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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* GIRISH BALASUBRAMANIAN<sup>1</sup>

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Appeal 2017-009573  
Application 13/782,188  
Technology Center 3600

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Before JOSEPH L. DIXON, CARLA M. KRIVAK, and  
JOHN R. KENNY, *Administrative Patent Judges*.

KRIVAK, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant appeals under 35 U.S.C. § 134(a) from a 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> Appellant identifies Western Union Company of Englewood, Colorado, as the real party in interest.

## STATEMENT OF THE CASE

Appellant's invention is directed to "authenticating or verifying the identity of an account holder. . . . by requiring a customer to provide personal information (such as address) associated with a first account number, and then also requiring the customer provide a second account number." Spec. ¶ 5. This "customer-provided personal information is compared to personal information stored by a card issuer for the first account number and personal information stored by a card issuer for the second account number." *Id.*

Independent claim 1, reproduced below, is exemplary of the subject matter on appeal.

1. A method for preventing fraudulent card transactions, comprising:
  - receiving from a point-of-sale (POS) system, by one or more processors, a first account number for a first card being used by a customer to conduct a transaction;
  - receiving from the POS system, by one or more of the processors, at least one piece of personal information provided by the customer;
  - accessing, by one or more of the processors, one or more databases having personal information of customers stored in association with each of a plurality of account numbers, to retrieve personal information of the customer associated with the first account number;
  - comparing, by one or more of the processors, the retrieved personal information associated with the first account number to the personal information provided by the customer;
  - receiving, by one or more of the processors, a second account number for a second card of the customer;
  - accessing, by one or more of the processors, one or more of the databases to retrieve personal information associated with the second account number;

comparing, by one or more of the processors, the retrieved personal information associated with the second account number to the personal information provided by the customer; and

approving, by one or more of the processors, the transaction using the first account number based at least in part on the personal information provided by the customer matching: (1) the retrieved personal information associated with the first account number, and (2) the retrieved personal information associated with the second account number.

### REJECTION

The Examiner rejects claims 1–20 under 35 U.S.C. § 101 as being directed to a judicial exception (i.e., a law of nature, a natural phenomenon, or an abstract idea) without significantly more.

### ANALYSIS

The Examiner determines the series of steps for preventing a fraudulent card transaction using account numbers and personal information as recited in claims 1–20, are fundamental economic practices and the claims do not include additional elements that amount to significantly more than the judicial exception. Final Act. 2. That is, the claims require no more than a general purpose computer that performs generic computer functions, which are well-understood, routine and conventional. *Id.*

Under 35 U.S.C. § 101, a patent may be obtained for “any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof.” The Supreme Court has “long held that this provision contains an important implicit exception: Laws of nature, natural phenomena, and abstract ideas are not patentable” (*Alice Corp. Pty.*

*Ltd. 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)). The Supreme Court in *Alice* reiterated the two-step framework previously set forth in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 566 U.S. 66, 82–84 (2012), “for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of these concepts” (*Alice*, 134 S. Ct. at 2355). The first step in that analysis is to “determine whether the claims at issue are directed to one of those patent-ineligible concepts,” such as an abstract idea. *Id.* The Court acknowledged in *Mayo* 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). We, therefore, look to whether the claims focus on a specific means or method that improves the relevant technology or are instead directed to a result or effect that is the abstract idea and merely invoke generic processes and machinery (*see Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1334 (Fed. Cir. 2016)). If the claims are not directed to an abstract idea, the inquiry ends. Otherwise, the inquiry proceeds to the second step where the elements of the claims are considered “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)).

*Alice/Mayo—Step 1 (Abstract Idea)*

The Examiner determines Appellant’s claims are directed to a fundamental business practice. Final Act. 2; Ans. 2–5. Appellant does not argue otherwise. App. Br. 4–5. That is, Appellant appears to agree the

claim is directed to an abstract idea, only providing argument for *Alice* Step 2. *Id.*

We agree with the Examiner’s determination that “the claims are not directed to ‘an improvement to computer functionality,’ such as found by the CAFC in *Enfish*, but to the abstract idea itself” (*see Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1339, 1336 (Fed. Cir. 2016)). Ans. 4. Appellant does not address this finding. Therefore, we agree with the Examiner’s determination that the claims are directed to an abstract idea under *Alice* Step 1.

*Alice/Mayo—Step 2 (Inventive Concept)*

Appellant asserts “at least two different factors enumerated by the Interim Guidance establish that claims 1–20 include ‘significantly more’ than the abstract idea to which the claims are allegedly directed. Consequently, these claims constitute statutory subject matter.” Br. 5. However, Appellant merely recites a portion of the Guidelines, and states their claims recite “non-generic, machines/computers are necessary to implement the systems and methods of the claims” and “[e]ach of the claims includes 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,” without stating why the non-generic machines/computers (servers) are non-generic and how the claim limitations are not routine or unconventional. *Id.* Further, Appellant has not identified support in the Specification for these allegations.

Appellant also asserts “the notion that the claims are directed to a fundamental economic practice is also thrown into question by the inability of the office to reject the claims under §102 or §103. If the claims are

directed to something so fundamental, where is the prior art demonstrating this?” Br. 5. However, the concept of inventiveness under § 101 is distinct from that of novelty. “The inventiveness inquiry of § 101 should therefore not be confused with the separate novelty inquiry of § 102 or the obviousness inquiry of § 103.” *See Amdocs (Israel) Ltd. v. Openet Telecom, Inc.*, 841 F.3d 1288, 1311 (Fed. Cir. 2016). *See also Two-Way Media Ltd. v. Comcast Cable Commc’ns, LLC*, 874 F.3d 1329, 1340 (Fed. Cir. 2017) (“[e]ligibility and novelty are separate inquiries.”) and *Affinity Labs of Tex., LLC v. DIRECTV, LLC*, 838 F.3d 1253, 1263 (Fed. Cir. 2016) (holding that “[e]ven assuming” a particular claimed feature was novel does not “avoid the problem of abstractness.”).

The Examiner provides a well-reasoned analysis based on current case law and Guidelines. Ans. 5–7. Appellant does not dispute the Examiner’s reasoning. Thus, we agree with the Examiner the claims “are directed to the use of conventional or generic technology in a nascent but well-known environment” (Ans. 7) and sustain the § 101 rejection of claims 1–20, argued together.

#### DECISION

The Examiner’s decision rejecting claims 1–20 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)(iv).

AFFIRMED