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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* AYMAN HAMMAD AND MARK CARLSON

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Appeal 2016-005367  
Application 12/563,586  
Technology Center 3600

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Before ST. JOHN COURTENAY III, JOHN D. HAMANN, and  
JASON M. REPKO *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from a final rejection of claims 1–3, 6–12, 14–16, 19–21, 23–26, and 28–30, which are all the claims pending in this application. Claims 4, 5, 13, 17, 18, 22, and 27 are cancelled. We have jurisdiction over the pending claims under 35 U.S.C. § 6(b).

We affirm.

STATEMENT OF THE CASE

*Introduction*

Appellants' invention relates to "systems and methods for generating intelligent alert messages." (Spec. ¶ 5).

*Exemplary Claim*

Claim 1 is exemplary of the invention and reads as follows.

1. An intelligent messaging system comprising:  
a database comprising alert customization data; and  
a notification server computer coupled to the database, wherein the notification server computer comprises a processor and a computer-readable medium coupled to the processor, the computer-readable medium comprising code executable by the processor for implementing a method comprising:  
receiving transaction data for a transaction in an authorization request message from a merchant;  
identifying merchant information from the transaction data for the transaction, the merchant information including one or more of a merchant identifier, a merchant location, and a merchant category code;  
accessing the database comprising the alert customization data;  
[L1] **selecting an intelligent alert message template** *for the transaction based on the merchant information from the received transaction data, the selected intelligent alert message template being unique to the merchant;*  
[L2] **generating an intelligent alert message** *based on the alert customization data, the intelligent alert message including the intelligent alert message template and one or more data elements in the transaction data;* and  
sending the intelligent alert message to a user device to confirm that the transaction has been performed, wherein the intelligent alert message has text that depends on the alert customization data.

(Contested limitations L1 and L2 are bracketed and emphasized in bold and italics).

*Rejections*

- A. Claims 1–3, 6–12, 14–16, 19–21, 23–26, and 28–30 are rejected under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter (Final Act. 3–4).
- B. Claims 1–4, 6, 7, 15, 16, 24–26, 28, and 29 are rejected under pre-AIA 35 U.S.C. § 103(a) as being obvious over the combined teachings and suggestions of **Wilson** (US 5,539,189; Jul. 23, 1996) in view of **Asikainen** (US 6,647,272 B1; Nov. 11, 2003).
- C. Claims 8–12, 14, 19–21, and 23 are rejected under pre-AIA 35 U.S.C. § 103(a) as being obvious over the combined teachings and suggestions of **Wilson**, **Asikainen**, and **Meador et al.** (US 7,431,202 B1; Oct. 7, 2008) (hereinafter “**Meador**”).

*Issues on Appeal*

Did the Examiner err in rejecting claims 1–3, 6–12, 14–16, 19–21, 23–26, and 28–30 under 35 U.S.C. § 101, as being directed to patent-ineligible subject matter?

Did the Examiner err in rejecting claims 1–3, 6–12, 14–16, 19–21, 23–26, 28, and 29 under pre-AIA 35 U.S.C. § 103(a), as being obvious over the cited combinations of references?<sup>1</sup>

ANALYSIS

*Rejection A of Claims 1–3, 6–12, 14–16, 19–21, 23–26, and 28–30*

Under 35 U.S.C. § 101, a patent may be obtained for “any new and useful process, machine, manufacture, or composition of matter, or any new

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<sup>1</sup> We note the Examiner does not set forth a rejection for dependent claim 30 under § 103 rejections B or C.

and useful improvement thereof . . . .” The Supreme Court has “long held that this provision contains an important implicit exception: Laws of nature, natural phenomena, and abstract ideas are not patentable.” *Alice Corp. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2354 (2014) (quoting *Ass’n for Molecular Pathology v. Myriad Genetics, Inc.*, 133 S. Ct. 2107, 2116 (2013)). The Supreme Court in *Alice* reiterated the two-step framework previously set forth in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 132 S. Ct. 1289, 1300 (2012), “for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts.” *Alice*, 134 S. Ct. at 2355.

The first step in that analysis is to determine whether the claims at issue are directed to one of those patent-ineligible concepts, such as an abstract idea. Abstract ideas may include, but are not limited to, fundamental economic practices, methods of organizing human activities, an idea of itself, and mathematical formulas or relationships. *Id.* at 2355–57.

If the claims are not directed to a patent-ineligible concept, the inquiry ends. Otherwise, the inquiry proceeds to the second step where the elements of the claims are considered “individually and ‘as an ordered combination’ to determine whether the additional elements ‘transform the nature of the claim’ into a patent-eligible application.” *Alice*, 134 S. Ct. at 2355 (quoting *Mayo*, 132 S. Ct. at 1298, 1297).

We, therefore, look to whether the claims focus on a specific means or method that improves the relevant technology, or instead are directed to a result or effect that itself is the abstract idea, and merely invoke generic processes and machinery. *See Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1336 (Fed. Cir. 2016).

*Step 1*

Turning to the first part of the *Alice/Mayo* analysis, the Examiner concludes the claims are directed to “to the abstract idea of an intelligent alert system.” (Final Act. 3).

Regarding *Alice* Step 1, Appellants contend, *inter alia*:

Here, the alleged abstract idea of “an intelligent alert system” is not the analogous to any of the “abstract ideas” that have been identified by the courts or in the USPTO's July 2015 Interim Eligibility Guidance for Identifying Abstract Ideas, and any such analogous case. In addition, the Final Office Action has provided no explanation or similarity to any concept the courts have identified as abstract. As such, the Examiner has failed to establish a *prima facie* case of patent ineligibility.

The rejection is also improper, because the Examiner has also failed to provide any evidence which establishes that “an intelligent alert system” is an abstract idea. In *PNC Bank v. Secure Access, LLC*, the PTAB found that there was not sufficient evidence to demonstrate that the placing of a trusted stamp or seal on a document was a fundamental economic practice or a building block of the modern economy, noting that in *Alice Corporation Pty. Ltd. v. CLS Bank International, et al.* there were various references cited on the record that related to the concept of intermediated settlement (the abstract idea in *Alice*). *PNC Bank, CBM2012-00100, PTAB, September 9, 2014*. Likewise, here, the Examiner has failed to produce any evidence that establishes that “an intelligent alert system” is an “abstract idea.” As such, the Examiner has failed to established a *prima facie* case of unpatentability under 35 U.S.C. 101 for yet another reason.

**Since claim 1 is not directed to an abstract idea**, there is no need for the analysis to proceed to Step 2B of the flowchart.

(App. Br. 8–9) (emphasis added in bold).

However, we find Appellants' arguments (*id.*) ignore the **transactional features** of the claims, and focus solely on the intelligent alert system feature. We consider Appellants' claims as a whole, under a broad but reasonable interpretation. *See* n.2, *infra*.

Appellants' independent claim 1 is directed to an "intelligent messaging system" pertaining to **transaction data**:

"receiving **transaction data** for a **transaction** in an authorization request message from a merchant; identifying merchant information from the **transaction data** for the transaction, the merchant information including one or more of a merchant identifier, a merchant location, and a merchant category code; [and] selecting an intelligent alert message template for the **transaction** based on the merchant information from the received **transaction data**, the selected intelligent alert message template being unique to the merchant . . . ." (emphasis added).

Similarly, independent claims 8 and 14 are broadly directed to methods pertaining to the processing of **transaction data** with a merchant.

Therefore, we conclude all claims on appeal are directed to the **abstract idea of a fundamental economic practice, i.e., the processing of financial transactions which trigger intelligent alert messages**. Our reviewing court has found similar methods to be abstract ideas. *See e.g., Dealertrack, Inc. v. Huber*, 674 F.3d 1315 (Fed. Cir. 2012) (processing loan information); *Bancorp Servs., L.L.C. v. Sun Life Assur. Co. of Canada (U.S.)*, 687 F.3d 1266 (Fed. Cir. 2012) (managing an insurance policy).

Applying this guidance to the claims presented here on appeal, we agree with the Examiner's conclusion that claims 1–3, 6–12, 14–16, 19–21, 23–26, and 28–30 are directed to an abstract idea.

*Step 2*

Because the claims are directed to an abstract idea, we turn to the second part of the *Alice/Mayo* analysis. We analyze the claims to determine if there are additional limitations that individually, or as an ordered combination, ensure the claims amount to “significantly more” than the abstract idea. *Alice*, 134 S. Ct. at 2357.

Regarding *Alice*, Step 2, Appellants contend, *inter alia*:

Here, it is clear that the claims recite additional features to ensure that the alleged exception of an “intelligent alert system” is not monopolized. For example, as explained in detail below, the steps including “selecting an intelligent alert message template for the transaction based on the merchant information from the received transaction data, the selected intelligent alert message template being unique to the merchant; [and] generating an intelligent alert message based on the alert customization data, the intelligent alert message including the intelligent alert message template and one or more data elements in the transaction data” limit any alleged “intelligent alert system” to a specific, novel, and inventive intelligent alert system. As noted above, these limitations define and make the present claims patentable over the prior art of record so they must recite “significantly more.”

(App. Br. 9).

Appellants’ arguments do not persuade us the Examiner erred. Appellants essentially recite claim limitations without any persuasive explanation of how the limitations either individually, or as an ordered combination, amount to an **inventive concept** that converts the abstract idea into patent-eligible subject matter (*Id.*).

To the extent Appellants argue the claims “must recite ‘significantly more,’” because the “limitations define and make the present claims patentable over the prior art of record” (*id.*), we note that “[e]ligibility and



novelty are separate inquiries.” *Two-Way Media Ltd. v. Comcast Cable Communications, LLC*, 874 F.3d 1329, 1340 (Fed Cir. 2017); *see also Affinity Labs of Texas, LLC v. DIRECTV, LLC*, 838 F.3d 1253, 1263 (Fed. Cir. 2016) (holding that “even assuming” that a particular claimed feature was novel does not “avoid the problem of abstractness”). Moreover, “a claim for a new abstract idea is still an abstract idea.” *Synopsys, Inc. v. Mentor Graphics Corp.*, 839 F.3d 1138, 1151 (Fed. Cir. 2016).

We conclude Appellants’ independent claims 1, 8, and 14 are each directed to utilizing a **generic processor**, i.e., a computer **server** and/or **user device** in combination with a **database** to automate the process of the intelligent message system to deliver **transaction alerts** to a user device. However, the Supreme Court guides: “the mere recitation of a generic computer cannot transform a patent ineligible abstract idea into a patent-eligible invention.” *See Alice*, 134 S. Ct. at 2358.

Nor have Appellants shown that the claims (directed to the processing of **financial transactions** which trigger intelligent alert messages) improve the functioning of the computer itself and amount to significantly more than the **abstract idea of a fundamental economic practice**. *See, e.g., BASCOM Glob. Internet Servs., Inc. v. AT&T Mobility LLC*, 827 F.3d 1341, 1348 (Fed. Cir. 2016) (“An abstract idea on ‘an Internet computer network’ or on a generic computer is still an abstract idea.”); *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1355 (Fed. Cir. 2016) (“We have repeatedly held that such invocations of computers and networks that are not even arguably inventive are insufficient to pass the test of an inventive concept in the application of an abstract idea.”) (Internal quotations omitted).

Regarding the method or process claims on appeal, “a method that can be performed by human thought alone 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).

Nor do we find persuasive Appellants’ arguments (App. Br. 11), which refer to *DDR Holdings, LLC v. Hotels.com*, 773 F.3d 1245 (Fed. Cir. 2014), as relevant authority. We conclude Appellants’ claimed solution is not rooted in computer technology, such that the invention on appeal overcomes a problem specifically arising in the realm of computer networks, as was the case presented in *DDR*. (*Id.* at 1257).

Applying the aforementioned guidance here, we conclude Appellants’ claims are not directed to an **improvement** in computer functionality, or database functionality, or network functionality. Therefore, we conclude that none of the claim limitations, viewed “both individually and as an ordered combination,” amount to significantly more than the judicial exception in order to sufficiently transform the nature of the claims into patent-eligible subject matter. *See Alice*, 134 S. Ct. at 2355 (internal quotations omitted) (quoting *Mayo*, 132 S. Ct. at 1297).

For at least the aforementioned reasons, and on this record, Appellants have not persuaded us the Examiner erred. Accordingly, we sustain the Examiner’s rejection under 35 U.S.C. § 101 of all claims on appeal.<sup>2</sup>

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<sup>2</sup> To the extent Appellants have not advanced separate, substantive arguments for particular claims, or other issues, such arguments are waived. *See* 37 C.F.R. § 41.37(c)(1)(iv).

*Rejection B of Claim 1 under pre-AIA 35 U.S.C. § 103(a)*

**Issue:** Under pre-AIA 35 U.S.C. § 103(a), did the Examiner err by finding the cited combination of Wilson, and Asikainen teaches or suggests contested limitations L1 and L2:

[L1] **selecting an intelligent alert message template** *for the transaction based on the merchant information from the received transaction data, the selected intelligent alert message template being unique to the merchant;*

[L2] **generating an intelligent alert message** *based on the alert customization data, the intelligent alert message including the intelligent alert message template and one or more data elements in the transaction data;*

within the meaning of independent claim 1?<sup>3</sup> (Emphasis added).

We have considered all of Appellants' arguments and any evidence presented. Regarding the Examiner's rejection under §103(a) of independent claim 1, Appellants contend, *inter alia*:

The cited portion of Asikainen states that a first notification message is sent when a credit transaction is performed, while a second message is sent when a debit transaction is performed. Asikainen, col. 3, lines 33-36. However, while the message in Asikainen may be different for triggering events, Asikainen only indicates that "the message generated by the notification message includes information indicating which of the triggering events of which occurrence is detected by the detector." Asikainen, col. 5, lines 63-66. This indication is then used to generate an audible signal to the user that is different for each triggering event, and "thereby the user of the mobile station is alerted to the occurrence of the triggering event." Asikainen, col. 3, lines 44-46, and col. 6, lines 8-12.

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<sup>3</sup> We give the contested claim limitations the broadest reasonable interpretation (BRI) consistent with the Specification. *See In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997).

While Asikainen, col. 3, lines 30-33, describes a “banking service-related event,” such as a debit or credit transaction, no portion of Asikainen describes the “alert message being unique to the merchant” or that the alert message is generated to include an “intelligent alert message template and one or more data elements in the transaction data,” as recited in claim 1.

(App. Br. 15).

Appellants further contend:

No portion of Asikainen describes generating or sending messages based on triggering events related to different merchants or using generating a message using **a template and one or more data elements from the transaction data**. At best, while different triggering events may be detected, the notification to the user is only that a particular type of triggering event occurred. The user in Asikainen is not provided with any information specific to the transaction beyond the type of triggering event that was triggered. As the notification to the user is an audible or melodic tune associated with the type of triggering event, the notification cannot convey detailed information to the user that is based on the transaction data. *See* Asikainen, col. 6, lines 64-67. The user in Asikainen would have to conduct a further inquire to obtain the specifics related to the triggering event that occurred.

(App. Br. 16) (emphasis added).

Regarding the contested **intelligent alert message template**, The Examiner disagrees:

Asikainen teaches an alert system wherein a user can select a unique alert to be sent to the user's device whenever a triggering event or combination of triggering events occur that involves the user's associated account (Asikainen: col 3, lines 30-50; col 7, lines 5-60). .The messaging service can then detect the user-defined triggering event, select an intelligent alert message template for the transaction based on merchant information from the monitored transaction data (the selected intelligent alert message being unique to the merchant), and generate an

intelligent alert message based on the alert customization data (i.e. triggering event), the intelligent alert message including the intelligent alert message template and one or more data elements in the transaction data (e.g. a tune could signal a transaction that involves a unique merchant, a unique account, and whether a debit or credit occurred). In this case, the data elements in the transaction data are represented by the identifying the unique merchant and the type of transaction (i.e. debit or credit). The template is the signal itself. Since the user defines the triggering event in Asikainen, a triggering event can be tailored for only transactions with a specific merchant.

(Ans. 8–9).

In the Reply Brief (6), the Appellants respond to the Examiner’s new findings regarding Asikainen’s audio signal as purportedly teaching or suggesting the claimed **intelligent alert message template**:

The Examiner is now alleging that the “audio signal” in Asikainen is a “template.”

The Examiner's interpretation that an “audio signal” in Asikainen is a “template” is nonsensical. According to Dictionary.com, a “template” is a “an electronic file with a predesigned, customized format and structure . . . ready to be filled in.” Clearly, an “audio signal” does not fit this definition or any other reasonable definition of the word “template.” Further, even if the “audio signal” in Asikainen could be construed as a “template,” there is no teaching of a “merchant specific” audio signal in Asikainen et al. For example, col. 3, lines 45-47 of Asikainen describes audio signals that are generated based upon whether the notification message indicates a debit or credit to a user's account, not whether the triggering event was for a specific merchant. In fact, the word “merchant” is not even in Asikainen at all.

This is actually admitted by the Examiner as the Examiner states at section 8 on page 10 of the Examiner's Answer that “[n]owhere in Asikainen is the user precluded from

using merchant information to define a triggering event and its associated alert.” **The Examiner is alleging that the absence of a “template being unique to the merchant” suggests that Asikainen teaches the limitation. This again is nonsensical.** (emphasis added).

We turn to Appellants’ Specification (¶¶ 62–63) for *context*:

[0062] Various tables of different specific messages or message templates may be associated with each of these data elements or combinations of data elements. For example, a **message template** under an MCC data element indicating a grocery store might be “You purchased \$[insert purchased amount] of groceries on January 4, 2009.” A **message template** under an MCC data element indicating a gas station might include “amount may vary” when an authorization request message is sent from the fuel dispenser, and might include “You purchased \$[insert purchase amount] in gas at [insert merchant name] on [insert date] when the actual amount of the gas purchase is determined.”

[0063] Further, under the MCC data elements, the **message templates** can be further subdivided using other data elements such as the location of the transaction or the native language of the user. The location of the transaction can be determined using a merchant identifier and the native language of the user can be determined using the account number of the portable consumer device (i.e., by checking for the address associated with the account number). For instance, in the prior example, grocery store **message templates** can be further subdivided based upon the language of the cardholder.

(emphasis added).

Turning to the evidence relied upon by the Examiner, we note Asikainen (col. 3, ll. 23–25), describes: “The transducer generates an **audio signal** to alert the user of the mobile station of the occurrence of the

triggering event.” Asikainen (col. 7, ll. 54–56) similarly describes: “When detected at the mobile station, an **audio tune** is caused to be played to alert a user of the mobile station of the occurrence of the triggering event.”

((emphasis added)).

As recently emphasized by our reviewing court:

Even when giving claim terms their broadest reasonable interpretation, the Board cannot construe the claims “so broadly that its constructions are *unreasonable* under general claim construction principles.” *Microsoft Corp. v. Proxyconn, Inc.*, 789 F.3d 1292, 1298 (Fed. Cir. 2015). “[T]he protocol of giving claims their broadest reasonable interpretation ... does not include giving claims a legally incorrect interpretation” “divorced from the specification and the record evidence.” *Id.* (citations and internal quotation marks omitted); *see PPC Broadband, Inc. v. Corning Optical Commc'ns RF, LLC*, 815 F.3d 747, 751–53 (Fed. Cir. 2016).

...

The correct inquiry in giving a claim term its broadest reasonable interpretation in light of the specification is not whether the specification proscribes or precludes some broad reading of the claim term adopted by the examiner. And it is not simply an interpretation that is not inconsistent with the specification. It is an interpretation that corresponds with what and how the inventor describes his invention in the specification, i.e., an interpretation that is “consistent with the specification.” *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997) (citation and internal quotation marks omitted); *see also In re Suitco Surface*, 603 F.3d 1255, 1259–60 (Fed. Cir. 2010).

*In re Smith Int'l, Inc.*, No. 2016-2303, 2017 WL 4247407, at \*5 (Fed. Cir. Sept. 26, 2017).

Applying this guidance here, we are constrained on this record to reverse the Examiner's obviousness rejection B of claim 1, and rejection B of the corresponding associated dependent claims.

Although paragraphs 62 and 63 of the Specification provide examples (not a definition per se) for the contested claim term "**intelligent alert message template**," on this record, we find a preponderance of the evidence supports Appellants' contention that the Examiner's claim interpretation is overly broad and unreasonable.

Thus, we find the Examiner has not fully developed the record to show how the claimed contested "**intelligent alert message template**" is reasonably taught or suggested by the audio alert signal in Asikainen. Moreover, limitation L1 ("selecting an **intelligent alert message template**") is a separate and distinct claim term from limitation L2 "generating an **intelligent alert message**." We find the Examiner has blurred the distinction between these separately recited claim terms.

*Rejection C under pre-AIA 35 U.S.C. § 103(a)*

In light of our reversal of rejection B of claims 1–4, 6, 7, 15, 16, 24–26, 28, and 29, *supra*, we also reverse Rejection C under § 103 of claims 8–12, 14, 19–21, and 23 for the same reasons, as argued by Appellants. On this record, the Examiner has not shown how the additionally cited Meador reference overcomes the aforementioned deficiency with the base combination of Wilson and Asikainen, as discussed above regarding independent claim 1.



### CONCLUSIONS

The Examiner did not err in rejecting claims 1–3, 6–12, 14–16, 19–21, 23–26, and 28–30 under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter.

The Examiner erred in rejecting claims 1–3, 6–12, 14–16, 19–21, 23–26, 28, and 29 under 35 U.S.C. § 103(a) as being obvious over the combined teachings and suggestions of the cited references.

### DECISION

We affirm the decision of the Examiner rejecting claims 1–3, 6–12, 14–16, 19–21, 23–26, and 28–30 under 35 U.S.C. § 101.

We reverse the decision of the Examiner rejecting claims 1–3, 6–12, 14–16, 19–21, 23–26, 28, and 29 under 35 U.S.C. § 103(a).

Because we have affirmed at least one ground of rejection with respect to each claim on appeal, the Examiner’s decision is affirmed. *See* 37 C.F.R. § 41.50(a)(1).

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). *See* 37 C.F.R. § 41.50(f).

AFFIRMED