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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JEFFREY A. COX, AVIVA K. KLEIN, and KELLY E. REID

Appeal 2016-007444¹
Application 13/739,204²
Technology Center 3600

Before MURRIEL E. CRAWFORD, ANTON W. FETTING, and
ALYSSA A. FINAMORE, *Administrative Patent Judges*.

FINAMORE, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ We make reference to the Specification (“Spec.,” filed Jan. 11, 2013), Appeal Brief (“Appeal Br.,” filed Dec. 15, 2015), and Reply Brief (“Reply Br.,” filed Aug. 1, 2016), as well as the Examiner’s Final Office Action (“Final Act.,” mailed July 16, 2015) and Answer (“Ans.,” mailed June 3, 2016). The record also includes a transcript of the oral hearing held on June 7, 2018.

² According to the Appeal Brief, the real party in interest is MasterCard International Incorporated. Appeal Br. 2.

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant³ appeals from the Examiner's decision to reject claims 1–5, 8, 17–21, and 24. We have jurisdiction under § 6(b).

We AFFIRM.

SUBJECT MATTER ON APPEAL

The invention “relates to the submission of transaction details and creation of transaction records, specifically the creation of transaction records for fleet transactions using a mobile communication device utilizing real-time authorization data.” Spec. ¶ 1. Claims 1 and 17 are the independent claims on appeal. Independent claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A method for facilitating vehicle data capture via a mobile communication device, comprising:
 - receiving, by a receiving device and from a merchant device, fleet card transaction data related to a financial transaction initiated by the receipt of a fleet card identifier at the merchant device, wherein the fleet card transaction data includes at least the fleet card identifier associated with a fleet member;
 - storing, in a transaction database, the fleet card transaction data;
 - receiving, by the receiving device and from a mobile communication device via an application running on the mobile communication device, a request for transaction data related to a financial transaction involving the fleet card identifier, wherein the request includes at least a fleet member identifier;
 - identifying, by a special purpose processing device, in a consumer database, on a basis of the fleet member identifier received in the request, a consumer data entry storing data related

³ We use the term “Appellant” herein to refer to any and all appellants collectively.

to the fleet member, wherein the identified consumer data entry includes at least the fleet member identifier;

identifying, by the special purpose processing device in the transaction database, transaction data related to the financial transaction initiated by the receipt of the fleet card identifier at the merchant device, wherein the transaction data is identified based on the identified consumer data entry;

transmitting, by a transmitting device, the identified transaction data to the mobile communication device, wherein the transmitted request causes an application running on the mobile communication device to display, on a display of the mobile communication device, at least some of the identified transaction data;

transmitting, by the transmitting device, a request for additional transaction details, wherein the specific additional transaction details include at least one of: a fuel quantity, a fuel unit price, a fuel type, and an odometer reading, wherein the transmitted request causes an application running on the mobile communication device to display, on the display of the mobile communication device, at least one field corresponding to the additional transaction details;

receiving, by the receiving device, the specified additional transaction details from the mobile communication device, wherein the specified additional transaction details are received by the mobile communication device from an input of the mobile communication device; and

creating, by the special purpose processing device, an electronic transaction record for the financial transaction initiated by the receipt of the fleet card identifier at the merchant device, wherein the transaction record (i) includes at least the transaction data received from the merchant device and the additional transaction details received from the mobile communication device and (ii) is associated with the fleet card identifier that initiated the financial transaction.

REFERENCES

The Examiner relies on the following prior art in rejecting the claims on appeal:

Nielsen et al. (“Nielsen”)	US 2007/0173993 A1	July 26, 2007
Lanc	US 2008/0103972 A1	May 1, 2008

REJECTIONS

The Examiner rejects the claims on appeal as follows:

claim 1 under 35 U.S.C. § 112, second paragraph, as indefinite;

claims 1–5, 8, 17–21, and 24 under 35 U.S.C. § 101 as non-statutory subject matter; and

claims 1–5, 8, 17–21, and 24 under 35 U.S.C. § 103(a) as unpatentable over Lanc and Nielsen.

ANALYSIS

Indefiniteness

Independent claim 1 recites

transmitting, by the transmitting device, a request for additional transaction details, wherein the specific additional transaction details include at least one of: a fuel quantity, a fuel unit price, a fuel type, and an odometer reading, wherein the transmitted request causes an application running on the mobile communication device to display, on the display of the mobile communication device, at least one field corresponding to the additional transaction details.

The Examiner determines the claim is indefinite because there is insufficient antecedent basis for the term “the specific additional transaction details.”

Final Act. 6.

Appellant argues it is clear that this term refers to the particular or specified additional transaction details included in the request. Appeal Br. 8. Appellant's argument is not convincing.

“[I]f a claim is amenable to two or more plausible claim constructions, the USPTO is justified in requiring the applicant 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, as indefinite.”

Ex Parte Miyazaki, 89 USPQ2d 1207, 1211 (BPAI 2008) (precedential).

Furthermore, our reviewing court has explained that

the patent drafter is in the best position to resolve the ambiguity in the patent claims, and it is highly desirable that patent examiners demand that applicants do so in appropriate circumstances so that the patent can be amended during prosecution rather than attempting to resolve the ambiguity in litigation.

Halliburton Energy Servs., Inc. v. M-1 LLC, 514 F.3d 1244, 1255

(Fed. Cir. 2008).

The term “the specific additional transaction details” can be interpreted to refer to previously-recited term “additional transaction details.” In light of the different wording, however, it also can be interpreted to mean something other than the previously-recited “additional transaction details.” Consequently, the term “the specific additional transaction details” is amendable to two different claim constructions, and the Examiner is justified in requiring Appellant to more precisely define the metes and bounds of the claimed invention by rejecting independent claim 1 under 35 U.S.C. § 112, second paragraph, as indefinite. We, therefore, sustain the rejection.

Non-Statutory Subject Matter

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 implicit exceptions: “[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) (quoting *Ass’n for Molecular Pathology v. Myriad Genetics, Inc.*, 133 S. Ct. 2107, 2116 (2013)). To “distinguish[] patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts,” the Supreme Court, in *Alice*, reiterated the two-step framework previously set forth in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 132 S. Ct. 1289 (2012), which, in the first step, considers whether a claim is directed to a patent-ineligible concept, e.g., an abstract idea, and, if so, considers, in the second step, whether the claim recites an inventive concept—an element or combination of elements sufficient to ensure the claim amounts to significantly more than the abstract idea and transform the nature of the claim into a patent-eligible application. *Alice*, 134 S. Ct. at 2355 (citing *Mayo*, 132 S. Ct. at 1294, 1296–98).

In rejecting the claims under 35 U.S.C. § 101, the Examiner analyzes the claims using this two-step framework and determines the claimed subject matter is judicially excepted from statutory subject matter. Final Act. 2–6; Ans. 2–8. In particular, the Examiner determines the claims are directed to an abstract idea without significantly more. Final Act. 2–6; Ans. 2–8.

Appellant argues claims 1–5, 8, 17–21, and 24 as a group. Appeal Br. 8–17; Reply Br. 2–20. We select independent claim 1 as

representative. The remaining claims of the group stand or fall with independent claim 1. 37 C.F.R. § 41.37(c)(1)(iv).

As a preliminary matter, we unpersuaded of error by Appellant's argument that the Examiner has not made a prima facie case of patent ineligibility under 35 U.S.C. § 101. Appeal Br. 8–10, 13–14; Reply Br. 20. The requirement to make a prima facie case is premised on notice, as the Federal Circuit has held that an examiner establishes a prima facie case by satisfying the notice requirement set forth in 35 U.S.C. § 132. According to the court,

the PTO carries its procedural burden of establishing a prima facie case when its rejection satisfies 35 U.S.C. § 132, in “notify[ing] the applicant ... [by] stating the reasons for [its] rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of [the] application.”

In re Jung, 637 F.3d 1356, 1362 (Fed. Cir. 2011) (alterations in original) (quoting § 132). All that is required of the Office is to set forth the statutory basis of the rejection in a sufficiently articulate and informative manner. *Id.* at 1363; *see also Chester v. Miller*, 906 F.2d 1574, 1578 (Fed. Cir. 1990) (“Section 132 is violated when a rejection is so uninformative that it prevents the applicant from recognizing and seeking to counter the grounds for rejection.”).

As set forth above, in determining that the subject matter of independent claim 1 is judicially excepted from statutory subject matter, the Examiner analyzes the claim using the two-step framework set forth in *Alice*, and explains why the claim is directed to an abstract idea under the first step and why the claim fails to recite significantly more under the second. Final Act. 2–6; Ans. 2–8. As such, the Examiner sufficiently

informs Appellant that the claims are patent ineligible. Furthermore, there is no indication that Appellant does not recognize or understand the Examiner's rejection, as Appellant's understanding is manifested in the arguments traversing it. Accordingly, the Examiner's rejection satisfies the notice requirement of § 132 and sets forth a prima facie case of patent-ineligible subject matter. We, therefore, consider Appellant's remaining arguments to determine whether the Examiner erred in rejecting the claims as patent ineligible. *See Ex Parte Frye*, 94 USPQ2d 1072, 1075 (BPAI 2010) (precedential) (explaining that the Board reviews a rejection for error "based upon the issues identified by appellant, and in light of the arguments and evidence produced thereon").

Pursuant to the first step of the *Alice* analysis, Appellant contends that, when properly characterized, independent claim 1 is not directed to an abstract idea. Appeal Br. 10–13; Reply Br. 3–15. In particular, Appellant asserts independent claim 1 is directed to vehicle data capture via a user mobile device such that the claimed invention is an improvement to fleet vehicle card electronic transaction processing systems, similar to the claims in *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327 (Fed. Cir. 2016). Reply Br. 6–8. Appellant's argument is not convincing.

Although we agree with Appellant that independent claim 1 is directed to vehicle data capture, the claimed invention is nonetheless a process that qualifies as an abstract idea for which computers are invoked merely as a tool. *See Enfish*, 822 F.3d at 1335–36 (“[T]he first step in the *Alice* inquiry . . . asks whether the focus of the claims is on the specific asserted improvement in computer capabilities . . . or, instead, on a process that qualifies as an ‘abstract idea’ for which computers are invoked merely

as a tool.”). Independent claim 1 recites a series of steps for receiving, storing, identifying, and transmitting data to create an electronic record that includes transaction data received from a merchant and additional transaction details, and that is associated with the fleet card identifier that initiated the financial transaction at the merchant. Independent claim 1 further recites that these steps involve various computing components, such as a receiving device, a merchant device, a transaction database, a special purpose processing device, a consumer database, and a transmitting device.

The Specification explains that the traditional process of using a fleet card for recording a driver’s purchase of fuel and maintenance services, i.e., entering an invoice or other number for the purchase, having the driver fill out a separate report regarding additional information, and matching the additional information provided by the driver to the transaction via the invoice or other identifying number, “may be cumbersome, as the driver spends less time on the road and more time filling out reports, or details may be lost or report[ed] incorrectly if the driver does not fil out a report immediately.” Spec. ¶ 3. The Specification further explains that the invention addresses a need “for capturing fleet data in real-time that may provide entities with additional information regarding fleet transactions while requiring less time and resources of both the driver and the entity.” *Id.* ¶ 4.

In light of the above, the claimed invention uses computing components to improve the capture and recording of data associated with fleet card transactions. The focus of the claimed invention, therefore, is not on some improvement to computer technology, but rather capturing and recording data associated with fleet card transactions.

Furthermore, the concept of capturing and recording data associated with fleet card transactions is similar to other concepts the courts of have held to be abstract ideas. *See Amdocs (Isr.) Ltd. v. Openet Telecom, Inc.*, 841 F.3d 1288, 1294 (Fed. Cir. 2016) (explaining that when determining whether a claim is directed to an abstract idea, “the decisional mechanism courts now apply is to examine earlier cases in which a similar or parallel descriptive nature can be seen—what prior cases were about, and which way they were decided”). For example, we see no meaningful distinction between the concept of capturing and recording data associated with fleet card transactions and the abstract idea of “collecting information, analyzing it, and displaying certain results of the collection and analysis” in *Electric Power Group v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016). Independent claim 1, therefore, is directed to an abstract idea under the first step of the two-step analysis.

Turning to the second step, Appellant contends that independent claim 1 recites significantly more than the abstract idea because, analogous to the claims in *BASCOM Global Internet Servs., Inc. v. AT&T Mobility LLC*, 827 F.3d 1341 (Fed. Cir. 2016), the claimed invention has a specific application and improves a particular type of technology. Reply Br. 19. Appellant similarly asserts the claims address a challenge unique to the processing of fleet transaction data by providing for particular communications among particularly configured devices. Appeal Br. 16. Appellant also asserts the claimed invention offers technical solutions such as increased security of the transactions due to the division of responsibility, instant verification of vehicle data, and real-time decision-making on

authorization of fleet transactions. *Id.* Appellant’s arguments do not apprise us of error.

The fact that the claimed invention uses computing components and provides electronic processing, in and of itself, does not mean the claimed invention improves the computer technology. Rather, as set forth above, the Specification explains that the claimed invention uses computing components to facilitate the traditional process of using a fleet card for recording a driver’s purchase of fuel and maintenance services, which may be cumbersome and inaccurate as it involves a driver filing out reports regarding additional information and an entity matching the additional information provided by the driver to the transaction via the invoice or other identifying number. Spec. ¶¶ 3–4. The claimed invention, therefore, does not improve a particular technology, but instead uses technology to improve the traditional way of processing fleet card transactions. *See OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1363 (Fed. Cir. 2015) (citing *Alice*, 134 S. Ct. at 2359) (“[R]elying on a computer to perform routine tasks more quickly or more accurately is insufficient to render a claim patent eligible.”).

Appellant also argues independent claim 1 recites significantly more than the abstract idea because, like the claims in *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245 (Fed. Cir. 2014), the claimed invention solves a transaction processing problem that is rooted in technology. Appeal Br. 16; Reply Br. 18. According to Appellant, the claimed invention provides authentication, which is “unnecessary *but-for* the electronic processing of fleet transaction data.” Appeal Br. 16; Reply Br. 18. Appellant’s argument does not apprise us of error.

At the outset, we disagree with Appellant that the need for authentication is exclusive to the electronic processing of fleet transaction data. For example, there is a need to authenticate the identity of the person providing the additional information regardless of whether the person provides the additional information electronically or on paper. Consequently, the transaction processing problem of authentication is not rooted in technology.

In any case, Appellant's argument regarding authentication is not commensurate with the scope of the claim. Independent claim 1 does not recite authentication expressly, and Appellant does not explain how the invention recited in independent claim 1 provides for authentication.

Appellant further argues that independent claim 1 recites significantly more than the abstract idea because the claimed invention provides a physical transformation, namely a change in the display at a mobile device. Appeal Br. 16; Reply Br. 18. Appellant's argument is not convincing.

"[S]atisfying the machine-or-transformation test, by itself, is not sufficient to render a claim patent-eligible, as not all transformations or machine implementations infuse an otherwise ineligible claim with an 'inventive concept.'" *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1256 (Fed. Cir. 2014). As set forth above, the Federal Circuit has explained that displaying data is an abstract idea, not an inventive concept sufficient to transform the nature of the claim into a patent-eligible application. *Elec. Power*, 830 F.3d at 1353 (holding "collecting information, analyzing it, and displaying certain results of the collection and analysis" is an abstract idea).

Appellant additionally contends that the Examiner erred in determining the claimed invention implements the abstract idea using generic computer performing generic computer functions because independent claim 1 recites a “special purpose processing device.” Reply Br. 20. Appellant’s argument does not apprise us of error.

In *Alice*, the Supreme Court explains that the second step of the two-step analysis considers “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*, 132 S. Ct. at 1298, 1297). For computer-implemented inventions like the claimed invention, the question in the second step is whether the computer implementation of the abstract idea involves “more than performance of ‘well-understood, routine, [and] conventional activities previously known to the industry.’” *Content Extraction & Transmission LLC v. Wells Fargo Bank, N.A.*, 776 F.3d 1343, 1347–48 (Fed. Cir. 2014) (quoting *Alice*, 134 S. Ct. at 2359).

Here, the Examiner determines that the claimed invention implements the abstract idea via generic computing components performing generic computer functions such as receiving and transmitting data. Ans. 14–15 (citing Spec. ¶ 76). Merely referring to a computing device as a “special purpose processing device,” without any further explanation as to the special characteristics of the device, does not apprise us of error in the Examiner’s determination.

Appellant also argues the Examiner’s determination that independent claim 1 recites only generic components is not sufficient to establish that the claim fails to recite significantly more than the abstract idea. Appeal Br. 14.

Appellant further asserts that the method of independent claim 1 is directed to much more than the creation of a transaction record. *Id.* Appellant's arguments do not apprise us of error because, for the reasons set forth above, the claimed invention is simply the generic computer implementation of processing fleet card transactions, i.e., capturing and recording data associated with fleet card transactions, which is insufficient for patent eligibility. *See DDR Holdings*, 773 F.3d at 1256 (“[T]hese claims [of prior cases] in substance were directed to nothing more than the performance of an abstract business practice on the Internet or using a conventional computer. Such claims are not patent-eligible.”).

In view of the foregoing, Appellant does not apprise us of error in the Examiner's determination that independent claim 1 is judicially excepted from statutory subject matter. Accordingly, we sustain the rejection of independent claim 1, with claims 2–5, 8, 17–21, and 24 falling therewith.

Obviousness

In rejecting independent claim 1, the Examiner determines

[i]t would have been obvious to one of ordinary skill in the art to include in the financial transaction system of Lan[c] the ability to run a fleet card transaction as taught by Nielsen et al. since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Final Act. 9. Appellant argues that one skilled in the art would not have combined the teachings of Lanc and Nielsen for the reason provided by the Examiner. Appeal Br. 23. Appellant's argument is convincing.

Lanc discloses a service that authenticates a user's identity and/or status as a part of a financial transaction with another party. Lanc ¶ 6; Appeal Br. 17. Nielsen teaches a system for monitoring fleet metrics. Nielsen ¶ 5. The Examiner's reason does not explain persuasively why or how a person of ordinary skill in the art would have incorporated Nielsen's teaching of processing fleet card transactions into Lanc's disclosed financial transaction authentication service to result in the claimed invention. *See KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418–19 (2007) (explaining that it is important to identify a reason that would have prompted a person of ordinary skill in the art to combine the teachings in the way the claimed invention does because “inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known”).

In view of the foregoing, we do not sustain the Examiner's rejection of independent claim 1 and claims 2–5 and 8 depending therefrom. The Examiner's rejection of independent claim 17 suffers from the same deficiency (Final Act. 9), and we likewise do not sustain the Examiner's rejection of independent claim 17 and claims 18–21 and 24 depending therefrom.

DECISION

The Examiner's decision to reject claim 1 under 35 U.S.C. § 112, second paragraph, is affirmed.

The Examiner's decision to reject claims 1–5, 8, 17–21, and 24 under 35 U.S.C. § 101 is affirmed.

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The Examiner's decision to reject claims 1–5, 8, 17–21, and 24 under 35 U.S.C. § 101 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). 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED