UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
11/849,210	08/31/2007	Gregory T. Byrd	RSW920070131US1 (304)	5210

46320 7590 02/09/2018		

CRGO LAW
STEVEN M. GREENBERG
7900 Glades Road
SUITE 520
BOCA RATON, FL 33434

EXAMINER
MCCORMICK, GABRIELLE A

ART UNIT	PAPER NUMBER
3629	

NOTIFICATION DATE	DELIVERY MODE
02/09/2018	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docketing@crgolaw.com

UNITED STATES PATENT AND TRADEMARK OFFICE

———————

BEFORE THE PATENT TRIAL AND APPEAL BOARD

———————

Ex parte GREGORY T. BYRD, MICHAEL G. McINTOSH,
NATARAJ NAGARATNAM, and ANTHONY J. NADALIN

———————

Appeal 2016-006652[1]
Application 11/849,210[2]
Technology Center 3600

———————

Before MURRIEL E. CRAWFORD, BIBHU R. MOHANTY, and
JAMES A. WORTH, *Administrative Patent Judges*.

WORTH, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's final
rejection of claims 1, 5–9, 11–13, and 17–20. We have jurisdiction under
35 U.S.C. §§ 134 and 6(b).

We AFFIRM.

Introduction

Appellants' application relates to "the field of data privacy and identity management in a computer communications network, and more p articularly [sic] to data parsimony in pseudonymous e-commerce transactions." Spec. ¶ 1.

Claims 1, 9, and 13 are the independent claims on appeal. Claim 1, reproduced below, is illustrative of the subject matter on appeal:

> 1. A method for trusted statement verification for data privacy within a voucher service data processing system communicatively coupled to one or more end users computing devices and one or more voucher consumers computing devices, the method comprising:
>
> deducing, by a processor of a computer in the voucher service data processing system, a claim according to a rule in a rule base from an attribute of personal data received from an end user from an end user computing device;
>
> receiving, by the processor of the computer, a request from a voucher consumer computing device issued via an exposed application programming interface over a computer communications network to vouch for an assertion based upon the attribute;
>
> comparing the assertion to the claim to determine whether the claim supports the assertion; and,
>
> providing a voucher for the assertion to the voucher consumer computing device on behalf of the end user upon determining that the claim supports the assertion without revealing the attribute to the voucher consumer computing device, wherein providing the voucher comprises providing the voucher in the form of a secure token over the computer communications network to the voucher consumer computing device, where the secure token does not include the attribute.

(Appeal Br. 17, Claims App.)

Rejections on Appeal

The Examiner maintains, and Appellants appeal, the following rejections:

I.   Claims 1, 5–9, 11–13, and 17–20 stand rejected under 35 U.S.C. § 101 as being directed to an abstract idea.

II.   Claims 1, 5–9, 11–13, and 17–20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Korosec (US 2003/0056113 A1, pub. Mar. 20, 2003), Sweeney (US 2002/0169793 A1, pub. Nov. 14, 2002), and Prafullchandra (US 2007/0261116 A1, pub. Nov. 8, 2007).

ANALYSIS

Rejection I (Unpatentable Subject Matter)

Claims 1, 5–9, 11–13, and 17–20

The Court in *Alice* emphasized the use of a two-step framework for analysis of patentability under 35 U.S.C. § 101:

> First, we 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, we 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.

See Alice Corp., Pty. Ltd. v CLS Bank Intl, 134 S. Ct. 2347, 2355 (2014) (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66 (2012)).

The Examiner determines that claims 1, 5–9, 11–13, and 17–20 are directed to deducing a claim according to a rule in a rule base from an attribute of data, which is comparing new and stored information and using rules to identify options. Final Act. 2–3. The Examiner determines that this is an abstract idea. *Id.*

The Examiner further determines that the limitations of receiving a request via an API and providing a voucher in the form of a secure token are well-known, routine and conventional practices that require no more than a generic computer to perform generic computer functions. *Id.* at 3. The Examiner determines that the claims do not include additional elements that are sufficient to amount to significantly more than the judicial exception because the claims do not recite an improvement to another technology or technical field, an improvement to the functioning of the computer itself, or meaningful limitations beyond generally linking the use of an abstract idea to a particular technological environment. *Id.*

Appellants contend that the Examiner has engaged in too high a level of abstraction, untethered from the claim language, in characterizing the claimed invention. Reply Br. 5 (citing *Robert W. Bahr, Memorandum — Recent Subject Matter Eligibility Decisions (Enfish, LLC v. Microsoft Corp. and TLI Communications LLC v. A.V. Automotive, LLC)*, p. 1 (USPTO May 19, 2016) (hereinafter, "Memorandum on *Enfish*"). Specifically, Appellants argue that the claimed invention is not directed to comparing new and stored information and using rules to identify options, but rather using rules in a computer communications network to deduce (or generate) a claim from an attribute. Appeal Br. 8–10. Appellants assert that independent claim 1 requires the specific performance of the following steps in a process:

First, a processor of a computer in the voucher service data processing system deduces a claim according to a rule in a rule base from an attribute of personal data received from an end user from an end user computing device.

Second, the processor of the computer receives a request from a voucher consumer computing device issued via an exposed application programming interface over a computer communications network to vouch for an assertion based upon the attribute.

Third, the assertion is compared to the claim to determine whether the claim supports the assertion.

Fourth, a voucher for the assertion is provided to the voucher consumer computing device on behalf of the end user upon determining that the claim supports the assertion without revealing the attribute to the voucher consumer computing device.

Reply Br. 6–7.

We agree with Appellants that the Examiner *may* have stated the invention too broadly. We determine that the claimed invention is directed to using an intermediary to vouch for a consumer's qualifications, upon request, without divulging a consumer's actual information. We determine that this idea embodies a fundamental economic principle, as described, for example, in the Specification, i.e., a bank may vouch that a consumer has a bank account value above a threshold. *See* Spec. ¶ 20 (discussing prior art sought to be improved). Such a claimed invention resembles others that have been found to be fundamental economic principles. *See, e.g., Credit Acceptance Corp. v. Westlake Servs.*, 859 F.3d 1044, 1054 (Fed. Cir. 2017) (claims directed to abstract idea of processing an application for financing a purchase held unpatentable) ("We see no meaningful distinction between this type of financial industry practice and 'the concept of intermediated

settlement' held to be abstract in *Alice*, 134 S.Ct. at 2356, or the 'basic concept of hedging' held to be abstract in *Bilski v. Kappos*, 561 U.S. 593 . . .").

The claimed invention is also abstract because it relates to the processing of information using generic computer technology. *See, e.g., Electric Power Group, LLC v. Alstom S.A.*, 830 F.3d 1350, 1354 (Fed. Cir. 2016) ("gathering and analyzing information of a specified content, then displaying the results, and not any particular assertedly inventive technology for performing those functions"); *see also Two-Way Media, Ltd. v. Comcast Cable Communications, LLC*, 874 F.3d 1329, 1337 (Fed. Cir. 2017) (agreeing with district court that claim was directed to abstract idea of sending information, directing sent information, monitoring the receipt of the sent information, and accumulating records about receipt of the sent information); *Smart Systems Innovations, LLC v. Chicago Transit Authority*, 873 F.3d 1364, 1372 (Fed. Cir. 2017) (claims directed to formation of financial transactions in a particular field (i.e., mass transmit) and data collection related to such transactions, which is an abstract idea).

According to Appellants, the claimed invention is directed to "an *improvement . . . [in] computer functionality* versus being directed to an abstract idea." Reply Br. 3 (internal citation omitted); *see also id.* at 2–7. Appellants argue that the Examiner erred by "automatically doom[ing]" a claim simply because of the ability of an invention to "run on a general purpose computer." Reply Br. 5 (citing Memorandum on *Enfish* at 1). However, we agree with the Examiner that the claimed invention does not require anything more than conventional components. *See* Final Act. 4. The claims do not recite, and the Specification does not disclose, any

particular structures other than referring to an "application programming interface," which the Examiner correctly finds to be a generic structure. A review of the Specification reveals that the Specification does not provide any detailed approach for the claimed method and system of vouching. As such, the claimed invention does not resemble that at issue in *Enfish*, where there was an improvement in computer capabilities, i.e., based on a self-referential table for a computer database. *See Enfish*, 822 F.3d at 1336; *see also* Memorandum on *Enfish*, at 1–2 ("a claim directed to an improvement to computer-related technology (*e.g.*, computer functionality) is likely not similar to claims that have previously been identified as abstract by the courts").

Appellants argue that the claimed invention cannot be performed using mental steps and that the claimed invention is not an idea in itself, as described in the *USPTO 2014 Interim Guidance of Patent Subject Matter Eligibility* (December 16, 2014) and *July 2015 Update: Subject Matter Eligibility*) (hereinafter, "Update"). Appeal Br. 8–9. According to the Update, "[t]he phrase 'an idea 'of itself,'' is used to describe an idea standing alone such as an uninstantiated concept, plan or scheme, as well as a mental process (thinking) that 'can be performed in the human mind, or by a human using a pen and paper.'" Update, at 5 (internal citation omitted). Even under Appellants' argument that the claimed invention requires the use of a computer, mere application of an abstract idea on a computer system does not make a claimed invention patentable. *See Electric Power Group, LLC v. Alstom S.A.*, 830 F.3d 1350, 1353–54 (Fed. Cir. 2016) (no particular assertedly inventive technology for performing functions). At most, the claims (and Specification) refer to the use of three

computers on a network without providing specific instructions for implementation, and without more than reciting generic processes. *See* claim 1 and Spec. ¶¶ 17–21.

Appellants argue that deducing a claim from an attribute constitutes a transformation. Appeal Br. 10. The Supreme Court has rejected the "machine-or-transformation" test as the sole test for patentable subject matter. *Bilski v. Kappos*, 561 U.S. 593, 603–04 (2010). Nevertheless, the Federal Circuit has explained that the presence of a machine or transformation may be considered as a "useful clue" as part of the second step of the *Alice* framework. *Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 716 (Fed. Cir. 2014) (internal quotation marks and citation omitted). In this case, the transformation is from one idea into another, e.g., transforming an attribute into a claim and then into a voucher based on a comparison with an assertion. As such, the transformation relates to abstract ideas and is itself abstract. *See also Smart Sys. Innovations, LLC v. Chicago Trust Authority*, 873 F.3d 1368, 1371–72 (the Asserted Claims of the '003 and '617 patents involve verifying validity of bankcard, which are part of an abstract idea); *Prism Techs. LLC v. T-Mobile USA, Inc.*, Case No. 2016-2031, -2049, 696 F. App'x 1014, 1017 (Fed. Cir. June 23, 2017) (non-precedential) (claim directed to abstract idea of providing restricted access to resources); *EasyWeb Innovations, LLC v. Twitter, Inc.*, Case No. 2016-2066, 689 F. App'x 969, 971 (Fed. Cir. May 12, 2017) (non-precedential) (claim directed to abstract idea of receiving, authenticating, and publishing data).

For the above reasons, we agree with the Examiner that the claimed invention is directed to an abstract idea of a fundamental economic principle, even if a computer is required for its performance, as argued. We

have reviewed the additional limitations of "deducing," "receiving," "comparing," "providing," and conclude that they are directed to the same abstract idea of vouching and, therefore, do not add significantly more, taken individually or as a whole, to remove the invention from the realm of the abstract. Accordingly, we sustain the Examiner's rejection under § 101 of independent claim 1.

With respect to the remaining claims, we have reviewed the additional limitations, e.g., of "retrieving a policy," "filtering the claim," "augmenting the claim," "wherein the assertion is a required bank account balance," and "wherein the assertion is a required age," and conclude that they are also directed to the same abstract idea of vouching and, therefore, do not add significantly more, taken individually or as a whole, to remove the invention from the realm of the abstract.

We have reviewed the additional limitations of claims 5–9, 11–13, and 17–20, e.g., "retrieving," "filtering," "augmenting," and various "wherein" clauses relating to the type of information being processed. We determine that these additional limitations, taken individually or as a whole, are directed to the same abstract idea of vouching and do not add significantly more to remove the claimed invention from the realm of the abstract. Thus, for similar reasons as independent claim 1, we sustain the Examiner's rejection under § 101 of independent claims 9 and 13 and dependent claims 5–8, 11, 12, and 17–20.

Rejection II (Obviousness)

We are persuaded by Appellants' argument that Korosec fails to disclose a "voucher consumer computing device," as recited in independent

claim 1, i.e., "receiving, by the processor of the computer, a request from a voucher consumer computing device issued via an exposed application programming interface over a computer communications network to vouch for an assertion based upon the attribute." *See* Appeal Br. 12 n.4. Appellants contend that Korosec's input device and output device facilitate identification of an entity or communication to a user, but do not request that a processor vouch for an attribute, as recited. *See id.* (citing Korosec ¶¶ 30, 41, Fig. 3; Final Act. 5).

The Specification indicates a desire to improve on problems in the art when a third-party intermediary vouches for a consumer, on behalf of consumer, in an interaction with a bank. Spec. ¶¶ 6–7. Independent claim 1 recites a method performed by at least three computing structures: (1) at least one end user computing device; (2) a processor; and (3) at least one voucher consumer computing device. One step recites that the processor receives a request to vouch for a claim from a voucher consumer computing device. A further step recites that a component provides a security voucher back to the voucher consumer computing device based on attribute information received from at least one end user computing device. In other words, the claims require that the same device that receives the voucher also makes a prior request for the voucher.

The Examiner relies on Korosec's input component 130 and output device 250 for providing a request for a voucher. Final Act. 5 (citing Korosec ¶¶ 30, 41); Ans. 4. Although the processor communicates a voucher to the output device for a claim based on an attribute, Korosec does not disclose that the output device provides a request to a processor for the voucher. *See* Korosec ¶¶ 30, 41, Fig. 5. The Examiner does not rely on

Sweeney or Prafullchandra to remedy the argued deficiency. We, therefore, do not sustain the Examiner's rejection under § 103(a) of independent claim 1 and claims 5–8, which depend therefrom.

Independent claims 9 and 13 contain similar language and requirements as independent claim 1. For similar reasons as for independent claim 1, we do not sustain the Examiner's rejection under § 103(a) of independent claims 9 and 13 and claims 11, 12, and 17–20, which depend therefrom.

DECISION

The Examiner's decision to reject claims 1, 5–9, 11–13, and 17–20 under 35 U.S.C. § 101 is affirmed.

The Examiner's decision to reject claims 1, 5–9, 11–13, and 17–20 under 35 U.S.C. § 103(a) is reversed.

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