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Table with 5 columns: APPLICATION NO., FILING DATE, FIRST NAMED INVENTOR, ATTORNEY DOCKET NO., CONFIRMATION NO.
10/225.410 08/20/2002 Paul A. Blair 90945-647781 (003400US) 3266

20350 7590 04/18/2018
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EXAMINER

OYEBISI, OJO O

ART UNIT PAPER NUMBER

3695

NOTIFICATION DATE DELIVERY MODE

04/18/2018

ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte PAUL A. BLAIR, KENNETH ALGIENE,
and MARK THOMPSON

Appeal 2016-004770¹
Application 10/225,410²
Technology Center 3600

Before JEFFREY B. ROBERTSON, DANIEL S. SONG, and
MATTHEW S. MEYERS, *Administrative Patent Judges*.

MEYERS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's Final Rejection of claims 22–24, 26–30, and 32. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ Our decision references Appellants' Appeal Brief ("Br.," filed August 21, 2015) and the Examiner's Answer ("Ans.," mailed February 15, 2016), and Final Office Action ("Final Act.," mailed March 3, 2015).

² Appellants identify "The Western Union Company" as the real party in interest (Br. 2).

CLAIMED INVENTION

Appellants' claims "relate[] generally to financial transactions" (Spec. ¶ 2), and more particularly, "to systems and methods for sending and receiving value using unmanned financial transaction kiosks" (*id.*).

Claims 24, 29, and 32 are the independent claims on appeal. Claim 32, reproduced below, is illustrative of the subject matter on appeal:

32. A method for receiving funds at a multi-purpose kiosk, the method comprising:

(1) initiating, via the multi-purpose kiosk, a transaction with a customer, wherein the multi-purpose kiosk comprises: a communication arrangement comprising a speaker and a microphone, configured to provide two-way communication between a customer and a customer service representative, via a communications network; and a value dispenser configured to dispense value to the customer;

(2) receiving, by the multi-purpose kiosk, from the customer, an indication that the customer is conducting a receive funds operation to receive a value;

(3) placing, by the multi-purpose kiosk, the customer in communication with the customer service representative via the communication arrangement of the multipurpose kiosk;

(4) providing, via the multi-purpose kiosk, by the customer, information that identifies the customer to the customer service representative;

(5) providing, from the customer service representative via the multi-purpose kiosk, to the user, a receiver personal identifier number (PIN);

(6) receiving, by a means for entering account information of the multi-purpose kiosk, the receiver PIN from the customer;

(7) determining whether the customer has provided the PIN;

(8) determining whether the value includes a coinage amount;

(9) when the value does not include a coinage amount dispensing the value to the customer in paper currency;

(10) based on a determination that the value does include a coinage amount, and if the value dispenser is capable of dispensing coinage:

(a) dispensing a first portion of the value to the customer in paper currency; and

(b) dispensing a second portion of the value to the customer in coinage; and

(11) based on a determination that the value does include a coinage amount, and if the value dispenser is not capable of dispensing coinage:

(a) dispensing the first portion of the value to the customer in paper currency;

(b) causing a plurality of options to be presented to the customer on a display screen of the multi-purpose kiosk, the plurality of options including:

(i) donating the coinage amount to a charity;
and

(ii) receiving a financial instrument for the coinage amount;

(c) receiving a selection from the customer of one of the plurality of options; and

(d) transferring the second portion of the value in accordance with the selection from the customer.

REJECTION

Claims 22–24, 26–30, and 32 are rejected as being directed to patent ineligible subject matter under the judicial exception to 35 U.S.C. § 101.

ANALYSIS

Judicially excepted subject matter

Appellants argue independent claims 24, 29, and 32 as a group. *See* Br. 6–8. We select independent claim 32 as representative. Claims 24 and 29 stand or fall with independent claim 32. *See* 37 C.F.R. § 41.37(c)(1)(iv).

In rejecting independent claim 32 as being directed to judicially excepted subject matter, the Examiner determines that the claim, considered as a whole, is “directed towards the abstract idea of sending and receiving value using unmanned financial transaction kiosks” (Final Act. 4; *see also* Ans. 2). More particularly, the Examiner finds “[s]ending and receiving value is a fundamental economic practice and a method of organizing human activity by providing an opportunity for parties to enter into a specified transaction” (Final Act. 4). The Examiner further finds independent claim 32 does not amount to significantly more than an abstract idea because “[t]he limitations are merely instructions to implement the abstract idea on a computer and require no more than a generic computer to perform generic computer functions that are well-understood, routine and conventional activities previously known to the industry” (*id.*; *see also* Ans. 2–3).

Appellants do not dispute the Examiner’s determination that the claims are directed to an abstract idea (*see* Br. 6–8). Instead, Appellants argue that the claims are directed to patent-eligible subject matter “at least because significantly more than the alleged abstract idea is present in these claims” (*id.* at 6).

Under 35 U.S.C. § 101, 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 an implicit exception: “laws of nature, natural phenomena, and abstract ideas” are not patentable. *See, e.g., Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2354 (2014).

In determining whether independent claim 32 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 must determine whether the claim is “directed to” a patent-ineligible abstract idea. If so, 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. *Id.* 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.*

Here, we agree with the Examiner that claim 32 is directed to “sending and receiving value using unmanned financial transaction kiosks” (Final Act. 4). We also agree with the Examiner that independent claim 32 is directed to a fundamental economic practice and method of organizing human activity, which is similar to other claims our reviewing courts have deemed abstract, such as *Alice*, 134 S. Ct. at 2356 (using a third party to mitigate settlement risk), *buySAFE, Inc. v. Google, Inc.*, 765 F.3d 1350, 1355 (Fed. Cir. 2014) (guaranteeing transactions), *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1372–73 (Fed. Cir. 2011) (verifying the validity of credit card transactions over the Internet), and *Smart Systems Innovation, Inc. v. Chicago Transit Authority*, 873 F.3d 1364, 1371–72 (Fed.

Cir. 2017) (forming and collecting data for financial transactions in a certain field).

Turning to the second step of the framework, we find unpersuasive Appellants' arguments "that [independent] claims 24, 29, and 32 include 'significantly more' than an abstract idea to which the claims are allegedly directed" (*see* Br. 6–8).

Appellants first argue that the claims include "significantly more" than an abstract idea because "[e]ach of the claims improves at least three other technical fields beyond sending and receiving value using unmanned financial transaction kiosks (the alleged abstract idea): personal finance management, security and cost reduction of financial institution procedures, and improved charitable organization acquisition of funds" (*id.* at 6). However, we agree with the Examiner that "the claims do not include an improvement to another technology or technical field, an improvement to the functioning of the computer itself, or meaningful limitations beyond generally linking the use of an abstract idea to a particular technological environment" (Final Act. 4). In this regard, we note that there is a fundamental difference between computer functionality improvements, on the one hand, and uses of existing computers as tools to perform a particular task, on the other. Here, the alleged improvements that Appellants refer to, e.g., "allowing a sender in a financial transaction to use different automated transfer mechanisms based on their present needs or desires" (Br. 7), "gain[ing] greater security in being able to automate methods and security during such transactions" (*id.*), creating charitable donation opportunities (*id.*), do not concern an improvement to computer capabilities, but instead relate to improvements in marketing and customer service, that simply

instructs the practitioner to implement the abstract idea on a generic computer.

There is no inventive concept or technological advance here that would support patent eligibility. Claim 32 is not focused on an improvement to any of the components of the claimed “multi-purpose kiosk.” *Cf. In re TLI Communications LLC Patent Litigation*, 823 F.3d 607, 613 (Fed. Cir. 2016) (The claims’ focus “was not on an improved telephone unit or an improved server.”). And merely limiting the scope of the claims to a particular technological environment or application, without more, does not change the outcome. *Alice*, 134 S. Ct. at 2358.

Appellants next argue that the claims include “significantly more” than an abstract idea because “[p]articular, non-generic, machines/computers are necessary to implement the systems and methods of the claims” (Br. 7). More particularly, Appellants argue that “unmanned kiosks are not off-the-shelf computers,” but instead, “and are highly customized equipment that would need to be built to specification to properly implement the systems and methods of these claims” (Br. 7–8). However, as the Examiner points out, “the kiosk is recited at a high level of generality to simply perform the generic transaction-kiosk functions of receiving, processing[,] and transmitting information.” (Ans. 3). There is no indication in the record that any specialized computer hardware or other “inventive” computer components are required by the “multi-purpose kiosk” of independent claim 32. To the contrary, Appellants’ Specification discloses that “[a] computing device, such as a central processor 101, controls many of the functions of the kiosk” (Spec. ¶ 29). Thus, independent claim 32 merely employs generic

computer components to perform generic computer functions, which is not enough to transform an abstract idea into a patent-eligible invention.

Also, considered as an ordered combination, we are unclear as to how the claimed “multi-purpose kiosk” adds anything that is not already present when the steps of the method are considered separately. Here, Appellants argue “processing interactions with consumers so as to provide them with the described options and receive their choices” and “handl[ing] a large bulk of transactions unable to be handled by human operators during peak financial transaction times” (Br. 7) establish that “[p]articular, non-generic, machines/computers are necessary to implement the systems and methods of the claims” (*id.*). However, Appellants do not adequately show how the claimed steps are technically done such that they are not routine, conventional functions of a generic computer. *See Intellectual Ventures I LLC v. Capital One Bank (USA)*, 792 F.3d 1363, 1370 (Fed. Cir. 2015) (“Rather, the ‘interactive interface’ simply describes a generic web server with attendant software, tasked with providing web pages to and communicating with the user’s computer.”). Appellants have not established that the claimed invention relates to a software-based invention that improves the performance of the computer system itself. And it is well-settled that “merely recit[ing] the abstract idea . . . with the requirement to perform it on a set of generic computer components . . . would not contain an inventive concept.” *See BASCOM Global Internet Servs., Inc. v. AT&T Mobility LLC*, 827 F.3d 1341, 1350 (Fed. Cir. 2016).

We last are not persuaded by Appellants’ argument that because the “claims do not stand rejected under § 102 or § 103,” the claims cannot be “labeled a fundamental economic practice,” and thus, something

“significantly more than the alleged abstract idea is present in the claim” (Br. 8). To the extent that Appellants argue that independent claim 32 necessarily contains an “inventive concept” because Appellants’ claims recite particular features which they alleged are not disclosed in the prior art (*id.*), Appellants misapprehend the controlling precedent. Although the second step in the *Alice/Mayo* framework is termed a search for an “inventive concept,” the analysis is not an evaluation of novelty or non-obviousness, but rather, a search for “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*, 134 S. Ct. at 2355. A novel and nonobvious claim directed to a purely abstract idea is, nonetheless, patent-ineligible. *See Mayo*, 132 S. Ct. at 1304.

In view of the foregoing, we sustain the Examiner’s rejection under 35 U.S.C. § 101 of independent claim 32 and independent claims 24 and 29, which fall with independent claim 32.

Appellants also address dependent claims 22, 23, 26–28, and 30 separately (*see* Br. 9). Appellants state “the Office Action makes no effort to analyze these claims and state any grounds for why the recitations of these claims do not amount to significantly more than the alleged abstract idea” (*id.*).

Appellants’ argument is not persuasive at least because Appellants offer no arguments in support of the patent eligibility of the dependent claims. As we find, however, that dependent claims 22, 23, 26–28, and 30 merely describe further characteristics of the underlying concept and lack additional elements that would render the claims patent-eligible, we also sustain the rejection of these dependent claims on the same basis as the

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independent claims from which they depend. In particular, the dependent claims merely recite variations of presenting or receiving information related to the abstract idea, which we discern sits squarely within, and does not alter appreciably, the broader concept of “sending and receiving value using unmanned financial transaction kiosks” (*cf.* Ans. 2–3).

DECISION

The Examiner’s rejection of claims 22–24, 26–30, and 32 under 35 U.S.C. § 101 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)(1)(iv).

AFFIRMED