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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte NICHOLAS LECUYER, TERRA GRANTHAM, and
MICHAEL KILBANE

Appeal 2017-010317
Application 14/107,447¹
Technology Center 3600

Before JOHNNY A. KUMAR, CATHERINE SHIANG, and
JOYCE CRAIG, *Administrative Patent Judges*.

SHIANG, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1–20, which are all the claims pending and rejected in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

¹ Appellants identify Western Union Company as the real party in interest. App. Br. 2.

STATEMENT OF THE CASE

Introduction

According to the Specification, the present invention relates to transmitting funds directly between financial institutions. Spec. ¶ 2. “In some embodiments, a method for analyzing multiple money transfer routing schemes to identify a preferable money transfer routing scheme from among the multiple money transfer routing schemes according to at least one predefined criterion is presented.” Spec. ¶ 3. Claim 1 is exemplary:

1. A method comprising:
 - receiving, by a computer system of a money transfer network, at least one predefined criterion used to analyze multiple money transfer routing schemes;
 - receiving, by the computer system, an indication of a source and a destination for a money transfer transaction;
 - selecting, by the computer system, a plurality of money transfer routing schemes, based at least in part on the at least one predefined criterion, wherein each the plurality of money transfer routing schemes comprises a route to transmit funds from the source for the money transfer transaction to the destination for the money transfer transaction, wherein at least one internal money transfer scheme and at least one external money transfer routing scheme are selected, and wherein:
 - an internal money transfer routing scheme refers to a money transfer routing scheme that utilizes a direct money transfer arrangement between the destination of the money transfer transaction and the money transfer network; and
 - an external money transfer routing scheme refers to a money transfer routing scheme that utilizes at least one third party money transfer network between the destination of the money transfer transaction and the money transfer network;
 - determining, by the computer system, a preferable money transfer routing scheme from among the plurality of money transfer routing schemes, based at least in part on predefined criterion;

causing, with the computer system, at least a subset of the plurality of money transfer routing schemes to be presented at a user interface, wherein the subset includes the preferable money transfer routing scheme and at least one other money transfer routing scheme; and

receiving from the user interface, by the computer system, a selection of a particular money transfer routing scheme from among the subset of the plurality of money transfer routing schemes.

Rejection²

Claims 1–20 stand rejected under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter. Non-Final Act. 3–8.

ANALYSIS

We disagree with Appellants’ arguments, and agree with and adopt the Examiner’s findings and conclusions in (i) the action from which this appeal is taken (Non-Final Act. 3–8) and (ii) the Answer (Ans. 3–11) to the extent they are consistent with our analysis below.

The Examiner rejects the claims under 35 U.S.C. § 101 because they are directed to patent-ineligible subject matter. *See* Non-Final Act. 3–8; Ans. 3–11. In particular, the Examiner concludes the claims are directed to the abstract idea of transferring money, which constitutes a fundamental economic practice. *See* Non-Final Act. 3–4, 6–7; Ans. 3, 5–6, 10. The Examiner determines the claims do not identify an inventive concept to transform the nature of the claims into a patent-eligible application. *See*

² Throughout this opinion, we refer to the (1) Non-Final Rejection dated September 22, 2016; (“Non-Final Act.”); (2) Appeal Brief dated February 22, 2017 (“Br.”); and (3) Examiner’s Answer dated May 5, 2017 (“Ans.”).

Non-Final Act. 4–8; Ans. 8–9. Appellants argue the Examiner erred. *See* Br. 4–8.

Appellants have not persuaded us of error. Section 101 of the Patent Act provides “[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.” 35 U.S.C. § 101. That 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)). According to the Supreme Court:

[W]e set forth a framework for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts. First, we determine whether the claims at issue are directed to one of those patent-ineligible concepts. . . . If so, we then ask, “[w]hat else is there in the claims before us?” . . . To answer that question, 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. . . . We have 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.”

Alice Corp., 134 S. Ct. at 2355 (quoting *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S.Ct. 1289, 1294, 1296–98 (2012)).

The Federal Circuit has described the *Alice* step-one inquiry as looking at the “focus” of the claims, their “character as a whole,” and the

Alice step-two inquiry as looking more precisely at what the claim elements add—whether they identify an “inventive concept” in the application of the ineligible matter to which the claim is directed. *See Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016); *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335–36 (Fed. Cir. 2016); *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1346 (Fed. Cir. 2015).

Regarding *Alice* step one, the Federal Circuit has “treated *collecting information*, including when limited to particular content (which does not change its character as information), as within the realm of abstract ideas.” *Elec. Power*, 830 F.3d at 1353 (emphasis added); *see also Internet Patents*, 790 F.3d at 1348–49; *OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1363 (Fed. Cir. 2015); *Content Extraction & Transmission LLC v. Wells Fargo Bank, Nat’l Ass’n*, 776 F.3d 1343, 1347 (Fed. Cir. 2014). “In a similar vein, we have treated *analyzing information* [including manipulating information] by steps people go through in their minds, or by mathematical algorithms, without more, as essentially mental processes within the abstract-idea category.” *Elec. Power*, 830 F.3d at 1354 (emphasis added); *see also In re TLI Commc’ns LLC Patent Litig.*, 823 F.3d 607, 613 (Fed. Cir. 2016). “And we have recognized that *merely presenting the results of abstract processes of collecting and analyzing information, without more* (such as identifying a particular tool for presentation), is abstract as an ancillary part of such collection and analysis.” *Elec. Power*, 830 F.3d at 1354 (emphasis added); *see also Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 714–15 (Fed. Cir. 2014).

The rejected claims “fall into a familiar class of claims ‘directed to’ a patent-ineligible concept.” *Elec. Power*, 830 F.3d at 1353. Contrary to

Appellants' arguments (Br. 4–8), the claims are similar to the claims of *Electric Power*, and are focused on the combination of abstract-idea processes or functions. *See Elec. Power*, 830 F.3d at 1354. For example, claim 1 is directed to receiving information (“receiving . . .”), analyzing information (“selecting . . .” and “determining . . .”), and displaying information (“causing . . . to be presented . . .”). Independent claims 13 and 17 are similarly directed to receiving, analyzing, and displaying information. *See* claims 13 and 17. The dependent claims are directed to similar functions or processes, and Appellants have not shown such claims are directed to other non-abstract functions or processes. *See* claims 2–12, 14–16, and 18–20.

We also agree with the Examiner that the claims are directed to the abstract idea of transferring money, which constitutes a fundamental economic practice. *See* Non-Final Act. 4, 6–7; Ans. 3, 9–10. As pointed out by the Examiner (Non-Final Act. 6–7; Ans. 10), our determination is consistent with the Specification, which repeatedly explains the invention is directed to transferring money. *See, e.g.*, Spec. Title, ¶¶ 2–6, 74.

Appellants' argument about pre-emption (Br. 7) is unpersuasive, because “[w]hile preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility Where a patent's claims are deemed only to disclose patent ineligible subject matter under the *Mayo* framework, as they are in this case, preemption concerns are fully addressed and made moot.” *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015); *see also OIP*, 788 F.3d at 1362–63 (“that the claims do not preempt all price optimization or

may be limited to price optimization in the e-commerce setting do not make them any less abstract”).

Regarding *Alice* step two, contrary to Appellants’ assertion (Br. 6–7), Appellants have not shown the claims in this case require any “inventive concept” or inventive set of components or methods, or invoke any assertedly inventive programming. *Elec. Power*, 830 F.3d at 1355.

Further, contrary to Appellants’ arguments (Br. 6–7), the claims are similar to the claims of *Electric Power*, because they do not require any nonconventional computer, network, or display components, or even a “non-conventional and non-generic arrangement of known, conventional pieces,” but merely call for performance of the claimed information collection, analysis, and display functions on generic computer components and display devices. *See Elec. Power*, 830 F.3d at 1355; *see also* independent claims 1, 13, 17 (each reciting “a computer system of a money transfer network”). The dependent claims call for similar generic components and devices, and Appellants have not shown such claims require any non-conventional components or devices. *See* claims 2–12, 14–16, and 18–20.

Similar to the claims of *Electric Power*, the rejected claims specify what information is desirable to gather, analyze, and display, but they “do not include any requirement for performing the claimed functions of gathering, analyzing, and displaying . . . by use of anything but entirely conventional, generic technology.” *Elec. Power*, 830 F.3d at 1356. Therefore, similar to the claims of *Electric Power*, the rejected claims “do not state an arguably inventive concept in the realm of application of the information-based abstract ideas.” *Id.* at 1356.

Appellants’ argument about the absence of a prior art rejection (Br. 6–

7) is unpersuasive, because a prior art rejection is determined under 35 U.S.C. § 102 and § 103, which are different statutory requirements. As the Supreme Court emphasizes: “[t]he ‘novelty’ of any element or steps in a process, or even of the process itself, is of *no relevance* in determining whether the subject matter of a claim falls within the § 101 categories of possibly patentable subject matter.” *Diamond v. Diehr*, 450 U.S. 175, 188–89 (1981) (emphasis added). Our reviewing court further guides that “[e]ligibility and novelty are separate inquiries.” *Two-Way Media Ltd. v. Comcast Cable Commc’ns, LLC*, 874 F.3d 1329, 1340 (Fed. Cir. 2017).

In short, Appellants have not shown the claims, read in light of the Specification, require anything other than conventional computer, network, and display technology for collecting, analyzing, and presenting the desired information. *See Elec. Power*, 830 F.3d at 1354. Such invocations of computers and networks are “insufficient to pass the test of an inventive concept in the application” of an abstract idea and, therefore, do not add significantly more to that idea. *Id.* at 1355 (citation omitted).

Because Appellants have not persuaded us the Examiner erred, we sustain the Examiner’s rejection of claims 1–20 under 35 U.S.C. § 101.

DECISION

We affirm the Examiner’s decision rejecting claims 1–20.

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). *See* 37 C.F.R. § 41.50(f).

AFFIRMED