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ORTIZ ROMAN, DENISSE Y

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte AYMAN HAMMAD, FRANCISCO OLIVA,
UZMA MAKHDUMI, PAT STAN, LORI VAN DELOO,
and ALLEN CUELI

Appeal 2017-010472¹
Application 12/895,208²
Technology Center 3600

Before BIBHU R. MOHANTY, NINA L. MEDLOCK, and
CYNTHIA L. MURPHY, *Administrative Patent Judges*.

MEDLOCK, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner’s final rejection of claims 1–4, 6, 9–13, 15–21, and 24–28. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ Our decision references Appellants’ Appeal Brief (“App. Br.,” filed March 13, 2017) and Reply Brief (“Reply Br.,” filed August 3, 2017), and the Examiner’s Answer (“Ans.,” mailed June 5, 2017) and Final Office Action (“Final Act.,” mailed October 13, 2016).

² Appellants identify Visa International Service Association, as the real party in interest. App. Br. 3.

CLAIMED INVENTION

Appellants describe that “[e]mbodiments of the present invention are directed to systems, apparatuses, and methods for providing a consumer with information regarding payment transactions,” and more specifically, to “a system and method for facilitating a consumer to receive an alert message responsive to a user transaction that, when combined with past transactions over a certain time period, satisfies specific criteria” (Spec. ¶ 1).

Claims 1, 10, and 20 are the independent claims on appeal. Claim 1, reproduced below with bracketed notations added, is illustrative of the claimed subject matter:

1. An alerts messaging system comprising:
 - [(a)] a database comprising an alert trigger including information based on alert criteria from a user; and
 - [(b)] a server computer coupled to the database, wherein the server computer comprises a processor and a computer-readable storage medium coupled to the processor, the computer-readable storage medium comprising code executable by the processor for implementing a method comprising
 - [(c)] receiving transaction data for a transaction in an authorization request message from an access device after the access device receives information from a portable consumer device,
 - [(d)] parsing the transaction data to identify a user account identifier,
 - [(e)] identifying an account corresponding to the user using the user account identifier,
 - [(f)] identifying historical transaction data associated with the account corresponding to the user,
 - [(g)] aggregating the transaction data for the transaction with the historical transaction data associated with the account corresponding to the user,
 - [(h)] accessing the database comprising the alert trigger,

[(i)] determining that the alert trigger is met, wherein determining that the alert trigger is met includes determining that the aggregated transaction data satisfies the alert criteria,

[(j)] generating an alert message when the alert trigger is met, wherein the alert message includes the aggregated transaction data, and wherein the aggregated transaction data included in the alert message comprises a total number of transactions at a specific merchant type and a total amount of the transactions at the specific merchant type, wherein the alert message is not generated when the alert trigger is not met,

[(k)] sending the alert message to a mobile device operated by the user after the alert message was generated, wherein the mobile device displays the alert message,

[(l)] transmitting the authorization request to an issuer computer,

[(m)] receiving an authorization response from the issuer computer, and

[(n)] forwarding the authorization response to the access device.

REJECTIONS

Claims 1–4, 6, 9–13, 15–21, and 24–28 are rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter.

Claims 1–4, 6, 9–13, 15–21, and 24–28 are rejected under 35 U.S.C. § 103(a) as unpatentable over Audebert et al. (US 2003/0105707 A1, pub. June 5, 2003) (“Audebert”), Chen et al. (US 2006/0151598 A1, pub. July 13, 2006) (“Chen”), and Bhojwani et al. (US 2009/0210886 A1, pub. Aug. 20, 2009) (“Bhojwani”).

ANALYSIS

Patent-Ineligible Subject Matter

Appellants argue the pending claims as a group (App. Br. 9–20). We select claim 1 as representative. The remaining claims stand or fall with claim 1. *See* 37 C.F.R. §41.37(c)(1)(iv).

Under 35 U.S.C. § 101, an invention is patent-eligible if it claims a “new and useful process, machine, manufacture, or composition of matter.” 35 U.S.C. § 101. The Supreme Court, however, has long interpreted § 101 to include an implicit exception: “[l]aws of nature, natural phenomena, and abstract ideas” are not patentable. *Alice Corp. v. CLS Bank Int’l*, 573 U.S. 208, 216 (2014).

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 (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 Corp.*, 573 U.S. at 217. The first step in that analysis is to “determine whether the claims at issue are directed to one of those patent-ineligible concepts.” *Id.* If the claims are not directed to a patent-ineligible concept, e.g., 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 there are additional elements that “‘transform the nature of the claim’ into a patent-eligible application.” *Id.* (quoting *Mayo*, 566 U.S. at 79, 78).

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. Therefore, the Federal Circuit has instructed that claims are to be considered in their entirety to determine “whether their character as a whole is directed to excluded subject matter.” *McRO, Inc. v. Bandai Namco Games Am., Inc.*, 837 F.3d 1299, 1312 (Fed. Cir. 2016) (quoting *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1346 (Fed. Cir. 2015)).

Addressing step one of the *Mayo/Alice* framework, Appellants first argue that the § 101 rejection cannot be sustained because the Examiner has provided no evidence to support the Examiner’s determination that the claims are directed to an abstract idea; therefore, according to Appellants, the Examiner has failed to establish a prima facie case of patent-ineligibility (App. Br. 10–11; *see also* Reply Br. 2–3). Appellants’ argument is not persuasive at least because we are aware of no controlling precedent that requires an examiner to identify specific references to support a determination that a claim is directed to an abstract idea. Nor, contrary to Appellants’ suggestion (App. Br. 10), did this Board hold in *PNC Bank v. Secure Access*, CBM2014-00100, 2014 WL 4537440 (PTAB September 9, 2014) that there is any such requirement.³ Evidence may be helpful, e.g., where facts are in dispute, but it is not always needed. *See Mortgage Grader, Inc. v. First Choice Loan Servs. Inc.*, 811 F.3d 1314, 1325–26 (Fed. Cir. 2016) (“[I]t is also possible, as numerous cases have recognized, that a § 101 analysis may sometimes be undertaken without resolving fact issues.”). Appellants’ bare assertion that evidence is needed here, without

³ We would not be bound, in any event, by a non-precedential decision of another panel of the Board.

any supporting reasoning as to why, is insufficient to require the Examiner to provide evidentiary support.⁴

The Federal Circuit, moreover, has observed repeatedly that “the prima facie case is merely a procedural device that enables an appropriate shift of the burden of production.” *Hyatt v. Dudas*, 492 F.3d 1365, 1369 (Fed. Cir. 2007) (citing *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992)). The court has, thus, held that the USPTO carries its procedural burden of establishing a prima facie case when its rejection satisfies the requirements of 35 U.S.C. § 132 by notifying the applicant of the reasons for the rejection, “together with such information and references as may be useful in judging of the propriety of continuing the prosecution of [the] application.” *See In re Jung*, 637 F.3d 1356, 1362 (Fed. Cir. 2011) (alteration in original). Thus, what is required of the Office is that it sets forth the statutory basis of the rejection in a sufficiently articulate and informative manner as to meet the notice requirement of § 132. *Id.*; *see also Chester v. Miller*, 906 F.2d 1574, 1578 (Fed. Cir. 1990) (“Section 132 is violated when a rejection is so uninformative that it prevents the applicant from recognizing and seeking to counter the grounds for rejection.”).

In rejecting the pending claims under 35 U.S.C. § 101, the Examiner set forth the statutory basis of the rejection in a sufficiently articulate and informative manner as to meet the notice requirement of 35 U.S.C. § 132 (*see* Final Act. 3–6). And, in doing so, the Examiner set forth a proper

⁴ We note that Appellants have put forward no rebuttal evidence showing the claims are not directed to an abstract idea.

rejection under § 101. *See* “July 2015 Update: Subject Matter Eligibility,”⁵ p. 6 (setting forth a general notice requirement to establish a prima facie rejection under 35 U.S.C. § 101); May 4, 2016 Memorandum to the Patent Examining Corps on “Formulating a Subject Matter Eligibility Rejection and Evaluating the Applicant’s Response to a Subject Matter Eligibility Rejection,”⁶ p. 2 (“[T]he rejection . . . must provide an explanation . . . which [is] sufficiently clear and specific to provide applicant *sufficient notice* of the reasons for ineligibility and enable the applicant to effectively respond.”) (emphasis added). Appellants do not contend that the Examiner’s rejection was not understood or that the Examiner otherwise failed to comply with the notice requirements of § 132.

Specifically focusing on claim 1, Appellants further argue that claim 1 is patent-eligible because the claim does not tie up the abstract idea of “sending alerts regarding payment transactions” such that others cannot practice it (App. Br. 12–13; *see also* Reply Br. 3). That argument is similarly unpersuasive of Examiner error.

There is no dispute that the Supreme Court has described “the concern that drives [the exclusion of abstract ideas from patent eligible subject matter] as one of pre-emption.” *Alice Corp.*, 573 U.S. at 216. But characterizing preemption as a driving concern for patent eligibility is not the same as characterizing preemption as the sole test for patent eligibility. “The Supreme Court has made clear that the principle of preemption is the

⁵ Available at <https://www.uspto.gov/sites/default/files/documents/ieg-july-2015-update.pdf>.

⁶ Available at <https://www.uspto.gov/sites/default/files/documents/ieg-may-2016-memo.pdf>.

basis for the judicial exceptions to patentability” and “[f]or this reason, questions on preemption are inherent in and resolved by the § 101 analysis.” *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015) (citing *Alice Corp.*, 134 S. Ct. at 2354). “[P]reemption may signal patent ineligible subject matter, [but] the absence of complete preemption does not demonstrate patent eligibility.” *Id.*

We also do not agree with Appellants that the Examiner’s determination that claim 1 is directed to an abstract idea is inconsistent with the state of the law as set forth in *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245 (Fed. Cir. 2014). To the contrary, the Examiner’s determination is, in our view, fully consistent with the controlling precedent, including *DDR Holdings*.

The Federal Circuit has explained that “the ‘directed to’ inquiry applies a stage-one filter to claims, considered in light of the [S]pecification, based on whether ‘their character as a whole is directed to excluded subject matter.’” *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335 (Fed. Cir. 2016) (quoting *Internet Patents Corp.*, 790 F.3d at 1346). It asks whether the focus of the claims is on a specific improvement in relevant technology or on a process that itself qualifies as an “abstract idea” for which computers are invoked merely as a tool. *See id.* at 1335–36. Here, it is clear from the Specification, including the claim language, that claim 1 focuses on an abstract idea, and not on any improvement to technology and/or a technical field.

The Specification is entitled “ACCUMULATION ALERTS.” The Background section of the Specification discloses that consumers use payment devices, e.g., debit cards, credit cards, to conduct a variety of

different types of transactions, and describes that, in some situations, prior to, during, or after a transaction, a consumer may wish to better understand his or her spending habits during a specific time period (Spec. ¶ 2). To this end, consumers typically log onto a website associated with the payment device of interest; once on the website, the consumer may view his or her account activities and mine data regarding transactions within a stated period, involving a particular merchant or merchant type, or that satisfy other criteria (*id.* ¶ 3). Alternatively, the consumer may receive alert messages describing transactions involving his or her account in real-time or digests at periodic points in time (*id.*). The Specification describes that these alert messages, however, can inconvenience a user by flooding the user with substantial amounts of information — data that the user may not wish to receive or may not wish to take the time to mine for relevant information (*id.* ¶¶ 3, 4). The claimed invention is ostensibly intended to improve on prior alert systems by “enabling a consumer to receive an alert message responsive to meeting some condition that involves an aggregation of transactions over a period of time” (*id.* ¶ 5), i.e., by enabling the consumer to receive only that information that the user wishes to receive.

Understood in light of the Specification, claim 1 is, thus, directed to sending alerts to a consumer regarding payment transactions by (1) collecting information, i.e., transaction data (step (c)); (2) analyzing the information, i.e., parsing the transaction data to identify a user account identifier, accessing historical transaction data and alert criteria associated with the user account, and determining if the alert criteria are met by aggregating the transaction data and the historical transaction data (steps (d) through (i)), and (3) displaying the results of the collection and analysis, i.e.,

generating and sending an alert message to the user device if the alert criteria are met (steps (j) and (k)). Simply put, we agree with the Examiner that claim 1 is directed to sending alerts regarding payment transactions (Final Act. 4) — in other words, to a method of organizing human activities and, therefore, to an abstract idea.

The Federal Circuit has consistently held that abstract ideas include the concepts of collecting data, analyzing the data, and displaying the results of the collection and analysis, including when limited to particular content. *See, e.g., Intellectual Ventures I LLC v. Capital One Fin. Corp.*, 850 F.3d 1332, 1340 (Fed. Cir. 2017) (identifying the abstract idea of collecting, displaying, and manipulating data); *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1354 (Fed. Cir. 2016) (characterizing collecting information, analyzing information by steps people go through in their minds, or by mathematical algorithms, and presenting the results of collecting and analyzing information, without more, as matters within the realm of abstract ideas); *see also SAP Am., Inc. v. Investpic, LLC*, 898 F.3d 1161, 1168 (Fed. Cir. 2018) (“As many cases make clear, even if a process of collecting and analyzing information is ‘limited to particular content’ or a particular ‘source,’ that limitation does not make the collection and analysis other than abstract.” (quoting *Elec. Power Grp.*, 830 F.3d at 1353, 1355 (citing cases))); *Berkheimer v. HP, Inc.*, 881 F.3d 1360, 1366 (Fed. Cir. 2018) (concluding that parsing, comparing, storing, and editing data are abstract ideas). Alerting, as the Examiner observes, also is a long-standing human practice (Final Act. 4).

We find no indication in the Specification, nor do Appellants direct us to any indication, that the operations recited in claim 1 invoke any assertedly

inventive programming, require any specialized computer hardware or other inventive computer components, i.e., a particular machine, or that the claimed invention is implemented using other than generic computer components to perform generic computer functions. *See DDR Holdings*, 773 F.3d at 1256 (“[A]fter *Alice*, there can remain no doubt: recitation of generic computer limitations does not make an otherwise ineligible claim patent-eligible.”). In fact, the Specification suggests just the opposite, i.e., that the claimed invention may be implemented using only generic computer components (*see, e.g.*, Spec. ¶¶ 95–105).

We also find no indication in the Specification that the claimed invention effects a transformation or reduction of a particular article to a different state or thing. Nor do we find anything of record that attributes any improvement in computer technology and/or functionality to the claimed invention or that otherwise indicates that the claimed invention integrates the abstract idea into a “practical application,” as that phrase is used in the USPTO’s “2019 Revised Patent Subject Matter Eligibility Guidance,” 84 Fed. Reg. 50, 55 (January 7, 2019).⁷

Appellants ostensibly maintain that the present claims are analogous to the claims at issue in *DDR Holdings* (App. Br. 14–15). But, we can find no parallel between claim 1 and the claims at issue in *DDR Holdings*.

⁷ In accordance with the USPTO’s revised guidance, a claim will be considered “directed to” an abstract idea if (1) the claim recites subject matter falling within one of the following groupings of abstract ideas: (a) mathematical concepts; (b) certain methods of organizing human interactions, e.g., fundamental economic principles or practices, commercial or legal interactions; and (c) mental processes, and (2) the claim does not integrate the abstract idea into a practical application. *See Revised Guidance*, 84 Fed. Reg. at 54–55.

There, the claims were directed to retaining website visitors, and in particular to a system that modified the conventional web browsing experience by directing a user of a host website who clicks an advertisement to a “store within a store” on the host website, rather directing the user to the advertiser’s third-party website. *DDR Holdings*, 773 F.3d at 1257–58. The court determined that “the claims address a business challenge (retaining website visitors) [that] is a challenge particular to the Internet.” *Id.* at 1257. The court also determined that the invention was “necessarily rooted in computer technology in order to overcome a problem specifically arising in the realm of computer networks,” and that the claimed invention did not simply use computers to serve a conventional business purpose. *Id.* Rather, there was a change to the routine, conventional functioning of Internet hyperlink protocol. *Id.*

Appellants describe that the present invention relates to sending a real time alert message to a user during a payment transaction; that the alert message includes an “‘aggregated’ transaction amount for a transaction conducted at a particular merchant or merchant type”; and that “the server receives ‘transaction data’ from an access device ‘after the access device receives information from a portable consumer device’ and sends ‘the alert message to a mobile device operated by the user . . . , wherein the mobile device displays the alert message’” (App. Br. 14). Appellants maintain that “these limitations affect other devices to help ‘overcome a problem specifically arising in the realm of computer technology,’ as discussed in *DDR Holdings* (*id.*; see also Reply Br. 7). Yet, unlike the situation in *DDR Holdings*, we are not persuaded that flooding consumers with alert messages and, thus, substantial amounts of information that the consumer is left to

mine and interpret is a problem specifically arising in the realm of computer technology. As the Examiner observes, alerting is a long-standing practice (Ans. 2) — a practice that existed before, and still exists, outside the realm of computer networks and computer technology. We also are not persuaded that “help[ing to] reduce the number of alert messages that the user might receive and help[ing] the user keep track of his activity at a particular merchant or merchant type” by transmitting an alert message only when an alert trigger is met, as called for in claim 1, is a solution necessarily rooted in computer technology.

Appellants argue that the pending claims also are similar to the patent-eligible claims of *DDR Holdings* because “they do not merely recite the performance of some business practice known from the pre-Internet world along with some generic requirement to perform it using the Internet” (App. Br. 14). Yet, the court cautioned in *DDR Holdings* that “not all claims purporting to address Internet-centric challenges are eligible for patent.” *DDR Holdings*, 773 F.3d at 1258. And the court distinguished the claims there at issue from those in *Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709 (Fed. Cir. 2014), in that, in *DDR Holdings*, the computer network was not operating in its “normal, expected manner” and the claims did not “recite an invention that is . . . merely the routine or conventional use of the Internet.” *Id.* at 1258–59.⁸ Unlike the situation in *DDR Holdings*, there is no

⁸ In *Ultramercial*, although the patentee argued that its claims were “directed to a specific method of advertising and content distribution that was previously unknown and never employed on the Internet before,” 772 F.3d at 714, the court found that this alone could not render its claims patent-eligible where the claims merely recited the abstract idea of “offering media content in exchange for viewing an advertisement,” along with

indication here that a computer network, or the Internet, in particular, is used other than in its normal, expected, and routine manner, e.g., for receiving and transmitting information.

Citing *Enfish* and *McRO*, Appellants argue that the Examiner has characterized the claims at an unreasonably high level of abstraction and improperly oversimplified the claims by failing to take into account that the claimed system, as recited in claim 1, “includes ‘a database’ comprising ‘alert trigger information based on alert criteria from a user’ and ‘a server computer’ that receives ‘transaction data for a transaction in an authorization request message,’ parses the transaction data, and identifies an ‘account’ and ‘historical transaction data associated with the account’” (App. Br. 15–16; *see also* Reply Br. 6–7). Yet, the law is clear that “not every claim that recites concrete, tangible components escapes the reach of the abstract-idea inquiry.” *In re TLI Commc’ns LLC Patent Litig.*, 823 F.3d 607, 611 (Fed. Cir. 2016). The claimed invention, as recited in claim 1, is not directed to an improvement in database or server technology; instead, it is directed to sending alerts regarding payment transactions and uses the database and server components only in their ordinary and conventional capacity.

Turning to step two of the *Mayo/Alice* framework, Appellants argue that even if the claims are directed to an abstract idea, the claims are nonetheless patent-eligible because the claims recite “significantly more” than the alleged abstract idea itself (App. Br. 17–20; *see also* Reply Br. 3–5).

“routine additional steps such as updating an activity log, requiring a request from the consumer to view the ad, restrictions on public access, and use of the Internet.” *Id.* at 715–716.

The features that Appellants identify as “significantly more,” i.e., parsing the transaction data for a transaction, identifying historical data associated with the account used to conduct the transaction, determining if an alert trigger is met, and sending the alert, which is then displayed on a mobile device, only if the alert trigger is met (App. Br. 19–20), are, however, part of the abstract idea itself, i.e., sending alerts regarding payment transactions. As such, these features cannot constitute the “inventive concept.” *Berkheimer v. HP, Inc.*, 890 F.3d 1369, 1374 (Fed. Cir. 2018) (Moore, J., concurring) (“It is clear from *Mayo* that the ‘inventive concept’ cannot be the abstract idea itself, and *Berkheimer* . . . leave[s] untouched the numerous cases from this court which have held claims ineligible because the only alleged ‘inventive concept’ is the abstract idea.”); *see also BSG Tech. LLC v. BuySeasons, Inc.*, 899 F.3d 1281, 1290 (Fed. Cir. 2018) (“Our precedent has consistently employed this same approach. If a claim’s only ‘inventive concept’ is the application of an abstract idea using conventional and well-understood techniques, the claim has not been transformed into a patent-eligible application of an abstract idea.”).

The Examiner determined here, and we agree, that the only elements beyond the abstract idea are the claimed database and server computer (including a processor and computer-readable storage medium) coupled to the database, i.e., generically-recited computer components used to generic computer functions, i.e., receiving, processing, and storing data (*see* Ans. 2-3) — a determination amply supported by, and fully consistent with the Specification (*see, e.g.*, Spec. ¶¶ 95–105).

Appellants cannot reasonably contend that there is a genuine issue of material fact (and, therefore, a requirement for evidence) regarding whether

operation of these components is well-understood, routine, or conventional, where, as here, there is nothing in the Specification to indicate that the operations recited in claim 1 require any specialized hardware or inventive computer components, invoke any assertedly inventive programming, or that the claimed invention is implemented using other than generic computer components. Indeed, the Federal Circuit, in accordance with *Alice*, has “repeatedly recognized the absence of a genuine dispute as to eligibility” where claims have been defended as involving an inventive concept based “merely on the idea of using existing computers or the Internet to carry out conventional processes, with no alteration of computer functionality.” *Berkheimer*, 890 F.3d at 1373 (Moore, J., concurring). (citations omitted).

Finally, Appellants misapprehend the controlling precedent to the extent Appellants maintain that the claimed invention is patent-eligible, i.e., that claim 1 amounts to “significantly more” than an abstract idea, because the claim is allegedly novel and/or non-obvious in view of the prior art (App. Br. 18–19). Neither a finding of novelty nor a non-obviousness determination automatically leads to the conclusion that the claimed subject matter is patent-eligible. Although the second step in the *Mayo/Alice* framework is termed a search for an “inventive concept,” the analysis is not an evaluation of novelty or non-obviousness, but rather, a search for “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.*, 573 U.S. at 217–18 (citation omitted). “Groundbreaking, innovative, or even brilliant discovery does not by itself satisfy the § 101 inquiry.” *Ass’n for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576, 591 (2013). A novel and non-obvious

claim directed to a purely abstract idea is, nonetheless, patent-ineligible. *See Mayo*, 566 U.S. at 90; *see also Diamond v. Diehr*, 450 U.S. 175, 188–89 (1981) (“The ‘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.”).

We are not persuaded, on the present record, that the Examiner erred in rejecting claim 1 under 35 U.S.C. § 101. Therefore, we sustain the Examiner’s rejection of claim 1, and claims 2–4, 6, 9–13, 15–21, and 24–28, which fall with claim 1.

Obviousness

Independent Claim 1 and Dependent Claims 2, 4, 6, 9, and 28

Appellants argue that the Examiner erred in rejecting independent claim 1 under 35 U.S.C. § 103(a) because none of the cited references, individually or in combination, discloses or suggests:

generating an alert message when the alert trigger is met, wherein the alert message includes the aggregated transaction data, and wherein the aggregated transaction data included in the alert message comprises a total number of transactions at a specific merchant type and a total amount of the transactions at the specific merchant type, wherein the alert message is not generated when the alert trigger is not met[.]

as recited in claim 1 (App. Br. 20–22). Pointing particularly to Figure 3 of Audebert, Appellants argue that although Audebert discloses a personal credit manager for establishing a cardholder’s preferences, neither this nor other portions of Audebert disclose or suggest “receiving an alert with aggregated transaction data (e.g., to determine how much money a consumer spends on coffee in a month, etc.)” (*id.* at 21). Appellants acknowledge that

Bhojwani discloses a notification message that includes “financial transaction properties,” e.g., the merchant’s address, transaction location, transaction type, and transaction amount (*id.* at 21–22). But Appellants maintain that Bhojwani fails to remedy the deficiency of Audebert because these transaction properties relate to a *single transaction*, i.e., Bhojwani fails to disclose an alert message with “aggregated transaction data” (*id.* at 22).

Appellants’ arguments are not persuasive at least because the feature that Appellants maintain is not disclosed or suggested by the cited references, i.e., that “the alert message includes the aggregated transaction data,” does not affect the structure or function of the claimed system. As such, it constitutes nonfunctional descriptive material that may not be relied on to distinguish over the prior art for purposes of patentability.

The Federal Circuit has long held that where a limitation claims printed matter that is not functionally or structurally related to its physical substrate, the printed matter may not be relied on to distinguish over the prior art for purposes of patentability. *In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability). In applying the printed matter doctrine, the first step is to determine whether the limitation is, in fact, directed to printed matter, i.e., whether the limitation claims the content of information. *See In re Distefano*, 808 F.3d 845, 848 (Fed. Cir. 2015). If so, “one must then determine if the matter is functionally or structurally related to the associated physical substrate, and only if the answer is ‘no’ is the printed matter owed no patentable weight.” *Id.* at 851. *See also King Pharms Inc.*

v. Eon Labs, Inc., 616 F.3d 1267, 1278–79 (Fed. Cir. 2010) (applying the “printed matter” reasoning to method claims).

Here, claim 1 claims the informational content of the alert message and as such, is directed to printed matter. The relevant inquiry then is whether the recitation that the alert message “includes the aggregated transaction data,” i.e., the claimed informational content, is functionally or structurally related to the claimed system.

There is no objective evidence of record that the fact that the alert message includes aggregated transaction data, as opposed to some other information, affects the structure or function of the claimed system in any way. Regardless of the nature of the alert message, the function and structure of the claimed system is the same. As such, the nature of the alert message, i.e., that it includes aggregated transaction data, constitutes non-functional descriptive material that may not be relied on for patentability. *See In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004).

In view of the foregoing, we sustain the Examiner’s rejection of independent claim 1. We also sustain the rejection of dependent claims 2, 4, 6, 9, and 28, which are not argued separately.

Dependent Claim 3

Claim 3 depends from claim 1, and recites that “the alert criteria includes the total number of transactions.” For much the same reasons outlined above with respect to claim 1, we are not persuaded by Appellants’ argument that the Examiner erred in rejecting claim 3 under 35 U.S.C. § 103(a) (App. Br. 22–23). Again, the content of the alert message, does not affect the structure or function of the claimed system. As such, it constitutes

nonfunctional descriptive material that may not be relied on to distinguish over the prior art for purposes of patentability.

Therefore, we sustain the Examiner's rejection of dependent claim 3 under 35 U.S.C. § 103(a).

Independent Claims 10 and 20 and Dependent Claims 11–13, 15–19, 21, and 24–27

Appellants argue that the independent claims 10 and 20 are allowable for at least the same reasons set forth with respect to independent claim 1 (App. Br. 23). We found Appellants' arguments unpersuasive with respect to claim 1. And we find them equally unpersuasive with respect to claims 10 and 20. Therefore, we sustain the Examiner's rejection of claims 10 and 20 under 35 U.S.C. § 103(a). We also sustain the Examiner's rejection of dependent claims 11–13, 15–19, 21, and 24–27, which are not argued separately.

DECISION

The Examiner's rejection of claims 1–4, 6, 9–13, 15–21, and 24–28 under 35 U.S.C. § 101 is affirmed.

The Examiner's rejection of claims 1–4, 6, 9–13, 15–21, and 24–28 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)(iv).

AFFIRMED