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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte THOMAS PURVES, SHILPAK MAHADKAR,
and AYMAN HAMMAD

Appeal 2017-001753
Application 13/624,779[1]
Technology Center 3600

Before JOSEPH A. FISCHETTI, ANTON W. FETTING, and ROBERT J. SILVERMAN, *Administrative Patent Judges*.

FISCHETTI, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134 from the Examiner's Final Rejection of claims 26–49. We have jurisdiction under 35 U.S.C. § 6(b).

SUMMARY OF DECISION

We AFFIRM.

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[1] Appellants identify Visa Inc. as the real party in interest. Appeal Br. 1.

THE INVENTION

Appellants state, "[t]he present innovations are directed generally to digital wallets…." Spec. ¶ 3.

Claim 26 reproduced below, is representative of the subject matter on appeal.

> 26. A processor implemented issuer facilitated wallet service account enrollment method, comprising:
>
> receiving, from a user logged into an issuer's page, the issuer's website, or the issuer's application, a request to (i) create a new virtual wallet account, or (ii) enroll a user's payment account in the new virtual wallet account, whereby the request includes a payment account identifier, a virtual wallet account identifier, and virtual wallet access credentials;
>
> retrieving, via a processor, from a card issuer database, virtual wallet account enrollment information for an account created by the issuer that is associated with the payment account identifier;
>
> transmitting, via the processor, the virtual wallet account enrollment information, the virtual wallet account identifier, and the virtual wallet access credentials to a virtual wallet server; and
>
> receiving an indication that the account created by the issuer has been successfully enrolled in the new virtual wallet account corresponding to the virtual wallet account identifier;
>
> wherein the virtual wallet access credentials enable the user to access the new virtual wallet account after the creation of the new virtual wallet account, wherein images of cards are cached for providing individually customized versions of the images of the cards for association with the new virtual wallet account.

THE REJECTION[2]

Claims 26–49 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. Final Act. 2–5.

ANALYSIS

35 U.S.C. § 101 REJECTION

We will sustain the rejection of claims 26–49 under 35 U.S.C. § 101.

The Supreme Court

> set forth a framework for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts. First, . . . determine whether the claims at issue are directed to one of those patent-ineligible concepts. . . . If so, we then ask, "[w]hat else is there in the claims before us?" . . . To answer that question, . . . 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. . . . [The Court] 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."

Alice Corp. Pty. Ltd. v. CLS Bank Int'l, 134 S. Ct. 2347, 2355 (2014) (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 72–73 (2012)).

To perform this test, we must first determine whether the claims at issue are directed to a patent-ineligible concept.

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[2] The Examiner withdrew the rejection made under 35 U.S.C. § 103(a) of claims 26–49. (Answer 2).

Although the Court in *Alice* made a direct finding as to what the claims were directed to, we determine that this case's claims themselves and the Specification provide enough information to inform one as to what they are directed to.

The steps in claim 26 result in:

> wherein the virtual wallet access credentials enable the user to access the new virtual wallet account after the creation of the new virtual wallet account, wherein images of cards are cached for providing individually customized versions of the images of the cards for association with the new virtual wallet account.

The Examiner found that the claims are directed to a fundamental economic practice of, "enrollment and payment (credit card and banking transaction process) in e-commerce using credit card (see specification page 2)." Final Act. 3. The Specification states:

> Various embodiments of the WSEP [(WALLET SERVICE ENROLLMENT PLATFORM)] may be configured to facilitate the creation of a virtual wallet account. For example, a financial institution may already have information in their records such as payment accounts, billing address, credit history reports and/ or the like. By providing this information to the wallet service provider, a wallet account may be established on behalf of the user. In some embodiments, the information provided by the financial institution will be sufficient itself to enable the creation of a virtual wallet account. This would be the case where the information requirements of the virtual wallet provider are such that the financial institution is able to provide sufficient information about the user to enable creation of a wallet account. In other embodiments, the information provided by the financial institution will only partly fulfill the information requirements of the virtual wallet provider, in which case the user may be prompted for additional information before the virtual wallet is created.

Spec. ¶ 35. The Specification also describes:

> Some embodiments of the WSEP may provide consumers facilities for easily and conveniently personalizing new prepaid accounts with their issuer using previously verified personal information stored in an online wallet, and expediting provisioning a prepaid account to a digital wallet. Once a prepaid card is connected with the wallet, the WSEP provides the consumer an easy to remember authentication tool to sign on to view and manage their prepaid account either at the wallet destination website/application or through limited federation to the prepaid issuers online (or mobile) prepaid service application.

Id. ¶ 51. The Specification at paragraph 112 describes that "the card image server may create an image 'on the fly' in real-time using a dynamic image creation tool and/or a template tool such as ImageMagik, Gimp, Photoshop droplets, and/ or the like." Thus, all this evidence shows that claim 26 is directed to adding an account to a virtual wallet account wherein virtual wallet access credentials enable individually customized versions of the images of the accounts for the new virtual wallet account. It follows from prior Supreme Court cases, and *Gottschalk v. Benson*, 409 U.S. 63 (1972), in particular, that the claims at issue here are directed to an abstract idea. Enabling individually customized versions of the images of accounts for a new virtual wallet account is a fundamental financial principle because it identifies in the mind of the account holder the source of the financial services provided, thus, avoiding confusion in the marketplace. The patent-ineligible end of the 35 U.S.C. § 101 spectrum includes methods that describe fundamental financial principles. *See Alice*, 134 S. Ct. at 2355–57.

As in *Alice*, we need not labor to delimit the precise contours of the "abstract ideas" category in this case. It is enough to recognize that there is no meaningful distinction in the level of abstraction between the concept of

an intermediated settlement in *Alice* and the concept of enabling individually customized versions of images of accounts for a new virtual wallet account, at issue here. Both are squarely within the realm of "abstract ideas" as the Court has used that term. That the claims do not preempt all forms of the abstraction or may be limited to virtual wallets, does not make them any less abstract. *See OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1360–61 (Fed. Cir. 2015).

Claim 26, unlike the claims found non-abstract in prior cases, uses generic computer technology to perform data reception, transmission, and linkage and does not recite an improvement to a particular computer technology. *See, e.g.*, *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1314–15 (Fed. Cir. 2016) (finding claims not abstract because they "focused on a specific asserted improvement in computer animation").

The introduction of a computer into the claims does not alter the analysis at *Mayo* step two.

> [T]he mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention. Stating an abstract idea "while adding the words 'apply it'" is not enough for patent eligibility. Nor is limiting the use of an abstract idea " 'to a particular technological environment.' " Stating an abstract idea while adding the words "apply it with a computer" simply combines those two steps, with the same deficient result. Thus, if a patent's recitation of a computer amounts to a mere instruction to "implemen[t]" an abstract idea "on . . . a computer," that addition cannot impart patent eligibility. This conclusion accords with the pre-emption concern that undergirds our § 101 jurisprudence. Given the ubiquity of computers, wholly generic computer implementation is not generally the sort of "additional featur[e]" that provides any "practical assurance that the

> process is more than a drafting effort designed to monopolize the [abstract idea] itself."

Alice, 134 S. Ct. at 2358 (alterations in original) (internal citations omitted).

"[T]he relevant question is whether the claims here do more than simply instruct the practitioner to implement the abstract idea . . . on a generic computer." *Id.* at 2359. They do not.

Taking the claim elements separately, the function performed by the computer at each step of the process is purely conventional. Using a computer to retrieve, select, and apply decision criteria to data and modify the data as a result amounts to electronic data query and retrieval—one of the most basic functions of a computer. All of these computer functions are well-understood, routine, conventional activities previously known to the industry. *See Elec. Power Grp. v. Alstom S.A.,* 830 F.3d 1354*; see also In re Katz Interactive Call Processing Patent Litig*, 639 F.3d 1303, 1316 (Fed. Cir. 2011) ("Absent a possible narrower construction of the terms 'processing,' 'receiving,' and 'storing,' . . . those functions can be achieved by any general purpose computer without special programming"). In short, each step does no more than require a generic computer to perform generic computer functions. As to the data operated upon, "even if a process of collecting and analyzing information is 'limited to particular content' or a particular 'source,' that limitation does not make the collection and analysis other than abstract." *SAP Am. Inc. v. InvestPic, LLC*, 890 F.3d 1016, 1022 (Fed. Cir. 2018) (internal citation omitted).

Considered as an ordered combination, the computer components of Appellants' method add nothing that is not already present when the steps are considered separately. The sequence of data reception-analysis-access/display is equally generic and conventional or otherwise held to be

abstract. *See Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 715 (Fed. Cir. 2014) (sequence of receiving, selecting, offering for exchange, display, allowing access, and receiving payment recited an abstraction); *Inventor Holdings, LLC v. Bed Bath & Beyond, Inc.*, 876 F.3d 1372, 1378 (Fed. Cir. 2017) (sequence of data retrieval, analysis, modification, generation, display, and transmission); *Two-Way Media Ltd. v. Comcast Cable Commc'ns, LLC*, 874 F.3d 1329, 1339 (Fed. Cir. 2017) (sequence of processing, routing, controlling, and monitoring). The ordering of the steps is, therefore, ordinary and conventional.

The method claims do not, for example, purport to improve the functioning of the computer itself. Nor do they effect an improvement in any other technology or technical field. The Specification spells out different generic equipment and parameters that might be applied using this concept and the particular steps such conventional processing would entail based on the concept of information access under different scenarios. *See, e.g.*, Spec. ¶¶ 36–40. The Specification does not describe any particular improvement in the manner a computer functions, at least with respect to the claims in the instant application. Instead, the claims at issue amount to nothing significantly more than instructions to apply the abstract idea of information access using some unspecified, generic computer. Under our precedents, that is not enough to transform an abstract idea into a patent-eligible invention. *See Alice*, 134 S. Ct. at 2360.

As to the system claims, they

> are no different from the method claims in substance. The method claims recite the abstract idea implemented on a generic computer; the system claims recite a handful of generic computer components configured to implement the same idea.

> This Court has long "warn[ed] . . . against" interpreting § 101 "in ways that make patent eligibility 'depend simply on the draftsman's art.' "

Id. (alterations in original).

We have reviewed all the arguments (Appeal Br. 8–15, Reply Br. 2–3) Appellants have submitted concerning the patent eligibility of the claims before us that stand rejected under 35 U.S.C. § 101. We find that our analysis above substantially covers the substance of all the arguments, which have been made. But, for purposes of completeness, we will address various arguments in order to make individual rebuttals of same.

Appellants argue:

> the claimed subject matter as discussed above relates to virtual wallet technology, and specifically to techniques for "frictionless" virtual wallets enrollment. (Original Specification at ¶ 36). The technology is not related to "agreements between people in the form of contracts, legal obligations, and business relations," as was the case in *Alice, Bilski,* and *buySafe.* Thus, Applicant respectfully submits that the claimed subject matter is not a "fundamental economic practice" as alleged by the Office.

Appeal Br. 11.

We disagree with Appellants. We find that the claimed association of a card issuer with a virtual wallet account is based on contractual agreements between the parties which is an abstract idea. Creating a contractual relationship in guaranteeing performance of an online transaction (*see buySAFE*, 765 F.3d at 1352, 1355), "verifying the validity of a credit card transaction over the Internet" (*CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1370 (Fed. Cir. 2011)), and using advertising as a currency on the Internet (*Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 716 (Fed. Cir. 2014)). Also, "[a]n abstract idea can generally be described at different

levels of abstraction." *Apple, Inc. v. Ameranth, Inc.*, 842 F.3d 1229, 1240–41 (Fed. Cir. 2016).

Appellants also argue,

> Applicant[s] strongly disagree[] with the Office's characterization of the additional elements as being "insignificant extra-solution activity" (Office Action at p. 4), and submits that the additional elements noted above are meaningful limitations that are not routine, not conventional, and not insignificant. As discussed above, an advantageous aspect of the invention relates to a system configured to allow a user who is logged in with an issuer to request enrollment of a payment account with a virtual wallet.

Appeal Br. 14.

In rejecting the pending claims under § 101, the Examiner analyzed the claims using the *Mayo/Alice* two-step framework, consistent with the guidance set forth in the USPTO's 2014 INTERIM GUIDANCE ON PATENT SUBJECT MATTER ELIGIBILITY. *See* Final Act. 4–5. Second, the Examiner's determination here of "well-understood, routine, and conventional" (Final Act. 4–5) is based on a rational basis for his conclusion stating:

> processor(s) <u>configured to</u> (see In re Alice, and Ultramerical; In re EON, CET v. Wells Fargo) communicate with server and to execute computer program modules, the computer program modules *comprising*: <u>*a feature module*</u> *configured to receive, transmit, determine, etc.* applies the abstract idea with or by use of a generic computer system using generic computer functions (not a particular machine where solution was necessarily rooted in computer technology….
>
> As such, the claim, when considered as a whole, is nothing more than the instruction to implement the abstract idea (i.e. registering a credit card, etc.) in a particular, albeit well-understood, routine and conventional technological environment.

Id. at 4. Such an analysis is a factual determination, and which determination we find without error. *See Berkheimer v. HP Inc.*, 881 F.3d 1360, 1369 (Fed. Cir. 2018) ("Whether something is well-understood, routine, and conventional to a skilled artisan at the time of the patent is a factual determination."). *See Credit Acceptance Corp. v. Westlake Servs.*, 859 F.3d 1044, 1057 (Fed. Cir. 2017) ("Significantly, the claims do not provide details as to any non-conventional software for enhancing the financing process."); *see also Intellectual Ventures I LLC v. Capital One Fin. Corp.*, 850 F.3d 1332, 1342 (Fed. Cir. 2017) (explaining that "[o]ur law demands more" than claim language that "provides only a result-oriented solution, with insufficient detail for how a computer accomplishes it.").

Concerning the bullet items listed by Appellants on page 14 of their Appeal Brief, alleged to be "elements in addition to" the Examiner's description of the abstract idea and that "go far beyond mere instructions to apply an alleged abstract idea on a computer," these are steps that coincide essentially with the identified abstract idea herein of enabling individually customized versions of images of accounts for a new virtual wallet account, such that they cannot constitute additional elements that could possibly amount to significantly more than the abstract idea. *See Alice*, 134 S. Ct. at 2355. Insofar as any aspects of the items identified by Appellants (Appeal Br. 14) are arguably distinct from the identified abstract idea, these constitute no more than generic computer functionality, as explained above.

We therefore affirm the rejections of claims 26–49.

CONCLUSIONS OF LAW

We conclude the Examiner did not err in rejecting claims 26–49 under 35 U.S.C. § 101.

DECISION

The decision of the Examiner to reject claims 26–49 is affirmed

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. § 1.136(a)(1)(iv).

AFFIRMED