



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.
13/102,086	05/06/2011	J. Mark Miller	007131.01023	6345
71733	7590	09/01/2017	EXAMINER	
BANNER & WITCOFF, LTD 10 SOUTH WACKER DR. SUITE 3000 CHICAGO, IL 60606			PRESTON, JOHN O	
			ART UNIT	PAPER NUMBER
			3691	
			NOTIFICATION DATE	DELIVERY MODE
			09/01/2017	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):

PTO-71733@bannerwitcoff.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte J. MARK MILLER, PETER CHARLES MOIR, FRANK LEROY GAUDIOS, GARY LYNN HARTLEY, DAWN RENEE JAMES, STEPHEN CHARLES MCAULIFFE, and CHERYL LYNNE LOWREY

Appeal 2016-002143
Application 13/102,086¹
Technology Center 3600

Before JOSEPH A. FISCHETTI, ANTON W. FETTING, and MATTHEW S. MEYERS, *Administrative Patent Judges*.

FISCHETTI, *Administrative Patent Judge*.

DECISION ON APPEAL
STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134 from the Examiner's final rejection of claims 1–5, 8–12, 15–19, and 22–27. We have jurisdiction under 35 U.S.C. § 6(b).

SUMMARY OF DECISION

We AFFIRM.

¹ Appellants identify Bank of America Corp. as the real party in interest. App. Br. 2.

THE INVENTION

Appellants' claims are directed to a system and method for providing uninterrupted transaction processing and/or backup data centers for processing transactions. Specification ¶ 4.

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

1. A system, comprising:
 - a primary data center for processing financial transactions associated with a financial institution;
 - a secondary data center for processing financial transactions associated with the financial institution;
 - a communication interface;
 - at least one processor; and
 - a memory storing instructions that when executed by the at least one processor cause the system to:
 - receive, via the communication interface and from a computing device, a request to withdraw funds from an account of the financial institution;
 - identify the primary data center as designated to process the request to withdraw the funds from the account of the financial institution;
 - responsive to a determination, by the at least one processor, that the primary data center is not available to process the request to withdraw the funds from the account of the financial institution:
 - identify, by the at least one processor, the secondary data center as designated as a backup to process the request to withdraw the funds from the account of the financial institution;
 - process, by the secondary data center, the request to withdraw the funds from the account of the financial institution; and

transmit, from the secondary data center and to the primary data center, data associated with processing the request to withdraw the funds from the account of the financial institution; and

subsequent to transmitting the data associated with processing the request to withdraw the funds from the account of the financial institution:

receive, via the communication interface and from the primary data center, a first sample of data, the first sample of data comprising a user-defined percentage of data that has been updated within a user-defined date range, and the first sample of data comprising the data associated with processing the request to withdraw the funds from the account of the financial institution;

receive, via the communication interface and from the secondary data center, a second sample of data, the second sample of data comprising the user-defined percentage of data that has been updated within the user-defined date range, and the second sample of data comprising the data associated with processing the request to withdraw the funds from the account of the financial institution; and

compare the first sample of data to the second sample of data to verify that the first sample of data matches the second sample of data with respect to the data associated with processing the request to withdraw the funds from the account of the financial institution.

THE REJECTION

The Examiner relies upon the following as evidence of unpatentability:

Filgate	US 6,178,521 B1	Jan. 23, 2001
Singh et al.	US 7,774,402 B2	Aug. 10, 2010

The following rejections are before us for review:

Claims 1–5, 8–12, 15–19, and 22–27 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. Final Act. 3.

Claims 1–5, 8–12, and 15–19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Filgate and in view of Singh. Final Act. 4.

ANALYSIS

35 U.S.C. § 101 REJECTION

Claim 1 is representative of the independent claims before us on appeal, which contain similar limitations, and is a method claim with the pertinent part steps, *viz.*,

receive . . . a request to withdraw funds from an account of the financial institution; identify the primary data center as designated to process the request to withdraw the funds from the account of the financial institution;

responsive to a determination . . . that the primary data center is not available to process the request to withdraw the funds from the account of the financial institution:

identify . . . the secondary data center as designated as a backup to process the request to withdraw the funds from the account of the financial institution;

process . . . the request to withdraw the funds from the account of the financial institution; and

transmit, from the secondary data center and to the primary data center, data associated with processing the request to withdraw the funds from the account of the financial institution; and

subsequent to transmitting the data associated with processing the request to withdraw the funds from the account of the financial institution:

receive . . . from the primary data center, a first sample of data, the first sample of data comprising a user-defined percentage of data that has been updated within a user-defined date range, and the first sample of data comprising the data associated with processing the request to withdraw the funds from the account of the financial institution;

receive . . . from the secondary data center, a second sample of data, the second sample of data comprising the user-defined percentage of data that has been updated within the user defined date range, and the second sample of data comprising the data associated with processing the request to withdraw the funds from the account of the financial institution; and

compare the first sample of data to the second sample of data to verify that the first sample of data matches the second sample of data with respect to the data associated with processing the request to withdraw the funds from the account of the financial institution.

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.*, 132 S. Ct. 1289 (2012)).

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

Although the Court in *Alice* made a direct finding as to what the claims were directed to, we find that this case’s claims themselves and the Specification provide enough information to inform one as to what they are directed to.

The steps in claim 1 result in comparing a first sample of data to a second sample of data to verify that the first sample of data matches the second sample of data with respect to data associated with processing the request to withdraw the funds from the account of the financial institution. The Specification at paragraph 2 recites: “[a]vailability of services to customers, particularly to customers of a financial institution, is a top priority. Customers expect to initiate a transaction, such as at an automated teller machine (ATM), online banking system, etc. and have the transaction completed.” At paragraph 4 the Specification states: “[a]ccordingly, a system and method for providing uninterrupted transaction processing and/or backup data centers for processing transactions would be

advantageous.” The Specification at ¶ 32 further states: “[t]hat is, the customer may request the transaction and the transaction will be processed in a similar amount of time, with similar confirmation, etc. regardless of whether the primary or secondary data center is processing the transaction.” Thus, all this evidence shows that claim 1 is directed to providing uninterrupted transaction processing and/or backup data centers for processing transactions.

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. Like the algorithm in *Gottschalk*, providing uninterrupted transaction processing and/or backup data centers for processing transactions by comparing a first sample of data to a second sample of data to verify that the first sample of data matches the second sample of data associated with processing a request to withdraw funds from an account of a financial institution is a mathematical algorithm in that the process utilizes first and second data samples for comparison to insure data integrity, and that preempts all implementations and uses. We treat “analyzing information by steps people go through in their minds, or by mathematical algorithms, without more, as essentially mental processes within the abstract-idea category.” *Electric Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1354 (Fed. Cir. 2016). Also, the claims are directed to requesting withdrawal of funds from the account of a financial institution, a fundamental economic practice. Thus, providing uninterrupted transaction processing and/or backup data centers for processing transactions is an “abstract idea” beyond the scope of § 101. *See Alice Corp. Pty. Ltd.*, 134 S. Ct. at 2355–57.

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 performing a mathematical algorithm in *Gottschalk* and the concept of providing uninterrupted transaction processing and/or backup data centers for processing transactions by comparing data samples, at issue here. Both are squarely within the realm of “abstract ideas” as the Court has used that term. *See Alice Corp. Pty. Ltd.*, 134 S. Ct. at 2357. That the claims do not preempt all forms of the abstraction or may be limited to the abstract idea to financial transactions settings, does not make them any less abstract. *See OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1362–63 (Fed. Cir. 2015).

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

[T]he 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.

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 and compute a result from a database amounts to electronic data query and retrieval—one of the most basic functions of a computer. All of these computer functions are well-understood, routine, conventional activities previously known to the 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 providing uninterrupted transaction processing and/or backup data centers for processing transactions by comparing a first sample of data to a second sample of data to verify that the first sample of data matches the second sample of data associated with the request to withdraw funds from the account of a financial institution, performed by a generic computer. The method 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 an instructions to provide uninterrupted transaction processing and/or backup data centers for processing transactions

by comparing a first sample of data to a second sample of data to verify that the first sample of data matches the second sample of data associated with the request to withdraw funds from the account of a financial institution, on a generic computer. 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).

35 U.S.C. § 103 REJECTION

The Appellants argued independent claims 1, 8, and 15 as a group. (Appeal Br. 12). We select claim 1 as the representative claim for this group, and the remaining independent claims standing or falling with claim 1. *See* 37 C.F.R. § 41.37(c)(1)(iv) (2015).

The only substantive argument advanced by Appellants is made in the Reply Brief of page 3 which states:

With respect to the allegation that the recited ‘user-defined percentage of data that has been updated within a user-defined date range’ constitutes ‘nonfunctional description material’ that should not be ‘given patentable weight,’ Examiner’s Answer, pp. 15-16, Appellants submit that even if the recited “first sample of data comprising a user-defined percentage of data that has been updated within a user-defined date range,” were

considered to be nonfunctional, the claims recite ‘receiv[ing], via the communication interface and from the secondary data center, a second sample of data, the second sample of data comprising the user-defined percentage of data that has been updated within the user-defined date range,’ which clearly is functional and should be accorded patentable weight.

(Reply Br. 3–4 (emphasis omitted).)

The Examiner found, “Singh teaches dynamically updating data in a database where the new data must be differentiated from the existing data (Singh: col 11, line 40 - col 12, line 16). This process implies determining whether the two data sets match.” (Answer 15.)

We disagree with Appellants that the Examiner’s findings constitute error in the rejection because we need not make a determination based on non-functional descriptive material here, because it would be cumulative to the obviousness finding. That is because the Examiner found (Answer 5) that Singh discloses differentiated data at column. 11, line 40–column 12, line 16, and that this implies determining whether the two data sets match. *See KSR Int’l. Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) (In making the obviousness determination one “can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.”).

Appellants’ remaining arguments, in their Appeal Brief, are not persuasive because Appellants do not rebut the prima facie case by distinctly and specifically pointing out supposed error in the Examiner’s action, as well as the specific distinctions believed to render a claim patentable over the cited art. *See* 37 C.F.R. § 41.37(c)(iv) (2015); *see also In re Lovin*, 652 F.3d 1349, 1357 (Fed. Cir. 2011) (“[W]e hold that the Board reasonably interpreted Rule 41.37 to require more substantive arguments in an appeal brief than a mere recitation of the claim elements and a naked assertion that

the corresponding elements were not found in the prior art.”). Appellants have failed to carry this burden.

The Federal Circuit has held that the USPTO carries its procedural burden of establishing a prima facie case when its rejection satisfies the requirements of 35 U.S.C. § 132 by notifying the applicant of the reasons for rejection, “. . . together with such information and references as may be useful in judging of the propriety of continuing the prosecution of [the] application.” *See In re Jung*, 637 F.3d 1356, 1362 (Fed. Cir. 2011). Thus, “all that is required of the office to meet its prima facie burden of production is to set forth the statutory basis of the rejection and the reference or references relied upon in a sufficiently articulate and informative manner as to meet the notice requirement of § 132.” *Jung*, 637 F.3d at 1363.

Here, the Examiner notified Appellants that independent claim 1 is rejected under 35 U.S.C. § 103 as being unpatentable over Filgate in view of Singh (Final Act. 4), and the Examiner cited specific portions of Singh, by paragraph number, that are the basis for one part of the rejection (*see* Final Act. 4–5; *see also* Answer 3–4), and cited specific portions of Filgate for the other part of the rejection to complete the obvious combination (*see* Final Act. 5–6; *see also* Answer 4–5). The cited portions of the references together with the accompanying explanations (*see* Answer 5) constitute the objectively verifiable evidence of the obvious combination, which Appellants allege is lacking. We find that the Examiner has made a prima facie case of unpatentability for each rejected claim.

Rather than explaining how the cited portions of Filgate and Singh do not disclose the limitations of claim 1 for example, Appellants merely quote the language of claim 1 without contrasting the cited portions of Filgate and

Singh do not disclose the listed claim language. In view of the foregoing, which is representative of the Appellants' arguments throughout their Appeal Brief, we find that the Examiner established a prima facie case of obviousness. Appellants do not rebut the prima facie case by distinctly and specifically pointing out supposed error in the Examiner's action, as well as the specific distinctions believed to render a claim patentable over the cited art. *See* 37 C.F.R. § 41.37(c)(iv) (2015); *see also Lovin*, 652 F.3d at 1357 (“[W]e hold that the Board reasonably interpreted Rule 41.37 to require more substantive arguments in an appeal brief than a mere recitation of the claim elements and a naked assertion that the corresponding elements were not found in the prior art.”). Appellants have failed to carry this burden.

CONCLUSIONS OF LAW

We conclude the Examiner did not err in rejecting claims 1–5, 8–12, 15–19, and 22–27 under 35 U.S.C. § 101.

We conclude the Examiner did not err in rejecting claims 1–5, 8–12, and 15–19 under 35 U.S.C. § 103.

DECISION

The decision of the Examiner to reject claims 1–5, 8–12, 15–19, and 22–27 is affirmed.

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).

AFFIRMED