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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte SCOTT PAINTIN

Appeal 2016-006744¹
Application 13/774,583²
Technology Center 3600

Before ANTON W. FETTING, BRADLEY B. BAYAT, and
MATTHEW S. MEYERS, *Administrative Patent Judges*.

MEYERS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134(a) from the Examiner's Final Rejection of claims 22–43. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ Our decision references Appellant's Appeal Brief ("Br.," filed September 23, 2015) and the Examiner's Answer ("Ans.," mailed April 15, 2016), Final Office Action ("Final Act.," mailed March 23, 2015), and Non-Final Office Action ("Non-Final Act.," mailed September 8, 2014).

² Appellant identifies "The Western Union Company" as the real party in interest (Br. 2).

CLAIMED INVENTION

Appellant's claims relate generally "to money transfers, and more particularly, to location-based money transfers" (Spec. ¶ 1).

Claims 22, 33, and 41 are the independent claims on appeal. Claim 22, reproduced below with added bracketed notations, is illustrative of the subject matter on appeal:

22. A method for transferring funds comprising:

[a] receiving at a money transfer system that transmits and receives data over a network a money transfer request for sending money from a proposed sender to a receiver that includes a proposed sender's contact information and a money transfer amount;

[b] tracking the location of the proposed sender's mobile device location;

[c] sending from the money transfer system a notification of the money transfer request to the proposed sender's mobile device, wherein the notification of the money transfer request comprises at least the money transfer amount;

[d] in the event that the proposed sender's location is proximate to a certain location, sending a notification to the proposed sender's mobile device regarding the certain location where the sender can initiate the money transfer; and

[e] receiving from the money transfer system an authorization notification from the proposed sender to proceed with the money transfer.

REJECTIONS

Claims 22–43 are rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter.

Claims 22–43 are rejected on the ground of Non-Statutory Double Patenting over claims 1–14 of Paintin (US 8,407,121 B2, issued Mar. 26, 2013).³

ANALYSIS

Non-statutory subject matter

Appellant argues independent claims 22, 33, and 41 as a group. *See* Br. 3–6. We select independent claim 22 as representative. Claims 33 and 41 stand or fall with independent claim 22. *See* 37 C.F.R. § 41.37(c)(1)(iv).

In rejecting independent claim 22 under 35 U.S.C. § 101, the Examiner determines that the claim, considered as a whole, is “directed towards performing a money transfer” (Non-Final Act. 2). More particularly, the Examiner determines that “[p]erforming a money transfer is a fundamental economic practice and thus, the claims include an abstract idea” (*id.*). The Examiner finds that independent claim 22 does not amount to significantly more than the abstract idea because the steps are performed by “the generically recited mobile device and payment processing system”

³ In response to this rejection (*see* Non-Final Act. 3), Appellant filed a Terminal Disclaimer on December 8, 2014, however, the Office disapproved it on December 19, 2014. In the Final Office Action, the Examiner notified Appellant that “[t]he terminal disclaimer failed to overcome the[] rejection[] and is made FINAL” (*see* Final Act. 3). The Examiner’s Answer does not withdraw the rejection (*see* Ans. 2). Because Appellant has not offered any response or arguments against the Examiner’s pending rejection of claims 22–43 on the ground of non-statutory double patenting, we summarily sustain this rejection.

using “well-understood, routine and conventional activities previously known to the industry” (*id.*).

Appellant does not dispute the Examiner’s determination that the claims are directed to an abstract idea (*see* Br. 3–6). Instead, Appellant argues that the claims are directed to patent-eligible subject matter “at least because significantly more than the alleged abstract idea is present in these claims” (*id.* at 4).

Under 35 U.S.C. § 101, 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 an implicit exception: “[l]aws of nature, natural phenomena, and abstract ideas” are not patentable. *See, e.g., Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2354 (2014).

In determining whether independent claim 22 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 must determine whether the claim is “directed to” a patent-ineligible abstract idea. If so, 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. *Id.* 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.*

Here, we agree with the Examiner that claim 22 is directed to “performing a money transfer” (Non-Final Act. 2). We also agree with the Examiner that independent claim 22 is directed to a fundamental economic practice, which is similar to other claims our reviewing courts have deemed abstract, such as *Alice*, 134 S. Ct. at 2356 (using a third party to mitigate settlement risk), *buySAFE, Inc. v. Google, Inc.*, 765 F.3d 1350, 1355 (Fed. Cir. 2014) (guaranteeing transactions), *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1372–73 (Fed. Cir. 2011) (verifying the validity of credit card transactions over the Internet), and *Smart Systems Innovation, LLC v. Chicago Transit Authority*, 873 F.3d 1364, 1371–72 (Fed. Cir. 2017) (forming and collecting data for financial transactions in a certain field).

Turning to the second step of the framework, we find unpersuasive Appellant’s arguments that independent claim 22 includes “significantly more” than an abstract idea to which the claim is allegedly directed (*see* Br. 3–6).

Appellant first argues that the claims include “significantly more” than an abstract idea because “[e]ach of the claims improves other technical fields beyond ‘performing a money transfer’ (the alleged abstract idea)” (*id.* at 4). More particularly, Appellant alleges that independent claim 22 improves the “personal finance management of both the recipient and sender” (*id.* at 5). However, we agree with the Examiner that “the claims do not include 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” (Non-Final Act. 2).

In this regard, we note that there is a fundamental difference between computer functionality improvements, on the one hand, and uses of existing computers as tools to perform a particular task, on the other. Here, the alleged improvements that Appellant refers to, e.g., “[t]he recipient can request money rather than await a *sua sponte* transfer by the sender. The recipient can be assisted by being informed of geographically proximate locations where such transfers can be initiated” (Br. 5) does not concern an improvement to computer capabilities, but instead relates to improvements in marketing and customer service, that simply instruct the practitioner to implement the abstract idea on a generic computer.

There is no inventive concept or technological advance here that would support patent eligibility. Claim 22 is not focused on an improvement to the claimed “money transfer system” or “mobile device.” *Cf. In re TLI Communications LLC Patent Litigation*, 823 F.3d 607, 613 (Fed. Cir. 2016) (The claims’ focus “was not on an improved telephone unit or an improved server.”). And merely limiting the scope of the claims to a particular technological environment or application, without more, does not change the outcome. *Alice*, 134 S. Ct. at 2358.

Appellant next argues that the claims include “significantly more” than an abstract idea because “[p]articular, non-generic, machines/computers are necessary to implement the systems and methods of the claims” (Br. 5). More particularly, Appellant argues that “a server capable of implementing the systems and methods must be able to communicate digital data with a multitude of differing financial networks and their associated protocols” and “[o]ff-the-shelf generic computers are not capable of performing such

functions, much less concurrently during an period of intense heavy transaction load as may be necessary in such industry” (*id.*).

However, independent claim 22 merely requires “a money transfer system that transmits and receives data over a network.” There is no indication in the record that any specialized computer hardware or other “inventive” computer components are required by the “money transfer system” of independent claim 22. To the contrary, Appellant’s Specification discloses “a computer system 700 that can perform the methods of the invention” (Spec. ¶ 40) and “can include one or more processors 710, including, without limitation, one or more general purpose processors and/or one or more special purpose processors (such as digital signal processing chips, graphics acceleration, chips, and/or the like)” (*id.* ¶ 41). Thus, independent claim 22 merely employs generic computer components to perform generic computer functions, which is not enough to transform the abstract idea into a patent-eligible invention.

Also, considered as an ordered combination, we are unclear as to how the claimed “money transfer system” or “mobile device” (*see* Spec. ¶ 19) adds anything that is not already present when the steps of the method are considered separately. In this regard, Appellant does not adequately show how the claimed steps are technically performed such that they are not routine, conventional functions of a generic computer. *See Intellectual Ventures I LLC v. Capital One Bank (USA)*, 792 F.3d 1363, 1370 (Fed. Cir. 2015) (“Rather, the ‘interactive interface’ simply describes a generic web server with attendant software, tasked with providing web pages to and communicating with the user’s computer.”). Appellant has not established that the claimed invention relates to a software-based invention that

improves the performance of the computer system itself. And it is well-settled that “merely recit[ing] the abstract idea . . . with the requirement to perform it . . . on a set of generic computer components . . . would not contain an inventive concept.” *See BASCOM Global Internet Servs., Inc. v. AT&T Mobility LLC*, 827 F.3d 1341, 1350 (Fed. Cir. 2016).

We last are not persuaded by Appellant’s argument that because the “claims do not stand rejected under § 102 or § 103,” the claims cannot be “labeled a fundamental economic practice,” and thus, something “significantly more than the alleged abstract idea is present in the claim” (Br. 5–6). To the extent that Appellant argues that independent claim 22 necessarily contains an “inventive concept” because Appellant’s claims recite particular features which they alleged are not disclosed in the prior art (*id.*), Appellant misapprehends the controlling precedent. Although the second step in the *Alice/Mayo* framework is termed a search for an “inventive concept,” the analysis is not an evaluation of novelty or non-obviousness, but rather, a search for “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.’” *Alice*, 134 S. Ct. at 2355. A novel and nonobvious claim directed to a purely abstract idea is, nonetheless, patent-ineligible. *See Mayo*, 132 S. Ct. at 1304.

In view of the foregoing, we sustain the Examiner’s rejection under 35 U.S.C. § 101 of independent claim 22, including independent claims 33 and 41, which fall with claim 22.

Appellant also addresses dependent claims 23–32, 34–40, 42, and 43 separately (*see* Br. 6). Appellant states “the Office Action makes no effort to analyze these claims and state any grounds for why the recitations of these

claims do not amount to significantly more than the alleged abstract idea” (*id.*).

Appellant’s argument is not persuasive at least because Appellant offers no arguments in support of the patent eligibility of the dependent claims. As we find, however, that dependent claims 23–32, 34–40, 42, and 43 merely describe further characteristics of the underlying concept and lack additional elements that would render the claims patent-eligible, we also sustain the rejection under § 101 of these dependent claims on the same basis as the independent claims from which they depend. In particular, the dependent claims merely recite variations of receiving and processing information related to the abstract idea, as well as determining a sender’s location using well-known techniques, i.e., “information received, either from the cellular triangulation or GPS location information” (Spec. ¶ 20), which we discern sits squarely within, and does not alter appreciably, the broader concept of “performing a money transfer” (*cf.* Non-Final Act. 2).

DECISION

The Examiner’s rejection of claims 22–43 under 35 U.S.C. § 101 is affirmed.

The Examiner’s rejection of claims 22–43 on the ground of non-statutory double patenting is summarily affirmed.

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