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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 90/012,517 | 09/12/2012 | 8036988 | 253.005 | 5785 |
| 34111 | 7590 | 09/12/2014 | EXAMINER | |
| Maxey Law Offices, PLLC 100 Second Avenue South Suite 401 North St. Petersburg, FL 33701 | | | HOTALING, JOHN M | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3992 | |
| | | | MAIL DATE | DELIVERY MODE |
| | | | 09/12/2014 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL 89A (Rev. 04/07)



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EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/012,517.

PATENT NO. 8036988.

ART UNIT 3992.

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified *ex parte* reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the *ex parte* reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).

PTOL-465 (Rev.07-04)

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|---|----------------------------------|--|--|
| Notice of Intent to Issue Ex Parte Reexamination Certificate | Control No. 90/012,517 | Patent Under Reexamination 8036988 | |
| | Examiner JOHN HOTALING | Art Unit 3992 | AIA (First Inventor to File) Status No |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

- Prosecution on the merits is (or remains) closed in this *ex parte* reexamination proceeding. This proceeding is subject to reopening at the initiative of the Office or upon petition. Cf. 37 CFR 1.313(a). A Certificate will be issued in view of
 - Patent owner's communication(s) filed: 23 July 2014.
 - Patent owner's failure to file an appropriate timely response to the Office action mailed: _____.
 - Patent owner's failure to timely file an Appeal Brief (37 CFR 41.31).
 - The decision on appeal by the Board of Patent Appeals and Interferences Court dated _____
 - Other: _____.
- The Reexamination Certificate will indicate the following:
 - Change in the Specification: Yes No
 - Change in the Drawing(s): Yes No
 - Status of the Claim(s):
 - Patent claim(s) confirmed: 1-38.
 - Patent claim(s) amended (including dependent on amended claim(s)): _____
 - Patent claim(s) canceled: _____.
 - Newly presented claim(s) patentable: _____.
 - Newly presented canceled claims: _____.
 - Patent claim(s) previously currently disclaimed: _____
 - Patent claim(s) not subject to reexamination: _____.
- A declaration(s)/affidavit(s) under **37 CFR 1.130(b)** was/were filed on _____.
- Note the attached statement of reasons for patentability and/or confirmation. Any comments considered necessary by patent owner regarding reasons for patentability and/or confirmation must be submitted promptly to avoid processing delays. Such submission(s) should be labeled: "Comments On Statement of Reasons for Patentability and/or Confirmation."
- Note attached NOTICE OF REFERENCES CITED (PTO-892).
- Note attached LIST OF REFERENCES CITED (PTO/SB/08 or PTO/SB/08 substitute).
- The drawing correction request filed on _____ is: approved disapproved.
- Acknowledgment is made of the priority claim under 35 U.S.C. § 119(a)-(d) or (f).
 - All Some* None of the certified copies have
 - been received.
 - not been received.
 - been filed in Application No. _____.
 - been filed in reexamination Control No. _____.
 - been received by the International Bureau in PCT Application No. _____.

* Certified copies not received: _____.
- Note attached Examiner's Amendment.
- Note attached Interview Summary (PTO-474).
- Other: _____.

All correspondence relating to this reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of this Office action.

| | |
|--|--|
| | /John M Hotaling II/ Primary Examiner Art Unit: 3992 |
|--|--|

cc: Requester (if third party requester)
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PTOL-469 (Rev. 08-13)

STATEMENT OF REASONS FOR PATENTABILITY AND/OR CONFIRMATION

Claims 1-38 are confirmed.

The following is an examiners statement of reasons for confirmation of the claims in this reexamination proceeding. Appellant contends:

Cohen does not disclose designating/selecting a payment category that places limitations on a transaction code before the transaction code is generated. Independent claims 1 and 17 are representative. Claim 1 is reproduced below, in relevant part (emphasis added):

c) *defining at least one payment category to include at least limiting a number of transactions* to one or more merchants, said one or more merchants limitation being included in said payment category prior to any particular merchant being identified as one of said one or more merchants;

d) *designating said payment category*;

e) *generating a transaction code* by a processing computer of said custodial authorizing entity, *said transaction code reflecting at least the limits of said designated payment category* to make a purchase within said designated payment category.

Claim 17 is reproduced below, in relevant part (emphasis added):

b) *selecting a predetermined payment category which limits a nature, of a series of subsequent purchases* to one or more merchants, said one or more merchants limitation being included in said payment category prior to any particular merchant being identified as one of said one or more merchants;

c) *generating a transaction code* by a processing computer of a custodial authorizing entity of said pre-established account, *said transaction code associated with at least said pre-established account* and the limits of said selected payment category and different from said pre-established account.

Independent claims 19, 21, and 22 include similar limitations and need not be discussed separately. Each independent claim requires the designating or selecting step to be performed *before* the generating step. The specification of the '988 patent only describes generating the transaction code after both (1) identifying an account that is used to make credit card purchases to associate with the transaction code and (2) designating or selecting a payment category.

Admittedly, Cohen discloses that a credit card number can have its use customized, but Cohen does not disclose defining/selecting customized uses of the credit card number *before* the credit number is generated for use. Instead, Cohen describes customizing use *after* the credit card number is generated:

In one embodiment, with respect to customization, the user receives one or more credit cards, each of which is inactive When the

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user receives the credit card, or when the user is ready to activate the credit card, the user determines...what particular uses or types of uses are desired.

Whereas, every independent claim of the '988 patent requires selecting or designating a payment category that includes limiting to either a single merchant or one or more merchants, and then *subsequently* generating the transaction code for use by a customer, where upon generating, use of the transaction code is restricted according to the payment category.

Consequently, because Cohen does not disclose selecting or designating a payment category that includes limiting to either an unidentified single merchant or unidentified one or more merchants, *before* the transaction code is generated for use by the customer, Cohen does not disclose every feature of independent claims 1, 17, 19, 21 and 22. The remaining dependent claims are appealed on the same basis as their respective base claims 1, 17, 19, and 22. Accordingly, the rejection should be reversed.

(AB 20-22, contested limitations emphasized)

The examiner agrees with the Appellant's contentions. Cohen discloses the following relevant section with respect to the contested sequence of claimed method steps:

The invention can be practiced according to a wide variety of embodiments. In one embodiment, for example, a user dials into her credit card company before making a transaction, and after providing the ordinary credit card number and verification data, is provided with a disposable or customized number and/or mailed, provided with, or allowed to activate a disposable or customized card for a single or a limited range use.

In one embodiment of the invention, a user can indicate in advance of purchase, on the telephone call with the credit card company, what the single use or the customized credit card number is to be used for. This can be used to provide additional security and/or control the uses of the funds placed on that card.

(Cohen 3:40-55 emphasis added)

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