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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JEFFREY B. WILLIAMS and ALLAN CAMAISA¹

Appeal 2016-006657
Application 13/386,546
Technology Center 3600

Before ROBERT E. NAPPI, TERRENCE W. McMILLIN, and
ALEX S. YAP, *Administrative Patent Judges*.

NAPPI, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1 through 19 and 21. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ According to Appellants, the real party in interest is Anakam Inc, a subsidiary of Equifax Inc. App. Br. 1.

INVENTION

Appellants' disclosed invention is directed to remotely confirming the identity of an individual with a high level of confidence. Specification, 0006. Claim 1 is representative of the invention and reproduced below.

1. A method of real-time remote identity proofing a user, the method comprising:

querying, by a network device, data sets, wherein the network device queries the data sets using biographic data received through a web interface from the user located remotely from the network device;

assembling, based on at least one result receiving in response to querying the data sets, government-issued identification cards associated with the user, financial accounts associated with the user, and telephone numbers associated with the user;

generating, by the network device, a list of types of the government-issued identification cards associated with the user and a government-issued identification card interface for receiving a number for a government-issued identification card that is the same type as the type selected by the user from the list of the types of the government issued identification cards associated with the user;

generating, by the network device, a list of types of the financial accounts associated with the user and a financial accounts interface for receiving a number for a financial account that is the same type as the type selected by the user from the list of the types of the financial accounts associated with the user;

generating, by the network device, a list of partially-obscured telephone numbers that includes at least one partially-obscured telephone number corresponding to a telephone number associated with the user and at least one dummy partially-obscured telephone number that does not correspond to any telephone numbers associated with the user; and

responsive to receiving via a network a selection by the user of the at least one partially-obscured telephone number,

(i) placing, by the network device, a call to the user at the telephone number associated with the user and corresponding to

the at least one partially obscured telephone number;

(ii) generating, by the network device, an interface that includes an identity-proofing transaction number for the user; and

(iii) transmitting, by the network device, a prompt to the user to enter the identity-proofing transaction number from the user via a telephone network.

REJECTIONS AT ISSUE²

The Examiner has rejected claims 1 through 19 and 21 under 35 U.S.C. § 112(b), as being indefinite.³ Final Act. 4–5. Answer 2.

The Examiner has rejected claims 1 through 19 and 21 under 35 U.S.C. § 101 for being directed to patent-ineligible subject matter. Final Act. 5–6. Answer 2.

ANALYSIS

We have reviewed Appellants' arguments in the Briefs, the Examiner's rejections, and the Examiner's response to Appellants' arguments. Appellants' arguments have not persuaded us of error in the Examiner's rejection under 35 U.S.C. § 112 or under 35 U.S.C. § 101.

Rejection under 35 U.S.C. § 112(b)

² Throughout this Decision we refer to the Appeal Brief filed October 21, 2015, Reply Brief filed June 21, 2016, Final Office Action mailed April 2, 2015, Appellants' Specification submitted January 23, 2012, and the Examiner's Answer mailed April 21, 2016.

³ The Examiner identifies that the rejection in the Final Action inadvertently included canceled claim 20 and did not include claim 21. Answer 2

Appellants argue the Examiner's rejection of independent claims 1, 7 and 14 as being ambiguous is in error because, when interpreted in light of the specification, the claims are clear. Appeal Br. 8–9. Specifically, Appellants argue that the specification discusses assembling all “available government issued identify information” and that the skilled artisan would ascertain that the limitation of “assembling... government issue identification cards” involves assembling information from these government issued identified cards. Appeal Br. 9.

We are not persuaded of error in the Examiner's rejection by Appellants' argument. The Examiner states:

The claim limitation at issue could reasonably be interpreted in several different ways and involve a myriad of modalities ... using a human being to ‘assemble’ the various ID cards in a situation where a person applies for authentication services is just one example of a reasonable interpretation. Rather than providing a simple fix to clarify the claim and solve the problem of multiple interpretations, Appellant wants to maintain a broad limitation capable of multiple interpretations.

Answer 2–3. We concur with the Examiner that the claim limitation is ambiguous and could be reasonable interpreted in several manners. The limitation could be interpreted as: merely an assembling of government issued identification cards; collecting required parts to create the cards; creating a group of cards; or, as Appellants assert, requiring obtaining information from the cards. These four interpretations are very different concepts and not merely narrower or broader versions of the same concept. They do not all require obtaining information from the cards. “[I]f a claim is amenable to two or more plausible claims constructions, the USPTO is

justified in requiring the application to more precisely define the metes and bounds of the claimed invention by holding the claim unpatentable under 35 U.S.C. § 112 second paragraph.” *Ex Parte Miyazaki*, 89 USPQ2d 1207, 1211 (BPAI 2008) (precedential); *see also Ex Parte McAward*, 2017 WL 3669566 (PTAB 2017) (precedential). Thus, we disagree with Appellants’ assertion that the multiple interpretations are directed to a breadth issue not an indefiniteness issue. Reply Brief 2. For these reasons, we affirm this rejection of all pending claims.

Rejection under 35 U.S.C. § 101

PRINCIPLES OF LAW

Patent-eligible subject matter is defined in § 101 of the Patent Act, which recites:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

There are, however, three judicially created exceptions to the broad categories of patent-eligible subject matter in § 101: laws of nature, natural phenomena, and abstract ideas. *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2354 (2014); *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 70 (2012). Although an abstract idea, itself, is patent-ineligible, an application of the abstract idea may be patent-eligible. *Alice*, 134 S. Ct. at 2355. Thus, we must 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.” Id. (citing Mayo, 566 U.S. at 78–80). The claim must contain elements or a combination of elements that are “sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [abstract idea] itself.” Id. (citing Mayo, 566 U.S. at 72–73).

The Supreme Court sets forth a two-part “framework for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts.” Id. at 2355.

First, we determine whether the claims at issue are directed to one of those patent-ineligible concepts. [Mayo, 566 U.S. at

76–77]. If so, we then ask, “[w]hat else is there in the claims before us?” Id., at [77–78]. 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. Id., at [77–78]. We have 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.” Id., at [71–73].

Id.

Appellants argue, on pages 11 through 13 and 16 through 20 of the Appeal Brief and pages 3 through 7, 11 and 12 of the Reply Brief, that the Examiner has not established the claims are directed to an abstract idea. Appellants argue that the Examiner has failed to provide an explanation as to how the claims constitute an abstract idea. App. Br. 12–13, Reply Br. 4–

12.⁴ Further, Appellants cite to a recent decision Board decision, and argue that current claims are similar to claims held to be non-abstract. App. Br. 17–20 (citing *T.Rowe Price Inv. Services, Inc. v. Secure Access LLC.*, CBM2015-00027, Paper 9, 20–31 (PTAB June. 22, 2015)).

The Examiner provides a detailed response to Appellants’ arguments on pages 3 through 10 of the Answer, providing a rationale to support the finding that the claims are directed to an abstract idea. Specifically, the Examiner finds that the steps of assembling and the three generating steps are steps of collecting data and compiling data. Answer 5–6. Further, the Examiner finds the step of querying is also a step of storing and transmitting information, which is similar to concepts identified by the courts as abstract. Answer 6 (citing *2014 Interim Guidance on Patent Subject Matter Eligibility*, 79 Fed. Reg. 74618 (Dec. 16, 2014); *SmartGene, Inc. v. Advanced Biological Labs., SA*, 555 Fed. App’x 950, 954 (Fed. Cir. 2014) (non-precedential); *Cyberfone Sys., LLC v. CNN Interactive Grp.*, 558 Fed. Appx. 988 (Fed. Cir. 2014); and *Digitech Image Techs., LLC v. Elecs. for Imaging, Inc.* 758 F.3d 1344 (Fed Cir. 2014)).

We concur with the Examiner that these limitations are directed to steps of collecting, compiling, storing, and transmitting information and are similar to steps held by the courts to recite abstract ideas. These limitations

⁴ Appellants’ arguments, on pages 4 through 6 of the Reply Brief, asserting that, because the Examiner’s Answer makes new findings, the rejection should be reversed is not persuasive of error. Whether the Examiner made new findings, and as such made a new rejection, relates to a petitionable matter and not an appealable matter. *See* 37 C.F.R. §41.40(a). Appellants failed to timely file such a petition and therefore have waived the argument that the rejection must be designated as a new ground of rejection. *See* 37 C.F.R. §41.40(a).

are also similar to those at considered to be abstract by the court in *Electric Power Group*, 830 F.3d at 1354 (holding that claims directed to a process of gathering and analyzing information of a specific content are directed to an abstract idea) and *Content Extraction and Transmission LLC. v. Wells Fargo Bank, Nat'l Ass'n*, 776 F.3d 1343, 1347 (Fed. Cir. 2014) (holding that the claims were “drawn to the abstract idea of 1) collecting data, 2) recognizing certain data within the collected data set, and 3) storing that recognized data in a memory.”). In *Electric Power Group*, the court stated “we have treated collecting information including when limited to particular content (which does not change its character as information), as within the realm of abstract ideas.” *Id.* at 1353. Further, the court stated that “merely presenting the results of abstract processes of collecting and analyzing information, without more (such as a identifying a particular tool for presentation), is abstract as an ancillary part of such collection and analysis.” *Id.* at 1354.

The Examiner finds that the limitations directed to: receiving a selection of a partially obscured telephone number, placing a call to the selected number, generating a transaction number, and transmitting a prompt to enter the transaction number are directed to basic and ubiquitous forums of a typical challenge/response type interaction. Answer 6–7 (citing examples of a school verifying a student’s absence note). Further, the Examiner also finds that supplementing the verification and authentication challenge of a person’s identity with other information is a concept that has been long established in human intercourse. Answer 6–7.

We concur with the Examiner that the limitations to receiving a selection of a partially obscured telephone number, placing a call to the selected number, generating an interface that includes an identity-proofing

transaction number, and transmitting a prompt to enter the transaction number all represent an abstract idea. These limitations represent activities of human interaction, which are being facilitated via technology.

Organizing human activities has been considered to be an abstract idea and use of computer and technology does not amount to significantly more.

“Because they [computers] are the basic tools of modern-day commercial and social interaction, their use should in general remain “free to all men and reserved exclusively to none,” *Ultramerical Inc. v. Hulu* 772 F3d 709, 723 (2014) (Meyer concurring) (citing *Funk Bros. Seed Co. v. Kalo Inoculant Co.*, 333 U.S. 127, 130, 68 S.Ct. 440, 92 L.Ed. 588 (1948); and *Alice*, 134 S.Ct. at 2354). That some of the information is redacted (partially obscuring phone number) or that the password for the challenge/response (identify-proofing transaction number) is communicated via a different communication session/modalities (i.e., to user by network from user via telephone) does not make the interaction any less abstract. Use of passwords in a challenge/response is the nature of the challenge response concept. To use different communication session/modalities for the password is also well known (i.e. inform a user of a password in a communication separate from the communication they are using it in for authentication) and it would be pointless to have it in the same communication session modality.

Further, Appellants’ arguments comparing the claims on appeal with those discussed in the Board’s decision in *T.Rowe Price Inv.*, on pages 16 through 20 of the Appeal Brief, are not persuasive of error. The decision in that case is not precedential and as such not binding on this proceeding.

Also there are significant difference between the claims at issue in that case

and the claims under appeal. Thus, Appellants have not persuaded us the Examiner erred in concluding the claims are directed to an abstract idea.

Appellants argue on pages 13 through 16 of the Appeal Brief that the Examiner has not explained why the claims do not amount to significantly more. Appellants assert on pages 20 through 22 of the Appeal Brief that the claims do recite significantly more as they are directed to identity proofing a remote user which is a technical field of authenticating a user that access a computer network. Appellants assert this is a problem arising from the use of a data network and as such the claims recite significantly more than an abstract idea. Appeal Br. 21.

The Examiner provides a comprehensive response to these arguments on pages 7 through 9 of the Answer. The Examiner finds that the Appellants have “merely made use of modern communications systems via computer networks to provide the supplemental information channels commonly used in identity proofing.” Answer 8. As such, the Examiner concludes that the claims do not recite significantly more than the abstract concept.

We have reviewed the Examiner’s response and concur with the Examiner that representative claim 1 does not recite significantly more than the abstract idea discussed above. Appellants’ arguments that the claims are directed to identity proofing a remote user which is a technical field of authenticating a user are not persuasive. The preamble of claim 1 recites, “remote identity proofing a user.” However, the remainder of the claim recites steps which involve gathering data and do not recite any process by which the authentication of the user is performed (i.e., there is no step(s) which recites using the gathered data to prove the identity of the user). Thus, we do not consider the mere recitation in the preamble of identity

proofing a user, to be sufficient to demonstrate that the claim is reciting something more than an abstract idea.⁵

Additionally, Appellants argue that the lack of a novelty or obviousness rejection demonstrates that the claims recite more than an abstract idea. Appeal Br. 22–24. We are not persuaded of error by these arguments. The question in step two of the *Alice* framework is not whether an additional feature is novel but whether the implementation of the abstract idea involves “more than [the] performance of ‘well-understood, routine, [and] conventional activities previously known to the industry.’” *Content Extraction and Transmission LLC v. Wells Fargo Bank, Nat. Ass’n*, 776 F.3d 1343, 1347–48 (Fed. Cir. 2014) (quoting *Alice*, 134 S. Ct. at 2359). A finding of novelty or non-obviousness does not necessarily lead to the conclusion that subject matter is patentable eligible. “Groundbreaking, innovative, or even brilliant discovery does not by itself satisfy the § 101 inquiry.” *Ass’n for Molecular Pathology v. Myriad Genetics, Inc.*, 133 S. Ct. 2107, 2117 (2013). Thus, Appellants’ arguments have not persuaded us of error in the Examiner’s rejection of claim 1 as reciting patent-ineligible subject matter. Accordingly we sustain the Examiner’s rejection of claim 1, and claims 2 through 19 grouped with claim 1, under 35 U.S.C. § 101.

Appellants separately argue that claim 21 amounts to significantly more than an abstract idea as it recites generating a list of partially obscured telephone numbers for a user to select by a user interface. Appeal Br. 24–

⁵ Our reviewing court has said “[p]reamble language that merely states the purpose or intended use of an invention is generally not treated as limiting the scope of the claim.” *Bicon, Inc. v. Straumann Co.*, 441 F.3d 945, 952 (Fed. Cir. 2006).

25. Specifically, Appellants argue that that the claim recites the use of an interface, which is rooted in computer technology and as such the claim recites significantly more than the abstract concept. Appeal Br. 25.

We are not persuaded of error by this argument. Our reviewing court has held that the use of a user interface does not transform an abstract idea into something more. *FairWarning IP v. Iatric Sys. Inc.*, 839 F.3d 1089, 1096 (Fed. Cir. 2016) (“the use of generic computer elements like a microprocessor or user interface do not alone transform an otherwise abstract idea into patent-eligible subject matter.”) (citing *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1256 (Fed. Cir. 2014)). Thus, we sustain the Examiner’s rejection of claim 21 under 35 U.S.C. § 101.

DECISION

We affirm the Examiner’s rejection of claims 1 through 19 and 21 under 35 U.S.C. § 112(b) and 35 U.S.C. § 101.

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