

COMMISSIONER'S DECISION

Sufficiency of Disclosure; S.2; Obviousness: The amended disclosure was sufficient to permit realization by a person skilled in the art. No finding as to patentable subject matter, as the rejection was raised only at the Final Action stage. The cited references are not appropriate, some as to dates, some as to subject matter. Rejection withdrawn.

This decision deals with Applicant's request that the Commissioner of Patents review the Examiner's Final Action on application 239,565 (Class 354-42). It was filed on November 13, 1975, and is entitled AUTOMATIC BANKING EQUIPMENT. The inventors are Donald E. Kinker and Herbert Morello. The Examiner in charge issued a Final Action refusing the application.

In reviewing the application, the Patent Appeal Board held a Hearing at which the Applicant was represented by Mr. A. Davidson, the Patent Agent. Mr. R. Faggetter of the Agent's Office also attended.

The application relates to a customer operated banking station as shown in figure 1, reproduced below, which is at a location remote from the bank. The station 1 has an entry slot 2 for insertion of a personalized, conventional coded card, and a keyboard 4 for entry of information necessary in carrying out a desired banking transaction. A display panel 5 displays instructions for carrying out a selected banking operation. A deposit slot 6 and a delivery drawer means 7 are also provided. A receipt for the transaction may be delivered through slot 10. All the electronic and control equipment components for the automatic operation of the station are stated to be within the housing 12.

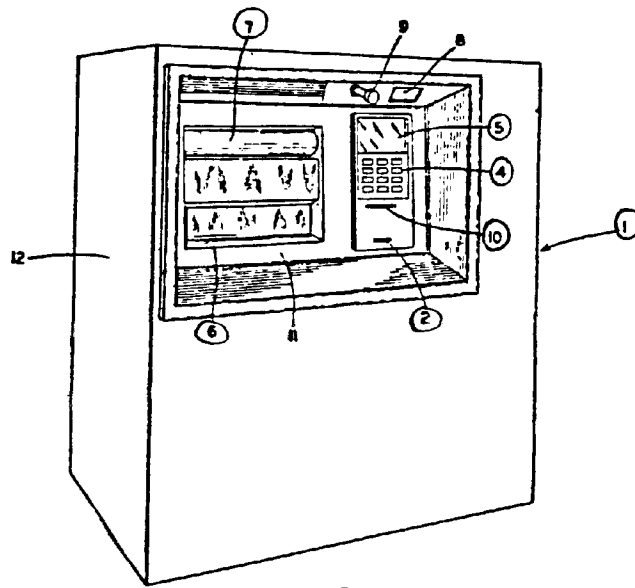


FIG. 1

In the Final Action the Examiner rejected the application for containing insufficient description to describe the inventive step. Further, the Examiner rejected the application under Section 2 of the Patent Act, for not being directed to patentable subject matter. He also rejected the claims for being obvious in view of certain prior art.

In making his rejection under Section 36(1) of the Act the Examiner stated (in part):

...

Inclusion of United States patent numbers in the disclosure does not overcome the objection wherein claims 1 to 9 are rejected under Rule 25 of the Patent Rules as not being fully supported by the disclosure.

Applicants' amendments entered do not make the specification sufficient. There is insufficient description in that the inventive step of the new structure resulting from the combination is not delineated neither in the disclosure nor in the drawings. The pictorial drawing would not be sufficient, even for one skilled in the art.

Applicant's are required to provide evidence that an inventive step was made and provide full disclosure for it as per Section 36(1) of the Patent Act. This has not been done. The specification remains rejected under Section 36(1) of the Patent Act.

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In response Applicant argued (in part) as follows:

In connection with the matter of a "full, clear, concise" disclosure which is a requirement of Section 36(1) of the Canadian Patent Act, said Canadian Statute is substantially the same in its terms and requirements as 35 USC 112 of the United States Patent Statutes.

Such requirements under said U.S. Statute have always been satisfied by referring to prior patents by number. This constitutes a full, clear and concise disclosure, and, thus, avoids lengthy specifications to repeat in detail matters that are known in the prior art, as contained in the patents identified.

Further, materials in these prior art patents provide the basis for the references to known components or elements in broad general terms, such as the terms "cash dispenser and delivery means", and "coded card means", etc.

...

Further, the Honourable Mr. Justice Thorson, President of the Exchequer Court in May, 1947, in *Mineral Separation North American Corporation v. Noranda Mines, Limited*, pointed out that two things must be described in the disclosure of an application: the invention and the use of it as contemplated by the inventor. Applicants have disclosed their invention as being a novel combination of old means and have shown how it can be used as an improvement over the prior art. The Examiner has questioned the sufficiency of the disclosure and in connection therewith applicants point to remarks made in the *Minerals Separation* decision (supra) by Thorson that the test as to whether a specification complies with the requirements of the Statute is whether a person skilled in the art, on reading the specification in the light of common general knowledge existing at its date and being willing to understand it, would be unerringly led to the invention and be enabled to put it into full use. Applicants are certain that one skilled in the automatic banking art would be aware of the prior art means that have been combined to form the present invention and that, having been apprised of it, he would quickly see the advantages offered by the present invention over the automatic banking systems of the prior art.

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In making his rejection under Section 2 of the Patent Act, the Examiner said (in part) as follows:

...

The essential equipment required to fulfil the concept outlined by the applicants' foregoing statement would be: a keyboard, computer and a CRT monitor; all known and old in prior art. Therefore, in the absence of any supporting evidence in the disclosure or drawings to the contrary for this "programmable display means" it must follow then

that anything novel in applicants' alleged invention must be done to the operation of the computer and its attendant program.

Reprogramming a computer is not patentable subject matter under Section 2 of the Patent Act. Applicants' attention is directed to the Commissioner's decision contained in C.P.O.R. dated August 1, 1978 which included the position: "claims to a computer programmed in a novel manner, expressed in any and all modes, where the novelty lies solely in the program or algorithm, are not directed to patentable subject matter under Section 2 of the Patent Act."

...

The Applicant's response to the rejection under Section 2 of the Act is (in part) as follows:

...

Claim 1 does not call for and is not intended to call for any computer programming. That is old and known in the arts of the use of computers in various equipment, systems, etc. as well as in the automatic banking system art.

In applicants' new concept, the customer is the programmer. He programs what happens. He is given an option at each state in the operation of the remote banking unit. He can select the procedure from directions, etc. displayed at the video display unit where all directions, data, etc. are displayed at one place.

The customer is instructed by the directions displayed what to do next based on the messages given him at the single display panel. The display at the same single display panel shows what he has done so that he can check his own accuracy in entering into the equipment, the PIN, or the amount of cash he wishes to withdraw, while at the same time he is addressed at the single display panel by his own name which has been read by the card reader from his card which he has entered into the equipment for actuation of the equipment and verification of the fact that he is an authorized holder and user of the particular card.

...

Fundamentally, the gist of the new concept is to bring displays of information or data to be used by the customer, originating at different locations in the equipment, all to one display panel, rather than individually and separately to a variety or plurality of different, separated display locations.

...

In the Manual of Patent Office Practice, Item 8.02.02 states that invention exists in a new combination of old means. Applicants maintain, for reasons set out above, that present claims 1 to 8 are directed to a novel combination of old means that is useful and patentable.

The issues before the Board are whether or not the disclosure is sufficient under Section 36(1) of the Patent Act, the application is directed to patentable subject matter under Section 2 of the Act, and the claims are obvious in view of prior art. Claim 1 reads:

In automatic multiple-transaction banking equipment of a type in which a remote vault-like unit has manual entry keyboard means, card entry means, card reader means, cash dispenser and delivery means, and customer accessible cash drawer means; in which the unit is activated by the entry of coded card means into the card entry means and card reader means; in which the cash dispenser and delivery means is actuated by such coded card means and is operative to deliver to said cash drawer means a selected amount of cash determined by transaction data keyed in at the keyboard means by an authorized identified customer for removal by such customer whose identity has been verified and the transaction authorized by the entry of coded means into the unit; in which the coded means includes data contained on the coded card means and also customer verifying and transaction data keyed in at the keyboard means; and in which the coded card means has the identity of the customer encoded thereon; the combination of programmable display means including a single display panel, and means for selectively presenting at the single display panel one of a series of successive message instructions for a selected one of a plurality of different banking transactions which at least includes a cash dispensing transaction; the message instructions for any selected banking transaction comprising instructions to the customer for the entry of customer verifying and transaction data at the keyboard means to conduct the selected transaction; the programmable display means also including means for displaying at the single display panel concurrently with the display of banking transaction message instructions, the identity of the customer encoded on the coded card means and read by the card reader means; the programmable display means also including means for displaying at the single display panel at least portions of the transaction data keyed in at the keyboard means, concurrently with the display of at least certain of said banking transaction message instructions; whereby the concurrent display at the single display panel of banking transaction message instructions and certain transaction data permits customer errors to be detected and corrected.

We turn first to the issue of sufficiency of disclosure. It is stated on page 11 of the original disclosure that the video controller and its character generator in the station operate in the manner of prior patents.

The Agent, Mr. Davidson, argued at the Hearing that a person skilled in the art, when told to connect a single display unit capable of displaying information from three sources, would be able to do that from the disclosure as amended. He said that the invention was in the idea of putting the various parts together in order to realize the advantages that would flow

from his combination. To bolster his point of view, the Agent referred to United States patent 3,772,676 to Conley, November '13, 1973, which had been inserted by amendment of page 11, to illustrate that the original reference to prior patents did find support in patent form. In that patent we see that a computer with a memory for storing sets of instructions is connected with other components including a single display unit which receives signals from three sources. The Agent further argued that by referring in the specification to certain specific prior patents there is provided a full, clear and concise disclosure of his invention. Although Applicant's original disclosure is sketchy in its description of how the components could be connected to present an integrated system, we are persuaded by his arguments that the amended disclosure may be sufficient to establish that a person skilled in the art would be able to realize Applicant's invention.

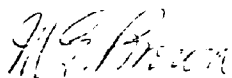
We turn next to the rejection under Section 2 of the Patent Act. The Agent presented arguments at the Hearing supporting the comments in his response that the application is not open to such a rejection. Although not brought out at the Hearing, we make the observation that the issue of patentable subject matter was raised for the first time in the Final Action. Such being the case, we find it would be inappropriate for the Board to make any comments on this rejection because the issue has not received that consideration prescribed by the Patent Rules.

We will consider now the rejection based on prior art. At the Hearing the Agent indicated he was prepared to discuss the patents which were cited in the Office Action prior to the Final Action. His primary argument was that none of the patents shows the use of a single display panel showing a plurality of images in the remote banking transaction field. He discussed the United States Patent to Voss 3,845,277 October 29, 1974, in relation

to its showing of three separate displays on the face of the machine, and he argued that it would not be obvious to a person skilled in the art to proceed from that patent to Applicant's kind of single display panel. We can do no more than accept this argument because on review we find that this patent and the United States patents, 3,833,885 September 3, 1974 and 3,832,790 September 3, 1974, issued less than two years before Applicant's Canadian filing date. These three patents will not be considered further with respect to the requirements of Section 28 of the Patent Act, although United States Patents 3,641,497 February 8, 1972 to Constable and 3,760,158 September 18, 1973 to Whitehead et al, do bear appropriate dates for consideration under that Section. The Constable patent relates to a money dispensing system which reacts to a customer's credit card, and the keyed entry of a personal identification number, but does not disclose a display screen. The Whitehead et al patent relates to dispensing sums of money in mixed denominations, and includes means in coded form to initiate dispensing, and also includes visual display means. In our view however these patents are not sufficient to sustain a rejection on the ground of obviousness of Applicant's combination.

In summary we are satisfied that the disclosure of the application is sufficient in view of the amendments and arguments, and that the cited art is not appropriate to sustain a rejection of the claims on the ground of obviousness. In view of our observation concerning the rejection under Section 2 of the Act we make no finding thereon.

We recommend that the rejection of the disclosure for being insufficient, and the claims for being obvious, be withdrawn, and the application be returned to the Examiner.

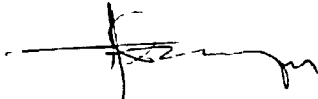


M.G. Brown
Acting Chairman
Patent Appeal Board



S.D. Kot
Member

I concur in the findings and the recommendation of the Patent Appeal Board. Accordingly, I withdraw the Final Action and remand the application to the Examiner.



J.H.A. Gariépy
Commissioner of Patents

Dated at Hull, Quebec

this 25th. day of November, 1983

Agent for Applicant

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