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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/032,722	02/23/2011	Manish JAIN	CITI0385-US	7487

75127 7590 08/01/2018
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EXAMINER

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ART UNIT	PAPER NUMBER
3691	

NOTIFICATION DATE	DELIVERY MODE
08/01/2018	ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MANISH JAIN

Appeal 2016-007309
Application 13/032,722¹
Technology Center 3600

Before JASON J. CHUNG, BETH Z. SHAW, and MICHAEL J. ENGLE,
Administrative Patent Judges.

ENGLE, *Administrative Patent Judge.*

DECISION ON APPEAL

Appellant appeals under 35 U.S.C. § 134(a) from a final rejection of claims 1–20. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

Technology

The application relates to “using a template and extracting information to generate a comprehensively populated payment file in an industry standard format.” Spec. ¶ 1.

Illustrative Claim

Claim 1 is illustrative and reproduced below with certain limitations at issue emphasized:

¹ Appellant states the real party in interest is Citicorp, N.A. App. Br. 1.

1. A computer-implemented method for generating a payment file, the method comprising:

receiving, by a payment configuration computer, a request for a payment to a beneficiary;

receiving, by the payment configuration computer, a request to pay the beneficiary using a template;

responsive to receiving the request, automatically identifying, by the payment configuration computer, a single template file from a plurality of template files in a database that is associated with the beneficiary in the request, wherein *the template file has a plurality of business rules for completing a plurality of data fields*;

extracting, by the payment configuration computer, information from a database to complete the data fields of the identified template configured for the beneficiary; and

generating and transmitting, by the payment configuration computer via a network gateway to a file exchange server, a payment file by completing the data fields of the identified template according to the plurality of business rules.

Rejections

Claims 1–20 stand rejected under 35 U.S.C. § 101 as being directed to ineligible subject matter. Final Act. 2.

Claims 1–20 stand rejected under 35 U.S.C. § 103(a) as obvious over the combination of Lovelett et al. (US 2007/0282743 A1; Dec. 6, 2007), Miller et al. (US 2009/0089696 A1; Apr. 2, 2009), and Rolf et al. (US 2007/0219871 A1; Sept. 20, 2007). Final Act. 4.

ISSUES

1. Did the Examiner err in determining that claim 1 was directed to ineligible subject matter without significantly more under § 101?

2. Did the Examiner err in finding Miller teaches or suggests “generating and transmitting . . . [a] file by completing the data fields of the identified template according to the plurality of business rules,” as recited in claim 1?

ANALYSIS

§ 101

Section 101 defines patentable subject matter, but the Supreme Court has “long held that this provision contains an important implicit exception” that “[l]aws of nature, natural phenomena, and abstract ideas are not patentable.” *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 70 (2012) (quotation omitted). To determine patentable subject matter, the Supreme Court has set forth a two part test.

“First, we determine whether the claims at issue are directed to one of those patent-ineligible concepts” of “laws of nature, natural phenomena, and abstract ideas.” *Alice Corp. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2355 (2014). “The inquiry often is whether the claims are directed to ‘a specific means or method’ for improving technology or whether they are simply directed to an abstract end-result.” *RecogniCorp, LLC v. Nintendo Co.*, 855 F.3d 1322, 1326 (Fed. Cir. 2017). A court must be cognizant that “all inventions at some level embody, use, reflect, rest upon, or apply laws of nature, natural phenomena, or abstract ideas” (*Mayo*, 566 U.S. at 71), and “describing the claims at . . . a high level of abstraction and untethered from the language of the claims all but ensures that the exceptions to § 101 swallow the rule.” *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1337 (Fed. Cir. 2016). Instead, “the claims are considered in their entirety to ascertain whether their

character as a whole is directed to excluded subject matter.” *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1346 (Fed. Cir. 2015).

In the second step, 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.” *Alice*, 134 S. Ct. at 2355 (quoting *Mayo*, 566 U.S. at 79, 78). The Supreme Court has “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.* (quotation omitted).

Here, Appellant contends the Examiner erred on both steps. With respect to step one, Appellant argues that “[t]he Examiner’s asserted abstract idea is not similar to an abstract idea previously identified by the courts.” App. Br. 5. The Examiner, however, determines that the claims are “directed to generation and transmission of payment files from a template according to business rules,” which the Examiner says is “similar to other concept[s] found by the courts to be abstract such as comparing new and stored information and using rules to identify options in *SmartGene*, and obtaining and comparing intangible data in *Cybersource*.” Ans. 2 (referencing *SmartGene, Inc. v. Advanced Biological Labs., SA*, 555 F. App’x 950 (Fed. Cir. 2014) (unpublished); *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366 (Fed. Cir. 2011)). Appellant does not address those decisions directly, but does argue that the Examiner’s stated abstract idea “is a process rooted in computer technology and cannot be performed by a human being.” Reply Br. 4.

We are not persuaded by Appellant’s argument. Appellant provides no explanation why templates would have been limited to or unique to computers. For example, a paper copy of the Manual of Patent Examining Procedure (“MPEP”) includes numerous form paragraphs with bracketed tags where data specific to each case should be filled in manually (i.e., a template). A template on a computer may well be more efficient than a template on paper or in the human mind, but the Federal Circuit is clear that “relying on a computer to perform routine tasks more quickly or more accurately is insufficient to render a claim patent eligible.” *OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1363 (Fed. Cir. 2015); *see also Credit Acceptance Corp. v. Westlake Servs.*, 859 F.3d 1044, 1055 (Fed. Cir. 2017) (“mere automation of manual processes using generic computers does not constitute a patentable improvement in computer technology”).

At heart, claim 1 is about picking a template based on the entity concerned (a “beneficiary”) and filling in the template to get a completed document (a “payment file”). The claim may be limited to a specific field of use (paying a beneficiary), but the Supreme Court has instructed that “limiting the use of an abstract idea to a particular technological environment” is “not enough for patent eligibility.” *Alice*, 134 S. Ct. at 2358 (quotation omitted). Thus, we are not persuaded the Examiner erred in step one of the analysis.

Appellant further argues that certain dependent claims are limited to XML files. Reply Br. 4; App. Br. 6. Yet the Federal Circuit recently rejected a similar argument specific to XML: “While limiting the index to XML tags certainly narrows the scope of the claims, in this instance, it is simply akin to limiting an abstract idea to one field of use or adding token

post solution components that do not convert the otherwise ineligible concept into an inventive concept.” *Intellectual Ventures I LLC v. Erie Indem. Co.*, 850 F.3d 1315, 1328–29 (Fed. Cir. 2017); *see also id.* at 1328 (“merely using XML tags—as opposed to other kinds of tags—to build an index is still abstract”).

Therefore, we are not persuaded that the Examiner erred in determining that the claims are directed to an abstract idea.

Turning to step two, Appellant argues that the claims do not “‘monopolize’ or ‘tie up’ the allegedly abstract idea.” App. Br. 8. But the Federal Circuit has “consistently held that claims that are otherwise directed to patent-ineligible subject matter cannot be saved by arguing the absence of complete preemption.” *Return Mail, Inc. v. U.S. Postal Service*, 868 F.3d 1350, 1370 (Fed. Cir. 2017). “While preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility.” *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015). “Where a patent’s claims are deemed only to disclose patent ineligible subject matter under the *Mayo* framework, as they are in this case, preemption concerns are fully addressed and made moot.” *Id.*

Appellant also argues that “use of any templates” and “extraction of information from a database” are “significantly more than the routine steps of generating a payment file.” App. Br. 7. We are not persuaded by this argument. First, use of a template is *part of* the abstract idea and therefore cannot be “significantly more” than the abstract idea. Ans. 2 (“claim 1 . . . is directed to generation and transmission of payment files from a template according to business rules”); *see Alice*, 134 S. Ct. at 2355. Second, the

Federal Circuit has already held that “generic computer components such as . . . [a] ‘database’ . . . do not satisfy the inventive concept requirement.” *Mortg. Grader, Inc. v. First Choice Loan Servs. Inc.*, 811 F.3d 1314, 1324–25 (Fed. Cir. 2016). For example, in one recent case, the Federal Circuit held that “searching a database using an index” with “XML tags” did not render the claims patent eligible. *Intellectual Ventures I LLC v. Erie Indem. Co.*, 850 F.3d at 1328. The same is true for the use of databases here.

We also are not persuaded by Appellant’s unsupported attorney argument that the claims are a “technical solution” to a “technical problem.” App. Br. 7–8; Reply Br. 4–5. As discussed above, templates are not “technical” because automation of a manual process, by itself, does not render a claim patentable. We agree with the Examiner that the additional limitations of a “generic processor” and “a field of use” for “a particular technological environment . . . do not add significantly more.” Ans. 3; *see also Affinity Labs of Texas, LLC v. DirecTV, LLC*, 838 F.3d 1253, 1259 (Fed. Cir. 2016) (“The Supreme Court and this court have repeatedly made clear that merely limiting the field of use of the abstract idea to a particular existing technological environment does not render the claims any less abstract.”). Moreover, although Appellant argues that the “technical solution” is “the template’s mapping rules,” App. Br. 7, we note that claim 1 merely recites (A) “the template file has a plurality of business rules” without providing any technical solution for how the business rules are derived and (B) “completing the data fields . . . according to the plurality of business rules” without providing any technical solution for how the business rules are applied. “Indeed, the claim language here provides only a result oriented solution, with insufficient detail for how a computer

accomplishes it. Our law demands more.” *Intellectual Ventures I LLC v. Capital One Fin. Corp.*, 850 F.3d 1332, 1342 (Fed. Cir. 2017).

Moreover, the Specification provides little specificity regarding the structural composition of technological elements. *E.g.*, Spec. ¶ 38 (“the above-described technology can be implemented on known devices such as a personal computer”). Thus, the Specification does not describe the system as made up of special-purpose or specially-configured computer components, but rather, as a general-purpose computer that includes generic components. As a result, nothing recited by the claims “offers a meaningful limitation beyond generally linking ‘the use of the [method] to a particular technological environment,’ that is, implementation via computers.” *Alice*, 134 S. Ct. at 2360 (quoting *Bilski*, 561 U.S. at 610–11). Thus, Appellant has not persuaded us that the claims provide a *technical* solution.

Appellant further argues that the claims involve a “non-conventional and non-generic arrangement of known, conventional pieces.” Reply Br. 5 (quoting *BASCOM Glob. Internet Servs., Inc. v. AT&T Mobility LLC*, 827 F.3d 1341, 1350 (Fed. Cir. 2016)). However, what Appellant alleges to be “non-conventional” are either (A) not reflected in the claim language, such as “mapping rules for all 136 data fields” rather than “only about 80,”² or (B) things the Federal Circuit has already held do not constitute “significantly more,” such as being “automated.” *See* Reply Br. 4–5 (quotation omitted); *see also Berkheimer v. HP Inc.*, 881 F.3d 1360, 1369

² We note that dependent claim 9 further undercuts Appellant’s argument because it recites that “a plurality of data fields are optional,” not “mandatory.”

(Fed. Cir. 2018) (“Thus, [claim 1] does not recite any of the purportedly unconventional activities”).

Accordingly, we sustain the Examiner’s rejection under § 101 of claim 1, and claims 2–20, which Appellant argues are patentable for similar reasons. *See* App. Br. 9; 37 C.F.R. § 41.37(c)(1)(iv).

§ 103

Claim 1 recites “the template file has a plurality of business rules for completing a plurality of data fields” and “generating and transmitting . . . a . . . file by completing the data fields of the identified template according to the plurality of business rules.”

Appellant argues that “Miller’s ‘rules’ are directed to a format and placement of fields, but not how the data is used to complete those fields.” App. Br. 11.

We are not persuaded by Appellant’s argument. The Examiner relied on paragraphs 15 and 29 of Miller for teaching this limitation. Final Act. 5. There, Miller discloses:

The template creation system enables a graphical selection of one or more fields from within a database system. For example, the database system may be an ERP system that provides a graphical interface for selecting fields of data to be exported. The ERP system provides the selected fields as a data source to a document editing system (e.g., a word processing or spreadsheet application) *that accepts data from external data sources*. For example, a user may use a word processing application with a mail merge function to incorporate the fields provided by the ERP system into a document. The user can then use the document editing system to graphically lay out the fields in a particular format using familiar document editing functions. For example, the user may bold a particular field, justify the text of a field, place a field in a table, and so forth. After the user has

created a document that describes the desired format for the data, the template creation system creates one or more template rules that convert *data exported from the database system* to the format of the document created by the user in the document editing system.

Miller ¶ 15 (emphases added). Thus, although Miller does refer to “template rules” for formatting, Miller also teaches completing the data fields according to the respective data exported from the database system. Similarly, the Specification of the present application explains that a template can have some “business rules” for “formatting” and others for “completing data fields.” Spec. ¶¶ 21–22. We, therefore, are not persuaded the Examiner erred in determining that Miller teaches or suggests “generating and transmitting . . . a . . . file by completing the data fields of the identified template according to the plurality of business rules.”

Appellant also recites multiple lines of claim limitations in claims 1, 12, and 17, yet fails to explain *why* those limitations are missing in the prior art. *See* App. Br. 10–11. By regulation, “[a] statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim.” 37 C.F.R. § 41.37(c)(1)(iv); *see also In re Lovin*, 652 F.3d 1349, 1357 (Fed. Cir. 2011) (“the Board reasonably interpreted Rule 41.37 to require more substantive arguments in an appeal brief than a mere recitation of the claim elements and a naked assertion that the corresponding elements were not found in the prior art”).

Accordingly, we sustain the Examiner’s rejection under § 103 of independent claims 1, 12, and 17, and their dependent claims 2–11, 13–16, and 18–20, which Appellant argues are patentable for similar reasons. *See* App. Br. 12; 37 C.F.R. § 41.37(c)(1)(iv).

DECISION

For the reasons above, we affirm the Examiner's decision rejecting claims 1–20.

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. § 41.50(f).³

AFFIRMED

³ In the event of further prosecution, the Examiner may wish to consider whether claim 1 is indefinite under 35 U.S.C. § 112, second paragraph, due to the limitation “responsive to receiving *the* request.” We note that the first two steps of the method each recite “receiving . . . *a* request,” so it may be unclear which of the two instances of “a request” is being referred to by “the request.”