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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte RAMAKRISHNA VENKATA SATYAVOLU,
SAMIR KOTHARI, and SHEHZAD DAREDIA¹

Appeal 2017-009305
Application 14/166,525
Technology Center 3600

Before JASON V. MORGAN, JOHN R. KENNY, and
AARON W. MOORE, *Administrative Patent Judges*.

KENNY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134 from a final rejection of claims 1–20. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ Appellants identify Truaxis, a subsidiary of Mastercard International Inc., as the real party in interest. App. Br. 3.

SPECIFICATION

The Specification relates generally to consumer comparison shopping and usage based service analysis. Spec. ¶ 4. Claim 1, which is illustrative, reads:

1. A computer-implemented method, the method implemented by one or more physical processors configured to execute computer program instructions, the method comprising:
 - embedding an executable script in a computer program for a graphical user interface of a financial account of each of a plurality of users;
 - executing the executable script when a user among the plurality of users accesses the user's financial account by at least one computer, the executable script effective for:
 - gathering transaction data from the financial account of each of the plurality of users using the at least one computer;
 - anonymizing the transaction data of each of the plurality of users by the at least one computer;
 - transmitting the anonymized transaction data of each of the plurality of users to the one or more physical processors for analysis;
 - analyzing the anonymized transaction data of each of the plurality of users by the one or more physical processors for at least one expenditure selected from the group consisting of a minimum total spending amount in a spending category, a minimum total spending amount with a particular merchant and a minimum single transaction amount;
 - matching by the one or more physical processors a savings opportunity from a database of savings opportunities to one or more users among the plurality of users based on the at least one expenditure selected from the group consisting of an expenditure in a period of time, a spending amount with a particular merchant and an amount spent on a particular transaction;
 - instructing a decision engine in communication with the one or more physical processors to select at least one matched savings opportunity based on the at least one expenditure of the one or more users;

receiving an indication of the at least one selected savings opportunity from the decision engine; and displaying the at least one selected savings opportunity in the account graphical user interface of the financial account of only the matched one or more users wherein the savings opportunity is displayed interweaved with at least a portion of the transaction data.

REJECTIONS

Claims 1–20 stand rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter. Final Act. 3.

Claims 1, 7, and 11 stand rejected under 35 U.S.C. § 112(a). Final Act. 5.

ANALYSIS

35 U.S.C. § 101

In *Alice Corp. Pty. Ltd. v. CLS Bank International*, 134 S. Ct. 2347 (2014), the Supreme Court reiterated an analytical two-step framework previously set forth in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 566 U.S. 66, 79 (2012), “for distinguishing 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. The first step in the analysis is to “determine whether the claims at issue are directed to one of those patent-ineligible concepts,” such as an abstract idea. *Id.* If the claims are directed to eligible subject matter, the inquiry ends. *Thales Visionix Inc. v. U.S.*, 850 F.3d 1343, 1346 (Fed. Cir. 2017); *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1339 (Fed. Cir. 2016).

If the claims are directed to a patent-ineligible concept, the second step in the analysis is to consider the elements of the claims “individually and ‘as an ordered combination’” to determine whether there are additional elements that “‘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). In other words, the second step is to “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.* (alteration in original) (quoting *Mayo*, 566 U.S. at 72–73).

In rejecting claims 1–20 under 35 U.S.C. § 101, the Examiner determines these claims are directed to the abstract idea of targeted marketing. Final Act. 4–5; Ans. 3. The Examiner analogizes claims 1–20 to the claims addressed in *FairWarning IP, LLC v. Iatric Systems, Inc.*, 839 F.3d 1089 (Fed. Cir. 2016), and *SmartGene, Inc. v. Advanced Biological Labs., SA*, 555 F. App’x 950 (Fed. Cir. 2014) (non-precedential). Final Act. 4; Ans. 5–6. Further, the Examiner determines that the additional elements recited by claim 1 add nothing more to the abstract idea than mere instructions to implement the idea on a computer and the recitation of generic computer structure that serve to perform well-understood, routine, and conventional activities. Final Act. 4–5.

Alice Step One

Appellants argue claims 1–20 are not directed to an abstract idea, analogizing those claims to hypothetical claim 1 in Example 23 in Appendix 1 of the July 2015 Update to the *2014 Interim Guidance on Subject Matter Eligibility* (“Example 23 claim 1”). App. Br. 12–13. Appellants argue that because claims 1, 7, and 11 (the independent claims amongst claims 1–20)

recite “wherein the savings opportunity is displayed interweaved with at least a portion of the transaction data,” claims 1, 7, and 11 of this Application are like claim 1 of Example 23, and are necessarily rooted in computer technology to overcome a problem specifically arising in graphical user interfaces. *Id.* The Examiner disagrees, finding that Appellants’ invention is directed to “presenting the consumer with relevant alternative service options,” which connotes targeted marketing. Ans. 3 (quoting Spec. ¶ 6). Further, the Examiner finds the Specification teaches that the invention can be practiced by hand. According to the Examiner, Figure 14 of the Specification, reproduced below, illustrates the recited displayed saving opportunity interweaved with the transaction data:

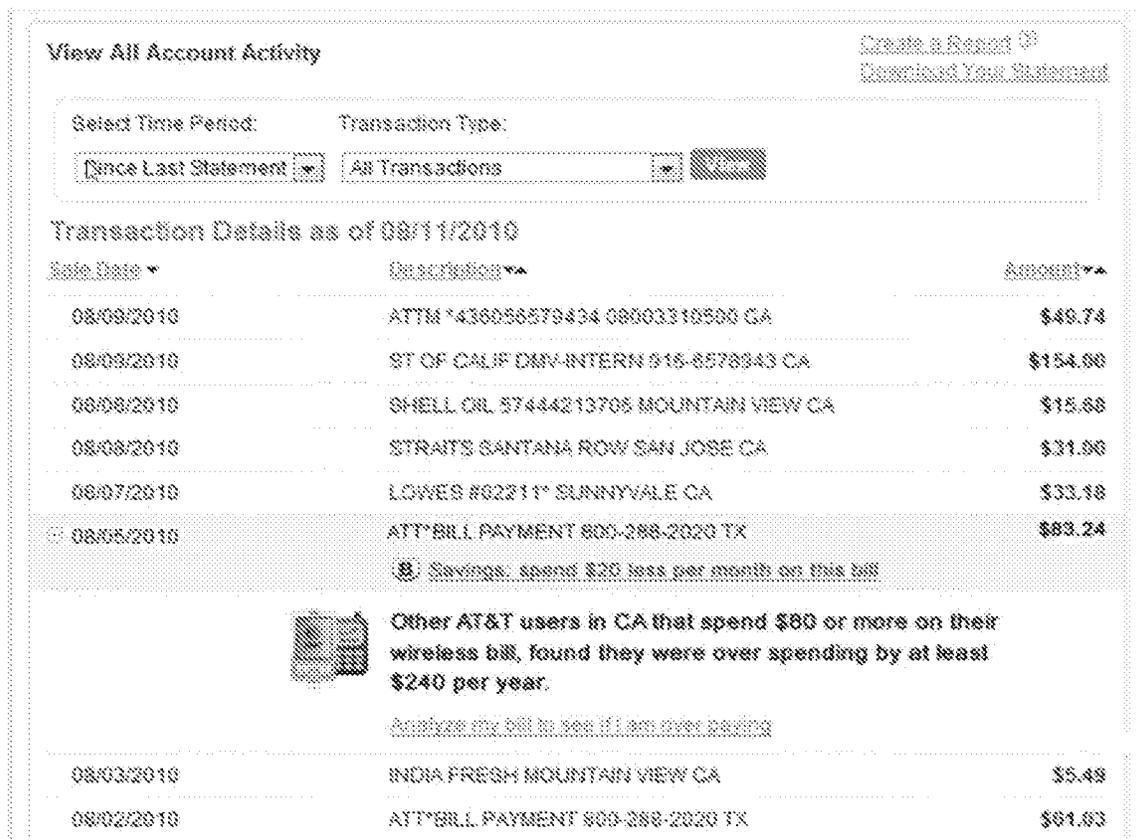


Figure 14 depicts a screenshot of an account statement of a user. Spec. ¶¶ 37, 110. The Examiner finds that the Specification teaches that the

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disclosed platform used to target customers in Figure 14 can be used for customers as they “review their recent transactions via an online or paper account statement.” Ans. 4 (emphasis omitted); Spec. ¶ 110. The Examiner determines the description of the paper account statement means that the invention can be performed by hand. Ans. 4.

Appellants argue that whether the invention can be performed by hand is irrelevant because “processes that automate tasks that humans are capable of performing are patent eligible if properly claimed.” Reply Br. 3–4 (quoting *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1313 (Fed. Cir. 2016)). According to Appellants, claims 1–20 are patent eligible because they focus on a specific asserted improvement in computer capabilities, dynamically displaying the savings opportunities as the user views its account statement, as provided by the interweaved limitation. Reply Br. 4. We are not persuaded by Appellants’ arguments.

First, we do not agree that claims 1–20 are analogous to Example 23 claim 1. The interleaving limitation of claims 1–20 does not address a technical problem arising with graphic user interfaces like the reformatting limitation of Example 23 claim 1. The interleaving limitation merely recites displaying cost savings information in a manner that, the Examiner finds and Appellants do not dispute, can also be used for paper statements. Further, claims 1–20 do address targeted marketing, “displaying the at least one selected savings opportunity,” which is similar to abstract ideas identified by the courts. *Ultramarcial, Inc. v. Hulu, LLC*, 772 F.3d 709, 715 (Fed. Cir. 2014) (“the concept embodied by the majority of the limitations describes only the abstract idea of showing an advertisement before delivering free content”); *FairWarning*, 839 F.3d at 1095 (“the focus of the claims is not on . . . an improvement in computers as tools, but on certain independently

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abstract ideas that use computers as tools” (quoting *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1354 (Fed. Cir. 2016))).

Second, we do not agree that the claims are analogous to those addressed in *McRO*. “The claimed rules in *McRO* transformed a traditionally subjective process performed by human artists into a mathematically automated process executed on computers.” *Fair Warning*, 839 F.3d at 1094. Here, as the Examiner finds and Appellants do not dispute, the interleaving limitation can be performed by humans in the same manner as claimed here.

Accordingly, we determine claims 1–20 are directed to an abstract idea.

Alice Step Two

Appellants argue that claims 1–20 recite an inventive concept that amounts to significantly more than an abstract idea: combining dynamic data, such as savings opportunities, with traditionally displayed static transaction data, thus comprising an inventive concept that amounts to significantly more than an abstract idea. App. Br. 13–14. Appellants also argue that claims 1–20 would not create broad preemption and, as such, are patent eligible. *Id.* at 14.

We are not persuaded by either argument. First, Appellants’ argument that combining dynamic and static data can transform a claim into eligible subject matter is not persuasive because claims 1–20 do not recite dynamic or static data. Similarly, Appellants’ argument that the allegedly narrow preemptive effects of the claims render them patent eligible is not persuasive because although “preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility.”

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Ariosa Diagnostics, Inc. v. Sequenom, Inc., 788 F.3d 1371, 1379 (Fed. Cir. 2015).

Accordingly, we sustain the rejection of claims 1–20 under 35 U.S.C. § 101.

35 U.S.C. § 112(a)

In evaluating compliance with the written description requirement, “the test for sufficiency is whether the disclosure of the application relied upon reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date.” *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (citing cases). When claims are drawn to a genus, “a sufficient description of [the] genus . . . requires the disclosure of either a representative number of species falling within the scope of the genus or structural features common to the members of the genus so that one of skill in the art can ‘visualize or recognize’ the members of the genus.” *Id.* at 1350, *cited in D Three Enters., LLC v. SunModo Corp.*, 890 F.3d 1042, 1047 (Fed. Cir. 2018); *see also Amgen Inc. v. Sanofi*, 872 F.3d 1367, 1373–74 (Fed. Cir. 2017).

The Examiner finds that the Specification does not provide written description support for the limitation recited by claims 1, 7, and 11 of: “analyzing . . . for at least one expenditure selected from the group consisting of a minimum total spending amount in a spending category, a minimum total spending amount with a particular merchant and a minimum single transaction amount.” Final Act. 5–6. Appellants argue that paragraph 13 of the Specification supports this analyzing-at-least-one-expenditure limitation. Paragraph 13 describes analyzing transaction data to determine if it meets a criteria set by a merchant for a savings opportunity. As Appellants highlight, paragraph 13 further describes that the criteria may

comprise a total spending amount with the merchant, total spending during a period of time, a particular transaction, and a transaction at a particular merchant location. App. Br. 15. Appellants argue these descriptions describe the analyzing-at-least-one-expenditure limitation. The Examiner disagrees, finding that paragraph 13 does not describe limiting the choice amongst expenditures to the three recited expenditures, noting that the Specification uses the term “may comprise,” rather than “consisting of.” Ans. 7. The Examiner also finds paragraph 13 does not describe using an amount spent on a particular transaction as a criteria. Ans. 7.

Appellants respond that “may comprise” describes a choice among three expenditures and that paragraph 13 describes using an amount spent on a particular transaction by describing using “a particular transaction” as a criteria. Reply Br. 6.

We are not persuaded by Appellants’ arguments. For clarity, we note that there are two different limitations in claims 1, 7, and 11 that recite “at least one expenditure” and the Examiner and Appellants address both limitations in this Appeal. The Final Action and the Appeal Brief address the analyzing-at-least-one-expenditure limitation. Final Act 5–6; App. Br. 15. The Answer and Reply Brief address another limitation: “matching . . . based on the at least one expenditure selected from the group consisting of an expenditure in a period of time, a spending amount with a particular merchant and an amount spent on a particular transaction.” Ans. 7; Reply Br. 6. We address the analyzing-at-least-one-expenditure limitation because it was the limitation addressed in the Final Action and the Appeal Brief.

Regarding the analyzing-at-least-one-expenditure limitation, we do not agree that paragraph 13 describes using a minimum single transaction amount as an analytical criteria. The paragraph merely describes using a

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transaction as an analytical criteria, but there are various characteristics that could be associated with a transaction, meaning that disclosure is insufficient for written description support. *D Three Enters.*, 890 F.3d at 1052 (disclosing a washer above a flashing does not provide written description support for a washer below a flashing or a washer either above or below a flashing). Although the use of a particular transaction as an analytical criteria might render obvious using a minimum single transaction amount as an analytical criteria, obviousness does not constitute written description support. *Ariad*, 598 F.3d at 1357 (rendering obvious is insufficient for written description support) (citing *Regents of the University of California v. Eli Lilly & Co.*, 119 F.3d 1559, 1567 (Fed. Cir. 1997)).

Accordingly, we sustain the written description rejection of claims 1, 7, and 11.²

² In the event of future prosecution, if the written description deficiency of independent claims 1, 7, and 11 is not resolved, claims 2–6, 8–10, and 12–20 should be rejected under 35 U.S.C. § 112(a) due to their dependency on claims 1, 7, and 11. Also, it could be worthwhile to ascertain whether “the at least one expenditure” recited by claims 1, 7, and 11 differs from the “at least one expenditure” in the analyzing-at-least-one-expenditure limitation and whether that difference renders claims 1, 7, and 11 and their dependent claims indefinite.

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DECISION

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

We affirm the rejection of claims 1, 7, and 11 under 35 U.S.C. § 112(a).

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

APJ Initials