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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
14/060,554	10/22/2013	Paul Bater	107687.00040	9812
33649	7590	12/14/2018	EXAMINER	
Mr. Christopher John Rourk Jackson Walker LLP 2323 ROSS AVENUE SUITE 600 DALLAS, TX 75201			CHANG, EDWARD	
			ART UNIT	PAPER NUMBER
			3696	
			MAIL DATE	DELIVERY MODE
			12/14/2018	PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte PAUL BATER

Appeal 2017-001624
Application 14/060,554¹
Technology Center 3600

Before BRUCE T. WIEDER, AMEE A. SHAH, and
ROBERT J. SILVERMAN, *Administrative Patent Judges*.

SILVERMAN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellant appeals under 35 U.S.C. § 134(a) from the Examiner's decision rejecting claims 51–74. We have jurisdiction under 35 U.S.C. § 6(b). An oral hearing was held on December 6, 2018.

We REVERSE and enter a NEW GROUND OF REJECTION, pursuant to 37 C.F.R. § 41.50(b).

¹ “The real party in interest in this appeal is BANKCLARITY JERSEY GROUP LIMITED.” Appeal Br. 4.

ILLUSTRATIVE CLAIM

51. A method of generating account management information, the method comprising the steps of:

providing a list of contacts to a processor;

securely downloading financial data from a financial data source using the processor, wherein the financial data comprises one or more transactions; and

automatically assigning each transaction to a contact on the list of contacts using the processor as a function of data fields defining each of the transactions;

wherein, if the processor is unable to automatically assign one of the transactions to a contact on the list of contacts, the processor generates a note that the one of the transactions is not assigned.

REJECTION

Claims 51–74 are rejected under 35 U.S.C. § 101 as ineligible subject matter.

FINDINGS OF FACT

The findings of fact relied upon, which are supported by a preponderance of the evidence, appear in the following Analysis.

ANALYSIS

Subject-Matter Eligibility

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. Yet, subject matter belonging to any of the statutory categories may, nevertheless, be ineligible for patenting. The Supreme Court has interpreted § 101 to exclude laws of nature, natural phenomena, and abstract ideas, because they are regarded as the basic tools of scientific and technological work, such that including them within the domain of

patent protection would risk inhibiting future innovation premised upon them. *Ass’n for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576, 589 (2013).

Of course, “[a]t some level, ‘all inventions . . . embody, use, reflect, rest upon, or apply’” these basic tools of scientific and technological work. *Alice Corp. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2354 (2014) (internal citation omitted). Accordingly, evaluating ineligible subject matter, under this judicial exclusion, involves a two-step framework for “distinguish[ing] between patents that claim the buildin[g] block[s] of human ingenuity and those that integrate the building blocks into something more, thereby transform[ing] them into a patent-eligible invention.” *Id.* (internal quotation marks and citation omitted). The first step determines whether the claim is directed to judicially excluded subject matter (such as a so-called “abstract idea”); the second step determines whether there are any “additional elements” recited in the claim that (either individually or as an “ordered combination”) amount to “significantly more” than the identified judicially excepted subject matter itself. *Id.* at 2355.

Although “claim construction is not an inviolable prerequisite” to an analysis under § 101, “a full understanding of the basic character of the claimed subject matter” is, nevertheless, needed to evaluate questions of subject-matter eligibility. *Bancorp Servs., LLC v. Sun Life Assur. Co. of Canada (U.S.)*, 687 F.3d 1266, 1273–74 (Fed. Cir. 2012). *See also McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1311 (Fed. Cir. 2016) (“As an initial matter, we note that, in this case, claim construction is helpful to resolve the question of patentability under § 101.”)

In the present Appeal, we are unable to ascertain such an understanding of the claimed subject matter and, therefore, we do not assess the merits of the rejection under § 101. Rather, for the reasons given below, and pursuant to our authority under 37 C.F.R. § 41.50(b) to enter a new ground of rejection, we determine that the claims are indefinite under 35 U.S.C. § 112(b). Accordingly, the rejection under § 101 must fall, *pro forma*, because it is necessarily based upon speculative assumption as to the meaning of the claims. *See In re Steele*, 305 F.2d 859, 862–63 (CCPA 1962) (addressing an obviousness rejection). This determination does not reflect on the merits of the underlying rejection based upon § 101.

Indefiniteness
(New Ground of Rejection)

During the Office’s evaluation, under 35 U.S.C. § 112(b), a proposed patent “claim is indefinite when it contains words or phrases whose meaning is unclear,” i.e., “ambiguous, vague, incoherent, opaque, or otherwise unclear in describing and defining the claimed invention.” *In re Packard*, 751 F.3d 1307, 1310–11 (Fed. Cir. 2014) (per curiam); *see also In re McAward*, No. 2015-006416, 2017 WL 3669566, at *3 (PTAB Aug. 25, 2017) (precedential).

Independent claim 1 includes the limitation “automatically assigning each transaction to a contact on the list of contacts using the processor as a function of data fields defining each of the transactions.” Neither the word “assign,” nor any variant thereof (e.g., “assigning”), appears in the Specification, original claims, or drawings. Although a failure to use the exact words that appear in the Specification does not necessarily give rise to indefiniteness, in the present case, the meaning of the claimed “assigning [a]

transaction to a contact,” in the context of claim 1, is unclear. The uncertainty as to the meaning of this language is emphasized by the Specification’s apparent effort to be precise, in regard to the financial terminology employed therein. For example, the Specification states:

It should be noted that the allocation of financial data to one or more headings and/or contacts as described above is sometimes referred to as the clarification of that data. It is hereby stated that references herein to the “allocation”, “clarification” and “posting” of data refer to the allocation process described above. Those terms are therefore interchangeable.

Spec. 10, ll. 5–11.

Similarly unclear is the meaning of the kindred phrase “the processor is unable to automatically assign one of the transactions to a contact,” which also appears in claim 1.

Variants of the word “assign” also appear in the other independent claims in this Appeal (claims 65 and 70). Therefore, we enter a new ground of rejection of independent claims 51, 65, and 70 — along with dependent claims 52–64, 66–69, and 71–74 — under 35 U.S.C. § 112(b), for failure to particularly point out and distinctly claim the subject matter regarded as the invention.

DECISION

We REVERSE the Examiner’s decision rejecting claims 51–74, *pro forma*.

We ENTER A NEW GROUND OF REJECTION for claims 51–74, under 35 U.S.C. § 112(b).

This Decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). Section 41.50(b) provides that “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.” Section 41.50(b) also provides:

When the Board enters such a non-final decision, the appellant, within two months from the date of the decision, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new Evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the prosecution will be remanded to the examiner. The new ground of rejection is binding upon the examiner unless an amendment or new Evidence not previously of Record is made which, in the opinion of the examiner, overcomes the new ground of rejection designated in the decision. Should the examiner reject the claims, appellant may again appeal to the Board pursuant to this subpart.

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same Record. The request for rehearing must address any new ground of rejection and state with particularity the points believed to have been misapprehended or overlooked in entering the new ground of rejection and also state all other grounds upon which rehearing is sought.

Further guidance on responding to a new ground of rejection can be found in the Manual of Patent Examining Procedure (MPEP) § 1214.01.

REVERSED; 37 C.F.R. § 41.50(b).