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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* DEAN SEIFERT, MATT BIXLER, DAVE OWEN, and  
ELIZABETH PETRI

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Appeal 2017-011083  
Application 14/171,410  
Technology Center 3600

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Before ELENI MANTIS MERCADER, JOHN P. PINKERTON,  
and BETH Z. SHAW, *Administrative Patent Judges*.

SHAW, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants<sup>1</sup> seek our review under 35 U.S.C. § 134(a) of the Examiner’s Final Office Action rejecting claims 1–20, all of which are pending on appeal. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.<sup>2</sup>

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<sup>1</sup> The real party in interest is Western Union Company of Englewood, Colorado. App. Br. 2.

<sup>2</sup> Our Decision refers to the Appeal Brief filed Feb. 21, 2017 (“App. Br.”); Examiner’s Answer mailed June 16, 2017 (“Ans.”); Final Office Action mailed Sept. 19, 2016 (“Final Act.”); and Specification filed February 3, 2014 (“Spec.”).

### STATEMENT OF THE CASE

Appellants' invention is for confirming the identity of a party seeking to be involved in a financial transaction with another party. Spec. ¶ 3.

Claim 1 is representative of Appellants' invention, as reproduced below:

1. A method comprising:

receiving, from a first party, by a computer system, verification criteria for verifying an identity of a second party, wherein the verification criteria specifies at least a verification procedure and a type of identification that is acceptable for use in the verification procedure;

sending, by the computer system, the verification criteria to a remote system;

receiving, by the computer system, from the remote system, a first indication that the verification procedure specified by the verification criteria was performed, and that an identification matching the type of identification specified by the verification criteria was presented by the second party; and

receiving, by the computer system, from the remote system, a second indication that the verification procedure successfully verified the identity of the second party.

#### *Examiner's Rejections*

Claims 1–20 stand rejected under 35 U.S.C. § 101 because the claimed invention is directed to ineligible subject matter. Final Act. 2–6.

Claims 1–20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Michelsen (US 2004/0215557 A1; published Oct. 28, 2004) and Jones (US 2003/0139994 A1; published July 24, 2003). Final Act. 6–12.

## CONTENTIONS AND ANALYSIS

### *SECTION 101 REJECTION*

The Examiner determines claims 1–20 are directed to ideas that have been identified as abstract by our reviewing court. Final Act. 2–6; Ans. 3–20. In particular, the Examiner finds that the abstract idea underlying these claims is comparing new and stored information. Final Act. 4. The Examiner also finds additional elements recited in the claims do not amount to significantly more than the abstract idea itself. *Id.* According to the Examiner, the claims require no more than performing generic computer functions. *Id.* at 5.

Appellants present several arguments against the 35 U.S.C. § 101 rejection. App. Br. 3–6. Appellants contend the claims are not directed to an abstract idea because the Examiner cited a large portion of the claim. App. Br. 4–5. Appellants also contend the claims recite significantly more than an abstract idea. *Id.* at 5–6.

We are not persuaded by Appellants’ arguments. Instead, we observe the Examiner has provided a comprehensive response to Appellants’ arguments supported by a preponderance of evidence. Ans. 3–20. As such, we adopt the Examiner’s findings and explanations provided therein. *Id.*; Final Act. 2–5. At the outset, we note the Supreme Court has long held that “[l]aws of nature, natural phenomena, and abstract ideas are not patentable.” *Alice Corp. Pty. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2354 (2014) (quoting *Assoc. for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576, 589 (2013)). “The ‘abstract ideas’ category embodies ‘the longstanding rule that

‘[a]n idea, of itself, is not patentable.’” *Id.* at 2355 (quoting *Gottschalk v. Benson*, 409 U.S. 63, 67 (1972)).

In *Alice*, the Supreme Court set forth an analytical “framework for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts.” *Id.* at 2355 (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66 (2012)). 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.* (citing *Mayo*, 566 U.S. at 77–78).

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.” *Id.* (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). The prohibition against patenting an abstract idea “‘cannot be circumvented by attempting to limit the use of the formula to a particular technological environment’ or adding ‘insignificant postsolution activity.’” *Bilski v. Kappos*, 561 U.S. 593, 610–11 (2010) (citation omitted).

Turning to the first step of the *Alice* inquiry, we agree with the Examiner that Appellants’ claims are directed to an abstract idea of

comparing new and stored information. Ans. 5. All the steps recited in Appellants' claims, including, (i) receiving verification criteria, (ii) sending the verification criteria to a remote system, (iii) receiving a first indication, and (iv) receiving a second indication, are abstract processes of receiving and sending data.

Our reviewing court finds an abstract idea in receiving and sending data. *See Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016) (“[C]ollecting information, analyzing it, and displaying certain results of the collection and analysis” is abstract); *In re Salwan*, 681 F. App'x 938, 941 (Fed. Cir. 2017) (nonprecedential) (affirming the rejection under § 101 of claims directed to “storing, communicating, transferring, and reporting patient health information,” noting that “while these concepts may be directed to practical concepts, they are fundamental economic and conventional business practices”); *Cyberfone Sys., LLC v. CNN Interactive Grp., Inc.*, 558 F. App'x 988, 992 (Fed. Cir. 2014) (nonprecedential) (“[U]sing categories to organize, store, and transmit information is well-established”). Similarly, all the steps executed by claim 1 are abstract processes of receiving and sending data.

Turning to the second step of the *Alice* inquiry, we find nothing in Appellants' claims that adds anything “significantly more” to transform them into a patent-eligible application of the abstract idea. *Alice*, 134 S. Ct. at 2357.

Appellants do not persuade us why the claims or Specification provide specific, technical improvements. Rather, as the Examiner points out, the computer system does not add meaningful limitations to the abstract idea.

Indeed, as the Examiner finds, the Specification supports the finding that the claimed system is implemented on a generic computer. Ans. 15 (citing Spec. ¶¶ 7–10, 17, 23, 24, 26, and Fig. 1). Thus, the Specification does not describe the system as made up of special-purpose or specially configured computer components, but rather, as a general-purpose computer that includes generic components. As a result, nothing recited by the claims “offers a meaningful limitation beyond generally linking ‘the use of the [method] to a particular technological environment,’ that is, implementation via computers.” *Alice* 134 S. Ct. at 2360 (quoting *Bilski*, 561 U.S. at 610–11).

As recognized by the Supreme Court, “the mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention.” *Alice*, 134 S. Ct. at 2358; *see id.* at 2359 (concluding claims “simply instruct[ing] the practitioner to implement the abstract idea of intermediated settlement on a generic computer” are not patent eligible); *see also Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 715–16 (Fed. Cir. 2014) (claims merely reciting an abstract idea of using advertising as currency as applied to particular technological environment of the Internet are not patent eligible); *Accenture Global Servs., GmbH v. Guidewire Software, Inc.*, 728 F.3d 1336, 1344–45 (Fed. Cir. 2013) (claims reciting “generalized software components arranged to implement an abstract concept [of generating insurance-policy-related tasks based on rules to be completed upon the occurrence of an event] on a computer” are not patent eligible); *Dealertrack, Inc. v. Huber*, 674 F.3d 1315, 1333–34 (Fed. Cir. 2012) (“Simply adding a ‘computer aided’ limitation to a claim covering an

abstract concept, without more, is insufficient to render [a] claim patent eligible”); *Credit Acceptance Corp. v. Westlake Services*, 859 F.3d 1044, 1056 (Fed. Cir. 2017) (generic computer elements did not represent improvement in computer technology but rather were invoked merely as tools, and did not transform the claims into significantly more than claims to an abstract idea itself); *Elec. Power Group*, 830 F.3d 1351 (rejection affirmed for a method of performing real-time performance monitoring of an electric power grid because “the claims do not go beyond requiring the collection, analysis, and display of available information in a particular field . . . over conventional computer and network technology”).

The claims are neither rooted in computer technology as outlined in *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245 (Fed. Cir. 2014), nor do they seek to improve any type of computer capabilities, such as a “self-referential table for a computer database” outlined in *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1336 (Fed. Cir. 2016). “[M]erely ‘configur[ing]’ [a] generic computer[] in order to ‘supplant and enhance’ an otherwise abstract manual process is precisely the sort of invention that the *Alice* Court deemed ineligible for patenting.” *Credit Acceptance Corp.*, 859 F.3d at 1056.

Appellants overlook that “the focus of the claims is not on such an improvement in computers as tools, but on certain independently abstract ideas that use computers as tools.” *Elec. Power Group*, 830 F.3d at 1354. In this case, as in *Electric Power Group*, the claims do not even require a new source or type of information. *Id.* at 1355.

We have also carefully considered Appellants' arguments regarding preemption. App. Br. 5, 6. However, although "preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility." *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015). Where claims are deemed to recite only patent ineligible subject matter under the two-step *Alice* analysis, as they are here, "preemption concerns are fully addressed and made moot." *Id.*

Because Appellants' claims are directed to a patent-ineligible abstract concept and do not recite something "significantly more" under the second prong of the *Alice* analysis, we sustain the Examiner's rejection of these claims under 35 U.S.C. § 101 as being directed to non-statutory subject matter in light of *Alice* and its progeny.

#### *SECTION 103 REJECTION*

Appellants argue the Examiner erred because Jones fails to teach allowing a first party to specify what type of identification a second party must present to be successfully verified by a remote system, as well as a procedure to use with such an identification type. App. Br. 7. Appellants identify an example of verification criteria as a library card. *Id.* Appellants argue Jones merely states that a remote system requests a biometric identifier such as a photo. *Id.* Appellants argue Jones does not state that a "first party specifies what type of identification is necessary for a verification procedure, or what procedure should be performed thereafter." *Id.* Appellants argue the "difference then between Jones and the instant claims is that the instant claims allow a party to specify what type of

identification and what type of procedures should be used with the type of identification, while Jones does not.” *Id.*

Appellants’ arguments regarding Jones’ individual shortcomings in this regard are unavailing, because the Examiner does not rely solely on Jones for teaching this limitation. Instead, the Examiner relies on Michelsen, and not Jones, as teaching “receiving, from a first party, by a computer system, verification criteria for verifying an identity of a second party,” which is the element Appellants argue is missing in Jones. Final Act. 6, 7.

Although Appellants cut and paste other limitations from the claim into the Appeal Brief (App. Br. 7), Appellants make no other substantive arguments regarding the claims other than those addressed above. Our reviewing court has explicitly held that “[37 C.F.R. §] 41.37 [] require[s] more substantive arguments in an appeal brief than a mere recitation of the claim elements and a naked assertion that the corresponding elements were not found in the prior art.” *In re Lovin*, 652 F.3d 1349, 1357 (Fed. Cir. 2011). Upon review of the record, we agree with and adopt the Examiner’s findings and conclusions in the Final Rejection and Answer.

Accordingly, we sustain the Examiner’s rejection of claim 1 under 35 U.S.C. § 103. Because Appellants have not presented separate patentability arguments or have reiterated substantially the same arguments as those previously discussed for patentability of claim 1 above (App. Br. 6–8), claims 2–20 fall therewith. *See* 37 C.F.R. § 41.37(c)(1)(iv).

CONCLUSION

On the record before us, we conclude Appellants have not demonstrated the Examiner erred in rejecting claims 1–20 under 35 U.S.C. § 101.

On the record before us, we conclude Appellants have not demonstrated the Examiner erred in rejecting claims 1–20 under 35 U.S.C. § 103.

DECISION

We affirm the Examiner’s rejections of 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).

AFFIRMED