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Table with 5 columns: APPLICATION NO., FILING DATE, FIRST NAMED INVENTOR, ATTORNEY DOCKET NO., CONFIRMATION NO. Includes details for application 12/377,749 filed 02/17/2009 by Torbernt Hjelmvik, attorney 1515-1092, confirmation 9215. Also includes examiner BORISSOV, IGOR N, art unit 3649, and notification date 03/26/2018 via ELECTRONIC mode.

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* TORBERNT HJELMVIK

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Appeal 2016-004136  
Application 12/377,749  
Technology Center 3600

Before MURRIEL E. CRAWFORD, CYNTHIA L. MURPHY and  
ROBERT J. SILVERMAN, *Administrative Patent Judges*.

CRAWFORD, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant(s) seek our review under 35 U.S.C. § 134 of the Examiner's final decision rejecting claims 1, 2, 16–24, 26, and 27. We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

BACKGROUND

Appellant's invention is directed "to a method for the purchase, payment and validation of a journey by means of transportation means wherein the traveler books the trip or trips via a mobile phone." Spec. 2.

Claim 1 is illustrative:

1. A method of purchasing a ticket for a journey on a transportation means, paying for the journey and validating the journey on said transportation means, comprising:

booking for the traveler a journey L on first transportation means (6) via a two way communication device by first storing an account K that can be billed in a database (2) of a superordinate data system (1), wherein the two way communication device has an identification number R that is stored in said database (2) coupled to the account K, wherein the journey L is stored in said database (2) coupled to the stored identification number R, and wherein a transceiver device (13) provided in or in the close proximity of the first transportation means (6) communicates with the database (2) of the superordinate system (1);

second, purchasing for the traveler the journey L via the traveler's two way communication device by virtue of the traveler connecting the traveler's two way communication device to the data system (1) in which the journey L is stored in said database (2) coupled to the stored identification number R;

third, a validation unit (5) that includes a mechanical reader provided in or in the close proximity of the first transportation means (6) reading the identification number R from the two way communication device;

fourth, ascertaining in a database (8) provided in or in the close proximity of the first transportation means (6) that the journey L tied to the identification number R has been purchased, wherein information has been transferred from the database (2) of the superordinate data system (1) to the database (8); and

fifth, a signaling device (12) provided in or in the close vicinity of the first transportation means (6) indicating whether the journey L has been bought;

wherein the second, third, fourth and fifth steps are repeated for additional journeys,

wherein upon said transceiver device (13) not being successively coupled to the database (2) of the superordinate data system (1) in order to receive information relating to purchased journeys L tied to different identification numbers R, the identification number R together with an identification of the journey L is cause to be stored in said database (8) provided in or in the close proximity of the first transportation means (6) for later control against the database (2) of the superordinate data system (1), and

wherein (a) the two way communication device is a mobile telephone (3) and a telephone number of the mobile telephone is the identification number R, and the telephone number is transferred to said validating device (5), or (b) the two way communication device includes a transponder (4) that provides the identification number R when read.

The Examiner relies on the following prior art reference as evidence of unpatentability:

Schultz et al.	US 5,679,943	Oct. 21, 1997
Puliese III	US 6,044,353	Mar. 28, 2000
Ochiai	US 2002/0188557 A1	Dec. 12, 2002
Linde	WO 02/29738 A2	April 11, 2002

Appellant appeal the following rejections:

Claims 1, 2, 16–24, 26, and 27 under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1, 2, 16–24, 26, and 27 under 35 U.S.C. § 103(a) as unpatentable over Linde, Pugliese III, Schultz and further in view of Ochiai.

Claim 20 under 35 U.S.C. § 103(a) as unpatentable over Linde, Pugliese III, Schultz, Ochiai, and further in view of Official Notice.

## PRINCIPLES OF LAW

An invention is patent-eligible if it claims a “new and useful process, machine, manufacture, or composition of matter.” 35 U.S.C. § 101. The Supreme Court, however, has long interpreted § 101 to include implicit exceptions: “[l]aws of nature, natural phenomena, and abstract ideas” are not patentable. *E.g.*, *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2354 (2014).

In determining whether a claim falls within the excluded category of abstract ideas, we are guided in our analysis by the Supreme Court’s two-step framework, described in *Mayo* and *Alice*. *Id.* at 2355 (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1296–97 (2012)). In accordance with that framework, we first determine whether the claim is “directed to” a patent-ineligible abstract idea. *See Alice*, 134 S. Ct. at 2356 (“On their face, the claims before us are drawn to the concept of intermediated settlement, *i.e.*, the use of a third party to mitigate settlement risk.”); *Bilski v. Kappos*, 561 U.S. 593, 611 (2010) (“Claims 1 and 4 in petitioners’ application explain the basic concept of hedging, or protecting against risk.”); *Diamond v. Diehr*, 450 U.S. 175, 184 (1981) (“Analyzing respondents’ claims according to the above statements from our cases, we think that a physical and chemical process for molding precision synthetic rubber products falls within the § 101 categories of possibly patentable subject matter.”); *Parker v. Flook*, 437 U.S. 584, 594–595 (1978) (“Respondent’s application simply provides a new and presumably better method for calculating alarm limit values.”); *Gottschalk v. Benson*, 409 U.S. 63, 64 (1972) (“They claimed a method for converting binary-coded decimal (BCD) numerals into pure binary numerals.”).

The patent-ineligible end of the spectrum includes fundamental economic practices, *Alice*, 134 S. Ct. at 2357; *Bilski*, 561 U.S. at 611; mathematical formulas, *Parker*, 437 U.S. at 594–95; and basic tools of scientific and technological work, *Gottschalk*, 409 U.S. at 69. On the patent-eligible side of the spectrum are physical and chemical processes, such as curing rubber, *Diamond*, 450 U.S. at 184 n.7, “tanning, dyeing, making waterproof cloth, vulcanizing India rubber, smelting ores,” and a process for manufacturing flour, *Gottschalk*, 409 U.S. at 69.

If the claim is “directed to” a patent-ineligible abstract idea, we then consider the elements of the claim—both individually and as an ordered combination—to assess whether the additional elements transform the nature of the claim into a patent-eligible application of the abstract idea. *Alice*, 134 S. Ct. at 2355. This is a search for an “inventive concept”—an element or combination of elements sufficient to ensure that the claim amounts to “significantly more” than the abstract idea itself. *Id.*

In addition, the Federal Circuit has held that if a method can be performed by human thought alone, or by a human using pen and paper, it is merely an abstract idea and is not patent-eligible under § 101. *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1373 (Fed. Cir. 2011) (“[A] method that can be performed by human thought alone is merely an abstract idea and is not patent-eligible under § 101”).

## ANALYSIS

### Rejection under 35 U.S.C. §101

The Examiner holds that the claims were directed to the concept of purchasing a ticket for a journey and validating the purchase and is similar to

the concepts involving human activity relating to commercial practices such as hedging that have been found by the courts to be abstract ideas. Final Act. 2. The Examiner also holds that the claimed method simply describes the concept of gathering, combining and outputting data by reciting steps of storing and ascertaining or combining data. The gathering and combining merely employs mathematical relationships to manipulate existing information to generate additional information in the form of modified stored data outputting information confirming the purchase. Ans. 4-5.

The Examiner also holds that the steps of the claim further describe the abstract idea but do not make it less abstract. The Examiner finds that the additional limitations including the hardware limitations do not offer a meaningful limitation beyond the general linking the use of the method to a particular technological environment because the hardware is known and operates in a conventional manner. Final Act. 4. The Examiner also finds that when considered separately and as an ordered combination, the claim elements do not provide an improvement to another technology or technical field nor do they provide an improvement to the functioning of the computer itself. Ans. 6.

Appellant argues that claim 1 includes elements beyond the abstract idea such as a two-way communication device, a transceiver device, a validation unit, databases, a mechanical reader, and a signaling device and that these specific pieces of hardware are tied together as claimed to define a method for purchasing a ticket for a journey and do more than mere manipulation of data. The Examiner in considering these elements of claim 1, determines that even though they are not directed to an abstract idea, they are not significantly more than the abstract idea because they are

known elements that operate in a conventional manner. In this regard, the Examiner considered these hardware elements in the second part of the *Alice* analysis. Appellant does not contest the finding that the hardware elements recited in claim 1 are known elements and operate in a conventional manner. As such, we are not persuaded of error on the part of the Examiner by this argument.

In view of the foregoing, we will sustain the Examiner's rejection of claim 1 and claim 2 dependent therefrom.

We will sustain the remaining claims for the same reason.

Rejection under 35 U.S.C. §103(a)

The Appellants argue that the prior art does not disclose storing data in a database near where it is to be used *when the data cannot be stored where it is normally stored*. App. Br. 14. We agree.

The Examiner relies on Schulz for teaching a device configured to store data and transmit said stored data at any time to a remote device, thereby suggesting the recited functionality. Final. Act. 8. The rejection does not address the recitation in the claims that the storage positively takes place *“upon said transceiver device not being successively coupled to the data base of the subordinate data system.”* Therefore, the Examiner has not established that Schulz discloses or suggests this subject matter.

In view of the foregoing, we will not sustain this rejection as it is directed to claims 1 and 2.

Independent claims 16 and 21 do not recite that storage takes place upon said transceiver device not being successively couple to the database of



the subordinate data system. As such, Appellant arguments regarding this limitation is not applicable to claims 16 and 21.

Appellant argues that the identification card disclosed in Pugliese is not a hand held communication device, and that Ochiai does not disclose using parameters K, L and R to verify an already bought journey. These arguments are not persuasive because they are directed to the teachings of the individual references and the rejection is based on the teachings of a combination of references. Nonobviousness cannot be established by attacking the references individually when the rejection is predicated upon a combination of prior art disclosures. *See In re Merck & Co. Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). In this regard, Linde is relied on for teaching a hand held communication device and Pugliese is relied on for teaching verification of an already bought journey. Final. Act. 5-7.

We are not persuaded of error on the part of the Examiner by the argument that Pugliese does not disclose a card reader because we find that this subject matter is clearly taught at column 6, line 46 of this reference.

In view of the foregoing, we will sustain this rejection as it is directed to claims 16–24, 26, and 27.

#### DECISION

We affirm the Examiner's § 101 rejection.

We do not affirm the Examiner's § 103 rejections of claims 1 and 2.

We affirm the Examiner's §103 rejection of claims 16–24, 26, and 27.

#### TIME PERIOD

Appeal 2016-004136  
Application 12/377,749

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) (2009).

ORDER  
AFFIRMED

~~APJ Initials:~~

~~MEC~~

~~RJS~~

~~CLM~~

~~PL/LT initials:pge~~

~~{MAILING ADDRESS OF APPELLANT(S)}~~