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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte T. CLAY WILKES

Appeal 2016–005481
Application 13/945,872¹
Technology Center 3600

Before ANTON W. FETTING, TARA L. HUTCHINGS, and
ROBERT J. SILVERMAN, *Administrative Patent Judges*.
FETTING, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ According to Appellant, Galileo Processing, Inc. is the Real Party in Interest.

STATEMENT OF THE CASE²

T. Clay Wilkes (Appellant) seeks review under 35 U.S.C. § 134(a) of a final rejection of claims 1–9 and 11–17, the only claims pending in the application on appeal. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b).

The Appellant invented a way of enabling consumers to make financial transactions using an account accessible using at least one social networking service. Spec. para. 2.

An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below (bracketed matter and some paragraphing added).

1. A method comprising:

[1] assigning, using a processor-based computing device programmed to perform the assigning,

an identifier for an account held on at least one social networking service to a financial account;

[2] associating the financial account with the at least one social networking service

based on the identifier for the account

so that the financial account is

accessible by a user using the identifier for the account

² Our decision will make reference to the Appellant’s Appeal Brief (“App. Br.,” filed June 25, 2015) and Reply Brief (“Reply Br.,” filed April 22, 2016), and the Examiner’s Answer (“Ans.,” mailed February 22, 2016), and Final Action (“Final Act.,” mailed February 25, 2015).

and

not accessible using a financial account number for the account;

[3] generating a code enabling access to the financial account;

and

[4] providing the code to a mobile device of the at least one user for display on a screen of the mobile device.

REJECTIONS

Claims 1–9 and 11–17 stand rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter.

Claims 1–8 stand rejected under 35 U.S.C. § 112(a) as lacking a supporting written description within the original disclosure.

ISSUES

The issues of eligible subject matter turn primarily on whether the claims recite more than abstract conceptual advice as to what a computer is to do without any implementation details as to how to do so.

The issues of written description matter turn primarily on whether the Specification describes precluding financial account access using the account number.

ANALYSIS

Claims 1–9 and 11–17 rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter

Method claim 1 recites assigning an account identifier, creating data associating the account with a network service based on the identifier, and generating and providing a code. Thus, claim 1 recites creating and

providing data that represent some relationships. Although claim 1 also recites making an association so that the financial account is accessible by a user using the identifier for the account and not accessible using a financial account number for the account and providing a code for display, the claim does not recite performing either accessing or preventing access, or display. Accordingly these limitations are aspirational rather than functional. None of the limitations recite implementation details for any of these steps, but instead recite functional results to be achieved by any and all possible means. Data creation and provision are generic, conventional data processing operations to the point they are themselves concepts awaiting implementation details. The sequence of data creation-provision is equally generic and conventional. The ordering of the steps is therefore ordinary and conventional. The remaining claims merely describe information and parameters fed into the steps, with no implementation details.

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 Intl, 134 S. Ct. 2347, 2355 (2014) (citing *Mayo Collaborative Services v. Prometheus Laboratories, 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. The Examiner finds the claims directed to associating a user financial account with his/her social networking service account and that correlating user accounts of one type to the other type is fundamental economic practice. Final Act. 3.

While 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 preamble to claim 1 does not recite what it is directed to, but the steps in claim 1 result in providing a code to a mobile device.³ The Specification at paragraph 2 recites that the invention relates to enabling consumers to make financial transactions using an account accessible using at least one social networking service. Thus, all this evidence shows that claim 1 is directed to providing some code or data usable in accessing an account, i.e. financial record management.

It follows from prior Supreme Court cases, and *Bilski* (*Bilski v Kappos*, 561 U.S. 593 (2010)) in particular, that the claims at issue here are directed to an abstract idea. Like the risk hedging in *Bilski*, the concept of financial

record management is a fundamental business practice long prevalent in our system of finance. The use of financial record management is also a building block of banking. Thus, financial record management, like hedging, is an “abstract idea” beyond the scope of §101. *See Alice Corp. Pty. Ltd.* at 2356.

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 risk hedging in *Bilski* and the concept of financial record management at issue here. Both are squarely within the realm of “abstract ideas” as the Court has used that term. *See Alice Corp. Pty. Ltd.* at 2357.

Further, claims involving data collection, analysis, and display are directed to an abstract idea. *Elec. Power Grp. v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016) (holding that “collecting information, analyzing it, and displaying certain results of the collection and analysis” are “a familiar class of claims ‘directed to’ a patent ineligible concept”); *see also In re TLI Commc’ns LLC Patent Litig.*, 823 F.3d 607, 611 (Fed. Cir. 2016); *FairWarning IP, LLC v. Iatric Sys., Inc.*, 839 F.3d 1089, 1093–94 (Fed. Cir. 2016). Claim 1, unlike the claims found non-abstract in prior cases, uses generic computer technology to perform data generation, analysis, and

³ Although claim 1 recites that the code is one enabling access to an account and is for display, the claim does not recite steps performing either enabling access or display.

transmission, and does not recite an improvement to a particular computer technology. *See, e.g., McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1314–15 (Fed. Cir. 2016) (finding claims not abstract because they “focused on a specific asserted improvement in computer animation”). As such, claim 1 is directed to the abstract idea of generating, analyzing, and transmitting data.

Independent claim 9 is similar except that the first step receives information with an identifier rather than generating the identifier, and is otherwise broader than claim 1. The remaining claims merely describe information and parameters fed into the steps. We conclude that the claims at issue are directed to a patent-ineligible concept.

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

the 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 featur[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 (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 2358. 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 generate, analyze, and transmit data 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 Appellant’s method add nothing that is not already present when the steps are considered separately. Viewed as a whole, Appellant’s method claims simply to recite the concept of financial record management as performed by a generic computer. To be sure, the claims recite doing so by advising one to associate an account with some identifier tied to some service, use the identifier instead of some account number to identify the account, and generate some code that is sent to a phone. But this is no more than abstract conceptual advice on the parameters for such financial record management and the generic computer processes necessary to process those parameters, and do not recite any particular implementation. Claim 1 does not even advise one as to any nexus between the associating and generating steps, nor

advise one on how the provided code is used subsequent to the claimed process to somehow enable access.

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. The 21+ pages of the Specification do not bulge with disclosure, but spell out different generic equipment and parameters that might be applied using this concept and the particular steps such conventional processing would entail based on the concept of financial record management under different scenarios. They do not describe any particular improvement in the manner a computer functions. Instead, the claims at issue amount to nothing significantly more than an instruction to apply the abstract idea of financial record management using some unspecified, 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.

We are not persuaded by Appellant’s argument that

The present claims are not directed toward an economic practice that is foundational or basic. Instead, the claimed subject matter is explicitly tied to a social network.

Considering that Facebook was founded in 2004, it is difficult to imagine how an economic practice tied to a social network could be foundational or basic. Certainly, the claimed subject matter with its social network requirements is not tied to a foundational or basic economic practice. In addition, it is this type of internet-centric solution to modern problems including social networks that the court in *DDR Holdings* found favor.

Reply Br. 3 (citing *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1257 (Fed. Cir. 2014)) (footnote reference omitted). Appellant conflates the two *Alice* steps. The first step determines whether the claims are directed to an abstract idea. We find the evidence in the record shows the claims are directed to a form of financial record management. It is the second step that then looks to see whether the claims accomplish this using some inventive technical manner. In this instance, claim 1 recites doing so by somehow associating a financial account with a social networking service. The claim goes on to say that it is the identifier, not the social networking service that is used to access the account. Thus, the only “tying” of the claim to a social network service is some manner of unspecified association.

Associating an identifier with some network or data is a routine form of data entry. The only distinction between a social network and any other network is in the mind of the beholder, which is afforded no patentable weight. *See In re Bernhart*, 417 F.2d 1395, 1399 (CCPA 1969)). Using an identifier to access a financial account is as old as banking.

We are not persuaded by Appellant’s argument that correlating user accounts of one type to the other type has not been found by the Federal

Circuit or the Supreme Court to be an abstract idea. App. Br. 8–10. As we find *supra*, such a correlation is no more than financial record management, which is as fundamental a practice as might be imagined.

We also are not persuaded by Appellant’s argument that the asserted claims are akin to the claims found patent-eligible in *DDR Holdings*. In *DDR Holdings*, the Court evaluated the eligibility of claims “address[ing] the problem of retaining website visitors that, if adhering to the routine, conventional functioning of Internet hyperlink protocol, would be instantly transported away from a host’s website after ‘clicking’ on an advertisement and activating a hyperlink.” *DDR Holdings*, 773 F.3d at 1257. There, the Court found that the claims were patent eligible because they transformed the manner in which a hyperlink typically functions to resolve a problem that had no “pre-Internet analog.” *Id.* at 1258. The Court cautioned, however, “that not all claims purporting to address Internet-centric challenges are eligible for patent.” *Id.*

In particular, in *DDR Holdings* the Court distinguished the patent-eligible claims at issue from claims found patent-ineligible in *Ultramercial*. *See id.* at 1258–59 (citing *Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 715–16 (Fed. Cir. 2014)). The Court noted that the *Ultramercial* claims were “directed to a specific method of advertising and content distribution that was previously unknown and never employed on the Internet before.” *Id.* at 1258 (quoting *Ultramercial*, 772 F.3d at 715–16). Nevertheless, those claims were patent ineligible because they “merely recite[d] the abstract idea of ‘offering media content in exchange for viewing an advertisement,’ along with ‘routine additional steps such as

updating an activity log, requiring a request from the consumer to view the ad, restrictions on public access, and use of the Internet.” *Id.*

Appellant’s asserted claims are analogous to the claims found ineligible in *Ultramercial* and distinct from the claims found eligible in *DDR Holdings*. The ineligible claims in *Ultramercial* recited “providing [a] media product for sale at an Internet website;” “restricting general public access to said media product;” “receiving from the consumer a request to view [a] sponsor message;” and “if the sponsor message is an interactive message, presenting at least one query to the consumer and allowing said consumer access to said media product after receiving a response to said at least one query.” 772 F.3d at 712. Similarly, Appellant’s asserted claims recite receiving, analyzing, and transmitting data. This is precisely the type of Internet activity found ineligible in *Ultramercial*.

We are not persuaded by Appellant’s argument that there is no evidence on the record to establish that the claim is an abstract method of “associating a user financial account with his/her social networking service account” under part one of the *Alice* test. App. Br. 10–12. We find sufficient intrinsic evidence *supra* that the claims are directed to abstract conceptual advice.

We are not persuaded by Appellant’s argument that the claims are not directed toward a mere abstract idea due to the presence of particular limitations that confine the scope of the claims to being much narrower than merely “associating a user financial account with his/her social networking service account” and provide enough extra to pass the *Alice* test. App. Br. 12–15. We find the particular limitations are conventional data

processing practices that add little more than abstract conceptual advice *supra*.

We are not persuaded by Appellant’s argument that claim 1 provides an inventive concept since the Examiner has not been able to establish rejections under §§ 102 and 103. App. Br. 16. “A claim for a new abstract idea is still an abstract idea. The search for a § 101 inventive concept is thus distinct from demonstrating § 102 novelty” or § 103 nonobviousness. *Synopsys, Inc. v. Mentor Graphics Corp.*, 839 F.3d 1138, 1151 (Fed. Cir. 2016).

We are not persuaded by Appellant’s argument that the claims do not wholly pre-empt the field of “associating a user financial account with his/her social networking service account” due to numerous non-infringing alternatives that are significant and substantial. That the claims do not preempt all forms of the abstraction or may be limited to the abstract idea in some setting do not make them any less abstract. *See OIP Technologies, Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1360–61 (2015). Abstract conceptual advice may be detailed, but it remains abstract conceptual advice and encompasses all possible implementations.

Claims 1–8 rejected under 35 U.S.C. § 112(a) as lacking a supporting written description within the original disclosure

We are not persuaded by Appellant’s argument that the limitation of “associating the financial account . . . so that the financial account is . . . not accessible using a financial account number for the account” is supported by the Specification as originally filed. Appellant cites several Specification paragraphs describing the use of an identifier other than an

account number, and argues that in those contexts, because the contexts expect the identifier, an account number would not work. Reply Br. 1–3.

The Examiner finds that this limitation “constitutes a negative limitation which was not described in the specification originally filed.” Ans. 3. We agree. The problem for Appellant is that although negative limitations are allowed, they are extremely broad. In this case, the limitation recites that a financial account is not accessible using a financial account number for the account. This is an unusual limitation as an account number, being the primary identifier to the account repository, is almost by definition a number that may be used to access an account. The claim does not narrow the limitation by context. Thus, as with most negative limitations, this is extremely broad in context.

Further, Appellant does not cite any portion of the Specification that describes this limitation. Appellant’s argument cites examples of using an identifier instead of an account number and the argument is essentially that it is obvious to one of ordinary skill that in the context of using the alternate identifier described, the system would not be looking for an account number. Written description requirements cannot be met by obviousness. *Lockwood v. Am. Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997), “[o]ne shows that one is ‘in possession’ of the invention by describing the invention, with all its claimed limitations, not that which makes it obvious (emphasis added; original emphasis not reproduced).” Further, showing examples of A instead of B is not evidence that B is precluded, only that B is not chosen. Also, absence of evidence is not evidence of absence.

CONCLUSIONS OF LAW

The rejection of claims 1–9 and 11–17 under 35 U.S.C. § 101 as directed to non-statutory subject matter is proper.

The rejection of claims 1–8 under 35 U.S.C. § 112(a) as lacking a supporting written description within the original disclosure is proper.

DECISION

The rejection of claims 1–9 and 11–17 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