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Suite 2800
Atlanta, GA 30309
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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* PAUL BLAIR, REX LIEURANCE, and  
DIANE SCOTT

(Applicant: The Western Union Company)

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Appeal 2017-003650  
Application 14/332,107<sup>1</sup>  
Technology Center 3600

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Before HUNG H. BUI, MICHAEL J. ENGLE, and PHILLIP A. BENNETT,  
*Administrative Patent Judges.*

BENNETT, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1–20. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

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<sup>1</sup> References herein to “Appellant” are to the applicant, The Western Union Company, also identified as the real party in interest. Br. 2.

### CLAIMED SUBJECT MATTER

According to the Specification, “[t]he present invention generally provides systems and methods for performing money transfer transactions *via* a wireless communication device.” Spec. ¶ 17.

Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A method comprising:
  - receiving, at a computer system, a request for a funds transfer transaction from a user via a mobile device, wherein:
    - the mobile device is associated with at least a first account;
    - the mobile device is associated with a second account maintained by a wireless communication services provider; and
    - the request includes a biometric reading of the user, an amount, and a recipient;
  - receiving, at the computer system, a biometric record associated with the account from the wireless communication services provider;
  - authorizing, by the computer system, the funds transfer transaction if the first account may be charged the amount and if the biometric reading matches the biometric record.

Br. 8 (Claims Appendix).

### REFERENCES

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Bansal	US 6,206,283	Mar. 27, 2001
Emmofit	US 6,424,845	July 23, 2002
Rudisill	US 6,816,721	Nov. 9, 2004

## REJECTIONS

(1) Claims 1–20 are rejected under 35 U.S.C. § 101 as being directed to ineligible subject matter. Final Act. 3–5.

(2) Claims 1–20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Bansal, Rudisill, and Emmoft. Final Act. 5–12.

## ANALYSIS

### SECTION 101 REJECTION

#### *Legal Standard for Patent-Eligibility*

In issues involving subject matter eligibility, our inquiry focuses on whether the claims satisfy the two-step test set forth by the Supreme Court in *Alice Corp. v. CLS Bank International*, 134 S. Ct. 2347 (2014). The Supreme Court instructs us to “first determine whether the claims at issue are directed to a patent-ineligible concept,” *Alice*, 134 S. Ct. at 2355, and, in this case, the inquiry centers on whether the claims are directed to an abstract idea. If the initial threshold is met, we then move to the second step, in which we “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.” *Id.* (quoting *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 79, 78 (2012)). The Supreme Court describes the second step 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.’” *Id.* (quoting *Mayo*, 566 U.S. at 72–73).

*The Examiner's Findings & Conclusions*

The Examiner rejects claims 1–20 under the two-step *Alice* framework. Under the first step, the Examiner determines the claims are directed to the abstract idea of “funds transfer transactions via wireless communication[s] devices.” Final Act. 3. In so doing, the Examiner determines that the claims are directed to “a fundamentally economic process” and that “it is a longstanding commercial practice.” *Id.*

Analyzing the claims under the second step of the *Alice* framework, the Examiner determines the additional claim limitations do not amount to significantly more than the abstract idea itself because the “steps would be routinely used by those of ordinary skill in the art to facilitate funds transfer transactions.” Final Act. 4. The Examiner further determines “the computer system and communication network, as recited is a generic computer component that performs functions that are generic computer functions that are well-understood, routine, and conventional activities previously known to the industry.” *Id.* The Examiner further determines that “[c]onsidered as an ordered combination, the computer components of the claim add[] nothing that is not already present when the steps are considered separately, and thus simply recite a funds transfer transaction[] via wireless communication devices as performed by a generic computer.” *Id.*; *see also* Ans. 3 (“There is no actual improvement made to the operations and/or physical structure of the additional elements claimed in the instant application.”).

*Appellant's Arguments*

Appellant presents several arguments in favor of patent eligibility. First, Appellant argues the claims “improve[] other technical fields beyond

‘funds transfer transactions via wireless communications devices’ . . . [because] at least personal finance management technology is improved by allowing both senders and recipients of funds to conveniently use their mobile communication devices . . . .” Br. 4. In support of this argument, Appellant asserts “security technologies are improved by using biometric readings and records to validate senders.” *Id.*

Second, Appellant argues “[p]articular, non-generic machines/computers are necessary to implement the systems and methods of the claims.” *Id.* Specifically, Appellant argues “a server capable of implementing the systems and methods must be able to communicate digital data with a multitude of differing mobile communication networks, as well as financial networks, and their associated protocols.” *Id.* According to Appellant, “[o]ff-the-shelf generic computers are not capable of performing such functions, much less concurrently during a[] period of intense heavy transaction load as may be necessary in such industry.” *Id.*

Third, Appellant argues the claims “include[] specific limitations other than what is well-understood, routine and conventional in the field, or add unconventional steps that confine the claim to a particular useful application.” *Id.* According to Appellant, the claims are novel and non-obvious which, “by their very definition, must include limitations other than what is well-understood, routine, and conventional in the field, or else they wouldn’t be novel and non-obvious.” *Id.* at 5.

#### *Analysis*

Appellant’s arguments are not persuasive, and we address each in turn. Although Appellant asserts the claims effect a technological improvement to personal finance management, Appellant does not

sufficiently explain how this is so. Appellant argues the improvement is found in the ability for “senders and recipients of funds to conveniently use their mobile communication devices to transfer funds instead of having to resort to traditional methods.” Appellant does not claim, however, to have invented mobile communication devices. Nor does Appellant claim to have invented the use of such devices in connection with personal finance. Moreover, the alleged improvement described by Appellant is better characterized as an improvement to the business process of personal finance management, as Appellant’s claims and Specification do not provide any indication that the recited method leads to improvement in the operations of any computer, but instead merely affords the benefit of convenience for participants in a funds transfer transaction.

We also are not persuaded by Appellant’s second argument that non-generic computers are required to perform the claimed method. Appellant’s contention rests on an assertion that computers “implementing the systems and methods must be able to communicate digital data with a multitude of differing mobile communication networks, as well as financial networks, and their associated protocols.” However, nothing in the claim requires any “multitude of differing mobile communication networks” nor does it require “financial networks.” Rather, the recited method merely includes two steps, a receiving step which involves obtaining a biometric record from a network, and an authorizing step which does not specify any particular source or destination for the authorization. Thus, Appellant’s argument is not commensurate with the broad scope of the claimed method. Appellant’s argument regarding “[o]ff-the-shelf generic computers are not capable of performing such functions, much less concurrently during a[] period of

intense heavy transaction load as may be necessary in such industry,” is also not persuasive because nothing in the claim or the specification indicates that functions must be performed concurrently or that they must be performed during a period of intense heavy transaction load. As such, Appellant’s contention is again not commensurate with the scope of the claim, and relies on specific features which are not recited therein.

Finally, Appellant’s third argument is also not persuasive. Appellant contends the alleged novelty and non-obviousness of the claims is determinative of the *Alice* step 2 inquiry. We do not agree. This argument lacks merit because it presupposes that any claim found to be novel and non-obvious over prior art cannot be found to be lacking an inventive concept in the *Alice/Mayo* framework. We are aware of no case supporting this proposition, nor does Appellant cite to any legal authority. Patent-eligibility of a claimed invention under 35 U.S.C. § 101 is a threshold requirement that must be satisfied *in addition to* being novel, nonobvious, and fully and particularly described. *See Bilski v. Kappos*, 561 U.S. 593, 602 (2010). As the Supreme Court and Federal Circuit have recognized, “[g]roundbreaking, innovative, or even brilliant discovery does not by itself satisfy the § 101 inquiry.” *Ass’n for Molecular Pathology v. Myriad Genetics, Inc.*, 133 S. Ct. 2107, 2117 (2013); *accord buySAFE, Inc. v. Google, Inc.*, 765 F.3d 1350, 1352 (Fed. Cir. 2014). Nor is it enough for subject-matter eligibility that claimed techniques be novel and nonobvious in light of prior art, passing muster under 35 U.S.C. §§ 102 and 103. *See Mayo*, 566 U.S. at 89–90; *Synopsys, Inc. v. Mentor Graphics Corp.*, 839 F.3d 1138, 1151 (Fed. Cir. 2016) (“[A] claim for a *new* abstract idea is still an abstract idea”). Appellant’s approach to the *Alice* step 2 search for an inventive concept is

inconsistent with the legal framework established in the Patent Act, as it would limit the application of 35 U.S.C. § 101 to only those claims found to be otherwise unpatentable under other sections of the Act (e.g., 35 U.S.C. §§ 102 and 103).

#### SECTION 103 REJECTION

The sole issue presented in connection with the obviousness rejection under 35 U.S.C. § 103 is whether the cited prior art teaches or suggests “receiving, at the computer system, a biometric record associated with the account from the wireless communication services provider,” as recited in the independent claims.

The Examiner finds Emmoft teaches receiving a biometric record associated with the account from the wireless communication services provider because it teaches the use of an authorized image stored on the handset for authentication purposes. Ans. 5. Appellant argues Emmoft is deficient because the biometric record is stored on the handset, and it is not received from the wireless carrier. App. Br. 6. We agree with Appellant that the Examiner has failed to show by a preponderance of evidence that Emmoft’s device “receiv[es] a biometric record . . . from the wireless communication services provider.” There is no indication in Emmoft that the authorized image (i.e., the biometric record) is stored anywhere other than the “transaction processor 20” which is part of the handset device. *See* Emmoft col. 3, ll. 65–66. Nor is there any indication in Emmoft that the authorized image is received by the handset device from any network. Accordingly, we are persuaded the Examiner erred in finding Emmoft teaches or suggests the disputed limitation. We, therefore, do not sustain the

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rejection claims 1, 8, and 15 or their respective dependent claims 2–7, 9–14, and 16–20 under 35 U.S.C. § 103.

#### DECISION

We affirm the Examiner’s rejection of claims 1–20 under 35 U.S.C. § 101.

We reverse the Examiner’s rejection of claims 1–20 under 35 U.S.C. § 103.

Because we have affirmed at least one ground of rejection for each claim on appeal, we affirm the Examiner’s decision to reject claims 1–20. 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). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED