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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte GREGORY DAVID LEIBON and
KATHERINE BECK HARRIS¹

Appeal 2016-008390
Application 12/908,677
Technology Center 3600

Before BRADLEY W. BAUMEISTER, AARON W. MOORE, and
MICHAEL J. ENGLE, *Administrative Patent Judges*.

BAUMEISTER, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's
Final Rejection of claims 1, 2, 4–10, 12–18, 20, and 21. App. Br. 7–28.²
We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

¹ Appellants list FIS Financial Compliance Solutions, LLC, as the real party
in interest. Appeal Brief 3, filed June 3, 2016 (“App. Br.”).

² Rather than repeat the Examiner's positions and Appellants' arguments in
their entirety, we refer to the above-mentioned Appeal Brief, as well as the
following documents, for their respective details: the Final Action mailed
November 4, 2015 (“Final Act.”); the Examiner's Answer mailed July 27,
2016 (“Ans.”); and the Reply Brief filed September 6, 2016 (“Reply Br.”).

STATEMENT OF THE CASE

Appellants describe the present invention as follows:

Systems and methods for presenting fraud detection information are presented. In one example, a computer system analyzes empirical data to detect potentially fraudulent activity and alerts users of the potentially fraudulent activity via a fraud detection user interface. The fraud detection user interface determines a set of user interface components . . . suitable to present the potentially fraudulent activity and presents facts associated with the potentially fraudulent activity to a user for further analysis and investigation.

Abstract.

Independent claim 1, reproduced below, illustrates the claimed invention:

1. A system for providing information regarding a suspect check that is potentially fraudulent, the system comprising:

a memory storing data describing a check book associated with a plurality of checks, the plurality of checks including the suspect check and a plurality of authentic checks, each check of the plurality of checks including a plurality of attributes, each attribute of each plurality of attributes having an actual value;

an interface configured to display representations of the plurality of checks by receiving data from the memory, based on attributes associated with each of the represented checks; and

a processor coupled to the memory and configured to:

receive an indication of the suspect check;

generate a zone related to the plurality of checks, the zone including a plurality of reference values for at least one of the plurality of attributes of the suspect check;

present the zone on the interface;

present on the zone at least one representation of the plurality of checks, the position of each representation on the zone being based on the values of each attribute

associated with each of the plurality of checks, the at least one representation comprising:

a representation of the suspect check, and

at least one representation of at least one authentic check; and

a bus connected to each of the memory, the processor, and the interface.

Claims 1, 2, 4–10, 12–18, 20, and 21 stand rejected under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter. Final Act. 2–8.

Claims 1, 2, 4–10, 12–18, and 20 stand rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1–20 of Leibon et al. (US 8,290,845 B2; issued Oct. 16, 2012) (hereinafter “Leibon”). Final Act. 9–11.

Claims 1, 2, 9, 10, 17, and 18 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Blaikie (US 2007/0297664 A1; published Dec. 27, 2007) and Jacobs (US 2005/0097019 A1; published May 5, 2005). Final Act. 11–14.

Claims 4–8, 12–16, and 20 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Blaikie, Jacobs, and Cordery et al. (US 2007/0143158 A1; published June 21, 2007) (hereinafter “Cordery”). Final Act. 14–15.

We review the appealed rejections for error based upon the issues identified by Appellants, and in light of the arguments and evidence produced thereon. *Ex parte Frye*, 94 USPQ2d 1072, 1075 (BPAI 2010) (precedential).

THE PATENT-INELIGIBLE-SUBJECT-MATTER REJECTION

Overview

The Examiner determines, *inter alia*, that independent claim 9 is directed to a method of providing information regarding a suspect check that is potentially fraudulent, comparing the gathered data to determine a risk level, and, thereby, mitigating the risk. Final Act. 3. Based on this determination, the Examiner concludes that claim 9 is directed to an abstract idea. *Id.*

The Examiner further determines that the method is not directed to significantly more than the abstract idea because the method is carried out on a computer system comprising a memory, an interface, and a suitably programmed processor such that the computer performs activities according to generic functionalities that are well-understood, routine, and conventional. *Id.* at 5. The Examiner, likewise, determines the other claims to be directed to patent-ineligible subject matter because “[s]imilar reasoning and rationale applies to [independent] system claim 1 and the computer-readable medium claim 17” and because the additionally recited limitations of the dependent claims fail to establish that the claims are not directed to an abstract idea. *Id.*

Appellants assert, *inter alia*, that the rejection suffers from the mistakes of a failure to properly apply the two-step *Alice* test, a failure to make a case of abstractness due to a failure of proof and law, a refusal to consider preemption, and an unreasonable construction of the claims to avoid determining them to be drawn to significantly more than an abstract idea. Reply Br. 2. We address Appellants’ arguments *seriatim*.

Principles of Law

The Supreme Court has set forth an analytical “framework for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts.” *Alice Corp. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2355 (2014) (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 71–73 (2012)). In the first step of the two-step analysis established in *Alice*, we determine whether the claims at issue are “directed to” a judicial exception, such as an abstract idea. *Alice*, 134 S. Ct. at 2355. If not, the inquiry ends. *Thales Visionix Inc. v. U.S.*, 850 F.3d 1343, 1346 (Fed. Cir. 2017); *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1339 (Fed. Cir. 2016). If the claims are determined to be directed to an abstract idea, then we consider under step two whether the claims contain an “inventive concept” sufficient to “transform the nature of the claim into a patent-eligible application.” *Alice*, 134 S. Ct. at 2355 (quotations and citation omitted).

In considering whether a claim is directed to an abstract idea, we acknowledge, as did the Supreme Court, 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. We therefore look to whether the claims focus on a specific means or method that improves the relevant technology or are instead directed to a result or effect that itself is the abstract idea and merely invoke generic processes and machinery. *See Enfish*, 822 F.3d at 1336.

If the claims are directed to an abstract idea, we then must consider whether a claim contains an element or a combination of elements that is

sufficient to transform the nature of the claim into a patent-eligible application. *Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 714 (Fed. Cir. 2014); *Alice*, 134 S. Ct. at 2355.

In applying step two of the *Alice* analysis, we must “determine whether the claims do significantly more than simply describe [the] abstract method” and thus transform the abstract idea into patentable subject matter. We look to see whether there are any “additional features” in the claims that constitute an “inventive concept,” thereby rendering the claims eligible for patenting even if they are directed to an abstract idea. Those “additional features” must be more than “well-understood, routine, conventional activity.”

Intellectual Ventures I LLC v. Erie Indem. Co., 850 F.3d 1315, 1328 (Fed. Cir. 2017) (citations omitted).

Claims that “merely require generic computer implementation[] fail to transform [an] abstract idea into a patent-eligible invention.” *Alice*, 134 S. Ct. at 2357.

Contentions and Analysis

Appellants first argue that the claims are not directed to an abstract idea. App. Br. 9–14. Towards this end, Appellants argue that “the Office has presented no evidence that the claims . . . are drawn to ‘long prevalent’ and ‘fundamental’ ideas.” App. Br. 11. According to Appellants,

Every Office Action has merely analogized chosen claim elements to a strawman vague concept and worked towards the predetermined conclusion that all elements are “abstract.” However, just as with the technology in *Enfish*, the independent claims do not merely recite “conventional computer components [added] to well-known business practices” or a basic concept that is similar to any abstract idea previously identified by the courts or the USPTO.

Id. (footnote omitted).

Appellants argue that “[t]he independent claims instead recite improvements to user interfaces—which are necessarily rooted in computer technology—and overcome problems specifically arising in graphical user interfaces.” *Id.* Appellants argue that the present invention overcomes prior software’s poor display paradigms in which a user must individually review details on every transaction and better enables businesses to find fraud hidden in large amounts of transactional information. *Id.* at 12.

This argument is unpersuasive. We agree with the Examiner (Final Act. 4) that the independent claims are directed to organizing, storing, and transmitting data. More particularly, the claims are directed to concepts relating to tracking and organizing information. *See* March 2018: Eligibility Quick Reference Sheet 1 (“*Identifying Abstract Ideas (Part 1)*”), available at <https://www.uspto.gov/sites/default/files/documents/ieg-qrs.pdf>.

This reference sheet includes a subsection labeled “Certain Methods of Organizing Human Activity—MPEP 2106.04(a)(2) Part (II),” as well as a further subsection thereunder—“D. Concepts Relating To Tracking or Organizing Information.” The cases cited in this subsection evidence that the courts have determined the subject matter to which the present claims are directed—a method of organizing and displaying information contained in checks to facilitate an analysis of the checks’ authenticity—constitutes patent-ineligible subject matter.

The fact that Appellants’ method is performed with the aid of conventional computer components does not mean, as Appellants allege (*see* App. Br. 11, 14), that the invention is rooted in computer technology or that the invention constitutes a patentable improvement in graphical user interfaces. Rather, the inventive concept of assisting in recognizing the

existence of fake or fraudulent checks alternatively could be achieved equally by a human using pen and paper to create graphs or charts. Restated, Appellants' invention constitutes undertaking a patent-ineligible abstract idea more efficiently by using well-known computer components in their routine and conventional manners.

Appellants argue that “[t]he Final Office Action oversimplifies the claims and ignores the technical elements thereof.” App. Br. 14 (emphasis omitted). According to Appellants, the Examiner has dumbed down the claims to mere concepts, downplaying the invention's benefits. Citing the reasoning of the arguments addressed above, Appellants argue “the claims provide benefits including enabling fraud detection software to find fraud hidden in large amounts of transactional information without requiring a user to individually review details on every transaction.” *Id.* at 14–15.

This argument is unpersuasive. Appellants do not set forth what technical improvements to fraud detection software the Examiner allegedly ignored. Furthermore, and as explained above, the claimed way of automating the organization of information so as to display check attributes or data in a particular manner that is easier for a human to analyze does not constitute a technological improvement.

Appellants next argue that “[t]here is no legitimate risk that any ‘basic tools’ would be monopolized.” App. Br. 15 (emphasis omitted). Even accepting this assertion and Appellants' supporting assertions *arguendo*, the arguments are unpersuasive. The Supreme Court has described “the concern that drives this exclusionary principle [i.e., the exclusion of abstract ideas from patent-eligible subject matter] as one of pre-emption.” *Alice*, 134 S. Ct. at 2354. However, characterizing preemption as a driving concern for

patent eligibility is not the same as characterizing preemption as the sole test for patent eligibility. As our reviewing court has explained: “The Supreme Court has made clear that the principle of preemption is the basis for the judicial exceptions to patentability” and “[f]or this reason, questions on preemption are inherent in and resolved by the § 101 analysis.” *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015) (citing *Alice*, 134 S. Ct. at 2354). Although “preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility.” *Id.*

Appellants next argue that even assuming the claims are directed to an abstract idea, they amount to significantly more than the abstract idea. App. Br. 16–19. Appellants assert that, “[a]s explained in the specification, typical software used by many businesses utilize ‘rudimentary user interfaces that display unadorned transactional information.’ The standard operation of such elements is to present vast amounts of transactional information.” *Id.* at 17 (footnote omitted).

Appellants then attempt to distinguish their invention to show that “elements of the independent claims include do not operate in a routine and conventional manner:”

For example, claim 1 recites: “generate a zone related to the plurality of checks, the zone including a plurality of reference values for at least one of the plurality of attributes of the suspect check” and “present on the zone at least one representation of the plurality of checks, the position of each representation on the zone being based on the values of each attribute associated with each of the plurality of checks, the at least one representation comprising: a representation of the suspect check, and at least one representation of at least one authentic check.”

Id. at 17–18.

This argument is unpersuasive. The features Appellants argue relate to what information is displayed and how it is displayed—not to how a display is improved in order to create better display capabilities. That is, the argued features relate to a purported improvement to the abstract idea itself—representations that alternatively could be presented on hand-printed graphs or charts. Because the arguments pertain to features that constitute the abstract idea, the arguments do not evidence that the claim limitations set forth significantly more than the abstract idea.

Appellants separately argue the patentability of dependent claim 21. App. Br. 18–19. Specifically, Appellants note that the Examiner indicates that claim 21 was not taught by the prior art. App. Br. 19; *see also* Final Act. 11–15 (wherein the Examiner does not reject claim 21 under 35 U.S.C. § 103 as obvious); *see also id.* at 16 (wherein the Examiner indicates that claim 21 would be allowable if rewritten to overcome the rejection under 35 U.S.C. § 101). Appellants argue that these actions indicate

[t]he Examiner [] impliedly agrees that claim 21 involves “significantly more” than the abstract idea, and is patent-eligible because it **exceeds** “well-understood, routine, conventional activities” already known in the industry. Moreover, because claim 21 is not taught by the prior art, it cannot recite “conventional computer components [added] to well-known business practices.” Rather, the claim recites elements “directed to an improvement in the functioning of a computer.”

App. Br. 19 (footnotes omitted).

Appellants’ argument is unpersuasive because it conflates the patent-eligibility inquiry under 35 U.S.C. § 101 with the patentability inquiries under 35 U.S.C. §§ 102 and 103. Furthermore, Appellants present no support for their assertion that the Examiner implicitly found claim 21 to involve significantly more than an abstract idea. *See* Final Act. 7–8

(determining the additional limitations of claim 21 do not add an inventive concept). It instead seems more reasonable to infer that because the Examiner did not reject claim 21 as obvious, but did maintain the § 101 rejection of claim 21, the Examiner determined the prior art did not reasonably teach or suggest performing the abstract idea of claim 21, itself.

THE OBVIOUSNESS REJECTIONS

Findings and Contentions

The Examiner finds that Blaikie discloses all of the limitations of independent claims 1, 9, and 17, except for the limitation of generating a zone including a plurality of reference values for at least one of the plurality of attributes of the suspect check. Final Act. 11–12. The Examiner also finds that Blaikie does not teach the additional steps associated with the generated zone—presenting the zone on an interface to display representations of the checks based on check attributes, and presenting the position of each representation on the zone based on values of the attributes. *Id.* at 12.

The Examiner then finds that Jacobs teaches these features. *Id.* at 12–13 (citing Jacobs ¶¶ 3, 4, 13–21, 26, 33, 41–59, 64–66; FIGs. 1–4; Abstract). The Examiner further finds that one of ordinary skill would have recognized that applying Jacobs’ features with the invention of Blaikie would have yielded predictable results. Final Act. 13–14. The Examiner also finds the cited art provides evidence that the claimed invention is merely a combination of old elements that produce predictable results. *Id.* at 14.

Appellants assert that Jacobs fails to teach generating and presenting a zone, as well as presenting the position of representations on the zone based on attribute values. App. Br. 23. Appellants argue

Jacobs relates to a system 50 for validating financial documents such as checks, cash or any other document. *Jacobs* teaches obtaining a “digital representation of [a] financial document,” and establishing “validation thresholds” corresponding to each data field on the financial document. The data fields are compared to model records and a “confidence value” is generated for each comparison representing a degree of similarity between the data field and the model record. The validation thresholds may be changed based on the confidence values.

Id. (footnotes omitted).

Appellants further argue that

comparing individual fields on a check to model data in order to validate the check is irrelevant to the claimed combination of elements[:] . . . receiving an indication of a suspect check, and presenting representations of the suspect check and other checks on a zone on an interface, the position of each representation being based on a value of each attribute associated with the checks.

Id. at 24.

Analysis

Appellants’ arguments persuade us of Examiner error. Accordingly, we do not sustain the obviousness rejection of independent claims 1, 9, and 17, or of claims 2, 10, and 18, which respectively depend from these claims.

With respect to the remaining rejection of dependent claims 4–8, 12–16, and 20, the Examiner has not established that Cordery cures the deficiency of the obviousness rejection explained above. We, therefore, do

not sustain this rejection for the reasons set forth above in relation to the obviousness rejection over Blaikie and Jacobs.

THE DOUBLE-PATENTING REJECTION

Findings and Contentions

The Examiner finds that the listed claims are not patentably distinct from claims 1–20 of Leibon. Final Act. 9–11. For example, the Examiner finds that claims 8 and 9 of Leibon recite all of the steps of claim 9 of the instant application, except for the steps of presenting the zone on an interface, and presenting on the zone at least one representation of the plurality of checks, as recited in claim 9. *Id.* at 10. The Examiner takes official notice that these additional limitations were old and well known. *Id.* (wherein the Examiner reasons “presenting on an interface a plurality of reference values for the checks (like the serial numbers of the checks, account numbers, fields for signature, routing numbers etc.) is old and well known”). The Examiner concludes that one of ordinary skill would have recognized that applying the steps to Leibon’s invention would have yielded predictable results. *Id.* at 10–11.

Appellants argue, *inter alia*, that the Examiner’s reliance on official notice is improper in this situation to make up for the differences between Leibon’s claims and the present claims. App. Br. 19–21.

Analysis

Just as in the case of the obviousness rejections, the Examiner improperly interprets the claim limitations for which official notice is taken. *See, e.g.*, Final Act. 10. The present claims do not require presenting serial numbers, account numbers, or the like. Rather, the claims require

“[presenting a] zone including a plurality of reference values for at least one of the plurality of attributes of the suspect check,” and “present[ing] on the zone at least one representation of the plurality of checks, the position of each representation on the zone being based on the values of each attribute associated with each of the plurality of checks.” *See* claim 1.

Because the Examiner relies upon an improper interpretation of the disputed limitations, the Examiner has not established the appropriateness of taking official notice in the present case. *See* Final Act. 10. We therefore do not sustain the non-statutory obviousness-type double patenting rejection of claims 1, 2, 4–10, 12–18, and 20.³

CONCLUSIONS

We sustain the rejection of claims 1, 2, 4–10, 12–18, 20, and 21 under 35 U.S.C. § 101.

We do not sustain the rejection of claims 1, 2, 4–10, 12–18, and 20 under 35 U.S.C. § 103.

We do not sustain the rejection of claims 1, 2, 4–10, 12–18, and 20 on the ground of non-statutory obviousness-type double patenting.

³ Being an appellate body, we do not exercise our discretionary authority under 37 C.F.R. § 41.50(b) to determine whether a double patenting rejection over any of Leibon’s claims would, in fact, be appropriate. We only determine that the Examiner has not established a *prima facie* case for the double patenting rejection.

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Application 12/908,677

DECISION

Because we have affirmed at least one ground of rejection with respect to each claim on appeal, the Examiner's decision rejecting claims 1, 2, 4–10, 12–18, 20, and 21 is affirmed. *See* 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)(1). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED