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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MOHAMMAD KHAN and PRADEEP KUMAR

Appeal 2016-008202
Application 12/651,420¹
Technology Center 3600

Before HUNG H. BUI, JOSEPH P. LENTIVECH, and
AARON W. MOORE, *Administrative Patent Judges*.

BUI, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants seek our review under 35 U.S.C. § 134(a) of the Examiner’s final rejection of claims 1–2, 4, 7–15, 17, 20–28, 30, and 33–38, which are all the claims pending in the application. Claims 3, 5, 6, 16, 18, 19, 29, 31, and 32 are canceled. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.²

¹ According to Appellants, the real party in interest is MasterCard International Incorporated. App. Br. 2.

² Our Decision refers to Appellants’ Appeal Brief filed December 4, 2015 (“App. Br.”); Reply Brief filed September 1, 2016 (“Reply Br.”); Examiner’s Answer mailed July 1, 2016 (“Ans.”); Final Office Action

STATEMENT OF THE CASE

Appellants' invention relates to "methods, systems, and computer readable media for redeeming and delivering electronic loyalty reward certificates using a mobile device." Spec. 1:14–16; Title.

Claims 1, 14, and 27 are independent claims. Claim 1 illustrates Appellants' invention, as reproduced below with disputed limitations emphasized:

1. A method for providing an electronic loyalty reward certificate to a mobile device, the method comprising:

utilizing a mobile device to generate electronic loyalty reward certificate selection information in response to redeeming, via a website associated with a merchant, loyalty points for an electronic loyalty reward certificate identified by the electronic loyalty reward certificate selection information, wherein the loyalty points are accumulated from purchase and non-purchase transactions conducted with the merchant, wherein utilizing the mobile device includes interfacing the mobile device to a smart poster via near field communications (NFC) to direct the mobile device to the website associated with the merchant, using a web browser of the mobile device to access the website, and selecting a loyalty reward option presented by the website using the web browser to generate the electronic loyalty reward certificate selection information;

providing, via the mobile device, the loyalty reward certificate selection information and a recipient mobile device identifier to a loyalty management server;

receiving, at an over the air (OTA) provisioning server and from the loyalty management server, electronic loyalty reward certificate data derived from the loyalty reward certificate selection information and the recipient mobile device identifier;

mailed May 4, 2015 ("Final Act."); and original Specification filed December 31, 2009 ("Spec.").

establishing, by the OTA provisioning server, a communications link with the mobile device using the recipient mobile device identifier; and

provisioning, from the OTA provisioning server, the electronic loyalty reward certificate data on the mobile device over the communications link via OTA communications, wherein the electronic loyalty reward certificate data is transferred from the mobile device to a wireless device reader via NFC upon interfacing the mobile device with the wireless device reader.

App. Br. 36 (Claims App.).

Examiner's Rejections and References

(1) Claims 1–2, 4, 7–15, 17, 20–28, 30, and 33–38 stand rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. Final Act. 2–5.

(3) Claims 1–2, 4, 7–15, 17, 20–28, 30, and 33–38 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Abifaker (US 2008/0052164 A1, published Feb. 28, 2008), Antonucci et al. (US 2003/0236712 A1, published Dec. 25, 2003; “Antonucci”), and Lauper (US 2007/0016479 A1, published Jan. 18, 2007). *Id.* at 5–17.

ANALYSIS

35 U.S.C. § 101: Claims 1–2, 4, 7–15, 17, 20–28, 30, and 33–38

In *Alice Corp. Pty. Ltd. v. CLS Bank International*, 134 S. Ct. 2347 (2014), the Supreme Court reiterates an analytical two-step framework previously set forth in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 132 S. Ct. 1289 (2012), “for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts.” *Alice*, 134 S. Ct. at

2355. The first step in the analysis is to “determine whether the claims at issue are directed to one of those patent-ineligible concepts,” such as an abstract idea. *Id.* If the claims are directed to a patent-ineligible concept, the second step in the analysis is to consider the elements of the claims “individually and ‘as an ordered combination’” to determine whether there are additional elements that “‘transform the nature of the claim’ into a patent-eligible application.” *Id.* (citing *Mayo*, 132 S. Ct. at 1297). In other words, the second step is to “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.* (citing *Mayo*, 132 S. Ct. at 1294).

In rejecting independent claims 1, 14, and 27 and dependent claims 2, 4, 7–13, 15, 17, 20–26, 28, 30, and 33–38 under 35 U.S.C. § 101, the Examiner finds these claims are directed to an abstract idea of organizing “human activity relating to commercial practices”, *i.e.*, a “fundamental economic practice.” Final Act. 3–4. The Examiner also finds

[t]he claim(s) do not include additional elements that are sufficient to amount to significantly more than the judicial exception because these elements are merely insignificant extra-solution activity and routine in implementing the aforementioned concepts; *i.e.*, applicant did not invent a novel way of allowing a user to navigate to a website, view gift card options, use loyalty points to purchase a gift card, nor a novel way of sending the information back/forth over the air (OTA) to provision a selected/purchase gift card onto a phone. Applicant also did not invent NFC, e-wallets, etc . . . through which he communicates a gift card to a merchant POS system.

Id. at 4.

As to the first step of the *Alice* inquiry, Appellants contend “independent claims 1, 14, and 27 are not directed to . . . an abstract idea,

because the claims are rooted in computer technology with no direct corresponding offline equivalence.” App. Br. 11 (citing *DDR Holdings v. Hotels.com*, 773 F.3d 1245 (2014)). Instead, Appellants argue these claims are directed to “a method, a system, and a computer readable medium for providing an electronic loyalty reward certificate to a mobile device that includes a mobile device interfaces [sic] that interfaces with a smart poster via near field communications (NFC), which is a wireless form of communications.” *Id.* at 11–12. According to Appellants, “the NFC communications conducted between the smart poster and mobile device, the communications conducted between the loyalty management server and the OTA provisioning server, and provisioning of the mobile device with electronic loyalty reward certificate data cannot be performed manually or via human activity alone.” *Id.* at 12. In the Reply, Appellants further argue “the instant claims are directed on a specific improvement in computer technology capabilities.” Reply Br. 3–4 (citing *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327 (Fed. Cir. 2016)).

We are not persuaded by Appellants’ arguments. As correctly recognized by the Examiner, (1) Appellants’ claims 1, 14, and 27, when considered in light of Appellants’ Specification, recite delivering “an electronic loyalty reward certificate” to a user, via a mobile device and (2) delivering “an electronic loyalty reward certificate” to a user, whether in person or via a mobile device, is nothing more than a “fundamental economic practice long prevalent [i.e., pre-existing] in our system of commerce” identified as an “abstract idea” by the Supreme Court in *Bilski v. Kappos*, 130 S. Ct. 3218 (2010). Final Act. 3–4.

Contrary to Appellants' arguments, none of the steps recited in claims 1, 14, and 27 provides: (1) a "solution . . . necessarily rooted in computer technology in order to overcome a problem specifically arising in the realm of computer networks," *DDR Holdings*, 773 F.3d at 1257; (2) "a specific improvement to the way computers operate," *Enfish*, 822 F.3d at 1336; or (3) an "unconventional technology solution . . . to a technological problem" that "improve[s] the performance of the system itself," *Amdocs (Israel) Ltd. v. Openet Telecom, Inc.*, 841 F.3d 1288, 1302 (Fed. Cir. 2016).

As to the second step of the *Alice* inquiry, Appellants argue "the claims recite significantly more than the judicially recognized exception" because each independent claim "recites the involvement and utilization of a mobile device, a smart poster, a loyalty management server, and an OTA provisioning server" and "the use of such elements to facilitate the providing of an electronic loyalty reward certificate to a mobile device constitutes significantly more than an abstract idea." App. Br. 12.

We remain unpersuaded by Appellants' arguments. In particular, we find nothing in Appellants' claims 1, 14, and 27 that adds anything "significantly more" to transform the abstract concept of delivering "an electronic loyalty reward certificate" to a user into a patent-eligible application. *Alice*, 134 S. Ct. at 2357. As described by the Supreme Court, the second step of the *Alice* inquiry is to "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.* 2355 (citing *Mayo*, 132 S. Ct. at 1294).

Appellants do not argue any of the elements of claims 1, 14, and 27 are individually inventive. Nor do Appellants argue the ordered combination of these elements is inventive. App. Br. 12–13. Limiting such an abstract concept to generic components such as “a mobile device,” “an OTA provisioning server,” and “a wireless device reader” for operation in the manner recited in Appellants’ claims 1, 14, and 27 does not make the abstract concept patent-eligible under 35 U.S.C. § 101. As recognized by the Supreme Court, “the mere recitation of a generic computer cannot transform a patent ineligible abstract idea into a patent-eligible invention.” *See Alice*, 134 S. Ct. at 2359 (concluding claims “simply instruct[ing] the practitioner to implement the abstract idea of intermediated settlement on a generic computer” not patent eligible); *see also Ultramercial*, 772 F.3d 709, 715–16 (Fed. Cir. 2014) (Claims merely reciting abstract idea of using advertising as currency as applied to particular technological environment of the Internet not patent eligible.); *Accenture Global Servs., GmbH v. Guidewire Software, Inc.*, 728 F.3d 1336, 1344–45 (Fed. Cir. 2013) (Claims reciting “generalized software components arranged to implement an abstract concept [of generating insurance-policy-related tasks based on rules to be completed upon the occurrence of an event] on a computer” not patent eligible.); *Dealertrack, Inc. v. Huber*, 674 F.3d 1315, 1333–34 (Fed. Cir. 2012) (“Simply adding a ‘computer aided’ limitation to a claim covering an abstract concept, without more, is insufficient to render [a] claim patent eligible.”).

Because Appellants’ claims 1–2, 4, 7–15, 17, 20–28, 30, and 33–38 are directed to a patent-ineligible abstract concept and do not recite

something “significantly more” under the second prong of the *Alice* analysis, we sustain the Examiner’s rejection of these claims under 35 U.S.C. § 101.

35 U.S.C. § 103(a): Claims 1–2, 4, 7–15, 17, 20–28, 30, and 33–38

The Examiner finds (1) the combination of Abifaker, Antonucci, and Lauper teaches all limitations of Appellants’ independent claims 1, 14, and 27; and articulates (2) “reasoning with underpinning” to support the combination of Abifaker, Antonucci, and Lauper. Final Act. 5–11 (citing Abifaker ¶¶ 31, 44–47, 50–51, 78; Antonucci ¶¶ 68–69; Lauper ¶ 10). In particular, the Examiner finds Abifaker teaches providing gift card services for mobile devices, including, *inter alia*: (1) “utilizing a mobile device to generate electronic loyalty reward certificate selection information” (*id.* at 5–6 (citing Abifaker ¶¶ 44–47)); (2) “loyalty reward certificate” in the form of loyalty programs associated with gift cards (*id.* at 6 (citing Abifaker ¶ 42)); and (3) “using a web browser of the mobile device to access the [merchant’s] website” and selecting a loyalty reward option presented by the website (*id.* (citing Abifaker ¶¶ 44–47)). The Examiner acknowledges Abifaker teaches “loyalty programs associated with gift cards” may be used to purchase “gift cards” but relies on Antonucci for teaching the redemption process, via a merchant’s website, using loyalty points to make any purchase including “gift cards.” *Id.* at 8–9 (citing Antonucci ¶¶ 68–69 (“consumers may request to redeem points for a gift card or certificate”)). Lauper is only relied upon for teaching “interfacing the mobile device to a smart poster, via near field communications (NFC) to direct the mobile device to the website associated with the merchant” to support the conclusion of obviousness. *Id.* at 10 (citing Lauper ¶ 10).

Appellants contend the combination of Abifaker, Antonucci, and Lauper does not teach or suggest the disputed limitation:

utilizing a mobile device to generate electronic loyalty reward certificate selection information in response to redeeming, via a website associated with a merchant, loyalty points for an electronic loyalty reward certificate identified by the electronic loyalty reward certificate selection information, as recited in claims 1 and 14, and similarly recited in claim 27 (emphasis added). In particular, Appellants acknowledge Abifaker teaches providing gift card services for mobile devices, including “loyalty programs associated with gift cards.” App. Br. 14–15. However, Appellants argue Abifaker does not teach such “loyalty programs associated with gift cards may be used to purchase wireless gift cards.” App. Br. 15. Likewise, Appellants acknowledge Antonucci teaches redemption of loyalty points, but argue Antonucci does not teach or suggest that “the points are redeemed in order to generate electronic loyalty reward certificate selection information,” as recited in claims 1 and 14, and similarly recited in claim 27. *Id.* at 16. Lastly, Appellants also contend Lauper does not teach or suggest the disputed limitation of claims 1, 14, and 27. *Id.* at 17–18.

We do not find Appellants’ arguments persuasive or commensurate with the scope of claims 1, 14, and 27. Instead, we find the Examiner provides a comprehensive response to Appellants’ arguments supported by a preponderance of evidence. Ans. 6–11. As such, we adopt the Examiner’s findings and explanations. *Id.* For example, as recognized by the Examiner, Appellants’ claims 1, 14, and 27 do not require “that ‘loyalty programs’ are used to purchase wireless gift cards.” Ans. 7. Instead, the claims merely recite generating “electronic loyalty reward certificate selection information in response to redeeming . . . loyalty points for an electronic loyalty reward

certificate identified by the electronic loyalty reward certificate selection information.”

One cannot show nonobviousness by attacking references individually where the rejection is based on a combinations of references. *In re Keller*, 642 F.2d 413, 425 (CCPA 1981). The test of obviousness is what the combined teachings would have suggested to those of ordinary skill in the art. *Id.* at 425. Contrary to Appellants’ arguments, we agree with the Examiner that the combined teachings of Abifaker and Antonucci teach “utilizing a mobile device to generate electronic loyalty reward certificate selection information in response to redeeming, via a website associated with a merchant, loyalty points for an electronic loyalty reward certificate identified by the electronic loyalty reward certificate selection information,” as recited in claims 1, 14, and 27. Final Act. 5–9 (citing Abifaker ¶¶ 31, 44–47, 50–51, 78; Antonucci ¶¶ 68–69).

For the reasons set forth above, Appellants have not persuaded us of Examiner error. Accordingly, we sustain the Examiner’s obviousness rejection of independent claims 1, 14, and 27.

With respect to dependent claims 2, 4, 7–13, 15, 17, 20–26, 28, 30, and 33–38, Appellants contend these claims are patentable over the cited references mostly for the same reasons discussed. App. Br. 19–34. We disagree and adopt the Examiner’s responses on pages 11–18 of the Examiner’s Answer.

CONCLUSION

On the record before us, we conclude Appellants have not demonstrated the Examiner erred in rejecting claims 1–2, 4, 7–15, 17, 20–28, 30, and 33–38 under 35 U.S.C. §§ 101 and 103(a).

DECISION

As such, we affirm the Examiner’s final rejections of claims 1–2, 4, 7–15, 17, 20–28, 30, and 33–38.

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