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EXAMINER

RANKINS, WILLIAM E

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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* SCOTT PAINTIN, LANCE MARR,  
MICHELLE KLOOSTERMAN, REBECCA LOEVENGUTH,  
and DIANE SCOTT

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Appeal 2016-005194  
Application 14/312,456<sup>1</sup>  
Technology Center 3600

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Before BIBHU R. MOHANTY, MICHAEL W. KIM, and  
NINA L. MEDLOCK, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellants seek our review under 35 U.S.C. § 134 of the final rejection of claims 1–20, which are all the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b).

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<sup>1</sup> Appellants identify the Western Union Company as the real party in interest. (App.Br. 2.)

## SUMMARY OF THE DECISION

We AFFIRM.

### THE INVENTION

The Appellants' claimed invention is directed to a method of transferring funds from a sender to a recipient with a recorded message (Spec., para.4). Independent claim 1, reproduced below, is representative of the subject matter on appeal.

1. A method comprising:
  - receiving, at a first computer system or a second computer system, a first request for a funds transfer from a sender to a recipient;
  - receiving, at the first computer system or the second computer system, a confirmation that a payment from the sender has been made for the funds transfer;
  - assigning, at the first computer system or the second computer system, an identifier to the funds transfer;
  - receiving, at the first computer system or the second computer system, a message from the sender;
  - receiving, at the first computer system or the second computer system, a second request from the sender that the message is provided to the recipient prior to receipt of funds by the recipient;
  - associating, at the first computer system or the second computer system, the message with the identifier or the funds;
  - receiving, at the first computer system or the second computer system, a third request from a recipient, wherein the third request includes the identifier; and
  - providing, from the first computer system or the second computer system, the message to the recipient after receiving the third request.

### THE REJECTIONS

The following rejections are before us for review:

1. Claims 1, 2, 6, 8, 9, 13, 15, 16, and 20 are rejected under 35 U.S.C. § 112, first paragraph, as failing to show possession of the claimed invention and comply with the written description requirement.
2. Claims 1–20 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

### FINDINGS OF FACT

We have determined that the findings of fact in the Analysis section below are supported at least by a preponderance of the evidence<sup>2</sup>.

### ANALYSIS

#### *Rejection under 35 U.S.C. § 112, first paragraph*

The Examiner made a new grounds of rejection on claims 1, 2, 6, 8, 9, 13, 15, 16, and 20 under 35 U.S.C. § 112, first paragraph, as failing to show possession of the invention and comply with the written description requirement (Ans. 3–5).

The Appellants have not provided any arguments for this rejection. Accordingly, this rejection is summarily affirmed.

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<sup>2</sup> See *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Patent Office).

*Rejection under 35 U.S.C. § 101*

The Appellants argue that the rejection of claim 1 is improper because the claim is directed to “significantly more” than an abstract idea (App. Br. 3–6). The Appellants argue the claim: 1) “improves other technical fields” beyond the alleged abstract idea, 2) uses particular, non-generic computers to implement the method, and 3) adds limitations beyond what is well-understood or routine, or adds unconventional steps to the claim (App. Br. 3–5).

In contrast, the Examiner has determined that the rejection of record is proper (Final Rej. 4, Ans. 6, 7).

We agree with the Examiner. 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 judging whether claim 1 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. If so, we then consider the elements of the 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 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.* The Court also stated that “the mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention”. *Id.* at 2358.

Here, the Examiner asserts that claims 1–20 are directed to “funds transfers,” with “messaging aspects [that] are ancillary to the fundamental purpose of transfers.” Ans. 2; Final Act. 4. We generally agree with the Examiner, although we determine that the messaging aspects are not ancillary, in that the messaging steps are intertwined with the funds transfer steps. Accordingly, we find that the claims are directed to the concept of transferring funds between parties with an included message, in that, in conjunction with the fund transfer steps, the claims also recite steps for including an appended message. This finding is consistent with the Specification, which recites as follows: “This disclosure relates in general to money transfers and by way of example, but not by way of limitation, to money transfers that include recorded messages amongst other things.” Spec. para. 2; *see also* Spec. para. 4 (“In one embodiment of the invention, a computerized method of transferring funds from a sender to a recipient with a recorded message is disclosed.”). In any case, there can be no doubt that “funds transfers” is a fundamental economic practice long prevalent in our system of commerce, and is an abstract idea beyond the scope of § 101, and that a contemporaneous communication of the funds transfer is no less fundamental than the funds transfer itself.

We next consider whether additional elements of the claim, both individually and as an ordered combination, transform the nature of the claim into a patent-eligible application of the abstract idea, e.g., whether the

claim does more than simply instruct the practitioner to implement the abstract idea with the use of generic computer components. The Examiner conclude that it does not (Ans. 6), an assessment with which we agree.

Considering each of the claim elements in turn, we are unpersuaded that the functions performed by the computer system at each step of the process are other than purely conventional. More specifically, we are unpersuaded that each step of the claimed system does any more than require a generic computer to perform a generic computer function. The Specification at paragraph 15, for instance, describes the system may use conventional memory devices and that a conventional computer system may be used. The Specification at paragraph 48 discloses that firmware and software implementation may be used with conventional machine-readable mediums. Here, the intrinsic evidence indicates that the claim limitations use generic computer systems in conventional manner to implement the system.

For these reasons the rejection of claim 1 is sustained. The Appellants has provided the same arguments for the remaining claims which are drawn to similar subject matter. Accordingly, the rejection of these claims is sustained as well for the same reasons given above.

#### CONCLUSIONS OF LAW

We conclude that Appellants have not shown that the Examiner erred in rejecting the claims under 35 U.S.C. § 112, first paragraph, as listed in the Rejections section above.

Appeal 2016-005194  
Application 14/312,456

We conclude that Appellants have not shown that the Examiner erred in rejecting the claims under 35 U.S.C. § 101 as listed in the Rejections section above.

#### DECISION

The Examiner's rejection of claims 1–20 is sustained.

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

AFFIRMED