



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/896,511	10/01/2010	JOSEF EHBAUER	13913-0454001/2010P002151	9894
32864	7590	02/28/2018	EXAMINER	
FISH & RICHARDSON, P.C. (SAP) PO BOX 1022 MINNEAPOLIS, MN 55440-1022			AGWUMEZIE, CHINEDU CHARLES	
			ART UNIT	PAPER NUMBER
			3685	
			NOTIFICATION DATE	DELIVERY MODE
			02/28/2018	ELECTRONIC

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.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JOSEF EHBAUER, RALF RUBEL, STEFAN TROEGER,
YANGNING PENG, GERO SCHULZ, CHRISTOPH GERSTLE,
CHRISTIAN KLUMPP, MARINA LAUMENIS, ANGELA KUBITZEK,
ALISSA RYZHOVA, MARCUS BOUWHUIS, MARTIN DAUER, and
GOKULA SUNDAR PONNUSAMY

Appeal 2016-001705
Application 12/896,511¹
Technology Center 3600

Before, JOSEPH A. FISCHETTI, KENNETH G. SCHOPFER, and
AMEE A. SHAH, *Administrative Patent Judges*.

FISCHETTI, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134(a) of the
Examiner's final rejection of claims 1–20. We have jurisdiction under
35 U.S.C. § 6(b).

¹ Appellants identify SAP SE as the real party in interest. Br. 4.

SUMMARY OF DECISION

We REVERSE (37 C.F.R. § 41.50(b)).

THE INVENTION

Appellants’ claims are directed to a method/system “for processing an online transaction involving a payment service provider” (Abstr. 2).

Claim 1 reproduced below, is representative of the subject matter on appeal.

1. A computer-implemented method for processing an online transaction involving a payment service provider, the method comprising:

receiving, in a backend system and from a frontend system, an initiate payment call triggered by a user application for a transaction involving a payment service provider external to a merchant system comprising the frontend and backend systems, wherein the frontend system is configured to be accessible to a user using the user application and the backend system is configured to perform transaction logistics and to control storage of financial records;

forwarding a set checkout instruction from the backend system to the payment service provider with first information about the transaction, the set checkout instruction causing the payment service provider to open a session regarding the transaction before the user application is redirected from the frontend system to the payment service provider;

redirecting the user application from the frontend system to the payment service provider;

receiving a finalize payment instruction in the backend system from the frontend system after redirecting the user application from the frontend system; and

forwarding, in response to the finalize payment instruction, a perform checkout instruction from the backend

Appeal 2016–001705
Application 12/896,511

system to the payment service provider with second information about the transaction, wherein forwarding the perform checkout instruction is performed after the payment service provider has confirmed payment and redirected the user application from the payment service provider to the frontend system, and wherein the payment service provider posts payment and payment confirmation in response to the perform checkout instruction.

THE REJECTION

The Examiner relies upon the following as evidence of unpatentability:

Rieck et al. (hereinafter “Rieck”)	US 2008/0103923 A1	May 1, 2008
Puura et al. (hereinafter “Puura”)	US 2011/0106709 A1	May 5, 2011
Stocker	US 2012/0197756 A1	Aug. 2, 2012

The following rejection is before us for review.

Claims 1–20 are rejected under 35 U.S.C. § 103.

ANALYSIS

35 U.S.C. § 103 REJECTION

Each of independent claims 1, 9 and 15, recites in pertinent part,

receiving, in a backend system and from a frontend system, an initiate payment call triggered by a user application for a transaction involving a payment service provider external to a merchant system comprising the frontend and backend systems, wherein the frontend system is

Appeal 2016–001705
Application 12/896,511

configured to be accessible to a user using the user application and the backend system is configured to perform transaction logistics and to control storage of financial records; . .

..

Claim 1 App'x. 18.

Concerning this limitation, the Examiner however found,

(see figs. 3 and 4; 0038, which discloses that "A customer 100 initiates a purchase over a communication network 102 through by a hosting website 108); ...*(emphasis original) (Answer 3–4); [and] [s]econdly[,] the limitation 'wherein the frontend system is configured to be accessible to a user using the user application and the backend system is configured to perform transaction logistics and to control storage of financial records' is an intended use limitation or at best a non-functional descriptive material which further explains the functions of the claimed front end system and the back end system but does not further limit the claimed invention.*

(Answer 11).

Appellants argue,

at least the cited portions of Rieck fail to disclose or render obvious receiving, in a backend system and

from a frontend system, an initiate payment call triggered by a user application for a transaction involving a payment service provider external to a merchant system comprising the frontend and backend systems (emphasis original). Instead, and as discussed above, Rieck discusses providing an arbitration forum to a payment service provider with a centralized gateway (Rieck, ¶ [0002]), where CPG is a Java application 122 deployed separately from a company's e-commerce platforms 146 (Rieck, ¶ [0039] and FIG. 2, emphasis added). That is, the centralized payment gateway (CPG) of Rieck is deployed separately from a company's ecommerce platforms 146, which is different than a merchant system comprising the frontend and back end systems, as provided in claims 1, 9 and 15.

(Appeal Br. 14–15).

We disagree with the Examiner's claim construction here, and hence with the Examiner's rejection being proper. A key part of the limitation at issue is, “wherein the frontend system is *configured to* be accessible to a user using the user application and the backend system is *configured to* perform transaction logistics and to control storage of financial records . . .” (emphasis added). We construe the use of the phrase “*is configured to*” to require a specially programmed computer to effect the required functions,

Appeal 2016–001705
Application 12/896,511

and, as such, each instance constitutes a positive limitation. *See WMS Gaming Inc. v. Int’l Game Tech.*, 184 F.3d 1339, 1349 (Fed. Cir. 1999), (citing *In re Alappat*, 33 F.3d 1526, 1545 (Fed. Cir. 1994) (en banc)).

Therefore, we disagree with the Examiner that the use of the phrase “‘configured to’ is an intended use or a functional language that does not structurally distinguish the claimed invention from the prior art.” (Final Act. 6, *see also* Answer 11).

The Examiner finds that Rieck discloses the claimed frontend system, backend system, and payment service, respectively, in shopping site 104, hosting site 108, and centralized payment gateway 112 disclosed by Rieck. (Answer 3–4, *citing* Rieck ¶ 38). However, because the Examiner does not give weight to the “configured to” clauses attached to each of the claimed front and backend systems referenced above, they are left unmapped in the rejection.

Accordingly, we cannot sustain the rejection of independent claims 1, 9, and 15. Since claims 2–8, 10–14, and 16–20 depend from one of claims 1, 9, and 15, and since we cannot sustain the rejection of claims 1, 9, and 15, the rejection of claims 2–8, 10–14, and 16–20 likewise cannot be sustained.

35 U.S.C. § 101 REJECTION

Pursuant to our authority under 37 CFR § 41.50(b), we enter a new grounds of rejection of claims 1–20 under 35 U.S.C. § 101.

The Supreme Court

set forth a framework for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts. First, . . . determine whether the claims at issue are directed to one of those patent-ineligible concepts. If so, we then ask, “[w]hat else is there in the claims before us?” To answer that question, . . . consider the elements of each claim both individually and “as an ordered combination” to determine whether the additional elements “transform the nature of the claim” into a patent-eligible application. [The Court] described step two of this analysis as a search for an “inventive concept”—*i.e.*, an element or combination of elements that is “sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself.”

Alice Corp., Pty. Ltd. v. CLS Bank Int’l, 134 S. Ct. 2347, 2355 (2014) (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 72–73 (2012)).

To perform this test, we must first determine whether the claims at issue are directed to a patent-ineligible concept.

The preamble states it is a method for processing an online transaction involving a payment service provider. The steps in claim 1, which are representative of the scope of all the independent claims before us, result in:

Appeal 2016–001705
Application 12/896,511

forwarding, in response to the finalize payment instruction, a perform checkout instruction from the backend system to the payment service provider with second information about the transaction, wherein forwarding the perform checkout instruction is performed after the payment service provider has confirmed payment and redirected the user application from the payment service provider to the frontend system, and wherein the payment service provider posts payment and payment confirmation in response to the perform checkout instruction.

Claim 1 App'x 18.

The Specification further states,

Payment service providers act in online environments as facilitators of financial transactions between a payer and a payee, for example when one or more customers purchase goods or services from a vendor. Payment service providers use different models for integration with the vendor system. Some customers have accounts with a payment service provider where they maintain their payment preferences such as credit or debit cards, bank accounts, etc.

Specification 1:2–7. Thus, all this evidence shows that claim 1 is directed to insuring payment confirmation is made against any of various forms payment preferences before directing the order-taking portion of a merchant system to perform checkout. It follows from prior Supreme Court cases, and *Gottschalk v. Benson*, 409 U.S. 63 (1972) in particular, that the claims at issue here are directed to an abstract idea. Insuring payment confirmation is

Appeal 2016–001705
Application 12/896,511

made against any of various forms payment preferences before directing the order–taking portion of a merchant system to perform checkout is a fundamental economic practice of a transaction because payment for goods/services is the engine of commerce. The patent-ineligible end of the 35 U.S.C. § 101 spectrum includes fundamental economic practices. *See Alice Corp. Pty. Ltd.*, 134 S. Ct. at 2355–1257. Thus, insuring payment confirmation is made against any of various forms payment preferences before directing the order–taking portion of a merchant system to perform checkout is an “abstract idea” beyond the scope of § 101.

As in *Alice Corp. Pty. Ltd.*, we need not labor to delimit the precise contours of the “abstract ideas” category in this case. It is enough to recognize that there is no meaningful distinction in the level of abstraction between the concept of an intermediated settlement in *Alice* and the concept of insuring payment confirmation is made against any of various forms payment preferences before directing the order–taking portion of a merchant system to perform checkout, at issue here. Both are squarely within the realm of “abstract ideas” as the Court has used that term. That the claims do not preempt all forms of the abstraction or may be limited to monetary exchanges at checkout, does not make them any less abstract. *See OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1360–61 (Fed. Cir. 2015).

The introduction of a computer into the claims does not alter the analysis at *Mayo* step two.

the mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention.

Stating an abstract idea “while adding the words ‘apply it’” is not enough for patent eligibility. Nor is limiting the use of an abstract idea “to a particular technological environment.” Stating an abstract idea while adding the words “apply it with a computer” simply combines those two steps, with the same deficient result. Thus, if a patent’s recitation of a computer amounts to a mere instruction to “implement[t]” an abstract idea “on ... a computer,” that addition cannot impart patent eligibility. This conclusion accords with the preemption concern that undergirds our § 101 jurisprudence. Given the ubiquity of computers, wholly generic computer implementation is not generally the sort of “additional feature[e]” that provides any “practical assurance that the process is more than a drafting effort designed to monopolize the [abstract idea] itself.”

Alice Corp. Pty. Ltd., 134 S. Ct. at 2358 (alterations in original) (citations omitted).

“[T]he relevant question is whether the claims here do more than simply instruct the practitioner to implement the abstract idea . . . on a generic computer.” *Alice Corp. Pty. Ltd.*, 134 S. Ct. at 2359. “They do not.” *Id.*

Taking the claim elements separately, the function performed by the computer at each step of the process is purely conventional. Using a computer to take in data, compute a result, and return the result to a user amounts to electronic data query and retrieval—some of the most basic functions of a computer. All of these computer functions are well-understood, routine, conventional activities previously known to the

Appeal 2016–001705
Application 12/896,511

industry. In short, each step does no more than require a generic computer to perform generic computer functions.

Considered as an ordered combination, the computer components of Appellants’ method add nothing that is not already present when the steps are considered separately. Viewed as a whole, Appellants’ claims simply recite the concept of insuring payment confirmation is made against any of various forms payment preferences before directing the order-taking portion of a merchant system to perform checkout. The claims do not, for example, purport to improve the functioning of the computer itself. Nor do they effect an improvement in any other technology or technical field. Instead, the claims at issue amount to nothing significantly more than instructions to insuring payment confirmation is made against any of various forms payment preferences before directing the order-taking portion of a merchant system to perform checkout. Under our precedents, that is not enough to transform an abstract idea into a patent-eligible invention. *See Alice Corp. Pty. Ltd.*, 134 S. Ct. at 2360.

As to the structural claims, they are no different from the method claims in substance. The method claims recite the abstract idea implemented on a generic computer; the system claims recite a handful of generic computer components configured to implement the same idea. This Court has long “warn[ed] ... against” interpreting § 101 “in ways that make patent eligibility ‘depend simply on the draftsman’s art.’”

Alice Corp. Pty. Ltd., 134 S. Ct. at 2360 (alterations in original).

Appeal 2016–001705
Application 12/896,511

Also, as to the dependent claims, nothing in these claims make an otherwise ineligible claim patent-eligible. That is, steps such as updating price data (claim 2), using a URL to communicate data between front and backend systems (claims 3, 4), and messaging to indicate status of order (claims 5–8) are all recitations of generic computer limitations which do not make an otherwise ineligible claim patent-eligible. *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1256 (Fed. Cir. 2014).

CONCLUSIONS OF LAW

We conclude the Examiner did err in rejecting claims 1–20 under 35 U.S.C. § 103.

DECISION

The decision of the Examiner to reject claims 1–20 is reversed.

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 C.F.R. § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 CFR § 41.50(b) also provides that the appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

- (1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the

Appeal 2016–001705
Application 12/896,511

examiner, in which event the proceeding will be remanded to the examiner

- (2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

REVERSED (37 C.F.R. § 41.50(b))