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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* MATTHEW W. AMACKER, PHILIP YUEN,
DIWAKAR GUPTA, and CHIH-JEN HUANG[1]

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Appeal 2017-006081
Application 14/275,660
Technology Center 3600

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Before ALLEN R. MacDONALD, JOSEPH P. LENTIVECH, and
MICHAEL M. BARRY, *Administrative Patent Judges*.

BARRY, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from a final rejection of
claims 1, 2, 4–11, 13–17, 19, 20, and 24–27, which are all the pending
claims. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

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[1] The Applicant, Amazon Technologies, Inc., a wholly owned subsidiary of
Amazon.com, Inc., is identified as the real party in interest. App. Br. 3.

*Introduction*

Appellants explain the Application as disclosing "[t]echniques and apparatuses for providing wallet server information to an entity using a real-time mobile wallet server (MWS)." Spec., Abstract.

Claims 1, 8, and 16 are independent. Claim 1 is illustrative of the claims on appeal:

1.     A method comprising:

receiving, by a mobile wallet application executed by one or more processors of a user device and from an entity device, a request for a type of personal information, the request being associated with a transaction between a merchant associated with the entity device and a customer associated with the user device;

outputting, by the mobile wallet application, a security request for authorization to access the personal information;

receiving the authorization to access the personal information;

presenting, by the mobile wallet application, information related to the request including:

the type of personal information requested;

an identity of the merchant associated with the entity device that sent the request;

a first location of the merchant associated with the entity device; and

a list of selectable items filtered to exclude other types of personal information other than the type of personal information requested;

receiving a selection of a selectable item from the list of selectable items that have been filtered;

determining that a location limit is associated with transmission, to the entity device, of the selectable item corresponding to the selection, wherein the location limit

defines a pre-defined distance between the first location of the
merchant associated with the entity device and a second
location of the user device;

determining that the first location of the merchant
associated with the entity device is within the pre-defined
distance of the second location of the user device; and

transmitting, by the mobile wallet application executed
by the one or more processors of the user device, the selectable
item corresponding to the selection to the entity device.

App. Br. 35 (Claims App'x).

*Rejections & References*

Claims 1, 2, 4–11, 13–17, 19, 20, and 24–27 stand rejected under 35
U.S.C. § 101 as directed to an abstract idea without reciting significantly
more.  Final Act. 2; Ans. 2, 8–10.

Claims 1, 2, 8–10, 16, and 24–26 stand rejected under 35 U.S.C. § 103
as unpatentable over Immonen (US 2002/0077993 A1; June 20, 2002),
"SplashData" (*SplashData Release Announcement for SplashID 3.0 for
Palm Powered Handhelds* (2004) (ProQuest document ID 446222959,
https://search.proquest.com/docview/446222959 (last accessed Aug. 2,
2018); *see also* http://splashdata.com/press/PR040302.htm (last accessed
Aug. 29, 2018))), and Weichselbaumer (US 2008/0147546 A1; June 19,
2008).  Final Act. 3–5.

Claims 5–7, 11, 13–15, 17, 19, and 20 stand rejected under § 103 as
unpatentable over Immonen, SplashData, Weichselbaumer, and Hurst
(US 2009/0063312 A1; Mar. 5, 2009).  Final Act. 5–8.

## ANALYSIS

### *The 35 U.S.C. § 101 Rejection*

Section 101 defines patentable subject matter, but the Supreme Court has "long held that this provision contains an important implicit exception" that "[l]aws of nature, natural phenomena, and abstract ideas are not patentable." *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 70 (2012) (citation and quotation marks omitted). "Eligibility under 35 U.S.C. § 101 is a question of law, based on underlying facts." *SAP Am., Inc. v. InvestPic, LLC*, 890 F.3d 1016, 1020 (Fed. Cir. 2018). "[I]n applying the §101 exception, we must distinguish between patents that claim the 'buildin[g] block[s]' of human ingenuity and those that integrate the building blocks into something more." *Alice Corp. v. CLS Bank Int'l*, 134 S. Ct. 2347, 2354–55 (2014). To determine patentable subject matter, the Supreme Court has set forth a two part test.

"First, we determine whether the claims at issue are directed to one of those patent-ineligible concepts" of "laws of nature, natural phenomena, and abstract ideas." *Alice*, 134 S. Ct. at 2355. "The inquiry often is whether the claims are directed to 'a specific means or method' for improving technology or whether they are simply directed to an abstract end-result." *RecogniCorp, LLC v. Nintendo Co.*, 855 F.3d 1322, 1326 (Fed. Cir. 2017). A court must be cognizant 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), and "describing the claims at . . . a high level of abstraction and untethered from the language of the claims all but ensures that the exceptions to § 101 swallow the rule." *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1337 (Fed. Cir. 2016). Instead, "the claims are

considered in their entirety to ascertain whether their character as a whole is directed to excluded subject matter." *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1346 (Fed. Cir. 2015).

If the claim is directed to a patent-ineligible concept then the inquiry continues to a 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." *Alice*, 134 S. Ct. at 2355 (quoting *Mayo*, 566 U.S. at 79, 78). The Supreme Court has "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." *Id.* (citation omitted).

In the first step, the Examiner determines the claims "are directed to a method for conducting a transaction using a mobile wallet. The method is similar to the concepts of obtaining and comparing intangible data and comparing new and stored information and using rules to identify options that the courts have previously found to be abstract." Final Act. 2. The Examiner reasons that "the steps of receiving, outputting, presenting, transmitting and determining personal information" constitute "simply the act of obtaining and manipulation of data which can be performed mentally and is an abstract idea of itself." Final Act. 8–9. "It is similar to other concepts that have been identified as abstract by the courts, such as obtaining and comparing intangible data in Cybersource[2] or comparing new

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2 *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366 (Fed. Cir. 2011).

and stored information and using rules to identify options in SmartGene[3]."
Final Act. 9; *see also* Ans. 9 (additionally stating the steps of receiving,
outputting, presenting, transmitting, and determining personal information
are similar to "collecting and analyzing information and displaying results
from the collected and analyzed information in Electric Power Group[4]").

Appellants argue the Examiner errs by, *inter alia*, oversimplifying the
claims, which Appellants contend are similar to those found not directed to
an abstract idea in *McRO v. Bandai Namco Games America*, 837 F.3d 1299
(Fed. Cir. 2016). *See* Reply Br. 4–7 ("the claims recite particular solutions
to a problem or a particular way to achieve a desired outcome, as opposed to
merely claiming the idea of a solution or outcome" (*id.* at 7)). On the record
before us, we agree with Appellants that the Examiner errs by not showing
how, as a whole, the claims are directed only to abstract ideas.

"The Supreme Court has recognized that all inventions . . . embody,
use, reflect, rest upon, or apply laws of nature, natural phenomena, or
abstract ideas. But not all claims are *directed to* an abstract idea." *Apple,
Inc. v. Ameranth, Inc.*, 842 F.3d 1229, 1241 (Fed. Cir. 2016) (citation and
quotation marks omitted). Although the Examiner fairly identifies the
independent claims implicate the types of abstract ideas in *CyberSource* (i.e.,
obtaining and comparing intangible data), *SmartGene* (i.e., comparing new
and stored information and using rules to identify options), and *Electric
Power Group* (i.e., displaying results from collected and analyzed
information), *see* Final Act. 9; Ans. 9, the Examiner's determination does

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[3] *SmartGene, Inc. v. Advanced Biological Laboratories, SA*, 555 F. App'x
950 (Fed. Cir. 2014).
[4] *Electric Power Group, LLC v. Alstom S.A.*, 830 F.3d 1350 (2016).

not address the specific limitations of the claims that are narrower than the Examiner's characterization. In other words, the Examiner does not address why the claims are not, as a whole, directed to those more narrow features.

For example, claim 1 functionally limits its method with authorization- and location-based limitations, which are not simply field-of-use limitations. The other independent claims include commensurate limitations. Appellants contend that claim 1 is directed to that functionality, *see* Reply Br. 6, and the Examiner does not explain how *CyberSource, SmartGene*, and *Electric Power Group* support the proposition that a claim that recites limitations describing "geolocation-based user authorization with location-aware mobile devices" (Reply Br. 6) is directed only to an abstract idea. In other words, by describing claim 1 as simply "a method for conducting a transaction using a mobile wallet" (Final Act. 2; Ans. 8) without addressing the other recited functional limitations, the Examiner's determination is too high of a level of abstraction that is untethered from the specific language of the claims. *See Enfish*, 822 F.3d at 1337.

We also disagree with the Examiner has shown that claim 1's recited limitations, as a whole, constitute "simply the act of obtaining and manipulation of data which can be performed mentally and is an abstract idea of itself." Final Act. 8–9; Ans. 9. The Examiner does not explain how requirements such as a mobile wallet "outputting . . . a security request for authorization" and "transmitting . . . the selectable item corresponding to the selection to the entity device," as recited, are types of acts that humans mentally perform. The Examiner's citations to *CyberSource, SmartGene*, and *Electric Power Group* are conclusory and do not show why the particular limitations of claim 1 are not—as Appellants contend—a technical

solution to challenges with using mobile wallet technology. *See Enfish*, 822 F.3d at 1337; *DDR Holdings, LLC v. Hotels.com*, 773 F.2d 1245, 1259 (Fed. Cir. 2015) (in the first step of the *Alice* analysis, determining that claims directed to solving a technical challenge arising with applications on the Internet were not directed to an abstract idea); *McRO*, 837 F.3d at 1316; App. Br. 16–17; Reply Br. 7–9.

Thus, there is insufficient evidence or explanation on the record before us to determine that all features (or ideas) for a mobile wallet application to which claim 1 is directed, such as the location-related determining steps and "outputting . . . a security request for authorization," constitute patent-ineligible abstract ideas. Accordingly, we do not sustain the Examiner's rejection of claims 1, 2, 4–11, 13–17, 19, 20, and 24–27 under § 101.

*The 35 U.S.C. § 103 Rejections*

In rejecting claim 1 under § 103, the Examiner finds Immonen teaches the limitation of "receiving, by a mobile wallet application executed by one or more processors of a user device and from an entity device, a request for a type of personal information," as recited. Final Act. 3 (citing Immonen ¶ 42). Appellants contend the Examiner errs in finding Immonen teaches the disputed limitation because the cited disclosure of Immonen teaches that its wallet application is executed on a server, not a user device, and Immonen's "wakeup message," which the Examiner maps to the recited "request for a type of personal information" (received by the user device), is a message used by the server (i.e., not the user device). App. Br. 26–27 (citing Immonen ¶¶ 39–42, 45–46). Appellants' argument is persuasive.

As illustrated in Figure 3 of Immonen, its mobile terminals 100 communicate with a Server Wallet 330 using a WAP (Wireless Application Protocol) protocol through a WAP server 300. Thus, Immonen teaches a server-based wallet system, in which mobile devices connect to the wallet server application using browser-type functionality via the WAP protocol, and all wallet server functionality is located on the "Server Wallet" that is remote from the mobile terminal. *See* Immonen ¶¶ 39–42. The disputed limitation of claim 1, on the other hand, requires the mobile wallet application to execute on a user device (i.e., not a server).

Accordingly, we do not sustain the § 103 rejection of claim 1. For the same reason we do not sustain the § 103 rejection of independent claims 8 and 16, which recite commensurate limitations. We also, therefore, do not sustain the § 103 rejection of dependent claims 2, 5–7, 9–11, 13–15, 17, 19, 20, and 24–26.

## DECISION

We reverse the rejections of claims 1, 2, 4–11, 13–17, 19, 20, and 24–27 under 35 U.S.C. § 101.

We reverse the rejections of claims 1, 2, 5–11, 13–17, 19, 20, and 24–26 under 35 U.S.C. § 103.

## REVERSED