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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* RONI DOLEV TAMARI, LARRY HERBINAUX,  
DARREN NEW, MILES PASCHINI, PATRICK K. HAZEL,  
and MARSHALL ROSE

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Appeal 2016-006183<sup>1</sup>  
Application 14/106,494  
Technology Center 3600

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Before MURRIEL E. CRAWFORD, MICHAEL W. KIM, and  
PHILIP J. HOFFMANN, *Administrative Patent Judges*.

KIM, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is an appeal from the final rejection of claims 1–16. We have jurisdiction to review the case under 35 U.S.C. §§ 134 and 6.

The invention “relates generally to methods and apparatus for effecting payment for goods and services.” Spec. ¶ 2.

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<sup>1</sup> The Appellants identify Blackhawk Network, Inc. as the real party in interest. Appeal Br. 3.

Independent claim 1 is illustrative:

1. A method of distributing prepaid products performed by a transaction processing platform having a processor and computer program code stored on a non-transitory computer readable memory which, when executed by the processor, causes the transaction processing platform to perform the method, the method comprising:

receiving, by the transaction processing platform, a request for an activation and issuance of a prepaid product from a client terminal operative for wireless communication, wherein the request is received by the transaction processing platform wirelessly from the client terminal through a conduit interface, wherein the transaction processing platform is in real-time communication with a plurality of prepaid service providers and routes the request and payment information to a provider of the prepaid product, and wherein the transaction processing platform routes the request and payment information from the client terminal to a service provider of the plurality prepaid service providers.

Claims 1–16 are rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter in the form of an abstract idea.

We AFFIRM and enter a NEW GROUND of rejection pursuant to our authority under 37 C.F.R. § 41.50(b).

*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 following method is then used to determine whether what the claim is “directed to” is an abstract idea:

[T]he decisional mechanism courts now apply is to examine earlier cases in which a similar or parallel descriptive nature can be seen—what prior cases were about, and which way they were decided. *See, e.g., Elec. Power Grp.*, 830 F.3d at 1353–54. That is the classic common law methodology for creating law when a single governing definitional context is not available. *See generally* Karl N. Llewellyn, *The Common Law Tradition*:

Deciding Appeals (1960). This more flexible approach is also the approach employed by the Supreme Court. *See Alice*, 134 S. Ct. at 2355–57. We shall follow that approach here.

*Amdocs (Israel) Limited v. Openet Telecom, Inc.*, 841 F.3d 1288, 1294 (Fed. Cir. 2016).

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, *Flook*, 437 U.S. at 594–95; and basic tools of scientific and technological work, *Benson*, 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 67.

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.*

#### Analysis

Claim 1, the sole independent claim on appeal, is directed to receiving and routing a request. The claim specifies the meaning of the content of the request as being “for an activation and issuance of a prepaid product.” The claim also specifies that the “processing platform” receives the request through wireless communication, and communicates “in real-time” to

forward the request to “a provider of the prepaid product,” along with “payment information.” Though these elements of claim language may nominally narrow the specific application of receiving and routing a request, the scope of the claim does not include any steps outside of what the claim is directed to: receiving and routing a request.

Claim 1 is similar in nature to other claims found to be directed to abstract ideas. For example, claim 1 is similar to the claims in the ‘794 patent in *GT Nexus*, where the court explained:

The Court finds that the ’794 patent simply adds generic computer limitations to the abstract idea of booking container shipping through a third party. The claimed system recites the use of a computer to create and transmit electronic booking requests using a neutral portal. With the use of templates, the computer system receives an electronic booking request from the shipper, generates and applies a contract reference, and transmits the request to a carrier.

*GT Nexus, Inc. v. Intra, Inc.*, No. C 11-02145-SBA, 2015 WL 6747142, at \*7 (N.D. Cal. Nov. 5, 2015), *aff’d*, 669 F. App’x 562 (Fed. Cir. 2016).

The claim is also similar to claim 26 in *Fidelity National Information Services*, which was described as being “directed to a method comprising capturing an image of documents and receipts and extracting data therefrom, and collecting, managing, encrypting subsystem identification information and the transaction data and transmitting the data to various locations within a system.” *Fidelity Nat’l Info. Servs., Inc. v. DataTreasury Corp.*, Case CBM2014-00021, slip. op. 12, 2015 WL 1967328, at \*7 (PTAB Apr. 29, 2015) (Paper 34), *aff’d*, 2016 WL 5939431 (Fed. Cir. 2016).

The claim further is similar to those describing an electronic version of a traditional mailroom, in *Symantec*, where our reviewing court agreed with the District Court’s characterization of the claim as merely “gating the

message for further review, as in claim 1, and also releasing, deleting, returning, or forwarding the message, as described elsewhere in the '142 patent, *see, e.g.*, col. 3, ll. 30–39.” *Intellectual Ventures I LLC v. Symantec Corp.*, 838 F.3d 1307, 1317 (Fed. Cir. 2016) (footnote omitted).

When considered along with dependent claim 6, which returns a PIN code to the terminal from which the request originated, and dependent claim 12, which sends advertising to the same terminal, the claims are similar to those in *Dealertrack*, where the Federal Circuit described the claims as follows:

Dealertrack’s claimed process in its simplest form includes three steps: receiving data from one source (step A), selectively forwarding the data (step B, performed according to step D), and forwarding reply data to the first source (step C). The claim “explain[s] the basic concept” of processing information through a clearinghouse.

*Dealertrack, Inc. v. Huber*, 674 F.3d 1315, 1333 (Fed. Cir. 2012).

Because claim 1 is directed to receiving and routing a request, and is similar to other claims found abstract by our reviewing court, we agree with the Examiner that claim 1 is directed to an abstract idea. *See* Final Act. 5.

We also consider the dependent claims to be directed to the aforementioned abstract idea, because none of the dependent claims alter the basic nature of claim 1 being directed to receiving and forwarding a request. Claims 2–5, 14, and 16 limit the technology employed for the receiving and routing. Claim 6 recites delivery of “a PIN or activation confirmation.” Claims 7 and 8 recite that the delivery is “on-demand” and from a database. Claim 9 recites that routing is based on information in routing tables. Claims 10 and 11 recite that the “processing platform” also stores customer information. Claim 12 recites that advertising information is transmitted,

and claim 13 recites that quantity information is transmitted. Claim 15 recites that the product, with which the request is associated, is “virtual.”

Turning to step two of the *Mayo* analysis, we consider whether additional elements in the claims transform the abstract idea into patentable subject matter.

Independent claim 1 specifies the meaning of the content of the request as being “for an activation and issuance of a prepaid product.” While that may be nominally limiting, in application, we discern that the nature of the content of the routed request does not lead to any specific action within the scope of the claims. There is, for example, no distribution of any “prepaid product” or use of the request that has been routed. The nature of the content of the request and its implied meaning, therefore, are not “significantly more” than the abstract idea.

The claim also specifies that the receiving “processing platform” receives the request through wireless communication, and communicates “in real-time” to forward the request. We note first that receiving and routing information (including using a routing table, as in claim 9), and responding to receiving information by sending information, from a database, as generally recited by claims 1, 6–8, 12, and 13, and storing information, as recited in claims 10 and 11, are all tasks commonly performed by general purpose computers, requiring no special programming.

In addition, the Specification describes the nature of computers employed in the claimed method as follows:

the transaction processing platform 112 includes a platform front-end 202, a conduit interface 204, a real-time supply (RTS) module 208, and a platform database 212. Each of the functional components of the transaction processing platform 112 may be

realized using a combination of software and/or hardware for performing a task or set of tasks. For example, certain of the functional components may include at least a data processor, memory, and computer program code collectively enabling the component to carry out its prescribed tasks. In addition, ones of the functional components may also include input and output devices, short term and long term memory systems, communication devices, or multiple processors. In some implementations certain of the functional components may share common hardware and portions of a software library. It should be understood that the set of functional components of the platform 112 described herein is conceptual in nature, and there may exist a variety of combinations of hardware and software elements capable of executing the tasks of each component.

Spec. ¶ 43.

This description indicates that the claimed method is performed using general purpose computers, which do not represent an “inventive concept” and do not transform the abstract idea into eligible subject matter. General purpose computers use “real-time” communications, as claimed, such as TCP/IP Ethernet, and telephone connections. Telephone and Internet networks frequently make use of wireless links along their paths, and computers frequently are enabled with wireless communications technology, such as BLUETOOTH. “[A]fter *Alice*, there can remain no doubt: recitation of generic computer limitations does not make an otherwise ineligible claim patent-eligible. The bare fact that a computer exists in the physical rather than purely conceptual realm is beside the point.” *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1256 (Fed. Cir. 2014) (internal citations and quotation marks omitted).

In addition, the specific technology limitations in claim 2 (“wherein the conduit interface is a web server”), claim 3 (“accessed through the use of a browser program”), claim 4 (“a terminal server”), claim 14 (“a POS

terminal”), and claim 16 (“a telephone network”), are all standard technologies, used by general purpose computers used in commerce, and fail to represent any “inventive concept.”

Nothing in claims 1–16 purports to improve computer functioning or “effect an improvement in any other technology or technical field.” *Alice*, 134 S. Ct. at 2359. Nor do claims solve a problem unique to the Internet. *See DDR Holdings*, 773 F.3d at 1257. The claims also are not adequately tied to “a particular machine or apparatus.” *Bilski v. Kappos*, 561 U.S. 593, 601 (2010). For these reasons, we agree with the Examiner’s rejection of claims 1–16 as being directed to ineligible subject matter under 35 U.S.C. § 101.

We have considered the Appellants’ arguments, but determine that they are unpersuasive in light of the analysis above. The Appellants argue the claims are not directed to fundamental economic practices, do not preempt the use of “electronic activation and issuance of prepaid product via a user interface,” and provide something “significantly more” through the use of “real-time communications” and the features of, essentially, every dependent claim. Appeal Br. 4–13. The Appellants also argue the claims are not methods of organizing human behavior, are unlike the claims in cases cited by the Examiner, and require the use of “specifically programmed computer processors.” Reply Br. 4–10. These arguments are unpersuasive when considered in view of the analysis set forth above.

As our rationale differs from that of the Examiner (*see* Final Act. 5, Answer 2–4), we denominate our affirmance of the rejection of claims 1–16, under 35 U.S.C. § 101 as being directed to an abstract idea, as a new ground of rejection.

DECISION

We AFFIRM the rejection of claims 1–16 under 35 U.S.C. § 101.

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b) (2008). 37 C.F.R. § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that the Appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner . . . .

(2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record . . . .

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; 37 C.F.R. § 41.50(b)