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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte TODD E. KAPLINGER, GAL SHACHOR, and
GREGORY L. TRUTY

Appeal 2018-001417
Application 14/486,880
Technology Center 2800

Before BEVERLY A. FRANKLIN, DONNA M. PRAISS, and
BRIAN D. RANGE, *Administrative Patent Judges*.

RANGE, *Administrative Patent Judge*.

DECISION ON APPEAL

SUMMARY

Appellant¹ appeals under 35 U.S.C. § 134(a) from the Examiner's
decision rejecting claims 1–8. We have jurisdiction. 35 U.S.C. § 6(b).

We AFFIRM.

¹ Appellant is the Applicant, International Business Machines Corporation, which, according to the Appeal Brief, is also the real party in interest. Appeal Br. 1.

STATEMENT OF THE CASE²

Appellant describes the invention as relating to “integrating a mobile payment application with other mobile applications while prevent security exposures.” Spec. ¶¶ 1, 17. In particular, the Specification explains that, in existing systems, a mobile payment application (such as Apple Passbook®) stores gift cards, generic cards, or other forms of mobile payment as a “pass” or “payment token.” *Id.* ¶ 2. Passes are separate from other applications (such as a Starbucks® mobile application) that may have generated the card/gift card. *Id.* ¶ 3. When the mobile application creates a gift card, a corresponding pass has to be created in order for the mobile payment application to be able to use the gift card. *Id.* Thus, “there is a period of time in which the mobile payment application does not have access to the gift card information.” *Id.* Also, the gift card number of the pass, especially when referenced outside of the mobile payment application, may be represented by a bar code or Quick Response code that is not entirely encrypted, and this is a security risk. *Id.* ¶ 5.

The Specification describes a system that improves upon past technology by “integrating a mobile payment application with other mobile applications.” Spec. ¶ 7. The improvement involves first receiving an indication that a pass was created by the mobile payment application. *Id.* The method then involves “generating, by a processor, a view of a set of application programming interfaces exposed to leverage the created pass.” *Id.* Once the view of “application program interfaces” is displayed, the

² In this Decision, we refer to the Final Office Action dated March 7, 2017 (“Final Act.”), the Appeal Brief filed June 5, 2017 (“Appeal Br.”), the Examiner’s Answer dated October 2, 2017 (“Ans.”), and the Reply Brief filed November 27, 2017 (“Reply Br.”).

method involves “receiving a selection of one or more of the set of application programming interfaces to interact with the created pass.” *Id.*

For example, a user may create a new Apple Passbook® mobile payment application pass. In response to receiving an indication that this pass was created, “a set of application programming interfaces of the mobile applications that may possibly be utilized by a pass is generated.” *Id.* ¶ 17. The user may select from among the generated application programming interfaces the Starbucks® application. Selecting the Starbucks® application interface programs the Starbucks® application as being affiliated with the Apple Passbook® mobile payment application’s pass. In this way, the “existing mobile applications are seamlessly integrated with the features of the passes.” *Id.* A virtual container is also created at this point “for the created pass and the selected application programming interfaces to interface with the created pass.” *Id.* For example, if the user “selects a favorite store location in the Starbucks® application, such information will automatically be accessible by the pass. . . .” *Id.* ¶ 43.

Claim 1, reproduced below with emphasis added to certain key recitations, is illustrative of the claimed subject matter and reflects much of the process described above:

1. A method for integrating a mobile payment application with other mobile applications while preventing security exposures, the method comprising:
 - receiving an indication that a pass was created by said mobile payment application, wherein said pass corresponds to a form of mobile payment;
 - generating a view of a set of application programming interfaces exposed to leverage said created pass;**

receiving a selection of one or more of said set of application programming interfaces to interact with said created pass thereby allowing one or more existing mobile applications to seamlessly be integrated with features of said created pass; and creating, by a processor, a virtual container for said created pass and said one or more of said set of application programming interfaces selected to interact with said created pass in order to control data to be exposed to an application layer.

Appeal Br. 67 (Claims App.) (emphasis added).

We note that Appeal 2018-0001460 involves a related patent application (Patent Application Number 14/154,376) and has claims similar to those at issue in this appeal.

REFERENCES

The Examiner relies upon the prior art below in rejecting the claims on appeal:

| | | |
|---------------------------|--------------------|---------------|
| Ortiz et al. ("Ortiz") | US 2015/0235212 A1 | Aug. 20, 2015 |
| Sartor | US 2015/0302374 A1 | Oct. 22, 2015 |

REJECTIONS

The Examiner maintains the following rejections on appeal:

Rejection 1. Claims 1–8 under 35 U.S.C. § 101 because the claimed invention is directed to a judicial exception without significantly more.

Final Act. 2.

Rejection 2. Provisionally, claims 1–8 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 9–16 of co-pending Application No. 14/154,376. *Id.* at 5.

Rejection 3. Claims 1, 7, and 8 under 35 U.S.C. § 102 as anticipated by Sartor. *Id.* at 6.

Rejection 4. Claims 2–6 under 35 U.S.C. § 103 as unpatentable over Sartor in view of Ortiz. *Id.* at 7.

ANALYSIS

Claim construction. The Examiner’s rejections under 35 U.S.C. §§ 101, 102, and 103 depend, at least in part, on claim construction. Claim 1 recites “generating a view of a set of application programming interfaces exposed to leverage said created pass.” Appeal Br. 67 (Claims App.). The Examiner does not provide an interpretation of this recitation, but, instead, states, “[i]t is respectfully submitted that the current claim does not define what the . . . application programming interfaces are. The interpretation of the claim limitations [are] a broad interpretation in the same field of endeavor.” Ans. 9.

Given the context of Appellant’s method, as the Specification describes and as we summarize above, claim 1’s recitation of “application programming interfaces” does not refer merely to interfaces that allow selection of options within one application. Rather, the “application programming interfaces” are interfaces that allow a user to program what application should be associated with (i.e., be able to leverage, be leveraged by, and/or interact with) a particular pass. *See, e.g.*, Spec. ¶ 42. Claim 1 supports this construction because the recited “application programming interfaces to interact with said created pass” are the selection that is received. This selection ultimately allows claim 1’s pass features and existing mobile applications “to seamlessly be integrated.”

We address the Examiner’s rejections in view of this claim construction.

Rejection 1, Section 101. The Examiner rejects claims 1–8 under 35 U.S.C. § 101 because the claimed invention is directed to a judicial exception without significantly more. Final Act. 2. In particular, the Examiner focuses, for example, on the claims’ process “including gathering, storing, organizing data, and transmit[ing] data relating to commercial practices.” Final Act. 2. The Examiner also emphasizes that the concept of a virtual container for storing a payment pass and interface is similar to the concept of an actual (i.e., a physical) wallet for storing payment cards and coupons. *Id.* at 2–3. The Examiner thus compares claim 1 to, for example, the claims that our reviewing court held were directed to an unpatentable abstract idea in *Elec. Power Grp., LLC, Alstom S.A.*, 830 F.3d 1350 (Fed. Cir. 2016). Ans. 5. Appellant argues that the claims are not directed to unpatentable subject matter because the claimed invention improves “an existing technological process, namely, seamlessly integrating the features of passes with other mobile applications while preventing security exposures.” Appeal Br. 5. Appellant emphasizes, for example, our reviewing court’s analysis in *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327 (Fed. Cir. 2016). *Id.*

On the present record, Appellant’s arguments persuade us of Examiner error. The Examiner bears the initial burden of presenting a prima facie case of unpatentability. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). To determine whether an invention claims ineligible subject matter requires the application of the two-step test first introduced in *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1293 (2012) and further explained in *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2354 (2014). The first step requires a determination as to whether the

claims at issue are directed to a patent-ineligible concept such as an abstract idea. *See Alice Corp. Pty. Ltd.*, 134 S. Ct. at 2355. The second step requires examination of “the elements of the claim to determine whether it contains an ‘inventive concept’ sufficient to ‘transform’ the claimed abstract idea into a patent-eligible application.” *Id.* at 2357 (quoting *Mayo* 132 S. Ct. at 1294, 1298).

For the first step, the Examiner indicates the claims are directed to receiving, generating a view, receiving a selection, creating a virtual container for the created pass and interface(s) are directed a scheme in which a created payment pass and a selectable programming interface to leverage the pass are collected and a virtual container is generated for a created payment pass and selectable interface that can leverage the created virtual pass.

Final Act. 2. The Examiner, however, does not expressly find that this combination of steps is merely an abstract idea. Rather, the Examiner focuses on the “virtual container” and states that the concept is “similar to the commercial practices found to be abstract by the courts.” *Id.* at 3.

The Examiner’s characterization of the claimed invention errs by failing to adequately consider, for example, claim 1’s recitations requiring “generating a view of a set of application programming interfaces exposed to leverage said created pass,” “receiving a selection of one or more of said set of application programming interfaces,” and “thereby allowing one or more existing mobile applications to seamlessly be integrated with features of said created pass.” Appeal Br. 15. The Examiner has not adequately explained why the recited process allowing two previously independent applications “to seamlessly be integrated” is an abstract idea rather than a specific asserted improvement in computer capabilities. *See Enfish, LLC*, 822 F.3d

at 1335 (“Software can make non-abstract improvements to computer technology just as hardware improvements can, and sometimes the improvements can be accomplished through either route.”); *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1257 (Fed. Cir. 2014) (holding claims patent eligible where they were “necessarily rooted in computer technology in order to overcome a problem specifically arising in the realm of computer networks”); *Alice Corp. Pty. Ltd.*, 134 S. Ct. at 2355, n.3 (2014) (“patent claims must be considered as a whole”) (internal quotation marks and citation omitted). Therefore, we do not sustain the Examiner’s rejection of claims 1–8 under 35 U.S.C. § 101.

Rejection 2, double patenting. The Examiner provisionally rejects claims 1–8 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 9–16 of co-pending Application No. 14/154,376. Final Act. 5. We summarily sustain this provisional rejection because Appellant does not dispute it.

Rejection 3, anticipation. The Examiner rejects claims 1, 7, and 8 under 35 U.S.C. § 102 as anticipated by Sartor. Final Act. 6. The Examiner finds that Sartor teaches each recitation of claim 1. *Id.* at 6–7. Most relevant here, the Examiner addresses claim 1’s recitation “generating a view of a set of application programming interfaces exposed to leverage said created pass” by citing Sartor at “Fig. 9A, 10A, 11A: Flashpay, Internet, Advertisement; paragraphs 230-231: celling limits, frequency, balance threshold.” *Id.* at 6. The Examiner elaborates on this position in the Answer by stating:

It is respectfully submitted that the current claim does not define what the virtual container and application programming interfaces are. The interpretation of the claim limitations a

broad interpretation in the same field of endeavor. . . . In this case, Fig. 10A shows application programming interfaces including “Flash Pay” and “Internet” being generated for the user to select. The “Flash Pay” programming interface makes “the purchase transaction application work according to a lighter” procedure (as compared to the “standard” one described above), that is, the purchase transaction application foregoes the verification phase with the transaction network 4 (although a “light” verification phase is performed, as described below) and is ready to perform the payment phase[] (paragraph 266). The “Internet” programming interface is utilized “when the user 10 is performing a purchase transaction at a Virtual Point-of-Sale (VPOS) (i.e., virtual check-out web-page), that is, the user 10 is performing a purchase transaction from an on-line store using the smartphone 2 (or, alternatively, a tablet, a tablet PC and even a personal computer) (paragraph 278).

Ans. 9.

Appellant argues that Sartor does not disclose “generating a view of a set of application programming interfaces exposed to leverage said created pass” as recited in claim 1. Appeal Br. 42–44; Reply Br. 26–27. We agree with Appellant that, on this record, the Examiner has not adequately explained how Sartor teaches this recitation. The portions of Sartor that the Examiner relies on are interface components of Sartor’s purchase transaction application. *See, e.g.*, Sartor ¶¶ 266 (referring to a user enabling “Flash Pay” as they log in to the purchase transaction application), 278 (referring to “[t]he Internet feature of the purchase transaction application”), 321 (referring to direct advertising being generated by the purchase transaction application). The Examiner does not adequately explain where Sartor teaches displaying applications as interfaces that allow a user to program what applications should be associated with, for example, Sartor’s purchase transaction application.

We thus do not sustain the Examiner's rejection of claim 1. We also do not sustain the Examiner's rejection of claims 7 and 8 because each of those claims depend from claim 1.

Rejection 4, obviousness. The Examiner rejects claims 2–6 under 35 U.S.C. § 103 as unpatentable over Sartor in view of Ortiz. Final Act. 7. Each of claims 2–6 directly or indirectly depends from claim 1, and the Examiner's use of Ortiz does not cure the error regarding Sartor that we address above. *Id.* We therefore do not sustain this rejection.

DECISION

For the above reasons, we affirm the Examiner's provisional rejection of claims 1–8 on the ground of nonstatutory obviousness-type double patenting. We reverse the Examiner's rejection (a) of claims 1–8 under 35 U.S.C. § 101, (b) claims 1, 7, and 8 under 35 U.S.C. § 102, and (c) claims 2–6 under 35 U.S.C. § 103.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED