UNITED STATES PATENT AND TRADEMARK OFFICE

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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 DAVID GALLOWAY, DONALD MacCORMICK,
and PETER MADAMS

_____

Appeal 2017-007212
Application 13/405,159
Technology Center 3600

_____

Before JOHN A. EVANS, JENNIFER L. McKEOWN, and
STEVEN M. AMUNDSON, *Administrative Patent Judges.*

EVANS, *Administrative Patent Judge.*

DECISION ON APPEAL

Appellants[1] seek our review under 35 U.S.C. § 134(a) from the
Examiner's final rejection of claims 1–4 and 6–36. App. Br. 3. We have
jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.[2]

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[1] Appellants state the real party in interest is Monitise Americas, Inc. App.
Br. 3.

[2] Rather than reiterate the arguments of the Appellants and the Examiner, we
refer to the Appeal Brief (filed November 14, 2016, "App. Br."), the Reply
Brief (filed April 5, 2017, "Reply Br."), the Examiner's Answer (mailed
February 9, 2017, "Ans."), the Non-Final Action (mailed June 13, 2016,

STATEMENT OF THE CASE

The claims relate to a system to facilitate contextually specific opportunity-based advertising. *See* Abstract.

INVENTION

Claims 1, 14, and 31 are independent. An understanding of the invention can be derived from a reading of claim 1, which is reproduced below with some formatting added:

> 1. A credential free, alert based method for managing personal finances, the method comprising:
>
> storing, by a server, data associating a network address with a user;
>
> receiving at the server from a financial institution a transaction message addressed to the network address, wherein the transaction message is responsive to, and indicative of, occurrence of a financial transaction involving the user, and content of the transaction message transmitted from the financial institution to the server does not contain any information specifically identifying the user;
>
> recognizing the transaction message and, in response to the transaction message, parsing the transaction message to map data elements in the transaction message to data elements in a uniform outbound alert template using an automatic message recognition process, wherein the automatic message recognition process is refined through continuous feeds of transaction messages;
>
> automatically tagging a source entity to the transaction message, in an event that the automatic message recognition

"Non-Final Act."), and the Specification (filed February 24, 2012, "Spec.") for their respective details.

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process identifies the source entity from the transaction
message;

using the stored data associating the network address
with the user to determine that the transaction message relates
to the user, and generating an alert for the user in a
predetermined uniform format;

transmitting the alert from the server for delivery to a
device associated with the user, the alert for prompting a user to
tag the financial transaction with at least one category from a
plurality of categories specified by the server;

receiving at the server from the user's device associated
with the user a response indicating a category with which the
user tagged the financial transaction; and

generating by the server a financial report summarizing
financial transactions in a plurality of categories.

App. Br. 20 (Claims App.).

The Prior Art Supporting the Rejection on Appeal

As evidence of unpatentability, the Examiner relies on the following

prior art:

Keeling	US 2005/0165680 A1	July 28, 2005
Hart	US 2006/0196930 A1	Sept. 7, 2006
Schmitt	US 2007/0156530 A1	July 5, 2007
Keld	US 7,949,579 B2	Filed Dec. 7, 2007
Noonan	US 2008/0133577 A1	June 5, 2008
Skowronek	US 2009/0112765 A1	Apr. 30, 2009

The Rejections on Appeal[3]

1.   Claims 1–4 and 6–36 stand rejected under 35 U.S.C. § 101 as

directed to a judicial exception. Non-Final Act. 3–8.

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[3] The Examiner has withdrawn the rejection of claims 1–4 and 6–36 under
35 U.S.C. § 112 (2nd paragraph) as indefinite. Ans. 2.

2.   Claims 1–4, 6–9, 12–21, and 24–30 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Skowronek, Noonan, Keeling, and Keld. Non-Final Act. 9–16.

3.   Claims 10, 11, 22, and 23 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Skowronek, Noonan, Keeling, Keld, and Schmitt. Non-Final Act. 16–17.

4.   Claim 36 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Skowronek, Noonan, Keeling, Keld, and Hart. Non-Final Act. 17.

ANALYSIS

We have reviewed the rejections of claims 1–4 and 6–36 in light of Appellants' arguments that the Examiner erred. We have considered in this Decision only those arguments Appellants actually raised in the Brief. Any other arguments which Appellants could have made but chose not to make in the Briefs are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(iv). We are not persuaded that Appellants identify reversible error.

Upon consideration of the arguments presented in the Appeal Brief and the Reply Brief, we agree with the Examiner that all the pending claims are unpatentable under 35 U.S.C. §§ 101 and/or 103. We adopt as our own the findings and reasons set forth in the rejections from which this appeal is taken and in the Examiner's Answer, to the extent consistent with our analysis below. We provide the following explanation to highlight and address specific arguments and findings primarily for emphasis.

We consider Appellants' arguments *seriatim*, as they are presented in the Appeal Brief, pages 7–18.

CLAIMS 1–4 AND 6–36: INELIGIBLE SUBJECT MATTER.

35 U.S.C. § 101.

Section 101 provides that a patent may be obtained for "any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof." 35 U.S.C. § 101. The Supreme Court has long recognized, however, that § 101 implicitly excludes "laws of nature, natural phenomena, and abstract ideas" from the realm of patent-eligible subject matter, as monopolization of these "basic tools of scientific and technological work" would stifle the very innovation that the patent system aims to promote. *Alice Corp. v. CLS Bank Int'l*, 134 S. Ct. 2347, 2354 (2014) (quoting *Ass'n for Molecular Pathology v. Myriad Genetics, Inc.*, 133 S. Ct. 2107, 2116 (2013)); *see also Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1294–97 (2012); *Diamond v. Diehr*, 450 U.S. 175, 185 (1981).

Mayo-Alice Step 1.

The Supreme Court has instructed us to use a two-step framework to "distinguish[] patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts." *Alice*, 134 S. Ct. at 2355. At the first step, we determine whether the claims at issue are "directed to" a patent-ineligible concept. *Id.*

The Examiner determines that claims 1–4 and 6–36 are directed to the abstract idea of parsing a transaction message in order to populate information fields associated with an alert template, automatically tagging a source entity to the transaction message, and generating an alert for a user, and generating a financial report summarizing financial transactions. Non-

Final Act. 3. The Examiner further determines the claims do not include additional elements that are sufficient to amount to significantly more than the judicial exception because the additional computer elements are recited at a high level of generality and in doing so provide conventional computer functionality that does not add meaningful limits to practicing the abstract idea. *Id.*

Appellants contend the claims are not directed to abstract ideas under step 1 of the *Mayo-Alice* test. App. Br. 8. Appellants argue there is no case law holding ideas such as "parsing the transaction message . . . automatically tagging . . . generating an alert . . . prompting the user to tag . . . generating a financial report . . ." or "generating and transmitting an alert . . . determining that the financial transaction is for a joint financial account . . . prompting first and second user to tag . . ." are abstract. *Id.* at 9.

The Examiner explains the method steps are drawn to organizing, storing, and categorizing information and can be performed mentally. Ans. 2. The Examiner reasons the claims are directed to an abstract idea because it is similar to other concepts which the courts have identified as abstract, such as using categories to organize, store, and transmit information. *Id.* at 3 (citing *Cyberfone*[4]).

Appellants' Reply Brief contrasts claim 1 of the present application with that of *Cyberfone* to argue the claims are not similar or analogous. Reply Br. 2–3.

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[4] *Cyberfone Sys., LLC v. CNN Interactive Grp., Inc.,* 558 F. App'x 988, 990 (Fed. Cir. 2014).

We disagree with Appellants because we agree with the Examiner that the steps of the claimed method are drawn to organizing, storing, and categorizing information and can be performed mentally. *See* Ans. 2. We note that the Federal Circuit has recognized that "[t]he concept of data collection, recognition, and storage is undisputedly well-known," and "humans have always performed these functions." *Content Extraction & Transmission LLC v. Wells Fargo Bank, Nat'l Ass'n*, 776 F.3d 1343, 1347 (Fed. Cir. 2014).

Therefore, we conclude all claims on appeal are directed to a patent-ineligible abstract idea, i.e., a fundamental economic practice, as determined by the Examiner. *See* Non-Final Act. 4–6; Ans. 3–4.

Mayo-Alice Step 2.

Where, as here, the claims are "directed to" a patent-ineligible concept, we then "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*, 132 S. Ct. at 1298). This analysis has been characterized as the search for an "inventive concept"— something sufficient to ensure that the claim amounts to "significantly more" than the abstract idea itself. *Id.* (quoting *Mayo*, 132 S. Ct. at 1294).

With respect to *Mayo-Alice* step 2, the Examiner notes the claimed invention includes additional elements directed towards computer implementation of the method, but finds the claims merely recite generic computer components and methods. Final Act. 3.

Appellants argue the Examiner's findings are faulty because, according to Appellants, the Examiner has oversimplified the claims and has failed to analyze them as an ordered combination. Reply Br. 5 (recapitulating arguments of the principal brief). We disagree with Appellants because we find the Examiner has adequately construed the claims. *See* Non-Final Act. 4–6; Ans. 3–4. We begin with a construction of the claim. *Cf. State St. Bank & Trust Co. v. Signature Fin. Grp., Inc.*, 149 F.3d 1368, 1370 (Fed. Cir. 1998) ("[W]hether the . . . patent is invalid for failure to claim statutory subject matter under § 101[ ] is a matter of both claim construction and statutory construction."); *Ex parte Poisson*, Appeal 2012-011084, slip op. at 4 (PTAB Feb. 27, 2015).

Appellants contend a proper analysis shows the claims entail an unconventional technological solution (a credential free method that generates user alerts) to a technical problem (enabling near real-time tagging of financial transactions with transaction categories). Reply Br. 5. Appellants conclude that, similar to *Amdocs*, "the ordered combination of these limitations provided the requisite inventive concept" and are patentable under 35 U.S.C. § 101. *Id.* (quoting *Amdocs (Isr.) Ltd. v. Openet Telecom, Inc.*, 120 USPQ2d 1527, Appeal No. 2015-1180, slip op. at 19 (Fed. Cir. Nov. 1, 2016). We disagree with Appellants.

The Federal Circuit has contrasted claims "directed to an improvement in the functioning of a computer" with claims "simply adding conventional computer components to well-known business practices," or claims reciting "use of an abstract mathematical formula on any general purpose computer," or "a purely conventional computer implementation of a mathematical formula," or "generalized steps to be performed on a computer

using conventional computer activity." *Enfish, LLC v. Microsoft Corp.*, 822
F.3d 1327, 1338 (Fed. Cir. 2016). Here, the Specification describes, and the
claims recite, "a desired function or outcome, without providing any limiting
detail that confines the claim[s] to a particular solution to an identified
problem." *Affinity Labs of Tex. LLC v. Amazon.com Inc.*, 838 F.3d 1266,
1269 (Fed. Cir. 2016). Contrary to Appellants' arguments on appeal, we
find the present claims are not directed to a specific improvement to
computer functionality. Rather, similar to those of *TLI*, "they are directed to
the use of conventional or generic technology in a nascent but well-known
environment, without any claim that the invention reflects an inventive
solution to any problem presented by combining the two." *In re TLI
Commc'ns LLC Patent Litig.*, 823 F.3d 607, 612 (Fed. Cir. 2016).

We disagree with Appellants' analogy to *Enfish* because the
Specification and claims describe the claimed invention at such a high level
of abstraction that the public is not taught *how* the desired functions are
achieved. Therefore, we conclude that the claim limitations, viewed "both
individually and as an ordered combination," do not amount to significantly
more than the judicial exception in order to sufficiently transform the nature
of the claims into patent-eligible subject matter. *See Alice*, 134 S. Ct. at
2355 (internal quotations omitted) (quoting *Mayo*, 132 S. Ct. at 1297).

Accordingly, we sustain the Examiner's 35 U.S.C. § 101 rejection of
representative claim 1 and claims 2–4 and 6–36 (not argued separately),
which fall with claim 1. *See* 37 C.F.R. § 41.37(c)(1)(iv).

CLAIMS 1–4, 6–30, AND 36: OBVIOUSNESS[5].

Parsing the transaction message.

Appellants contend the cited art fails to teach "parsing the transaction message," as recited in claim 1. App. Br. 17. Appellants admit Noonan is directed to an "adaptive data exchange system" which parses a received "description of data to identify individual data elements, and maps the individual data elements to corresponding data element fields in a transaction message specific format description." *Id.* at 17–8 (quoting Noonan ¶ 9). Appellants further acknowledge Noonan discloses a "message generator uses the transaction message specific format description and transaction identifier to identify source transactions." *Id.* at 18 (quoting Noonan ¶ 9). However, Appellants argue Noonan fails to teach or suggest that Noonan's "source transactions" in any way relate to the claimed "source entity to the transaction message." *Id.*

The Examiner finds that Noonan identifies and maps individual data elements to corresponding data element fields in a transaction message specific format description. Ans. 7 (citing Noonan Abstract). The Examiner finds Noonan teaches the transaction identifier obviously contains source entity identification so as to generate a transaction message for communication to a remote destination in response to receiving an inbound transaction message having the transaction identifier. *Id.* (citing Noonan ¶ 9).

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[5] Claims 31–35 appear not to have been rejected under 35 U.S.C. § 103(a). *See* Ans. 7.

Appellants contend the Examiner merely makes the conclusory statement that "source transaction obviously contain [sic] source entity identification," without providing any evidence therefor. Reply Br. 9. Appellants argue the Examiner fails to show how Noonan teaches or suggests that the identified "source transactions" enable identification of the "source entity" from the transaction message, or in any way relate the source entity to the transaction message. *Id.*

Neither the claims nor the Specification explicitly defines the claimed "source entity." However, Appellants' Specification exemplifies "source entity" as "banks, credit unions, credit card companies." Spec. ¶ 26. We find such a loose definition fairly reads on Noonan's disclosure of an organization "NAME" or "OFFICE." *See* Noonan Figure 5.

Automatically tagging.

Without more, Appellants contend Noonan neither teaches nor suggests: "automatically <u>tagging</u> a source entity to the transaction message, in an event that the intelligent message recognition process identifies the source entity from the transaction message," as recited in claim 1. App. Br. 18.

We find that Appellants have failed to present *substantive* arguments and supporting *evidence* persuasive of Examiner error regarding the aforementioned disputed limitation. *See In re Lovin*, 652 F.3d 1349, 1357 (Fed. Cir. 2011) ("we hold that the Board reasonably interpreted Rule 41.37 to require more substantive arguments in an appeal brief than a mere recitation of the claim elements and a naked assertion that the corresponding elements were not found in the prior art.").

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Automatically tagging to a default category.

Appellants contend the cited references neither teach nor suggest: "automatically <u>tagging</u> the transaction to a default category in an event that an amount associated with the transaction is below a threshold number," as recited in dependent claim 36. App. Br. 18.

The Examiner finds Hart discloses automatically tagging the transaction to a default category in an event that an amount associated with the transaction is below a threshold number, as claimed. Non-Final Act. 17. The Examiner finds Hart discloses multiple default categories per financial transaction and automatically assigns a given percentage of a transaction amount to various categories. *Id.*; Ans. 8 (citing Hart ¶¶ 40, 42).

Appellants argue Hart recites: "[u]ser 102 can also set up a default allocation such that processing module 107 automatically assign a given percentage of a transaction amount to a category, another percentage of the transaction amount to another category, and so on." App. Br. 18 (citing Hart ¶ 42). Appellants contend a user may assign a default allocation, but there is no teaching that the system assigns a default allocation in the event an amount is below a threshold. *Id.*

Hart discloses: "the presence of a particular piece of information (e.g., transaction date, **amount**, location, party) on financial instrument **104** suggests a default category for the financial transaction." Hart ¶ 40 (cited by the Examiner) (emphasis added). We find the disputed limitation fairly reads on the disclosure of Hart.

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DECISION

The rejection of claims 1–4 and 6–36 under 35 U.S.C. § 101 is AFFIRMED.

The rejection of claims 1–4, 6–30, and 36 under 35 U.S.C. § 103(a) 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)(1). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED