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CHOATE, HALL & STEWART LLP TWO INTERNATIONAL PLACE BOSTON, MA 02110			GLASS, RUSSELL S	
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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* YAIR GOLDFINGER and AMICHAY OREN

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Appeal 2018-001067  
Application 14/315,257  
Technology Center 3600

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Before JENNIFER S. BISK, JOHN P. PINKERTON, and JOYCE CRAIG,  
*Administrative Patent Judges.*

CRAIG, *Administrative Patent Judge.*

DECISION ON REQUEST FOR REHEARING

STATEMENT OF THE CASE

Appellant<sup>1</sup> filed a Request for Rehearing (“Req. Reh’g”), pursuant to 37 C.F.R. § 41.52, on December 19, 2019, seeking reconsideration of our Decision on Appeal mailed October 31, 2019 (“Decision”), in which we affirmed the Examiner’s rejection of claims 27–33 under 35 U.S.C. § 101 as directed to patent-ineligible subject matter.<sup>2</sup> We have jurisdiction over the Request under 35 U.S.C. § 6(b).

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<sup>1</sup> We use the term “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42.

<sup>2</sup> We reversed the Examiner’s rejection of claims 27–33 under 35 U.S.C. § 102(a).

## DISCUSSION

Appellant alleges in the Request that, in applying Step 2A, Prong 2 of the patent eligibility test set forth in the U.S. Patent and Trademark Office’s (the “USPTO’s”) 2019 Revised Patent Subject Matter Eligibility Guidance, 84 Fed. Reg. 50, 57 (Jan. 7, 2019) (the “Office Guidance”), the Board “overlooked limitations of the dependent claims and/or elements of claim analysis.” Req. Reh’g 2.

Appellant submits that at least claims 30 and 31 recite additional elements that appear to have been overlooked by the Board. *Id.* at 4. Appellant contends that the Decision “does not provide any analysis of the corresponding relevant claim limitations.” *Id.* Appellant explains that claim 30 recites a specific configuration of said I/O ports of the intermediary device recited in claim 27, namely a configuration “wherein the second I/O port is connected to the first I/O port such that data passed into the first I/O port is allowed to pass through the apparatus to the second I/O port unimpeded in at least a first operating mode.” *Id.* Appellant explains that Claim 31 specifies that the intermediary device “extract[s] information passed from the point of sale device connected to the first I/O port to the purchase recording device connected to the second I/O port while the information passes unimpeded to the purchase recording device.” *Id.*

On page 9 of the Decision, we identified and addressed the additional elements in independent claim 27 and dependent claims 30 and 31. Decision 9. Thus, we disagree with Appellant that additional elements in claims 30 and 31 “appear to have been overlooked by the Board.”

Appellant also contends that the Decision “overlooked that an ‘improvement’ under Step 2A Prong 2 is not limited to improvements of a

computer itself, but may be an ‘improvement to any other technology or technical field.’” Req. Reh’g 5 (citing MPEP § 2106.04(a)). Appellant asks the Board to revisit arguments that Appellant made in the Appeal Brief. *Id.* (citing Appeal Br. 11–12).

In the Decision, we agreed with the Examiner that none of the claims on appeal integrates the abstract idea (mental processes) into a practical application because the claims do not apply, rely on, or use the judicial exception in a manner that imposes a meaningful limit on the exception. Decision 8–11. The Decision explicitly identifies the additional elements recited in claim 27, as well as the additional elements recited in claims 30 and 31. Decision 9. In addition, we addressed Appellant’s argument that

[t]he present claims describe a technological solution to problems associated with allocating or redeeming rewards when underlying transactions occurred in different locations or by different vendors, or required the customer to be member of a loyalty program. The automation is accomplished via a method / apparatus that involves extraction of point of sale data from a data stream without impeding the flow of information ( a safety feature) (see, e.g., claim 30), identification of a qualifying offer and automatic application of the offer to a user’s electronic account (see, e.g., claim 31 ).

Decision 9–10 (citing Appeal Br. 9, Reply Br. 5). While we determined that Appellant had not persuaded us that the additional elements and the alleged improvement “improve[s] on the capabilities of the computer itself,” we also determined that the additional elements do “not impose any meaningful limits on practicing the abstract idea.” *Id.* at 10. To the extent it may not be clear from our Decision, “meaningful limits on practicing the abstract idea” include (i) an improvement to the functionality of a computer or other technology or technical field (*see* MPEP § 2106.05(a)); (ii) a “particular

machine” to apply or use the judicial exception (*see* MPEP § 2106.05(b)); (iii) a particular transformation of an article to a different thing or state (*see* MPEP § 2106.05(c)); or (iv) any other meaningful limitation (*see* MPEP § 2106.05(e)). *See* Office Guidance, 84 Fed. Reg. at 55. Moreover, the “mere automation of manual processes using generic computers . . . does not constitute a patentable improvement in computer technology.” *Trading Techs. Int’l v. IBG LLC*, 921 F.3d 1378, 1384 (Fed. Cir. 2019) (quoting *Credit Acceptance Corp. v. Westlake Servs.*, 859 F.3d 1044, 1055 (Fed. Cir. 2017)).

Appellant further contends that “[p]roper analysis of the claims under Step 2A Prong 2 would have shown that the claims are directed to patentable subject matter because any alleged judicial exception recited in the claims is integrated in a practical application and constitutes a technological improvement.” Req. Reh’g 6 (emphasis omitted). Appellant argues for the first time in the Request that

[t]he intermediary device recited in the claims (e.g., claims 30 and 31) constitutes by no means a “generic computer” but is a device configured as a passive listening device that can extract and manipulate data without the risk of disrupting the operation of electronic point-of-sale systems (operation of cash registers, order entry terminals, internet merchant transaction servers, or combinations thereof).

*Id.* Appellant, however, fails to provide any objective evidence that the intermediary device recited in claims 30 and 31 is not generic. Nor has Appellant persuasively argued or explained how extracting and manipulating data without the risk of disrupting the operation of electronic point-of-sale systems improves the functionality of a computer or other technology or technical field, as opposed to the abstract idea itself. For example, the

automatic deducting or crediting of reward points is part of the abstract idea itself.

A request for rehearing is properly limited to previously addressed matters that were misapprehended or overlooked. *See* 37 C.F.R. § 41.52(a). It is not an opportunity to further develop the record through the introduction of either new evidence and/or arguments.

Appellant also contends that “[p]roper analysis of the claims under Step 2B would have shown that the claims are directed to patentable subject matter because they provide ‘significantly more,’ i.e., an inventive concept.” Req. Reh’g 6 (emphasis omitted).

On page 12 of the Decision, we agreed with the Examiner that “the actions, functions, and/ or steps performed by the generically recited computer elements would be routine and conventional in any computer implementations.” Decision 12 (citing Ans. 4). Appellant has not persuasively rebutted that determination. For example, Appellant has not identified, and we do not find, where the Specification describes an unconventional use of the intermediary device that is not well-understood or routine.

We remind Appellant that 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). 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); *see also Affinity Labs of Tex., LLC v. DIRECTV, LLC*, 838 F.3d 1253, 1263 (Fed. Cir. 2016) (holding that “[e]ven

assuming” that a particular claimed feature was novel does not “avoid the problem of abstractness”).

Moreover, a request for rehearing is not an opportunity to disagree with the Board’s assessment of the arguments or to bolster an insufficient argument already made.

We are not persuaded that we overlooked or misapprehended any point of law or fact in rendering our Decision. Therefore, we decline to modify our original Decision.

### CONCLUSION

Appellant’s Request has been granted to the extent that we have reconsidered our Decision in light of Appellant’s Request, but is denied in all other respects.

### SUMMARY

Outcome of Decision on Rehearing:

<b>Claims Rejected</b>	<b>35 U.S.C. §</b>	<b>Reference(s)/Basis</b>	<b>Denied</b>	<b>Granted</b>
27–33	101	Eligibility	27–33	

Final Outcome of Appeal after Rehearing:

<b>Claims Rejected</b>	<b>35 U.S.C. §</b>	<b>Reference(s)/Basis</b>	<b>Affirmed</b>	<b>Reversed</b>
27–33	101	Eligibility	27–33	
27–33	102(a)	Bohn		27–33
<b>Overall Outcome</b>			27–33	

DENIED