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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* RICHARD JACKMAN, MARK HERRINGTON, and  
MARK V. PUTMAN

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Appeal 2017-011217  
Application 14/191,220<sup>1</sup>  
Technology Center 3600

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Before: ELENI MANTIS MERCADER, JENNIFER S. BISK,  
and JASON M. REPKO, *Administrative Patent Judges*.

MANTIS MERCADER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 from a rejection of claims 2, 3, 5–10, 12–17, and 19–21. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

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<sup>1</sup> The real party in interest is First Data Corporation. App. Br. 3.

CLAIMED SUBJECT MATTER

The claims are directed to payer-based account porting to portable value distribution systems and methods. Claim 2, reproduced below, is illustrative of the claimed subject matter:

2. A method for porting a value program, the method comprising:  
enrolling, by a computer system, a payee into a payroll source program such that the payee is associated with a stored value account, wherein:  
the payee can access funds in the stored value account using a presentation instrument and only an employer payer is permitted to deposit funds, comprising payroll deposits, to the stored value account of the payroll source program;  
determining, by the computer system, a predetermined period of inactivity has occurred in relation to the stored value account of the payroll source program;  
based on the predetermined period of inactivity being determined to have occurred in relation to the stored value account, generating, by the computer system, a porting trigger;  
enrolling, by the computer system, based on the porting trigger being generated, the payee into a target program, such that the payee's enrollment in the target program replaces the payee's enrollment in the payroll source program and the payee is associated with a target account, wherein the target program permits entities other than the employer payer to deposit funds to the target account; and  
porting, by the computer system, account information associated with the payee from the payroll source program to the target program to permit the payee to continue to use the presentation instrument, wherein porting the account information associated with the payee from the payroll source program to the target program comprises porting an account number of the stored value account to the target program.

App. Br. 12 (Claims Appendix).

REFERENCES

There was no prior art relied upon by the Examiner in rejecting the claims on appeal.

## REJECTIONS

1. Claims 2, 3, 5–10, 12–17, and 19–21 stand rejected on the ground of nonstatutory double patenting over claims 1, 2, 9, 11, 12, 16–24 of U.S. Patent No. 8,700,507.

2. Claims 2, 3, 5–10, 12–17, and 19–21 stand rejected under 35 U.S.C § 101 because the claimed invention is directed to non-statutory subject matter.

## OPINION

*Claims 2, 3, 5–10, 12–17, and 19–21 rejected on the ground of nonstatutory double patenting*

The Examiner rejects claims 2, 3, 5–10, 12–17, and 19–21 on the ground of nonstatutory double patenting over claims 1, 2, 9, 11, 12, 16–24 of U.S. Patent No. 8,700,507. Final Act. 3. Appellants do not provide any arguments. Because Appellants do not challenge the merits of the double patenting rejection, we summarily sustain it.

*Claims 2, 3, 5–10, 12–17, and 19–21 rejected under 35 U.S.C § 101*

Appellants argue that similar to *DDR Holdings*, the claims do not merely recite the performance of some business practice known from the pre-internet world along with the requirement to perform it on the internet. App. Br. 6. Appellants assert that because the claims were not rejected under 102 or 103, the claimed subject matter did not exist prior to the internet. App. Br. 7.

Appellants further argue that similar to *McRO*, the claims do not preempt and will not tie-up any judicial exception such that others cannot

practice it. App. Br. 7–8. Appellants assert that the claimed invention is focused on a specific way of authenticating and performing a transaction. App. Br. 8.

Appellants argue that claims 2, 9, and 16 involve more than sorting data or mental steps, and embody the following concepts and steps unlike *Cyberfone* and *SmartGene*:

- (1) A computer system enrolls a payee into a payroll source program in order to associate the payee with a stored value account with a computer system;
- (2) The computer system determines a period of inactivity;
- (3) The computer system generates a porting trigger in response to the period of inactivity;
- (4) The computer system enrolls the payee into a target program so that the payee's enrollment in the target program replaces the payee's enrollment in the payroll source program, based on the porting trigger.

App. Br. 8–9.

Appellants further argue that particular machines (i.e., non-generic machines/computers) are necessary to implement the systems and methods of the claims. App. Br. 9. For example, Appellants contend a server capable of implementing the systems and methods must be able to communicate digital data with many different financial networks and their associated protocols. *See* App. Br. 9, *citing* Spec. paras. 17–19; Figs. 1A, 1B.

Appellants add that off-the-shelf generic computers are not capable of performing such functions. Accordingly, Appellants contend independent claims 2, 9, and 16 use a particular machine and therefore include *significantly more* than the alleged abstract idea. Appellants add that, even if the computer elements of the claims could be considered generic (i.e., computer system), the PTAB recently recognized that general purpose

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computers become special purpose computers (i.e., non-generic or particular computers) when specially programmed. App. Br. 9.

Appellants also contend that because the claims do not stand rejected under 35 U.S.C. §§ 102, 103 the claims have been found novel and non-obvious. By definition, novel and non-obvious claims must include limitations other than what is well understood, routine, and conventional in the field, or else the claims would not be novel and nonobvious. Appellants conclude that because independent claims 2, 9, and 16 include elements that are not well understood, routine, or conventional in the field, Appellants' claims include significantly more than an abstract idea. App. Br. 10.

We are not persuaded by Appellants' arguments. The Supreme Court's two-step framework guides our analysis. *See Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 134 S.Ct. 2347, 2355 (2014). According to step one, "[w]e must first determine whether the claims at issue are directed to a patent-ineligible concept," such as an abstract idea. *Id.*

Our reviewing court has concluded that abstract ideas include the concepts such as the collection and analysis of information. *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016). Additionally, the collecting of data, recognizing certain data within the collected data set, and storing the data in memory are also abstract ideas. *Content Extraction & Transmission LLC v. Wells Fargo Bank, N.A.*, 776 F.3d 1343, 1347 (Fed. Cir. 2014). Similarly, "collecting, displaying, and manipulating data" is an abstract idea. *Intellectual Ventures I LLC v. Capital One Fin. Corp.*, 850 F.3d 1332, 1340 (Fed. Cir. 2017); *see also SAP Am., Inc. v. InvestPic, LLC*, 898 F.3d 1161, 1167 (Fed. Cir. 2018) ("merely presenting the results of abstract processes of collecting and analyzing information . . . is abstract as an ancillary part of such collection and

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analysis” (citation omitted)). Moreover, “analyzing information by steps people go through in their minds, or by mathematical algorithms, without more, as essentially mental processes within the abstract-idea category” and “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.

Further, merely combining several abstract ideas does not render the combination any less abstract. *RecogniCorp, LLC v. Nintendo Co.*, 855 F.3d 1322, 1327 (Fed. Cir. 2017) (“Adding one abstract idea (math) to another abstract idea . . . does not render the claim non-abstract.”); *see also FairWarning IP, LLC v. Iatric Sys., Inc.*, 839 F.3d 1089, 1093–94 (Fed. Cir. 2016) (determining the pending claims were directed to a combination of abstract ideas).

In the instant case, the Examiner finds and we agree, that the steps of enrolling a payee into a payroll source program, determining a predetermined period of inactivity, enrolling payee into target program and porting account information associated with the payee describe manipulating information by comparing and sorting the information based on a subscriber preference. Ans. 10. In other words, these steps describe the abstract idea of comparing and organizing information for transmission. *Id.*

Because the claims are “directed to an abstract idea,” we consider the claim limitations “both 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 Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 78–79 (2012)). The Supreme Court has described this analysis “as a search for an

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‘inventive concept.’” *Alice*, 134 S.Ct. at 2355. Put differently, we must search the claims for an “inventive concept,” that is, “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*, 134 S.Ct. at 2355 (quoting *Mayo*, 132 S.Ct. at 1294).

Here, we agree with the Examiner that generic computers performing generic computer functions to apply an abstract idea do not amount to significantly more than the abstract idea. App. Br. 11. The additional computer limitations do not add an inventive concept to the abstract idea of comparing and organizing information for transmission. Viewing the limitations as a combination does not add anything further than looking at the limitations individually. *Id.*

As explained in *OIP Technologies, Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1363 (Fed. Cir. 2015), “relying on a computer to perform routine tasks more quickly or more accurately is insufficient to render a claim patent eligible.” *See also Alice*, 573 U.S. at 224 (“use of a computer to create electronic records, track multiple transactions, and issue simultaneous instructions” is not an inventive concept); *Bancorp Servs., L.L.C. v. Sun Life Assur. Co. of Can. (U.S.)*, 687 F.3d 1266, 1278 (Fed. Cir. 2012) (a computer “employed only for its most basic function . . . does not impose meaningful limits on the scope of those claims”).

We are further not persuaded by Appellants’ preemption argument. “[W]hile preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility.”

*FairWarning IP*, 839 F.3d at 1098 (quoting *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015)); *see also OIP Techs.*,

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788 F.3d at 1362–63 (Fed. Cir. 2015) (“[T]hat 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.”). Further, “[w]here 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*, 788 F.3d at 1379.

Finally, Appellants improperly conflate the requirements for eligible subject matter (§ 101) with the independent requirements of novelty (§ 102) and non-obviousness (§ 103). “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.” *Diamond v. Diehr*, 450 U.S. 175, 188–89 (1981); *see also Genetic Techs. Ltd. v. Merial L.L.C.*, 818 F.3d 1369, 1376 (Fed. Cir. 2016) (stating that, “under the *Mayo/Alice* framework, a claim directed to a newly discovered law of nature (or natural phenomenon or abstract idea) cannot rely on the novelty of that discovery for the inventive concept necessary for patent eligibility”).

For the reasons discussed *supra*, we are unpersuaded that the Examiner erred in rejecting under 35 U.S.C. § 101 claim 2 as being directed to patent-ineligible subject matter. Additionally, we sustain the Examiner’s rejection of independent claims 9 and 16, which recite similar limitations, and dependent claims 3, 5–8, 12–15, 17, and 19–21, which are not separately argued.

## DECISION

The Examiner’s rejections of claims 2, 3, 5–10, 12–17, and 19–21 are affirmed.

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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