



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

Table with 5 columns: APPLICATION NO., FILING DATE, FIRST NAMED INVENTOR, ATTORNEY DOCKET NO., CONFIRMATION NO.
12/521,737 07/18/2011 Francesco Lodolo PAT 82873W-2 1510

132251 7590 03/26/2019
(BLG/Conversant Wireless/27921)
Borden Ladner Gervais LLP
World Exchange Plaza
100 Queen Street, Suite 1300
Ottawa, ON K1P 1J9
CANADA

Table with 1 column: EXAMINER

ARAQUE JR, GERARDO

Table with 2 columns: ART UNIT, PAPER NUMBER

3689

Table with 2 columns: NOTIFICATION DATE, DELIVERY MODE

03/26/2019

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ipinfo@blg.com

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

*Ex parte* FRANCESCO LODOLO

---

Appeal 2018-001673  
Application 12/521,737<sup>1</sup>  
Technology Center 3600

---

Before JOSEPH A. FISCHETTI, KEVIN W. CHERRY, and  
BRUCE T. WIEDER, *Administrative Patent Judges*.

WIEDER, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the Examiner’s final rejection of claims 15, 16, and 21–28, which constitute all of the claims pending in this application. Claims 1–14 and 17–20 have been cancelled. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

CLAIMED SUBJECT MATTER

Appellant’s “invention relates to a mechanism for facilitating data transfer and storage between two electronic devices.” (Spec. 1, ll. 9–10.)

---

<sup>1</sup> According to Appellant, the real party in interest is Core Wireless Licensing, S.a.r.l. (Appeal Br. 3.)

Claims 15 and 16 are the independent claims on appeal. Claim 15 is illustrative and is reproduced below:

15. A portable electronic device, comprising:
  - at least one processor
  - and at least one memory including computer program code
  - the at least one memory and the computer program code configured to, with the at least one processor, cause the device at least to perform:
    - receive an electronic transaction object based on an initial transaction executed over a short range wireless connection with a second device;
    - store the electronic transaction object received from the second device, the electronic transaction object comprising a time field specifying a time of the initial transaction, a descriptor field specifying a description of the initial transaction, and a time limit field specifying a time limit for subsequent action related to the initial transaction;
    - monitor the elapse of time since the time of the initial transaction; and
    - at a selected time based on the time limit, issue a notification regarding the time limit for subsequent action.

#### REJECTION

Claims 15, 16, and 21–28 are rejected under 35 U.S.C. § 101 as directed to a judicial exception without significantly more.

#### ANALYSIS

*The § 101 rejection of claims 15, 16, 21, 22, 24–26, and 28*

“Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.” 35 U.S.C. § 101. Section 101, however,

“contains an important implicit exception: Laws of nature, natural phenomena, and abstract ideas are not patentable.” *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 573 U.S. 208, 216 (2014) (quoting *Assoc. for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576, 589 (2013)).

*Alice* applies a two-step framework, earlier set out 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*, 573 U.S. at 217.

Under the two-step framework, it must first be determined if “the claims at issue are directed to a patent-ineligible concept.” *Id.* at 218. If the claims are determined to be directed to a patent-ineligible concept, e.g., an abstract idea, then the second step of the framework is applied to determine if “the elements of the claim . . . contain[] an ‘inventive concept’ sufficient to ‘transform’ the claimed abstract idea into a patent-eligible application.” *Id.* at 221 (citing *Mayo*, 566 U.S. at 72–73, 79).

With regard to step one of the *Alice* framework, we apply a “directed to” two prong test to: 1) evaluate whether the claim recites a judicial exception, and 2) if the claim recites a judicial exception, evaluate whether the claim “appl[ies], rel[ies] on, or use[s] the judicial exception in a manner that imposes a meaningful limit on the judicial exception, such that the claim is more than a drafting effort designed to monopolize the judicial exception.” See *2019 Revised Patent Subject Matter Eligibility Guidance*, 84 Fed. Reg. 50, 54 (Jan. 7, 2019) (hereinafter “2019 Guidance”).

Here, the Examiner determines that claim 15 “is directed towards the abstract idea of commerce, specifically, the handling of a transaction based

on the provision of a receipt.” (Final Action 6.) More specifically, the Examiner determines that the claims “are simply directed to the abstract idea of transaction management.” (*Id.* at 24.)

Appellant does not present any persuasive argument in response to the Examiner’s determination that claim 15 is directed to an abstract idea. (*See* Appeal Br. 6–12; *see also* Reply Br. 2–5.)

Nonetheless, we review the Examiner’s determination. Under step one of the *Alice* framework, we “look at the ‘focus of the claimed advance over the prior art’ to determine if the claim’s ‘character as a whole’ is directed to excluded subject matter.” *Affinity Labs of Texas, LLC v. DIRECTV, LLC*, 838 F.3d 1253, 1257 (Fed. Cir. 2016) (quoting *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016)).

The “directed to” inquiry . . . cannot simply ask whether the claims *involve* a patent-ineligible concept, because essentially every routinely patent-eligible claim involving physical products and actions *involves* a law of nature and/or natural phenomenon . . . . Rather, the “directed to” inquiry applies a stage-one filter to claims, considered in light of the specification, based on whether “their character as a whole is directed to excluded subject matter.” *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1346 (Fed. Cir. 2015).

*Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335 (Fed. Cir. 2016). In other words, the first step of the *Alice* framework “asks whether the focus of the claims is on the specific asserted improvement in [the relevant technology] or, instead, on a process that qualifies as an ‘abstract idea’ for which computers are invoked merely as a tool.” *Id.* at 1335–36; *see also* 2019 Guidance at 54–55.

The Specification provides evidence as to what the claimed invention is directed. In this case, the Specification discloses that the “invention

relates to a mechanism for facilitating data transfer and storage between two electronic devices.” (Spec. 1, ll. 9–10.) Claim 15 provides further evidence. Claim 15 recites “[a] portable electronic device comprising: at least one processor[,] and at least one memory including computer code . . . configured to . . . perform: receive an electronic transaction object,” “store the . . . object . . . , the . . . object comprising a time field specifying a time of the initial transaction,” “monitor the elapse of time since the time of the initial transaction,” “and at a selected time based on the time limit, issue a notification.” In other words, claim 15 recites receiving and storing an object based on a transaction, e.g., a receipt from a sales transaction (*see* Spec. 3, ll. 23–24), monitoring the elapse of time since the transaction, and issuing a notification. Thus, claim 15 recites commercial interactions, monitoring/managing interactions between people, and following rules, each of which is a method of organizing human activities. *See, e.g., Accenture Glob. Servs., GmbH v. Guidewire Software, Inc.*, 728 F.3d 1336, 1344 (Fed. Cir. 2013) (“[T]he abstract idea at the heart of system claim 1 of the ’284 patent is ‘generating tasks [based on] rules . . . to be completed upon the occurrence of an event.’”); *see also* 2019 Guidance at 52. This is accomplished by using a generic processor and memory (*see* Spec. 1, ll. 18–22, 4, ll. 16–17), and “standard well-known programming techniques” (*id.* at 12, ll. 8–9) to receive information, store information, analyze/monitor information, and output/display information.

Although we and the Examiner describe, at different levels of abstraction, to what the claims are directed, it is recognized that “[a]n abstract idea can generally be described at different levels of abstraction.” *Apple, Inc. v. Ameranth, Inc.*, 842 F.3d 1229, 1240 (Fed. Cir. 2016). That

need not and, in this case does not, “impact the patentability analysis.” *See id.* at 1241.

Appellant does not argue that Appellant invented a processor, a memory, or even a portable electronic device.<sup>2</sup> Nor do we see how the recitation of a generic processor, memory, and portable electronic device, even in conjunction with the recited functions, “ensure[s] ‘that the [claim] is more than a drafting effort designed to monopolize the [abstract idea].” *Alice*, 573 U.S. at 221 (brackets in original) (quoting *Mayo*, 566 U.S. at 77.) Moreover, the limitations of claim 15 do not recite implementation details. Rather, “the recited physical components merely provide a generic environment in which to carry out the abstract idea.” *In re TLI Commc’ns LLC Patent Litig.*, 823 F.3d at 611.

“[W]e have treated collecting information, including when limited to particular content (which does not change its character as information), as within the realm of abstract ideas.” *Elec. Power Grp.*, 830 F.3d at 1353. “In a similar vein, we have treated 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.” *Id.* at 1354. Additionally, the Federal Circuit has “recognized that merely 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.” *Id.*

In view of the above, we agree with the Examiner that claim 15 is directed to an abstract idea.

---

<sup>2</sup> We make no determination as to whether the recitation in the claim preamble of “[a] portable electronic device” limits the claim scope.

Step two of the *Alice* framework has been described “as a 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.’” *Alice*, 573 U.S. at 217–18 (citing *Mayo*, 566 U.S. at 72–73).

The Examiner determines “that the claims’ recitation of generic computing components/environment fail [sic] to add an inventive concept sufficient to bring the abstract idea into the realm of patentability.” (Final Action 24–25.) Specifically, the Examiner determines that

the claimed invention amounts to nothing more than looking at the date of the receipt and the current date in order to determine if a notification should be issued, e.g., whether to grant a refund or whether to remind a user about a warranty. This is a concept that has existed long before computers and many companies, organizations, businesses, and the like have long been known to send out letters to customers in order to remind a customer that their warranty is about to expire . . . . This is not only a concept that existed long before computers were used, but is a concept that is not deeply rooted in technology, as well as not being an invention that is attempting to resolve an issue that arose from technology. Again, this is a concept that can be done by a human using pen and paper . . . .

(Answer 6.)

Appellant disagrees and argues that

[i]n following the Examiner’s logic, applying conventional advantages that computers provide to the concept described above would result in nothing more than a portable electronic device at the customer side of the transaction that receives a notification from an electronic device at the company side of the transaction, based on when the notification should be issued to the customer portable electronic device. The presently pending claims are not directed to such a system.

In contrast, pending claims 15 and 16 clearly recite that it is the portable electronic device that initially receives the electronic transaction object that self-issues a notification at a particular point in time based on the monitoring of information that it has received in the electronic transaction object. In other words, there is no further receipt of notifications by the portable electronic device from any other device.

(Reply Br. 5.)

Appellant's argument is not commensurate with the scope of the claim. Appellant's argument assumes that the device is "at the customer side of the transaction" and that the recited notification is received by such a customer device "from an electronic device at the company side." (*See id.*) Applying a broadest reasonable interpretation, we see nothing in claim 15 restricting the device from being on the merchant/company side of the transaction. The claim does not require the notification to be issued to the customer. Rather, the notification recited in the claim could, as the Examiner suggests, be issued on the merchant side of the transaction to remind the merchant to, for example, send a letter to the consumer. This, as the Examiner notes, is an idea that has long been known in business and could be performed by a human using pen and paper. (*See Answer 6.*)

Even if we treated the preamble as a limitation of the claim, Appellant does not persuasively argue why incorporating the processor and memory in a merchant's "portable electronic device," as opposed to, e.g., a merchant's generic desktop computer, would make the claim patent-eligible.

Moreover, "[i]t has been clear since *Alice* that a claimed invention's use of the ineligible concept to which it is directed cannot supply the inventive concept that renders the invention 'significantly more' than that

ineligible concept.” *BSG Tech LLC v. BuySeasons, Inc.*, 899 F.3d 1281, 1290 (Fed. Cir. 2018).

Taking the claim elements separately, the functions performed by the generic processor and memory are purely conventional. Receiving information, storing information, monitoring/analyzing information, and displaying/notifying are basic computer functions, i.e., they are well-understood, routine, and conventional functions previously known to the industry. *See Elec. Power Grp.*, 830 F.3d at 1356 (The claims “do not include any requirement for performing the claimed functions of gathering, analyzing, and displaying in real time by use of anything but entirely conventional, generic technology. The claims therefore do not state an arguably inventive concept . . . .”); *see also In re Katz Interactive Call Processing Patent Litig.*, 639 F.3d 1303, 1316 (Fed. Cir. 2011) (“Absent a possible narrower construction of the terms ‘processing,’ ‘receiving,’ and ‘storing,’ . . . those functions can be achieved by any general purpose computer without special programming.”).

Considered as an ordered combination, the generic components of Appellant’s device add nothing that is not already present when the limitations are considered separately. For example, claim 15 does not, as discussed above, purport to improve the functioning of the processor or memory. Nor does it effect an improvement in any other technology or technical field. Instead, claim 15 amounts to nothing significantly more than an instruction to apply the abstract idea using generic computer components. That is not enough to transform an abstract idea into a patent-eligible invention. *See Alice*, 573 U.S. at 225–26.

In view of the above, we are not persuaded that the Examiner erred in rejecting claim 15. Independent claim 16 is argued together with claim 15, and dependent claims 21, 22, 24–26, and 28 are not separately argued. These claims fall with claim 15. *See* 37 C.F.R. § 41.37(c)(1)(iv).

*The § 101 rejection of claims 23 and 27*

Claim 27 recites:

27. The device of claim 15, wherein the memory and the computer program code are further configured to cause the device to perform:

in a second transaction related to the initial transaction, send at least a portion of the electronic transaction object to a computer, the sent portion configured to cause the computer to initiate computer software pre-installed at that computer.

Claim 23 depends from claim 16, contains similar language, and is argued with claim 27. Therefore, claim 23 will stand or fall with claim 27. *See* 37 C.F.R. § 41.37(c)(1)(iv).

The Examiner determines that claim 27 is

simply directed towards sending some portion information [sic] found on the receipt, e.g., date, user, credit card number, or etc., and having some other computer perform some unknown operation. This unknown operation is so broad that it can simply read on informing a credit card company to refund a customer's credit card amount for the amount of the product that is being refunded, which, again, is a process that has long been performed by humans using pen and paper . . . .

(Answer 7.)

Appellant disagrees and argues that “the Examiner has misconstrued the claim limitations.” (Reply Br. 6.) Specifically, Appellant argues that

[f]or this feature, the specification at page 12 [sic, 11], lines 22 – 25 describes an embodiment in which the transaction object

“automatically cause[s] the computer to initiate pre-installed servicing software”. Considered in light of the specification reference to “automatically cause”, the claim term “configured to cause” should be understood to mean that the transaction object includes functional content (such as program instructions or code) that, when executed by the receiving computer, initiates that computer’s own software.

This proper construction of the claim language excludes the alleged “informing a credit card company to refund a customer’s credit card” with a particular amount, as stated in the Examiner’s Answer, because that construction involves no functional content of the sent object, nor the initiation of any pre-installed software at a computer receiving the sent object.

Instead when properly construed, claims 23 and 27 represent an invention that can improve the performance of a computer by way of the automatic initiation of servicing software

....

(Reply Br. 6–7.) In short, Appellant’s argument is that, based on a disclosed embodiment, claim 27 should be construed as requiring “that the transaction object includes functional content (such as program instructions or code).” (*See id.*) But claim 27 only recites that “the sent portion [of the transaction object be] configured to cause the computer to initiate” software on that computer. And, “[t]he general rule, of course, is that the claims of a patent are not limited to the preferred embodiment, unless by their own language.” *Karlin Tech., Inc. v. Surgical Dynamics, Inc.*, 177 F.3d 968, 973 (Fed. Cir. 1999).

Here, Appellant does not persuasively argue why a computer configured to monitor received information for, e.g., a particular description of the initial transaction, and initiate a designated task upon detection of the particular description, would not be included under a broadest reasonable interpretation of claim 27. Therefore, we do not agree with Appellant that

claim 27 must be construed as requiring the sent portion of the transaction object to include functional content, such as programming code or programming instructions. Thus, we are not persuaded that the Examiner erred in determining that claim 27, like claim 15, is directed to “a process that has long been performed by humans using pen and paper.” (*See* Answer 7.) In short, claim 27 merely provides additional detail regarding the abstract ideas of claim 15.

In view of the above, we are not persuaded that the Examiner erred in rejecting claim 27. Dependent claim 23 falls with claim 27. *See* 37 C.F.R. § 41.37(c)(1)(iv).

Other arguments, including arguments seeking to analogize claims 15 and 16 to cancelled claims, have been considered but are not persuasive.

#### DECISION

The Examiner’s rejection of claims 15, 16, and 21–28 under 35 U.S.C. § 101 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). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED