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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ERNEST ARMENTA and GAIL GALUPPO

Appeal 2017-007761
Application 12/189,950¹
Technology Center 3600

Before HUNG H. BUI, DAVID J. CUTITTA II, and
PHILLIP A. BENNETT, *Administrative Patent Judges*.

BENNETT, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's non-final rejection of claims 1, 4–8, 12, 13, 15, and 16. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

¹ Appellants' Brief ("Br.") identifies The Western Union Company as the real party in interest. Br. 2.

CLAIMED SUBJECT MATTER

The claims are directed to conducting money transfers via cable and/or satellite providers. Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A method of providing a money transfer executed in connection with a television provider, the method comprising:
 - receiving, at a set top box, a signal from a remote control associated with the set top box, wherein the signal indicates that a money transfer initiation button built into the remote control has been pressed by a user;
 - in response to receiving the signal, presenting, with the set top box, an interface to the user on a television, the interface configured to receive a money transfer initiation request and a first identifier from the user;
 - receiving, at the set top box, the money transfer initiation request and the first identifier;
 - sending, to a television provider server from the set top box, the money transfer initiation request and the first identifier;
 - verifying, at the television provider server, the user's identity by comparing the first identifier with a second identifier stored by the television provider server;
 - in response to the user's identity being verified by the television provider server, forwarding, from the television provider server, the money transfer initiation request to a money transfer provider server;
 - receiving, at the television provider server, from the money transfer provider server, a money transfer control number associated with a money transfer initiated in response to the money transfer initiation request;
 - sending from the television provider server to the set top box, the money transfer control number;
 - presenting, on the television via the set top box, the money transfer control number to the user via the interface and instructions on how to activate the money transfer control number, the instructions comprising instructions for using a mobile device of the user to send the money transfer control

number and a form of personal identification to the money transfer provider server;

receiving, at the money transfer provider server from the mobile device of the user, the money transfer control number and the form of personal identification;

verifying, with the money transfer provider server, that the money transfer control number is associated with the user by comparing the form of personal identification with information stored in a customer database;

in response to verification of the money transfer control number being associated with the user, activating the money transfer control number with the money transfer provider server; and

in response to activation of the money transfer control number, and later receipt of a request to withdraw funds associated with the money transfer control number, authorizing, with the money transfer server, distribution of funds associated with the money transfer control number.

Br. 13 (Claims Appendix).

REFERENCES

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

Linehan	US 2004/0249726 A1	Dec. 9, 2004
Hill	US 2008/0249928 A1	Oct. 9, 2008
Campagna	US 2009/0300668 A1	Dec. 3, 2009

REJECTIONS

Claims 12 and 13 stand rejected 35 U.S.C. § 112, second paragraph as being indefinite.² Final Act. 3.

² Appellants do not challenge this rejection. As a result we summarily affirm the rejection of claims 12 and 13 under 35 U.S.C. § 112, second paragraph.

Claims 1, 4–8, 12, 13, 15, and 16 stand rejected under 35 U.S.C. § 101 as being directed to ineligible subject matter. Final Act. 3–7.

Claims 1, 4–8, 12, 13, 15, and 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Linehan, Hill, and Campagna. Final Act. 7–17.

REJECTION UNDER 35 U.S.C. § 101

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 Int’l*, 573 U.S. 208 (2014). The Supreme Court instructs us to “first determine whether the claims at issue are directed to a patent-ineligible concept,” *Id.* at 217, 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 USPTO recently published revised guidance on the application of § 101. USPTO’s January 7, 2019 Memorandum, *2019 Revised Patent*

Subject Matter Eligibility Guidance (“Memorandum”). Under that guidance, we first look to whether the claim recites:

- (1) any judicial exceptions, including certain groupings of abstract ideas (i.e., mathematical concepts, certain methods of organizing human interactions such as a fundamental economic practice, or mental processes); and
- (2) additional elements that integrate the judicial exception into a practical application (*see* MPEP § 2106.05(a)–(c), (e)–(h)).

Only if a claim (1) recites a judicial exception and (2) does not integrate that exception into a practical application, do we then look to whether the claim:

- (3) adds a specific limitation beyond the judicial exception that is not “well-understood, routine, conventional” in the field (*see* MPEP § 2106.05(d)); or
- (4) simply appends well-understood, routine, conventional activities previously known to the industry, specified at a high level of generality, to the judicial exception.

See Memorandum.

Examiner’s Findings and Conclusion

In the first step of the *Alice* inquiry, the Examiner determines the claims are directed to an abstract idea of “initiating a money transfer request using a set top box, which is an idea of itself and a certain method of organizing human activity.” Ans. 3.

At *Alice* step 2, the Examiner determines the claims do not recite elements sufficient to amount to significantly more than the abstract idea because:

[T]he claim limitations do not include additional elements that are sufficient to amount to significantly more than the judicial exception because the claim limitations simply describe the abstract idea. The limitations directed to sending data (e.g. sending the money request and first identifier, forwarding the money request, sending the control number) are well-understood, routine, and conventional in the field; thus, they do not add significantly more to the abstract idea. Examples of well-understood, routine, and conventional computer functions include performing repetitive calculations; receiving, processing, and storing data; electronically scanning or extracting data from a physical document; electronic recordkeeping; automating mental tasks; and receiving or transmitting data over a network, e.g. using the Internet to gather data.

Ans. 5–6 (citing USPTO July 2015 Update: Subject Matter Eligibility). The Examiner further finds “[t]he limitations directed to activating the control number and withdrawing funds simply add insignificant extrasolution activity (i.e. generally link the use of the judicial exception to a particular technological environment) to the judicial exception.” Ans. 6. The Examiner also finds the various hardware components recited in the claims are not sufficient to supply an inventive concept:

Furthermore, using well-known computer functions to execute an abstract idea does not constitute significantly more. The recitations to "set top box", "remote control", "television", and "server" are generically recited computer structure. Using a general purpose computer to perform the limitations is not sufficient to transform a judicial exception into a patentable invention. The computer components are recited at a high level of generality and perform the basic functions of a computer. Generically recited computer elements do not add a meaningful limitation to the abstract idea since they would be routine in any computer implementation.

Ans. 6.

Appellants' Contentions

Appellants present five brief arguments in favor of eligibility, which we reproduce in their entirety:

First, using a set top box to initiate money transfers is not an abstract idea. It's a concrete technical solution to a technical problem (novelly using a device not intended for such activities to cause a money transfer to occur). Second, this is not an "idea of itself" such as comparing one set of data to another and the like. It's a concrete method for directing the operation of a machine. This is almost the exact opposite of an idea of itself. Third, the alleged abstract idea is not a method of organizing human activities. Applicant cannot parse out any interpretation of the claims where using financial networks and television content distribution systems such as set top boxes is a representation of human activities. Fourth, substantially more is present because generic computers are not being used to implement an alleged abstract idea. Instead, specialized equipment, including reprogrammed set top boxes and financial server/networks that interact with television content delivery systems, are employed. Fifth, as will be demonstrated below, novel techniques are claimed, and therefore specific limitations other than what is well understood in the art are recited which limit the claims to specific applications.

Br. 4–5 (emphasis omitted).

Our Review

Applying the guidance set forth in the Memorandum, we are not persuaded of Examiner error. The Memorandum instructs us first to determine whether any judicial exception to patent eligibility is recited in the claim. The guidance identifies three judicially-excepted groupings: (1) mathematical concepts, (2) certain methods of organizing human behavior such as fundamental economic practices, and (3) mental processes. We

focus here on the second grouping—certain methods of organizing human behavior such as fundamental economic practices. *See Memorandum.*

Claim 1 recites the following limitations: (1) “[a] method of providing a money transfer,” (2) “receiving . . . a signal . . . wherein the signal indicates [a] money transfer initiation . . . by a user,” (3) “in response to receiving the signal . . . presenting . . . an interface to the user . . . the interface configured to receive a money transfer initiation request and a first identifier,” (4) “receiving . . . the money transfer initiation request and the first identifier,” (5) “sending . . . the money transfer initiation request and the first identifier,” (6) “verifying . . . the user’s identity by comparing the first identifier with a second identifier,” (7) “in response to the user’s identity being verified . . . forwarding . . . the money transfer initiation request to a money transfer provider,” (8) “receiving . . . from the money transfer provider . . . a money transfer control number associated with a money transfer initiated in response to the money transfer initiation request,” (9) “sending . . . the money transfer control number,” (10) “presenting . . . the money transfer control number to the user . . . [and] instructions on how to activate the money transfer control number,” (11) “receiving at the money transfer provider . . . the money transfer control number and the form of personal identification,” (12) “verifying, with the money transfer provider . . . that the money transfer control number is associated with the user by comparing the form of personal identification with information stored in a customer database,” (13) “in response to verification of the money transfer control number being associated with the user, activating the money transfer control number with the money transfer provider,” and (14) “in response to activation of the money transfer control number, and later

receipt of a request to withdraw funds associated with the money transfer control number, authorizing . . . distribution of funds associated with the money transfer control number.” Br. 9–10 (Claims Appendix).

These limitations, under their broadest reasonable interpretation, recite the fundamental economic practice of money transfer because the limitations all recite the operations that would ordinarily take place in executing a money transfer. Like the concept of intermediated settlement in *Alice*, and the concept of hedging in *Bilski*, the concept of money transfer recited in Appellants’ claims “is a fundamental economic practice long prevalent in our system of commerce.” *Alice*, 134 S. Ct. at 2356 (citations and internal quotation marks omitted). Accordingly, we conclude the claims recite a judicial exception of a fundamental economic practice.

Having determined that the claims recite a judicial exception, our analysis under the Memorandum turns now to determining whether there are “additional elements that integrate the judicial exception into a practical application.” See MPEP § 2106.05(a)–(c), (e)–(h)). Appellants’ claim 1 recites various computer-related and/or hardware-related limitations, including “a set top box,” “a remote control associated with the set top box [having] a money transfer initiation button,” “a television provider server,” “a money transfer provider server,” “a television,” and a “mobile device.” These computer and/or hardware-related limitations are described at a high level in the Specification without any meaningful detail about their structure or configuration. As such, we do not find the computer and/or hardware-related limitations are sufficient to integrate the judicial exception into a practical application.

Claim 1 also recites additional limitations which focus on providing instructions on how to activate the money transfer: “presenting . . . instructions on how to activate the money transfer control number, the instructions comprising instructions for using a mobile device [to initiate the money transfer].” We conclude that these limitations are insufficient to integrate the recited judicial exception of money transfer into a practical application. In particular, these additional elements merely implement the familiar practice of providing instructions to consumers for completing a transaction. The presentation of these instructions does not improve the functioning of a computer, nor do the instructions solve any technological problem with a technological solution. Indeed, the “instructions” described in the Specification include no detail, as the extent of the description is “[t]he message may include instructions as to how to activate the control number.” Spec. ¶ 26. Accordingly, we conclude claim 1 is *directed to a* judicial exception.

Having determined the claim is directed to a judicial exception, we proceed to evaluating whether the claim adds a specific limitation beyond the judicial exception that is not “well-understood, routine, conventional” in the field (see MPEP § 2106.05(d)) or simply appends well-understood, routine, conventional activities previously known to the industry, specified at a high level of generality, to the judicial exception. *See* Memorandum. We agree with the Examiner that the claim does not add specific limitations beyond what is well-understood, routine, and conventional. We note Appellants’ do not challenge the Examiner’s determination under *Alice* step 2 other than the brief contention that “novel techniques are claimed, and therefore specific limitations other than what is well understood in the art are

recited which limit the claims to specific applications.” Br. 5. However, Appellants do not identify what the specific inventive concept is, nor do they explain why it is an inventive concept in the non-abstract realm. *SAP Am., Inc. v. InvestPic, LLC*, No. 2017-2081, 2018 U.S. App. LEXIS 12590, Slip. Op. 13 (Fed. Cir. May 15, 2018) (“[w]hat is needed is an inventive concept in the non-abstract realm”). Accordingly, we do not discern in claim 1 any “specific limitation beyond the judicial exception that is not ‘well-understood, routine, conventional,’” and instead agree with the Examiner that the claims do not provide an inventive concept sufficient to transform the judicial exception into patent-eligible subject matter.

Because the Examiner correctly concluded claim 1 is directed to a judicial exception, and because Appellants do not identify any error in the Examiner’s determination under *Alice* step 2, we sustain the rejection of claim 1 under 35 U.S.C. § 101. Appellants do not present arguments for any other claim. Accordingly, we treat claim 1 as representative, and sustain the patent-eligibility rejection of the remaining claims for the same reasons.

REJECTION UNDER 35 U.S.C. § 103(a)

The Examiner rejects claim 1 as obvious over Linehan, Hill, and Campagna. Final Act. 7–11; Ans. 7–8. Relevant here, the Examiner finds Hill teaches the limitation of “sending from the television provider server to the set top box, the money transfer control number,” because it describes transmitting a recipient’s mobile telephone number in a money transfer transaction. Final Act. 9 (citing Hill ¶ 86); Ans. 8 (“Hill is cited to teach sending the money transfer control number (recipient’s mobile telephone number, see [0086]) from the television server back to the set top box.”)

Appellants argue Hill is deficient because to the extent a mobile telephone number can be considered a “money transfer control number,” Hill describes that “the recipient mobile telephone number is never provided to a television provider server as recited by the claim.” Br. 7. We agree with Appellants. Hill makes no mention of any television provider server, nor of any set top box. The Examiner does not explain why the teachings of Hill would have made it obvious to send the mobile telephone number to these destinations. Accordingly, we are persuaded the Examiner has not sufficiently explained how the cited prior art renders this limitation obvious, and we do not sustain the rejection of claim 1 under 35 U.S.C. § 103(a). For the same reason, we also do not sustain the rejection of independent claim 16, nor of the remaining dependent claims.

DECISION

We summarily affirm the Examiner’s rejection of claims 12 and 13 under 35 U.S.C. § 112, second paragraph.

We affirm the rejection of claims 1, 4–8, 12, 13, 15, and 16 under 35 U.S.C. § 101.

We reverse the rejection of claims 1, 4–8, 12, 13, 15, and 16 under 35 U.S.C. § 103(a).

Because we have affirmed at least one ground of rejection for each claim on appeal, we affirm the Examiner’s decision to reject the claims. 37 C.F.R. § 41.50(a)(1).

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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