

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FRANCOIS DEVAUX

Appeal No. 1999-0477
Application No. 08/571,236

Heard: January 24, 2001

Before THOMAS, HAIRSTON, and LEVY, Administrative Patent Judges.
LEVY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 2-13, which are all of the claims pending in this application.

BACKGROUND

The appellant's invention relates to an interactive television reception console. An understanding of the invention

can be derived from a reading of exemplary claim 13, which is reproduced as follows:

13. An interactive television receiver console comprising:
a television receiver;
an interface pack linked to said television receiver, said interface pack including a data transmission means for transmitting transmitted data to a televised program distributor which implements transactional applications based on said transmitted data, a data reception means for receiving received data from said televised program distributor, and an image overlay means for overlaying an image corresponding to said received data on another image displayed on said television receiver;
a keyboard linked to said interface pack configured to enter information elements to said interface pack;
a chip card reader linked to said interface pack; and
a chip card which is inserted into said chip card reader to enable reading of data from said chip card, said chip card comprising:
a memory configured to hold said chip card data and
a processor configured to determine steps in said transactional applications based on said chip card data.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Moreno	4,102,493	Jul. 25, 1978
Ware	4,707,592	Nov. 17, 1987
Biggs	5,333,181	Jul. 26, 1994

Claims 13 and 2-8 stand rejected under 35 U.S.C. § 103 as being unpatentable over Biggs in view of Moreno.

Claims 9-12 stand rejected under 35 U.S.C. § 103 as being unpatentable over Biggs in view of Moreno, further in view of Ware.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 13, mailed June 9, 1998) for the examiner's complete reasoning in support of the rejections, and to the appellant's brief (Paper No. 12, filed March 16, 1998) and reply brief (Paper No. 15, filed August 10, 1998) for the appellant's arguments thereagainst. Only those arguments actually made by the appellant have been considered in this decision. Arguments which the appellant could have made but chose not to make in the briefs have not been considered. See 37 CFR 1.192(a).

OPINION

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 not have suggested to one of ordinary

skill in the art the invention as set forth in claims 2-13. Accordingly, we reverse, essentially for the reasons set forth by the appellant.

We note, at the outset, the appellant's statement (brief, page 4) that claims 2-13 do not stand or fall together because the dependent claims 2-12 each provide further patentable limiting features. From our review of the brief, we find that the appellant only provides separate arguments with respect to dependent claim 9. Accordingly, each of the other dependent claims will rise or fall with the claim from which it depends.

We begin with the rejection of claims 2-8 and 13 under 35 U.S.C. § 103 as unpatentable over Biggs in view of Moreno.

The examiner asserts (answer, page 3) that Biggs does not disclose a chip card, including a memory and processor. To overcome the deficiencies of Biggs, the examiner turns to Moreno. The examiner states (answer, page 4) that Moreno teaches a chip or smart card which includes "memory to hold data (storage 1) and processor (electronics) to process the stored data."

The examiner concludes that it would have been obvious to "use a 'smart' card taught by Moreno for the interactive system taught by Biggs in order to provide more security when the user is using the interactive system."

The appellant asserts (brief, page 6), inter alia, that any obvious combination of Biggs and Moreno would not yield the appellant's invention. We agree, for the reasons which follow.

The appellant asserts (brief, page 7) Biggs does not disclose an image overlay means for overlaying an image corresponding to said received data on another image displayed on the television receiver. From the examiner's statement, (answer, page 4) that the "overlying image, ordered by the user is send [sic] to the user's TELEVISION receiver to replace the old program" it is clear that as recognized by the examiner, the image corresponding to the received data "replaces" and does not overlay another image. In addition, we find that although Biggs's discloses (col. 3, lines 1-5) that "[t]he access phone 10 can be interfaced with a . . .

television **16** such that information can be transmitted therefrom through the access phone **10**," there is no disclosure in Biggs that the information transmitted from the television **16** via the access phone **10** includes an overlay image. Further, we find that Biggs discloses (col. 4, line 61 through col. 5, line 2) that

This would allow the user to select, for example, a movie. The amenity **52** would then initiate activation of the in-room amenity **54**. This could be done remotely by a call to the hotel establishment to activate the amenity, or some similar way.

Another method for activating an in-room amenity is that the store-and-forward switch **48** itself collects prompt information from the access phone **10** and then initiates a routine wherein it activates the in-room amenity **54** itself.

Thus, we find no teaching or suggestion in Biggs of "image overlay means for overlaying an image corresponding to said received data on another image displayed on said television receiver" as recited in claim 13. We would have to resort to speculation to assert that an image would be received on the TELEVISION of Biggs and that the image received corresponding to received data was overlaid on another image.

The appellant further asserts (brief, pages 6 and 7) that a combination of Biggs and Moreno would not yield the claimed invention because the identification circuit of Moreno is not a processor and is not configured to determine steps in the particular transactional application. The examiner's response (answer, page 6) is that nonobviousness cannot be established by attacking the references individually. The examiner asserts (id.) that

In this regard, the chip card and interface pack 10 of Fig. 1 taught by Biggs clearly implementing transactional application (credit card paying service) with determined steps. It is irrelevant whether Moreno's teaching of a smart or chip card with processor (electronics) to configured to determine steps in the particular transaction application. The teaching of Moreno having a chip card with processor (electronics) is modified to the teaching of Biggs to provided [sic] more security for the user when using the interactive system as stated in the rejection above.

With regard to the examiner's assertion that it is "the chip card and the interface pack 10" of Biggs that teaches "implementing transactional application (credit card paying services) with determined steps." We find that in Biggs, (col. 1, line 64 through col. 2, line 7):

The system includes a telephone having an input device. Telephone amenity i.d. information is stored in the telephone and then billing information from a user is input and stored in the telephone. In addition, amenity selection information is also input into the telephone to select an amenity having associated therewith selected stored identification information. The telephone is connected with a remote billing station in response to input of both the amenity selection information and the user billing information. This information is then translated to the remote billing station. At the remote billing station, the received billing information is validated to determine if it is acceptable.

Additionally, col. 4, lines 3-7 state "[t]he entire billing procedure is performed at the store-and-forward switch **20** at the remote location and neither the amenities nor the establishment contracting for the access phone **10** have the responsibility for validation of the card or retaining billing information."

From these teachings of Biggs, we find that Biggs does not disclose that a credit card, used to charge amenities, will include a processor configured to determine steps in the transactional applications based on chip card data.

Turning to Moreno, we find that (col. 1, lines 5-7) Moreno discloses a system for storing and transmitting data in a confidential manner. Specifically, Moreno discloses (col. 2, lines 50-56 and col. 4, lines 25-31) that in order to prevent fraudulent use of the portable article (card), the portable article 50 contains a programmable memory store 1 and an identification circuit (Figure 1) for comparing the enabling data in the store with confidential information introduced into the transfer device (Figure 2) by a person in possession of the portable article. In addition, Moreno discloses (col. 4, lines 60-62) that before any operation, the confidential code must be introduced into the portable article by the transfer device. Moreno further discloses (col. 5, lines 7-12) that control means 56 "ensures that the different operating sequences . . . proceed in the proper manner." However, control means 56 is part of the transfer device (Figure 2), and not part of the chip card. Accordingly, even if we considered the identification circuit of portable article 50 of Moreno to be a processor, we find that Moreno does not disclose a chip card which includes a

processor configured to determine steps in transactional applications.

We agree with the examiner that it would have been obvious to have provided Biggs with a chip card including an identification circuit as taught by Moreno. However, we are in agreement with the appellants (brief, page 6) that if the teachings of Moreno and Biggs were combined, the only feature of Biggs that would change is that the identification circuit within the card would ensure that the correct person is using the card.

From all of the above, we conclude that the examiner has failed to establish a prima facie case of obviousness of the invention set forth in claim 13. Accordingly, the rejection of claims 2-8 and 13 under 35 U.S.C. § 103 is reversed. Turning to claims 9-12, rejected under 35 U.S.C. § 103 as unpatentable over Biggs in view of Moreno, further in view of Ware, we find that Ware does not overcome the deficiencies of the basic combination of Biggs and Moreno. As claims 9-12 depend from claim 13, the rejection of claims 9-12 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 2-13 under 35 U.S.C. § 103 is reversed.

REVERSED

JAMES D. THOMAS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
KENNETH W. HAIRSTON)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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