

**Keywords: Interference, Reduction to Practice, Intended Purpose, Commercial Use**

**General: Determining that an invention would work for its intended purpose does not require that the invention be tested under conditions of actual, commercial use.**

*Taskett v. Dentlinger*

68 U.S.P.Q.2d 1473 (Fed. Cir. 2003)

September 26, 2003

**I. Facts**

In 1995, Taskett and Dentlinger filed separate patent applications covering processes for the automated purchase of prepaid telephone services. Taskett filed his application on June 1 while Dentlinger filed his application on June 7. The Board of Patent Appeals and Interferences (the Board) declared an interference between the two applications on July 9, 1997 with Taskett designated as the senior party. The interference involved a single count.

In the interference proceeding, Taskett relied solely on his filing date for priority while Dentlinger alleged an actual reduction to practice prior to his filing date. In particular, Dentlinger alleged an actual reduction to practice on October 11, 1994, at which time he performed a test of his proposed system.

During the test in question, Dentlinger demonstrated obtaining “financial authorization” by accessing a dummy checking account via a switch at his employer. As part of the test, the switch received a purchase request from an ATM terminal and checked the amount of available funds in the dummy checking account to determine their sufficiency. Upon determining the sufficiency of the funds, the switch debited the dummy account by the purchase amount and the ATM terminal printed a receipt showing the debit and a call-in number and PIN for prepaid phone services. As evidence of the test and reduction to practice, Dentlinger offered the testimony of two employees as well as the receipt generated by the ATM terminal. Based on the October 11 test, the Board awarded Dentlinger priority. Taskett appealed the decision of the Board on the grounds that the test failed to perform a process that met all of the limitations of the count and that the test was insufficient to show that the process worked for its intended purpose.

**II. Issues**

- A. Did the Board err by not construing the limitation of “financial authorization” to require authorization from a third party institution?
- B. Did the Board err by not requiring that the test occur under conditions of actual, commercial use?

**III. Discussion**

- A. No. The panel found that the count of the interference, which recited “obtaining financial authorization ... by a central terminal,” did not require the reading proposed by Taskett, i.e., authorization by a central terminal located at a third party institution. The panel did note that the Dentlinger application discussed preferred embodiments in which authorization was obtained from a third party financial institution but concluded that it would be impermissible

to import these limitations into the count. The panel, therefore, held that “financial authorization” was not limited to authorization received from a third party financial institution. Furthermore, the panel concluded that the count did not require “actual” authorization based on real funds in an actual checking account.

- B. No. The panel noted that courts have found that testing may be sufficient to demonstrate that an invention is suitable for its intended use. In particular, the panel notes that the law does not require that an inventor create a viable commercial embodiment to demonstrate reduction to practice. With regard to the particular issues of the case, the aspect of obtaining financial authorization was deemed to be well-known and well-tested by the panel and was, presumably, not a new feature which would require more extensive testing or demonstrations. Similarly, the panel discerned that there was substantial evidence that the printed receipt generated by the October 11 test would be usable to make phone calls.