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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte PATTY M. McKERNAN, SCOTT R. PAINTIN, and
ANDREW MOORE SULLIVAN III

Appeal 2018-004048
Application 13/622,020
Technology Center 3600

Before JOHNNY A. KUMAR, LINZY T. McCARTNEY, and
JOYCE CRAIG, *Administrative Patent Judges*.

McCARTNEY, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants seek review under 35 U.S.C. § 134 of the Examiner's final rejection of claims 1–22. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

BACKGROUND

This patent application concerns “systems and methods for loading prepaid accounts.” Specification ¶ 5, filed September 18, 2012 (“Spec.”). Claims 1, 13, and 22 are independent. Claim 1 illustrates the claimed invention:

1. A method comprising:

[a] receiving, at a money transfer platform computer system, an account number from a consumer, wherein the account number is associated with a prepaid account;

[b] receiving, at a money transfer platform computer system, a request from the consumer to load the prepaid account, wherein the request is associated with a reload identifier;

[c] associating, at a money transfer platform computer system, the account number with the reload identifier;

[d] receiving, at a money transfer platform computer system, the reload identifier and a fund amount after receiving the request from the consumer;

[e] comparing the account number using the reload identifier, at a money transfer platform computer system; and

[f] in response to the account number corresponding to the reload identifier, loading the reload amount onto the prepaid account, at a money transfer platform computer system.

Appeal Brief 9, filed June 26, 2017 (“App. Br.”) (bracketed letters added).

REJECTIONS

Claims	Basis	References
1–22	§ 101	
1–22	§ 112(a)	
1–22	§ 112(b)	
1, 2, 7, 10, 12, and 22	§102(b)	Dixon ¹
3 and 4	§ 103(a)	Dixon and Sobek ²
5, 6, 8, 13–18, 20, and 21	§ 103(a)	Dixon and Hartmaier ³
9	§ 103(a)	Dixon and Alvarez ⁴
11	§ 103(a)	Dixon and Smith ⁵
19	§ 103(a)	Dixon, Hartmaier, and Alvarez

DISCUSSION

We have reviewed the Examiner’s rejections and Appellants’ arguments. Except for the § 112(b) rejection, Appellants have not persuaded us that the Examiner erred. For the §§ 101, 112(a), 102(b), and 103(a) rejections, as consistent with the discussion below, we adopt the Examiner’s findings, reasoning, and conclusions in the Final Office Action mailed January 26, 2017 (“Final Act.”) and the Answer mailed November 30, 2017 (“Ans.”).

We address these rejections below. Appellants argue the rejected claims together for each of the appealed rejections. As permitted by 37 C.F.R. § 41.37(c)(1)(iv), we decide the appeal for the §§ 101, 112(a),

¹ Dixon et al. (US 2011/0166914 A1; July 7, 2011).

² Sobek (US 2012/0221422 A1; Aug. 30, 2012).

³ Hartmaier (US 8,095,463 B1; Jan. 10, 2012).

⁴ Alvarez et al. (US 2007/0168283 A1; July 19, 2007).

⁵ Smith et al. (US 2004/0133511 A1; July 8, 2004).

112(b), and 102(b) rejections based on independent claim 1 and for the § 103(a) rejection based on independent claim 13.

Section 101 Rejection

Section 101 of the Patent Act provides that “any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof” is patent eligible. 35 U.S.C. § 101. But the Supreme Court has long recognized an implicit exception to this section: “Laws of nature, natural phenomena, and abstract ideas are not patentable.” *Alice Corp. v. CLS Bank Int’l*, 573 U.S. 208, 216 (2014) (quoting *Ass’n for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576, 589 (2013)). To determine whether a claim falls within one of these excluded categories, the Court has set out a two-part framework. The framework requires us first to consider whether the claim is “directed to one of those patent-ineligible concepts.” *Alice*, 573 U.S. at 217. If so, we then examine “the elements of [the] claim 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*, 573 U.S. at 217 (quoting *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 78, 79 (2012)). That is, we examine the claim for an “inventive concept,” “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 (alteration in original) (quoting *Mayo*, 566 U.S. at 72–73).

The Patent Office recently revised its guidance about this framework. *See* 2019 Revised Patent Subject Matter Eligibility Guidance, 84 Fed. Reg. 50 (Jan. 7, 2019) (“Revised Guidance”). Under the Revised Guidance, to

decide whether a claim is directed to an abstract idea, we evaluate whether the claim (1) recites subject matter that falls within one of the abstract idea groupings identified in the Revised Guidance and (2) fails to integrate the recited abstract idea into a practical application. *See* Revised Guidance, 84 Fed. Reg. at 51, 54. If the claim is directed to an abstract idea, as noted above, we then determine whether the claim has an inventive concept. The Revised Guidance explains that when making this determination, we should consider whether the additional claim elements add “a specific limitation or combination of limitations that are not well-understood, routine, conventional activity in the field” or “simply append[] well-understood, routine, conventional activities previously known to the industry, specified at a high level of generality.” Revised Guidance, 84 Fed. Reg. at 56.

With these principles in mind, we turn to the § 101 rejection.

Abstract Idea

The Examiner determined that claim 1 recites a fundamental economic practice, which falls within the “certain methods of organizing human activity” abstract idea grouping identified in the Revised Guidance. *See* Final Act. 2–3; Revised Guidance, 84 Fed. Reg. at 52. For the reasons explained below, we agree with the Examiner that claim 1 recites a fundamental economic practice.

Claim 1 recites a method that includes limitations [a]–[f] reproduced in full above. These limitations recite using “a money transfer platform computer system” to load funds onto a prepaid account. *See* App. Br. 9. The written description suggests that loading funds onto a prepaid account is a longstanding business practice. *See, e.g.*, Spec. ¶ 3 (disclosing that “[t]here are several ways that consumers may currently load funds onto a prepaid

card including, for example, using credit card, checks, ACH (Automated Clearing House) debit, payments at a physical location, and Pay[Pal]TM). And using a computer system to load funds onto a prepaid account is an economic act that is not meaningfully different from economic acts that courts have determined are fundamental economic practices. *See, e.g., Alice*, 573 U.S. at 219 (intermediated settlement); *Smart Sys. Innovations, LLC v. Chicago Transit Auth.*, 873 F.3d 1364, 1372 (Fed. Cir. 2017) (determining that claims “directed to the formation of financial transactions in a particular field (i.e., mass transit) and data collection related to such transactions” are drawn to an abstract idea). We thus determine that claim 1 recites a fundamental economic practice, one of the certain methods of organizing human activity identified in the Revised Guidance, *see* Revised Guidance, 84 Fed. Reg. at 52. Claim 1 therefore recites an abstract idea.

Because we determine that claim 1 recites an abstract idea, we next consider whether claim 1 integrates the abstract idea into a practical application. *See* Revised Guidance, 84 Fed. Reg. at 51. In doing so, we consider whether there are any additional elements beyond the abstract idea that, individually or in combination, “integrate the [abstract idea] into a practical application, using one or more of the considerations laid out by the Supreme Court and the Federal Circuit.” Revised Guidance, 84 Fed. Reg. at 54–55.

Claim 1 recites one additional element: “a money transfer platform computer system.” *See* App. Br. 9. The written description indicates that this system encompasses generic computer components. For example, the written description discloses that “[m]oney transfer platform 110 can include *any* financial system that associates a prepaid account with funds.” Spec.

¶ 15 (emphasis added). The written description also discloses computer system 400 used to implement the invention. Computer system 400 consists of generic computer components such as central processing units, keyboards, printers, and disk drives. *See* Spec. ¶¶ 10, 43–47, Fig. 4 (showing computer system 400).

Given these disclosures, the recited “money transfer platform computer system” is simply a generic computer system that serves as a tool to perform the abstract idea. Claim 1 thus does not integrate the abstract idea into a practical application. *See Alice*, 573 U.S. at 223–24 (“[W]holly generic computer implementation is not generally the sort of ‘additional featur[e]’ that provides any ‘practical assurance that the process is more than a drafting effort designed to monopolize the [abstract idea] itself.’”) (quoting *Mayo*, 566 U.S. at 77)); *see also* Revised Guidance, 84 Fed. Reg. at 55 (explaining that merely using a computer as a tool to perform an abstract idea may show that an abstract idea has not been integrated into a practical application).

Inventive Concept

Finally, we consider whether claim 1 has an “inventive concept.” That is, we examine “the elements of [the] claim 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*, 573 U.S. at 217 (quoting *Mayo*, 566 U.S. at 78, 79). Under the Revised Guidance, we evaluate whether the additional claim elements add “a specific limitation or combination of limitations that are not well-understood, routine, conventional activity in the field” or “simply append[] well-understood, routine, conventional activities previously known to the

industry, specified at a high level of generality.” Revised Guidance, 84 Fed. Reg. at 56.

The Examiner determined that the additional element recited in claim 1 consists of components “generally found in computer implementations” and performs “well-known, routine and conventional computer functions.” Final Act. 4. In response, Appellants contend that the Examiner erred because claim 1 executes the recited method with “very particular machines” that “have been configured for a special purpose,” not “generic computers.” App. Br. 4.

We disagree. The only additional element in claim 1 is the recited “money transfer platform computer system.” *See* App. Br. 9. As discussed above, the written description indicates that this system consists of generic computer components. *See, e.g.*, Spec. ¶¶ 15, 43–47, Fig. 4. The claimed invention uses this system to perform generic computer functions such as receiving, associating, comparing, and loading data. *See* App. Br. 9; *cf. Alice*, 573 U.S. at 226 (“Nearly every computer will include a ‘communications controller’ and ‘data storage unit’ capable of performing the basic calculation, storage, and transmission functions required by the method claims.”). The written description provides few details about the system or the functions it performs, which indicates that both are well known. *Cf. Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384 (Fed. Cir. 1986) (explaining that “a patent need not teach, and preferably omits, what is well known in the art”). As a result, the written description adequately supports the Examiner’s determination that the additional element recited in claim 1 is conventional and performs well-understood, routine, and conventional activities. *See* Robert W. Bahr,

Memorandum on Changes in Examination Procedure Pertaining to Subject Matter Eligibility, Recent Subject Matter Eligibility Decision (*Berkheimer v. HP, Inc.*) 3 (Apr. 19, 2018), available at <https://www.uspto.gov/sites/default/files/documents/memo-berkheimer-20180419.PDF> (explaining that a specification that describes additional elements “in a manner that indicates that the additional elements are sufficiently well-known that the specification does not need to describe the particulars of such additional elements to satisfy 35 U.S.C. § 112(a)” can show that the elements are well understood, routine, and conventional).

Finally, Appellants contend that limitations [c]–[f] “are not well-understood, routine, and conventional in the field” and protect against “preemption of . . . the alleged abstract idea.” App. Br. 5. But except for the recited “money transfer platform computer system,” these limitations form part of the abstract idea and thus are not “additional elements” that “‘transform the nature of the claim’ into a patent-eligible application.” *Alice*, 573 U.S. at 217 (quoting *Mayo*, 566 U.S. at 78, 79). And as discussed above, the recited “money transfer platform computer system” consists of conventional computer components that perform well-understood, routine, and conventional computer functions and thus does not provide the necessary inventive concept. As for Appellants’ preemption argument, even if these limitations prevent claim 1 from preempting the identified abstract idea, this fact alone does not show that claim 1 is patent eligible. *See Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015) (“While preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility.”).

At bottom, the additional element in claim 1 “simply appends well-understood, routine, conventional activities previously known to the industry, specified at a high level of generality.” Revised Guidance, 84 Fed. Reg. at 56. We thus determine that claim 1 does not contain an inventive concept.

Conclusion

For at least the above reasons, we determine that claim 1 is directed to a fundamental economic practice and does not have an inventive concept. We therefore sustain the Examiner’s rejection of claim 1 under § 101.

Section 112(a) Rejection

Claim 1 recites “comparing the account number using the reload identifier, at a money transfer platform computer system.” App. Br. 9. The Examiner determined that this limitation lacks written description support and therefore rejected claim 1 under § 112(a). *See* Final Act. 4–5.

Appellants contend that paragraph 5 of the written description provides adequate support for this limitation. *See* App. Br. 5. Appellants point out that this paragraph states “[u]sing the reload identifier received from the agent, the account number can be identified” and argue that, along with unspecified “further discussion therein,” this statement provides the necessary support, “implicitly or inherently . . . if not explicitly.” App. Br. 5.

We find Appellants’ arguments unpersuasive. To satisfy the written description requirement, “the disclosure of the application relied upon” must “reasonably convey[] to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date.” *Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc). “[W]hile the description requirement does not demand any particular form

of disclosure, or that the specification recite the claimed invention *in haec verba*, a description that merely renders the invention obvious does not satisfy the requirement.” *Ariad*, 598 F.3d at 1352 (citations omitted).

The limitation at issue requires comparing the account number using the reload identifier. *See* App. Br. 9. In contrast, the cited part of paragraph 5 discusses using the reload identifier to identify the account number, but does not explicitly mention comparing the account number using the reload identifier. Although Appellants argue that the recited comparison is implicit or inherent in this part of paragraph 5, Appellants have not explained why this is so. *See* App. Br. 5. And Appellants’ vague reference to “further discussion” in the written description does not fill this gap. On this record, Appellants have not persuaded us that the Examiner erred. We therefore sustain this rejection.

Section 112(b) Rejection

Claim 1 recites “the account number corresponding to the reload identifier.” App. Br. 9. The Examiner found the word “corresponding” in this limitation unclear and rejected claim 1 under § 112(b) as indefinite. *See* Final Act. 5–6.

Appellants contend that “the context of the claim” and paragraph 5 of the written description “render this [limitation] well understandable by any person of skill in the art.” App. Br. 6.

We agree with Appellants that the word “corresponding” is clear in this context. The plain and ordinary meaning of the word “corresponding” includes related or accompanying. *See Corresponding*, Merriam-Webster.com, <https://www.merriam-webster.com/dictionary/corresponding>. The written description describes the relationship between the account

number and the reload identifier in a manner consistent with the plain and ordinary meaning of “corresponding.” *See, e.g.*, Spec. ¶¶ 5 (“The account number and/the reload identifier can be associated together.”), 26 (“[T]he account number can then be preassociated with the reload identifier at the [money] transfer platform.”), 29 (“The consumer can provide their account number and it can be associated with a reload identifier.”), 31 (“In each of the examples above, the reload identifier is associated with the consumer’s account number through a number of different mechanisms.”) We thus agree with Appellants that the word “corresponding” in the limitation at issue does not make claim 1 indefinite. We therefore do not sustain this rejection.

Section 102(b) and 103(a) Rejections

Appellants assert that claim 1 recites that “a reload identifier along with funds are provided by a consumer to reload a prepaid account” and that “the money transfer platform computer system looks up the prepaid account number using the reload identifier.” App. Br. 6. For the § 102(b) rejection, Appellants contend that Dixon fails to disclose these limitations because “Dixon does not have to compare anything to determine where to load funds.” App. Br. 7. Appellants also argue that in Dixon “there is no lookup of information” and “no ‘translation’ of one identifying number . . . for another.” App. Br. 7. Appellants assert that therefore Dixon does not disclose “comparing of an account number and a reload identifier to determine correspondence and consequent allowance of a reloading function.” App. Br. 7.

Appellants have not persuaded us that the Examiner erred. First, claim 1 does not explicitly recite the limitations argued by Appellants. Claim 1 recites “receiving . . . a request from the consumer to load the prepaid

account, wherein the request is associated with a reload identifier” and “receiving . . . the reload identifier and a fund amount after receiving the request from the consumer”; the claim does not explicitly require that a consumer provide the funds *and* the reload identifier as Appellants contend. *See* App. Br. 9. Similarly, claim 1 recites “comparing the account number using the reload identifier” and “in response to the account number corresponding to the reload identifier, loading the reload amount onto the prepaid account.” App. Br. 9. Claim 1 does not explicitly recite looking up the prepaid account number using the reload identifier, comparing an account number and a reload identifier and then allowing a reloading function, or translating one number for another as asserted by Appellants. *See* App. Br. 9. Because the limitations argued by Appellants do not explicitly appear in claim 1, we find these arguments unpersuasive. *See In re Self*, 671 F.2d 1344, 1348 (CCPA 1982) (“Many of appellant’s arguments fail from the outset because, as the solicitor has pointed out, they are not based on limitations appearing in the claims.”).

Second, if Appellants contend that Dixon does not disclose the “comparing” limitation recited in claim 1, Appellants have not persuaded us that the Examiner erred. The Examiner mapped the “comparing” limitation to paragraph 96 of Dixon, but Appellants have not addressed this paragraph. *Compare* Final Act. 8, *with* App. Br. 6–7. Appellants have thus not persuaded us that the Examiner erred.

For the above reasons, we sustain the Examiner’s rejection of claim 1 under § 102(b). Because Appellants rely on largely similar arguments for the rejection of claim 13 under § 103(a), we also sustain the Examiner’s rejection of this claim.

CONCLUSION

Claims Rejected	Basis	References	Affirmed	Reversed
1-22	§ 101		1-22	
1-22	§ 112(a)		1-22	
1-22	§ 112(b)			1-22
1, 2, 7, 10, 12, and 22	§102(b)	Dixon	1, 2, 7, 10, 12, and 22	
3 and 4	§ 103(a)	Dixon and Sobek	3 and 4	
5, 6, 8, 13-18, 20, and 21	§ 103(a)	Dixon and Hartmaier	5, 6, 8, 13-18, 20, and 21	
9	§ 103(a)	Dixon and Alvarez	9	
11	§ 103(a)	Dixon and Smith	11	
19	§ 103(a)	Dixon, Hartmaier, and Alvarez	19	
Outcome			1-22	

Because we affirm at least one ground of rejection for each claim on appeal, we affirm the Examiner’s decision. *See* 37 C.F.R. § 41.50(a)(1). No time for taking any action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 41.50(f).

AFFIRMED