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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte GREG TRIFILETTI and AYMAN HAMMAD

Appeal 2016-006694
Application 12/849,931¹
Technology Center 3600

Before ALLEN R. MacDONALD, BETH Z. SHAW, and
PHILLIP A. BENNETT, *Administrative Patent Judges*.

BENNETT, *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 1–3, 5–13, 21–26, and 28–41. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

¹ Appellants’ Brief (“App. Br.”) identifies Visa International Service Association as the real party in interest. App. Br. 3.

CLAIMED SUBJECT MATTER

Appellants describe their invention as being “directed to systems, apparatuses and methods that allow a user (e.g., a cardholder) to enroll for, receive and respond to (e.g., request a change in delivery instructions, request more information, etc.) alerts sent via a notification device.”

Spec. ¶ 19. Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A system comprising:
 - a first server comprising
 - a first processor,
 - a first computer readable medium coupled to the first processor, the first computer readable medium comprising first computer readable program code embodied therein, the first computer readable program code adapted to be executed by the first processor to
 - receive an authorization message associated with a transaction performed on a consumer account,
 - determine, using data included in the authorization message associated with the transaction performed on the consumer account, that the consumer account is enrolled in an alert messaging service, and
 - send transaction data associated with the transaction performed on the consumer account to a second server;
 - the second server, wherein the second server comprises
 - a second processor,
 - a second computer readable medium coupled to the second processor, the second computer readable medium comprising second computer readable program code embodied therein, the second computer readable program code adapted to be executed by the processor to

receive, from the first server, the transaction data associated with the transaction performed on the consumer account,

send an alert message related to the transaction to a user based on delivery instructions previously provided by the user,

receive an alert response message from the user, in response to the alert message related to the transaction, that includes a user request to modify delivery instructions for subsequent alerts associated with the consumer account, and

modify the delivery instructions for the alerts associated with the consumer account based on the user request to modify the delivery instructions for subsequent alerts, wherein the alerts are delivered in response to a transaction performed on the consumer account;

a database coupled to the first server; and

a notification device in operative communication with the second server.

App. Br. 25–26 (Claims Appendix).

REFERENCES

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

| | | |
|-------------|--------------------|---------------|
| Eichstaedt | US 7,143,118 B2 | Nov. 28, 2006 |
| Herz | US 2008/0165022 A1 | Jul. 10, 2008 |
| Wentker | US 2008/0167017 A1 | Jul. 10, 2008 |
| Ravishankar | US 2009/0328118 A1 | Dec. 31, 2009 |
| Carlson | US 2010/0325047 A1 | Dec. 23, 2010 |

REJECTIONS

Claims 1–3, 5–13, 21–26, and 28–41 stand rejected under 35 U.S.C. § 101 as being directed to ineligible subject matter. Final Act. 4.

Claims 1–3, 5–13, 21, 22, 25, and 28–41 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Eichstaedt, Wentker, Ravishankar, and Herz. Final Act. 5–28.

Claims 23, 24, and 26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Eichstaedt, Wentker, Ravishankar, Herz, and Carlson. Final Act. 28–30.

ISSUES

First Issue: Has the Examiner erred in concluding the claims are directed to ineligible subject matter?

Second Issue: Has the Examiner erred in finding the cited prior art teaches or suggests each limitation recited in the independent claims?

Third Issue: Has the Examiner erred in relying upon Carlson as prior art in rejecting claims 23, 24, and 26 under 35 U.S.C. § 103?

ANALYSIS

First Issue - § 101

In rejecting the claims under 35 U.S.C. § 101, the Examiner finds the claims are directed to the abstract idea of “modifying delivery instructions for alerts associated with the consumer.” Ans. 3. The Examiner further finds “modifying delivery instructions for alerts associated with the consumer . . . is similar to an idea of itself found by the courts to be abstract ideas.” *Id.* The Examiner further finds the claims “do not effect an improvement to another technology or technical field” nor do they “amount to an improvement to the functioning of a computer itself.” *Id.* The Examiner explains that the claims “do not move beyond a general link of the

use of an abstract idea to a particular technological environment” and that the claims “amount to nothing more than requiring a generic computer system to merely carry out the abstract idea.” *Id.*

Appellants argue the Examiner has failed to establish a prima facie case of ineligibility because “the Examiner has failed to indicate what the alleged abstract idea is.” Reply Br. 10. Appellants further argue the Examiner has failed to establish that the identified abstract idea “is one that has been identified by the courts as being an abstract idea,” because Appellants’ claims are markedly different from those in the *SmartGene* case cited by the Examiner. Reply Br. 10–11, (emphasis omitted). Appellants further contend the Examiner has improperly overgeneralized the nature of the invention “to such an extent, that ‘all’ inventions would be unpatentable.” Reply Br. 12.

We are not persuaded the Examiner has erred. In issues involving subject matter eligibility, our inquiry focuses on whether the claims satisfy the two-step test set forth by the Supreme Court in *Alice Corp. v. CLS Bank Int’l.*, 134 S. Ct. 2347 (2014). The Supreme Court instructs us to “first determine whether the claims at issue are directed to a patent-ineligible concept,” *Alice*, 134 S. Ct. at 2355, and, in this case, the inquiry centers on whether the claims are directed to an abstract idea. If the initial threshold is met, we then move to the second step, in which 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.* (quoting *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 79, 78 (2012)). The Supreme Court describes the second step 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.* (quoting *Mayo*, 566 U.S. at 72–73).

Here, the Examiner characterizes the invention as being directed to the abstract idea of “modifying delivery instructions for alerts associated with the consumer.” Ans. 3. This characterization is supported by the evidence of record. More specifically, Appellants’ Specification states “[e]mbodiments of the invention are *directed to* systems, apparatuses and methods that allow a user (e.g., a cardholder) to enroll for, receive and respond to (e.g., *request a change in delivery instructions*, request more information, etc.) *alerts sent via a notification device*.” Spec. ¶ 19 (emphasis added). Appellants’ own characterization in the Specification is consistent with the Examiner’s characterization.

As noted above, Appellants argue the Examiner has failed to establish a prima facie case of ineligibility because “the Examiner has failed to indicate what the alleged abstract idea is.” Reply Br. 10. This argument is not persuasive because, as we discussed above, the Examiner found the claims directed to the abstract idea of “modifying delivery instructions for alerts associated with the consumer.” Ans. 3. As such, we see no support for Appellants’ assertion that the Examiner failed to identify the abstract idea to which the claims are directed.

We also are not persuaded by Appellants’ argument that differences between Appellants’ claims and those in *SmartGene* require reversal here. The Examiner did not find the claims in the cases were directed to the same abstract idea. Rather, the Examiner cited *SmartGene* as an example of the types of generic computer operations that have been previously found by

courts to be abstract ideas when performed on a generic computing device. We discern no error in the Examiner's analysis in this regard. We are also not persuaded that Examiner has improperly overgeneralized the claims in determining they are directed to an abstract idea as Appellants allege. As we noted above, Appellants' Specification characterizes the invention in a similarly broad fashion. *See* Spec. ¶ 19. Moreover, although Appellants contend "[t]he claims feature a plurality of interrelated technical operations conducted in a specific manner" (Reply Br. 12), in our view, these operations "can readily be understood as simply adding conventional computer components to well-known business practices." *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1338 (Fed. Cir. 2016) (describing characteristics of claims found to be impermissibly abstract). As such, we are not persuaded the Examiner erred in determining Appellants' claims are directed to an abstract idea, and we proceed, therefore, to the second step of the *Alice* inquiry.

In determining Appellants' claims do not amount to "significantly more" in the second step of the *Mayo/Alice* analysis, the Examiner notes the claims do not effect an improvement to another technology or technical field, and they "amount to nothing more than requiring a generic computer system to merely carry out the abstract idea." Ans. 3–4. Appellants argue the claims amount to significantly more than the alleged abstract idea because they include additional features beyond the abstract idea itself. More specifically, Appellants argue the claims provide technical improvements, citing the advantages described in paragraph 96 of the Specification. App. Br. 15. Appellants further argue that the absence of several limitations from the prior art demonstrates that the claims amount to

significantly more than any abstract idea, and that they “recite a technical solution that is necessarily rooted in computer technology.” App. Br. 15–17. We agree with the Examiner.

The advantages described in paragraph 96 of the Specification relate to business process improvements, and not technological innovations. For example, the Specification states the embodiments allow a user to “quickly and easily change his delivery options” via a text message. Appellants do not claim to have invented text messaging, nor do they disclose in any detail any specialized use or programming of an SMS gateway to achieve these benefits. Instead, the Specification merely describes what the changed delivery options do, but not how they do it.

The Specification teaches the various embodiments can be performed on generic computing devices. *See* Spec. ¶ 97 (referencing an “exemplary computer system” which “may be used to implement any of the computer systems described above”), ¶¶ 98–105 (describing generic computer components).

Appellants further argue that the absence of several limitations from the prior art demonstrates that the claims amount to significantly more than any abstract idea, and that they “recite a technical solution that is necessarily rooted in computer technology.” App. Br. 15–17. Appellants’ argument is, in essence, that because the claims are not unpatentable over the prior art of record, they amount to significantly more than the abstract idea itself. This argument lacks merit because it presupposes that any claim found to be novel and non-obvious over prior art amounts to “significantly more” within the *Alice/Mayo* framework. We are aware of no case supporting this proposition, nor do Appellants cite to any. Nor would such a rule make

sense, as it would limit the application of 35 U.S.C. § 101 to only those claims found to be otherwise unpatentable under other sections of the Patent Act (e.g., 35 U.S.C. §§ 102, 103, 112).

In sum, we are not persuaded the Examiner has erred in determining the claims are directed to an abstract idea under *Alice* step 1. Nor are we persuaded the Examiner has erred in determining the claims do not amount to something more under *Alice* step 2. Accordingly, we sustain the rejection of the claims under 35 U.S.C. § 101.

Second Issue - § 103(a)

Appellants also challenge the rejection under 35 U.S.C. § 103(a), arguing the prior art fails to teach or suggest four different limitations recited in the independent claims. In rejecting the independent claims, the Examiner relies on the combined teachings of Eichstaedt, Wentker, Ravishankar, and Herz. Relevant here, the Examiner finds Wentker teaches two of the disputed the limitations: (1) “receive an authorization message associated with a transaction performed on a consumer account,” and (2) “determine, using data included in the authorization message associated with the transaction performed on the consumer account, that the consumer account is enrolled in an alert messaging service.” Ans. 4–6, 30–31 (citing Wentker ¶¶ 67, 97, 99; Fig. 2). The Examiner also finds Ravishankar teaches the third and fourth disputed limitations: (3) “receive an alert response message from the user, in response to the alert message related to the transaction, that includes a user request to modify delivery instructions for subsequent alerts associated with the consumer account,” and (4) “modify the delivery instructions for the alerts associated with the consumer account based on the user request to modify the delivery instructions for

subsequent alerts, wherein the alerts are delivered in response to a transaction performed on the consumer account.” Ans. 31–32.

With respect to the first two disputed limitations, Appellants argue Wentker is deficient because it merely describes how a consumer can configure a proximity payment settings option in a payment system and the general use of transaction alert messages. App. Br. 20–21. With respect to the second two disputed limitations, Appellants assert Ravishankar is deficient because it merely relates to call alert messages and handling incoming calls. App. Br. 21–22. Appellants further argue that Herz does not cure Ravishankar’s deficiencies. App. Br. 22.

We are not persuaded by Appellants’ arguments for the reasons stated in the Final Rejection and Answer, and we agree with, and adopt as our own, the detailed findings and explanations provided by the Examiner in the Answer. *See* Final Act. 5–9; Ans. 29–32. Accordingly, we sustain the rejections of the independent claims 1, 2, 12, 13, and 21 under 35 U.S.C. § 103(a). Aside from claims 23, 24, and 26 discussed below, Appellants have not presented separate patentability arguments for patentability of the dependent claims. Accordingly, dependent claims 3, 5–11, 22, 25, and 28–41 fall therewith. *See* 37 C.F.R. § 41.37(c)(1)(iv) (2013).

Third Issue - § 103(c)

Appellants also challenge the rejections of claims 23, 24, and 26, each of which rely upon Carlson. App. Br. 22–23. Appellants contend Carlson cannot be used an obviousness rejection because it falls within the safe harbor of 35 U.S.C. § 103(c). App. Br. 23. More specifically, Appellants contend Carlson is prior art only under 35 U.S.C. § 102(e) and “*Carlson* and the claimed invention were both under an obligation of assignment to Visa

International Service Association at the time the claimed invention was made.” App. Br. 23; Reply Br. 22. We agree with Appellants, and the Examiner did not respond to this argument in the Answer. Accordingly, on this record, we do not sustain the rejections of claims 23, 24, and 26 under 35 U.S.C. § 103(a).

DECISION

We affirm the Examiner’s rejection of claims 1–3, 5–13, 21–26, and 28–41 under 35 U.S.C. § 101.

We affirm the Examiner’s rejection of claims 1–3, 5–13, 22, 25, and 28–41 under 35 U.S.C. § 103(a).

We reverse the Examiner’s rejection of claims 23, 24, and 26 under 35 U.S.C. § 103(a).

Because we affirm at least one ground of rejection for each claim on appeal, we affirm the Examiner’s decision to reject claims 1–3, 5–13, 21–26, and 28–41. 37 C.F.R. § 41.50(a)(1).

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