elements, is “expansive claim language [that fails to] satisfy the requirements of” 112(a). MPEP 2163 (II)(A)(3)(a)(ii) (citing *LizardTech v. Earth Resource Mapping, Inc.*, 424 F.3d 1336, 1346, 76 USPQ2d 1731, 1733 (Fed. Cir. 2005)); see also MPEP 2163.03(V) (“The

appearance of mere indistinct words in a specification...does not necessarily satisfy that requirement.”)  
(quoting *Enzo Biochem, Inc. v. Gen-Probe, Inc.*, 323 F.3d 956, 968, 63 USPQ2d 1609, 1616 (Fed. Cir. 2002)).

## **II (C). Indefiniteness under §112(b), answering A to H**

### **(A)**

Appellant contends that one would “readily understand...that a transaction according to the invention involves a number of stages, including a device authentication stage.” Examiner respectfully disagrees with this claim construction. The operation of “performing” is adjacent to “the device authentication stage.” It is unclear what a “device authentication stage” is and what it means for a “device authentication stage” to be performed. This “ambiguous” language fails to place the public on notice. MPEP 2173.05(a). Appellant has pointed to p. 6 ll. 18-25 of the Spec. The Spec. there discloses: “The device authentication phase [not stage] includes cryptographically hidden presentation of a session key....” In view of this, it is still unclear what “performing a device authentication stage” is.

### **(B)**

Examiner has withdrawn the rejection.

### **(C)**

Claim 11 is unclear because each of the operations, as indicated by the preamble, are performed by the computing device. Therefore, it is unclear what “in the computer device” is to mean when all the operations are performed by the computer device. Paragraphs 44-45 of the Final Rejection (10/10/2019) build on a similar issue. That is, it is unclear how many devices are being claimed and which devices are performing the operations.

### **(D)**

Examiner has withdrawn the rejection.

(E)

Appellant contends that “the claim [is] directed to a method, and not to a user or a computer device.” Br. at 13 (emphasis added). Examiner disagrees. The claims are directed towards a method *performed* by the actor of the computing device per the language in the preamble (“using a computing device”). Therefore, claim 17’s scope is unclear because it further describes an additional actor performing further method steps. This user performs the operations of “permitted” and “access[ing] a digital wallet...in a remote server.”

(F)

Examiner has withdrawn the rejection.

(G)

Examiner has withdrawn the rejection.

(H)<sup>1</sup>

Applicant contends that the “term ‘different’ has been widely used in claim language...and simply means ‘not the same.’” (Rm. 14.) Examiner agrees that this is a widely used term and thus is to be given a plain and ordinary meaning, *see* MPEP 2111; however, the claim language is indefinite given the dictionary definition of “Unlike in form, quality, amount, or nature; dissimilar.” *See, e.g.*, The American Heritage Dictionary (Online Ed.), available at <https://ahdictionary.com/word/search.html?q=different>. According to Appellant’s construction within the Brief, the “two session keys [are] different from each other” based upon a “formula.” Br. at 10, 11 (citing Spec. at p. 39 l. 16, p. 38). Therefore, this construction is unlike in terms of “quality” or “form.”

Examiner respectfully disagrees as is shown through the prosecution history. Examiner constructed the term in terms of “amount,” not “form.” This construction is supported through Fielder. *See* Non-Final Rejection (05/20/2019) at 55, third bullet (constructing claims); *see also* PTO-892

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<sup>1</sup> Out of Alphabetic order, Appellant refers to this as (N).

(05/20/2019) at Item A. In Fielder, paragraph 0095 discloses that “the members of a group may agree to change the encryption key.” That is, the language of different may be understood in terms of quantity and thus “different” may be construed as a key of differing numeric value. *Compare* Field at 0036 (disclosing the form of different “encryption algorithm[s]”). Therefore, one skilled in the art of cryptography would not be readily placed on notice as it would be unclear whether the keys differ in terms of numeric value or differ in terms of quality/form.

### III. Conclusion

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/DENNIS G KERITSIS/  
Examiner, Art Unit 3685

Conferees:

/ZESHAN QAYYUM/  
Primary Examiner, Art Unit 3685

/CALVIN L HEWITT II/  
Supervisory Patent Examiner, Art Unit 3685

**Requirement to pay appeal forwarding fee.** In order to avoid dismissal of the instant appeal in any application or ex parte reexamination proceeding, 37 CFR 41.45 requires payment of an appeal forwarding fee within the time permitted by 37 CFR 41.45(a), unless appellant had timely paid the fee for filing a brief required by 37 CFR 41.20(b) in effect on March 18, 2013.