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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MOHAMMAD KHAN, PRADEEP KUMAR,
HANS BIELEFELD REISGIES, KAUSHIK ROY,
and ROSHAN VIJAYSHANKAR

Appeal 2016-006320
Application 13/118,046
Technology Center 3600

Before ANTON W. FETTING, CYNTHIA L. MURPHY, and
KENNETH G. SCHOPFER, *Administrative Patent Judges*.

MURPHY, *Administrative Patent Judge*.

DECISION ON APPEAL

The Appellants¹ appeal under 35 U.S.C. § 134 from the Examiner's rejections of claims 1, 3–19, and 21–37. We have jurisdiction over this appeal under 35 U.S.C. § 6(b).

We AFFIRM.

¹ The Appellants identify the real party in interest as “MasterCard International Incorporated.” (Appeal Br. 2.)

STATEMENT OF THE CASE

According to the Appellants, this case “relates to using an intelligent server to receive and manage opt-in requests for electronic certificates sent from [near field communication enabled mobile devices] that interface with touch points.” (Spec. 1, lines 11–13.)

*Illustrative Claim*²

1. A method for utilizing a consumer opt-in management system, the method comprising:

interfacing, via near field communications (NFC), an NFC enabled mobile device with a touch point associated with an electronic marketing program to obtain touch point identification information and a trigger management server (TMS) address identifier from the touch point, wherein the touch point identification information includes a tag location code (TLC) that indicates a location of the touch point;

receiving, by a TMS from the NFC enabled mobile device, an opt-in request message from the NFC enabled mobile device, wherein the opt-in request message includes both the TLC and a subscriber identifier associated with the NFC enabled mobile device and wherein the opt-in request message initiates communication between the NFC enabled mobile device and the TMS for subscribing to the electronic marketing program and is sent from a midlet in the NFC enabled mobile device to the TMS using the TMS address identifier, wherein the midlet is initiated in response to the interfacing of the NFC enabled mobile device with the touch point, and wherein the TMS includes a processor and memory unit;

accessing, by the TMS, a business rules database via a database query that includes the TLC from the opt-in request message to identify an electronic marketing program identifier; and

² This illustrative claim is quoted from the Claims Appendix (“Claims App.”) set forth on pages 49–54 of the Appeal Brief.

sending, by the TMS, the electronic marketing program identifier and the subscriber identifier to a content management server (CMS) in order to trigger the provisioning of content data associated with the electronic marketing program to the NFC enabled mobile device.

References

Lauper	US 2007/0016479 A1	Jan. 18, 2007
Rice	US 2011/0082746 A1	Apr. 7, 2011
Durvasula	US 2011/0264490 A1	Oct. 27, 2011

Rejections

I. The Examiner rejects claims 1, 3–19, and 21–37 under 35 U.S.C. § 101 as directed to ineligible subject matter. (Final Action 2.)

II. The Examiner rejects claims 1, 3–19, and 21–37 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. (*Id.* at 4.)

III. The Examiner rejects claims 1, 3–19, and 21–37 under 35 U.S.C. § 103(a) as unpatentable over Rice and Durvasula. (*Id.* at 6.)

IV. The Examiner rejects claims 17, 18, 35, and 36 under 35 U.S.C. § 103(a) as unpatentable over Rice, Durvasula, and Lauper. (*Id.* at 21.)

ANALYSIS

Claims 1, 19, and 37 are the independent claims on appeal, with the rest of the claims on appeal (i.e., claims 3–18 and 21–36) depending therefrom. (*See* Claims App.) Independent claim 1 recites “[a] method for utilizing a consumer opt-in management system,” independent claim 19 recites “[a] consumer opt-in management system,” and independent claim 37 recites “[a] computer readable medium.” (*Id.*)

Rejection I— 35 U.S.C. §101

Independent claim 1 recites a database-accessing step and an identifier-sending step. (Claims App.) In the database-accessing step, a server accesses “a business rules database via a database query that includes [a tag location code] from [an] opt-in request message to identify an electronic marketing program identifier.” (*Id.*) In the identifier-sending step, the server sends “the electronic marketing program identifier and [a] subscriber identifier to [another server] in order to trigger the provisioning of content data associated with the electronic marketing program to [a mobile device].” (*Id.*) Independent claims 19 and 37 recite similar database-accessing and identifier-sending limitations. (*Id.*)

The Examiner performs the *Alice* two-step analysis³ and concludes that the claimed invention “is directed to [an abstract idea] without significantly more.” (Final Action 2.)

The Appellants argue that the Examiner’s *Alice* analysis is incorrect and/or incomplete in that it “selectively references certain portions of the recited claim language” and “fails to address other elements and limitations recited in the claims.” (Reply Br. 3–4; *see also* Appeal Br. 13–15.) We are

³ In *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347 (2014), the Supreme Court reiterated the two-step framework previously set forth in *Mayo Collaborative Services v. Prometheus Labs., 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 these concepts.” *Alice*, 134 S. Ct. at 2355. The first step in the analysis is to “determine whether the claims at issue are directed to one of those patent-ineligible concepts.” *Id.* If so, the second step is to consider the elements of the claims “individually” and “as an ordered combination” to determine whether there are additional elements that “transform the nature of the claim” in a patent-eligible application. *Id.*

persuaded by these arguments because independent claim 1 also recites, *inter alia*, a touch-point-interfacing step. (Claims App.) In the touch-point-interfacing step, a mobile device interfaces “with a touch point associated with an electronic marketing program to obtain touch point identification information and [a server address] from the touch point.” (*Id.*) Independent claims 19 and 37 recite similar touch-point-interfacing limitations. (*Id.*)

With respect to the first step of the *Alice* analysis, the Examiner’s characterization of the directed-to concept of the Appellant’s claims is based only upon the database-accessing and identifier-sending limitations – the touch-point-interfacing limitation is not mentioned in this determination. (*See* Final Action 2.) Thus, the Examiner establishes, at most, that there may be a patent-ineligible principle underlying the claims (e.g., the comparison of new data to that in a database and the identification of options based upon this comparison). But this does not mean that the claims are “directed to” this concept.⁴ (*See* Final Action 2.) For this same reason, the Examiner’s proposed paralleling of the Appellants’ claims to those in the *SmartGene* case (*see id.*) is incongruous, as the *SmartGene* claims did not involve interfacing limitations.⁵

⁴ *See Rapid Litig. Mgmt. Ltd. v. CellzDirect, Inc.*, No. 2015–1570, 2016 WL 3606624 (Fed. Cir. July 5, 2016) (At *Alice* step one, “it is not enough to merely identify a patent-ineligible concept underlying the claim; we must determine whether that patent-ineligible concept is what the claim is ‘directed to.’”).

⁵ In *SmartGene, Inc. v. Advanced Biological Labs., SA*, 555 F. App’x 950, (Fed. Cir. 2014), the Federal Circuit addressed a claim that “does no more than call on a ‘computing device,’ with basic functionality for comparing stored and input data and rules, to do what doctors do routinely,” in the three recited steps of providing “patient information to a computing device,”

With respect to the second step of the *Alice* analysis, the Examiner implicates that the touch-point-interfacing limitation only involves elements that are conventional in wireless communication technology. (*See* Answer 6–7.) However, the Examiner does not adequately address the claimed arrangement and interaction of these touch-point-interfacing elements with the other elements recited in the claims.⁶ As such, the Examiner does not sufficiently show that the Appellants’ ordered combination of the claim elements does not amount to significantly more than an abstract idea.⁷

Thus, we do not sustain the Examiner’s rejection of claims 1, 3–19, and 21–37 under 35 U.S.C. § 101.

Rejection II – 35 U.S.C. §112

As indicated above, independent claims 1, 19, and 37 each recites an identifier-sending limitation wherein “[an] electronic marketing program

generating “a ranked listing of available therapeutic regimes” and generating “advisory information for one or more therapeutic treatment regimes in said ranked list.” *Id.* at 954–55.

⁶ *See BASCOM Global-Internet Services v. AT&T Mobility* (Fed. Cir. 2015-1736, June 27, 2016) (“The inventive concept inquiry requires more than recognizing that each claim element, by itself, was known in the art” as “an inventive concept can be found in the non-conventional and non-generic arrangement of known, conventional pieces”).

⁷ As such, the Examiner’s findings and determinations with respect to the second step of the *Alice* analysis, and particularly the “ordered combination” prong, would be incomplete even if the Appellants’ claims are directed to an abstract idea involving touch-point-interfacing aspects. Thus, for the purposes of this appeal we need not, and do not, construe the Appellants’ claims to determine whether they are directed to an abstract idea or other patent-ineligible subject matter.

identifier and [a] subscriber identifier” are sent to a server “in order to trigger the provisioning of content data associated with the electronic marketing program to [a mobile device].” (Claims App.)

The Examiner determines that the Specification does not “disclose the algorithm/s which the computer employs” to achieve the recited result of the identifier-sending limitation. (Final Action 4.) The Examiner therefore concludes that the Appellants are “asserting possession over a procedure that was not in [their] possession at the time of the invention.” (*Id.*)

The Appellants argue that the Specification, as filed, provides sufficient written description for the identifier-sending limitation in the independent claims. (*See* Appeal Br. 16–18.) We are persuaded by this argument because the original Specification contains a flow chart (Figure 2) and prose (pages 18–19) detailing the sending of the identifiers to the content management server and the triggering of the provisioning of the content data. This drawing and this description adequately demonstrate possession of the claimed procedure at the time the application was filed.⁸

Thus, we do not sustain the Examiner’s rejection of claims 1, 3–19, and 21–37 under 35 U.S.C. § 112, first paragraph.

Rejection III – 35 U.S.C. §103

As indicated above, independent claims 1, 19, and 37 each recites a touch-point-interfacing limitation wherein a mobile device interfaces with “a

⁸ *See In re Kaslow* 707 F.2d. 1366, 1375 (Fed. Cir. 1983) (“The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter”).

touch point.” (Claims App.) Independent claims 1, 19, and 37 also each recites a message-receiving limitation wherein “an opt-in request message” from the mobile device “initiates communication between [the mobile device] and [a server] for subscribing to the electronic marketing program.” (*Id.*)

The Examiner finds that Rice discloses a mobile device 106 that interfaces with a touch point (e.g., a beacon at a particular business location) and that sends a message that initiates communication with a server 108 for the purposes of opting into a feedback program. (*See* Final Action 6–7.)

The Appellants argue that, in Rice, server 108 “is responsible for initiating communication (e.g., via an opt-in request message) with a mobile device.” (Appeal Br. 19.) According to the Appellants, server 108 first determines the location of the mobile device and then subsequently sends an opt-in request to the mobile device based on its location. (*Id.*) We are not persuaded by this argument because Rice discloses that server 108 receives an indication when mobile device 106 moves into the proximity of the business location (e.g., is in range of the beacon), and that the server 108 can receive this indication “from the device 106.” (Rice ¶ 78.) Although this “indication” is not called an “opt-in” message, it nonetheless is a message that initiates communication between the mobile device 106 and the server 108. As noted by the Examiner, the “opt-in request message” is “data” that once received by the trigger management server, initiates a process for subscribing the user to the electronic marketing program. (*See* Answer 17.)

Independent claims 1, 19, and 37 also each requires the opt-in request message to be “sent from a midlet.” (Claims App.) The Examiner finds that

Rice's mobile device 106 "must have some mechanism [midlet application] which is capable of transmitting data." (Answer 9, brackets in original.)

The Appellants argue that Rice "is completely silent with respect to a midlet in a [near field communication] enabled device." (Appeal Br. 24.) We are not persuaded by this argument because Rice discloses that the location indicator (i.e., the data that initiates communication between the mobile device 106 and the server 108) can be "submitted by a user of the device 106 via a feedback or rating application." (Rice ¶ 79.) The Appellants do not adequately address why one of ordinary skill in the art would not appreciate that, in Rice, the mechanism for transmitting the communication-initiation data could comprise a midlet application.

Independent claims 1, 19, and 37 further each require that the midlet be "initiated in response to the interfacing of the [mobile device] with the touch point." (Claims App.) As discussed above, Rice teaches that mobile device 106, upon moving into range of a beacon at the business location (i.e., touch point), sends a location indication to the server 108. And as also discussed above, the Appellants do not adequately address why one of ordinary skill in the art would not appreciate that the mechanism for transmitting this data could comprise a midlet application.

Thus, we sustain the Examiner's rejection of independent claims 1, 19, and 37 under 35 U.S.C. § 103.

Dependent Claims 8, 13, 14, 16, 26, 31, 32, and 34

These dependent claims are not argued separately or further from claims 1 and 19 for this rejection (*see* Appeal Br. 27, 30, 31, 36, 39, 40); and thus we sustain the Examiner's rejection of dependent claims 8, 13, 14, 16, 26, 31, 32, and 34 under 35 U.S.C. § 103.

Dependent Claims 3 and 21

Dependent claims 3 and 21 each recites a determination, at a content management server, of “the appropriate content provider server that contains the content data.” (Claims App.) The Examiner finds that Rice discloses such a determination. (*See* Final Action 11–12.)

The Appellants argue that there is no teaching or suggestion in Rice “that either [server 108] or [server 104] is responsible for determining an appropriate content provider server that contains the content data.” (Appeal Br. 25–26, 34–35.). We are not persuaded by this argument because the Appellants do not adequately address the Examiner’s findings regarding Rice’s promotion server 110 (*see* Answer 19–20) which “generates the promotion based upon the actual content of the feedback” (Rice ¶ 110).

Thus, we sustain the Examiner’s rejection of dependent claims 3 and 21 under 35 U.S.C. § 103.

Dependent Claims 4–6 and 22–24

These dependent claims 4–6 and 22–24 are not argued separately or further from claims 3 and 21 for this rejection (*see* Appeal Br. 26, 35); and thus we sustain Examiner’s rejection of dependent claims 4–6 and 22–24 under 35 U.S.C. § 103.

Dependent Claims 7 and 25

Dependent claims 7 and 25 each recites that “the content provider server is indicated as an authenticated source by a content management server.” (Claims App.) The Examiner finds that Rice discloses such an authentication. (*See* Final Action 14.)

The Appellants argue there is no teaching or suggestion in Rice of “a content provider being authenticated.” (Appeal Br. 36.) We are not

persuaded by this argument because Rice discloses “verification modules” that “determine if information requests come from authorized requestors” (Rice ¶ 70); and the Appellants do not adequately address the Examiner’s finding that such information requests can come from “the content provider server” (Answer 21).

Thus, we sustain the Examiner’s rejection of dependent claims 7 and 25 under 35 U.S.C. § 103.

Dependent Claims 9 and 27

Dependent claims 9 and 27 each recites a determination “if the server carrier is blocked from participation in the electronic marking program.” (Claims App.) The Examiner finds Rice teaches such a determination. (*See* Final Action 15–16.)

The Appellants argue that Rice discloses a determination of what features/services a user is entitled to request/use, but “is silent with respect to determining whether a service carrier itself is blocked from participating in an electronic marketing program.” (*See* Appeal Br. 27–28.) We are not persuaded by this argument because the Examiner explains that, by determining the services supported by an account/device, “this step is inherent in the method disclosed by Rice” (Final Action 16); and the Appellants do not adequately address Rice’s inherent teaching (or lack thereof) in this regard.

Thus, we sustain the Examiner’s rejection of dependent claims 9 and 27 under 35 U.S.C. § 103.

Dependent Claims 10 and 28

Dependent claims 10 and 28 each recites “preventing the transmission of the requested electronic certificate to [the mobile device] of the service

carrier is not participating in the electronic marketing program.” (Claims App.) The Examiner finds that Rice teaches such a prevention. (*See* Final Action 17.)

The Appellants argue that Rice does not teach the recited prevention and “instead discloses that [server 108] uses billing information of a user to adjust functionality of [server 108].” (Appeal Br. 37.) We are not persuaded by this argument because the Appellants do not adequately address the Examiner’s finding that “billing is tied to a carrier” and therefore Rice’s system has “the capability to enable or disable functionality based on information from a carrier.” (Answer 23.)

Thus, we sustain the Examiner’s rejection of dependent claims 10 and 28 under 35 U.S.C. § 103.

Dependent Claims 11 and 29

Dependent claims 11 and 29 each recites that “the touch point includes at least one of a smart poster, a bar code poster, a short code poster, a point of sale device, a parking meter, a shelf tag, and an Internet advertisement.” (Claims App.) The Examiner finds that Rice teaches such a touch point. (*See* Final Action 17.)

The Appellants argue that Rice fails to teach a touch point, and “instead discloses that [mobile device 106] includes a communication component 222 that can facilitate wireless communications.” (Appeal Br. 38.) We are not persuaded by this argument because communication component 222 interfaces with a location server 104 (that determines and reports the location of mobile device 106) via near-field communications and/or radio frequency (*see* Rice ¶¶ 37, 52); and the Appellants do not adequately address the

Examiner's finding that such a location server 104 can be considered one of the recited touch-point devices (*see* Answer 23–24).

Thus, we sustain the Examiner's rejection of dependent claims 11 and 29 under 35 U.S.C. § 103.

Dependent Claims 12 and 30

Dependent claims 12 and 30 each recites “the touch point identification information includes at least one of content provider code [] and the tag location code [] associated with the touch point.” (Claims App.) The Examiner finds that Durvasula discloses such identification information. (*See* Final Action 17–18.)

The Appellants argue that Rice fails to teach this and instead discloses “identifiers associated with a product and/or a user.” (Appeal Br. 38.) We are not persuaded by this argument because “the Examiner does not rely upon Rice to teach the argued feature” as “the Examiner has relied upon Durvasula.” (Answer 24.)

Thus, we sustain the Examiner's rejection of dependent claims 12 and 30 under 35 U.S.C. § 103.

Dependent Claims 15 and 33

Dependent claims 15 and 33 each recites “the request message includes a timestamp indicating the date and time the mobile device interfaced with the touch point.” (Claims App.) The Examiner finds that Rice discloses such a timestamp. (*See* Final Action 19–20.)

The Appellants argue that Rice “instead discloses a timestamp corresponding to the time in which the subscriber provides the feedback” and this would occur sometime “after the subscriber enrolled or opted into the feedback program.” (Appeal Br. 30.) We are not persuaded by this

argument because the Appellants do not adequately address the Examiner's finding that "Rice teaches that the feedback response may take the place of a separate opt-in request" (Answer 25) in which case the opt-in request would include a timestamp.

Thus, we sustain the Examiner's rejection of dependent claims 15 and 33 under 35 U.S.C. § 103.

Rejection IV – 35 U.S.C. §103

As indicated above, independent claims 1 and 19 each recites a touch-point-interfacing limitation wherein a mobile device interfaces with a touch point and an identifier-sending limitation wherein the provisioning of content data is triggered. (Claims App.) As also indicated above, claims 3 and 21 (which depend from independent claims 1 and 19) each recites a determination, at a content management server, of "the appropriate content provider server that contains the content data." (*Id.*)

Dependent Claims 17 and 35

Dependent claims 17 and 35 (which depend from claims 3 and 21) each recites that "the touch point is located at a merchant location and the content data contained in the content provider server is associated with the merchant location." (Claims App.) The Examiner finds that Lauper, in combination with Rice and Durvasula, teaches such a touch-point location and such location-associated content data. (*See* Final Action 21–22.)

The Appellants argue that Lauper "instead discloses the location of the user" which "is not the same as the merchant location." (Appeal Br. 44.) We are not persuaded by this argument because the Examiner relies upon Rice to teach that "beacons [touch points] are associated with entities and entity locations" (Answer 26) and Lauper teaches that different information

can be accessed depending on location (*see* Lauper ¶ 72). The Appellants do not adequately address the Examiner’s combination of the teachings of the prior art references.

Thus, we sustain the Examiner’s rejection of dependent claims 17 and 35 under 35 U.S.C. § 103.

Dependent Claims 18 and 36

Dependent claims 18 and 36 (which depend from claims 3 and 21) each recites that “the content provider server is authenticated by the content management server to avoid delivery of spam content to [the mobile device].” (Claims App.) The Examiner finds that Rice discloses such an authentication. (*See* Final Action 22.)

The Appellants argue that Rice “fails to make any teaching or suggestion with respect spam content.” (Appeal Br. 45.) We are not persuaded by this argument because Rice discloses verification modules that determine “if information requests come from authorized requestors” and/or “if the information is likely being requested for a legitimate purpose” (Rice ¶ 70); and the Appellants do not adequately address the Examiner’s finding that such determinations would avoid the delivery of span (*see* Answer 28).

Thus, we sustain the Examiner’s rejection of dependent claims 18 and 36 under 35 U.S.C. § 103.

DECISION

We REVERSE the Examiner's rejection of claims 1, 3–19, and 21–37 under 35 U.S.C. § 101.

We REVERSE the Examiner's rejection of claims 1, 3–19, and 21–37 under 35 U.S.C. § 112, first paragraph.

We AFFIRM the Examiner's rejections of claims 1, 3–19, and 21–37 under 35 U.S.C. § 103.

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