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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/012,589	01/24/2011	Ron Hirson	BOKU-P030	7082
17169	7590	09/26/2019	EXAMINER	
Stephen M. De Klerk MatterLight IP 2033 Gateway Place 5th Floor San Jose, CA 95110			AGWUMEZIE, CHINEDU CHARLES	
			ART UNIT	PAPER NUMBER
			3685	
			NOTIFICATION DATE	DELIVERY MODE
			09/26/2019	ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte RON HIRSON and DAVID YOO

Appeal 2018-005482
Application 13/012,589¹
Technology Center 3600

Before JASON V. MORGAN, DANIEL N. FISHMAN, and
NABEEL U. KHAN, *Administrative Patent Judges*.

MORGAN, *Administrative Patent Judge*.

DECISION ON APPEAL
STATEMENT OF THE CASE

Introduction

This is an appeal under 35 U.S.C. § 134(a) from the Examiner’s Final Rejection of claims 1, 2, 4, and 6–19. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

Summary of the disclosure

Appellants disclose systems and methods “to facilitate online transactions via mobile communications.” Abstract.

¹ Appellants identify Boku, Inc., as the real party in interest. Appeal Br. 3.

Representative claim (key limitations emphasized and formatting added)

1. A computer-implemented method, comprising:

displaying, by a host, to a user at a user terminal system an interface of the host at a first domain on a browser of the user with an option selectable by the user *if the user selects to either sign in via the mobile phone* of the user or to sign in an account on the host using a username and password or to sign in via a mobile phone of the user;

(i) *if the user selects to sign in using a username and password[:]*

receiving, at the host, a username and password from the user terminal system;

determining, by the host, whether the username and password are correct; and

if the username and password are correct then signing the user into the account on the host without transmitting a request to a computer to authenticate the user by communicating with the mobile phone to confirm an identity of the user; and

(ii) *if the user selects to sign in via the mobile phone of the user:*

transmitting from the host and receiving at the computer, a request from the host to the computer to authenticate the user to sign in the account on the host including providing an identifier to uniquely represent the user among a plurality of users on the host;

redirecting, by the host, the browser of the user to display an interface of the computer at a second domain that is different than the first domain, to receive the phone number specified by the user to confirm an identity of the user;

communicating, by the computer, with the mobile phone of the user at a phone number specified by the user to confirm an identity of the user;

if the identity of the user is confirmed via the communicating with the mobile phone[:]

providing, by the computer, information to the host to allow the user to sign in the account including providing the identifier to uniquely represent the user among the plurality of users on the host; and signing the user into the account on the host corresponding to the identifier to uniquely represent the user among the plurality of users on the host without requiring the username and without requiring the password to be entered at the user terminal displayed by the host.

Rejections

The Examiner rejects claims 1 and 19 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Final Act. 8–9.

The Examiner rejects claims 1 and 19 under 35 U.S.C. § 112, second paragraph, as being indefinite. Final Act. 9.

The Examiner rejects claims 1, 2², 4, and 6–19 under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter. Final Act. 5–8.

The Examiner rejects claims 1, 2, 4, and 6–19 under 35 U.S.C. § 103(a) as being unpatentable over Labrou et al. (US 2006/0206709 A1; published Sept. 14, 2006) (“Labrou”), Seidl et al. (US 2011/0289573 A1; published Nov. 24, 2011) (“Seidl”), and Yared et al. (US 2003/0149781 A1; published Aug. 7, 2003) (“Yared”). Final Act. 10–17.

² The Examiner only lists claims 1 and 19 in the statement of the rejection. Final Act. 5. The Examiner, however, further determines the “[d]ependent claims do not resolve the deficiency of independent claims and accordingly stand rejected under 35 USC 101 based on the same rationale.” *Id.* at 7.

35 U.S.C. § 112, FIRST PARAGRAPH

In rejecting claim 1 under 35 U.S.C. § 112, first paragraph, the Examiner finds the Specification fails to provide sufficient written description support for the recitation of *redirecting, by the host, the browser of the user to display an interface of the computer at a second domain that is different than the first domain, to receive the phone number specified by the user to confirm an identity of the user.* Final Act. 8. Appellants contend the Examiner erred because the Specification provides sufficient written description support in paragraph 196 of the Specification. Appeal Br. 24. The Examiner “reviewed the entire paragraph but could not discern the claimed limitation either expressly disclosed or disclosed by implication.” Ans. 4.

We agree with Appellants that the Specification reasonably apprises an artisan of ordinary skill that Appellants had possession of the disputed recitation at the time of filing. The Specification depicts an interface at a first domain (www.songs.com) that provides button 509 to allow for a user to sign into an account via mobile phone. Spec. Fig. 20. After the user selects button 509, server 113 redirects the user to another website for authentication. Spec. ¶ 180. This second website is at a second domain (www.mobillcash.com) different from the first domain. Spec. Fig. 21. At this site, the user is prompted to provide or verify a mobile number to sign into the account at the first domain. *Id.*; *see also* Spec. ¶ 196. Based on these disclosures, we are unable to discern what features of the disputed recitation the Examiner finds are not sufficiently supported by the Specification.

Accordingly, we do not sustain the Examiner's 35 U.S.C. § 112, first paragraph, rejection of claim 1, and claim 19, which the Examiner similarly rejects. Final Act. 8.

35 U.S.C. § 112, SECOND PARAGRAPH

In rejecting claim 1 under 35 U.S.C. § 112, second paragraph, the Examiner finds that “displaying by a ‘host’ a host [sic] and computer are not the same thing.” Final Act. 9. Appellants contend the Examiner erred because “the technology of the subject patent application deals with computer technologies and that a ‘host’ is therefore a ‘computer.’” Appeal Br. 24; *see also* Reply Br. 29.

The Specification contains multiple disclosures to server 113 (Spec. Fig. 1) serving as a host for an online game environment or a virtual reality world (*id.* ¶ 47), for websites (*id.* ¶¶ 54, 109), for account-based services (*id.* ¶ 175), and for accounts (*id.* ¶¶ 176, 207, 210, 216, 219–22, 228). *See also id.* Fig. 20, ¶¶ 178–80 (disclosing presenting a user interface to the user for signing in and server 113 redirecting the user to a website of an interchange for authentication). These disclosures provide sufficient evidence that the claimed *host* is a server and, as Appellants' contend, a computer. *See* Appeal Br. 24. Therefore, we agree with Appellants that the *host* recitation is not indefinite.

Accordingly, we do not sustain the Examiner's 35 U.S.C. § 112, second paragraph, rejection of claim 1, and claim 19, which the Examiner similarly rejects. Final Act. 9.

35 U.S.C. § 101

Principles of law

To be statutorily patentable, the subject matter of an invention must be a “new and useful process, machine, manufacture, or composition of matter, or [a] new and useful improvement thereof.” 35 U.S.C. § 101. There are implicit exceptions to the categories of patentable subject matter identified in § 101, including: (1) laws of nature; (2) natural phenomena; and (3) abstract ideas. *Alice Corp. v. CLS Bank Int’l*, 573 U.S. 208, 216 (2014). The Supreme Court has set forth a framework for distinguishing patents with claims directed to these implicit exceptions “from those that claim patent-eligible applications of those concepts.” *Id.* at 217 (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66 (2012)). The evaluation follows a two-part analysis: (1) determine whether the claim is *directed to* a patent-ineligible concept, e.g., an abstract idea; and (2) if so, then determine whether any element, or combination of elements, in the claim is sufficient to ensure that the claim amounts to *significantly more* than the patent-ineligible concept itself. *See id.* at 217–18.

“[A]ll inventions at some level embody, use, reflect, rest upon, or apply laws of nature, natural phenomena, or abstract ideas.” *Mayo*, 566 U.S. at 71. We ““must be careful to avoid oversimplifying the claims’ by looking at them generally and failing to account for the specific requirements of the claims.” *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1313 (Fed. Cir. 2016) (quoting *In re TLI Commc’ns LLC Pat. Litig.*, 823 F.3d 607, 611 (Fed. Cir. 2016)).

The U.S. Patent and Trademark Office (USPTO) recently published revised guidance on the application of the two-part analysis. USPTO, 2019

Revised Patent Subject Matter Eligibility Guidance, 84 Fed. Reg. 50 (January 7, 2019) (“Memorandum”). Under that guidance, we first look to whether the claim recites:

(1) any judicial exceptions, including certain groupings of abstract ideas (i.e., mathematical concepts, certain methods of organizing human activity such as a fundamental economic practice, or mental processes) (*see id.* at 54 (step 2A, prong one)); and

(2) additional elements that integrate the judicial exception into a practical application (*see id.* at 54–55 (step 2A, prong two); MPEP §§ 2106.05(a)–(c), (e)–(h)).

See Memorandum, 84 Fed. Reg. at 52–55.

Only if a claim (1) recites a judicial exception and (2) does not integrate that exception into a practical application, do we then look to whether the claim:

(3) adds a specific limitation beyond the judicial exception that is not “well-understood, routine, conventional” in the field (*see* MPEP § 2106.05(d)); or

(4) simply appends well-understood, routine, conventional activities previously known to the industry, specified at a high level of generality, to the judicial exception.

See Memorandum, 84 Fed. Reg. at 56.

Memorandum step 2A, prong one

In rejecting claim 1 as being directed to patent-ineligible subject matter, the Examiner determines that claim 1 “is directed to displaying [an] interface for signing in (with optional limitations that may or may not

occur)” and thus is directed to an abstract idea in the form of a “fundamental economic practice long prevalent in our system of commerce.” Final Act. 6; *see also* Ans. 3.

We agree with the Examiner that claim 1—which includes recitations directed to receiving and using *a username and password* and recitations in the alternative directed to authentication using mobile phone without using *a username and password*—recites an abstract idea. Final Act. 6. In particular, claim 1 recites steps related to controlling access to resources, which represents a certain method of organizing human activity (e.g., enforcing a degree of ownership and control over a resource). *See, e.g., Prism Techs. LLC v. T-Mobile USA, Inc.*, 696 F. App’x 1014, 1017 (Fed. Cir. 2017) (citing *In re TLI Commc’ns LLC Patent Litig.*, 823 F.3d 607, 613 (Fed. Cir. 2016); *Intellectual Ventures I LLC v. Capital One Bank (USA)*, 792 F.3d 1363, 1367 (Fed. Cir. 2015)).

Memorandum step 2A, prong two

Appellants contend the Examiner erred because “[i]n finding that the claims were directed simply to ‘*displaying an interface and signing in*’ the Examiner oversimplified **presence detection by a remote computer as an alternative to password login on a host** of the claims and downplayed the invention’s benefits.” Appeal Br. 17; *see also* Reply Br. 9 (“[s]imply because the claim includes the term ‘if’ does not mean that it is a limitation that may or may not occur. Instead, it is a limitation that is included in the method and represents a branch of the algorithm.”).

We do not agree with Appellants that the claimed alternative to password login steps may be sufficient to make claim 1 patent-eligible (e.g., by representing a practical application of the underlying abstract idea). In

particular, the recited steps providing an alternative to a password login on a host are recited as *conditional recitations*. That is, in at least one scenario—such as the user selecting to sign in using a username and password rather than via a mobile phone—the conditional recitations need not be performed. *See Ex parte Schulhauser*, Appeal No. 2013-007847, 2016 WL 6277792, at *5 (PTAB 2016) (precedential) (the broadest reasonable interpretation of a claim to a method excludes conditional steps that need not be performed). Thus, we need only consider whether the embodiment that uses a *username and password* login integrates the underlying abstract idea into a practical application. *Cf. Mentor Graphics Corp. v. EVE-USA, Inc.*, 851 F.3d 1275, 1295 (Fed. Cir. 2017) (citing MPEP § 2106 (9th ed. Mar. 2014)) (“a claim [that] covers ‘both statutory and non-statutory embodiments,’ . . . is not eligible for patenting”).

The use of usernames and passwords (i.e., evidence to identify and authenticate an entity requesting access to a resource) claimed without, for example, any particular technique for determining whether the username and password are correct amounts to the equivalent of merely reciting use of a computer to control access to a resource. *See Memorandum*, 84 Fed. Reg. at 55 (citing, e.g., *Alice*, 573 U.S. at 222–26). “Given the ubiquity of computers wholly generic computer implementation is not generally the sort of additional feature that provides any practical assurance that the process is more than a drafting effort designed to monopolize the abstract idea itself.” *Alice*, 573 U.S. at 223–24 (citations omitted) (internal quotation marks and alteration indications omitted).

For these reasons, we determine that claim 1, which does not recite additional elements sufficient to integrate the recited abstract idea into a practical application, is directed to the abstract idea.

Memorandum step 2B

The Examiner further determines that:

[t]he use of a computer implementing the abstract idea [of claim 1] does not render the claim patent eligible because it does not provide meaningful limitations beyond generally linking the use of an abstract idea to a particular technology environment and requires no more than a generic computer to perform generic computer functions.

Final Act. 7.

The Examiner’s determinations are reasonable and Appellants do not contest the Examiner’s rejection under *Alice* step 2. Appeal Br. 19 (“[b]ecause the claims are not directed to an abstract idea under step one of the *Alice* analysis, we do not need to proceed to step two of that analysis”).

Accordingly, we sustain the Examiner’s 35 U.S.C. § 101 rejection of claim 1, and claims 2, 4, and 6–19, which Appellants do not argue separately. Appeal Br. 23.

35 U.S.C. § 103(A)

In rejecting claim 1 as obvious, the Examiner finds, and Appellants acknowledge, that Labrou teaches or suggests use of a *username and password* to sign a user into an account. Final Act. 10 (citing Labrou ¶ 78); *see also* Appeal Br. 26. Appellants contends, however, the Examiner erred in finding that Labrou, even in combination with Seidl and Yared, teaches or suggests recitations related to a *user signing in via a mobile phone*. *See* Appeal Br. 26 (“Logging in using a mobile phone is not the same as

presence detection by a remote computer”), 27 (“**The combination of references thus fails to teach or suggest presence detection by remote computer as an alternative to password log in on a host**”); *see also* Reply Br. 30–38.

Appellants’ arguments are unpersuasive of error because the disputed recitations are *conditional recitations* that need not be performed. *See Schulhauser*, 2016 WL 6277792, at *5. Therefore, the Examiner’s findings showing that Labrou teaches or suggests recitations related to the use of a *username and password* are sufficient to show that claim 1, given its broadest reasonable interpretation, would have been obvious in light of the combined teachings and suggestions of Labrou, Seidl, and Yared. Final Act. 10.

Accordingly, we sustain the Examiner’s 35 U.S.C. § 103(a) rejection of claim 1, and claims 2, 4, and 6–19, which Appellants do not argue separately. Appeal Br. 27.

DECISION

We reverse the Examiner's decision rejecting claims 1 and 19 under 35 U.S.C. § 112, first paragraph.

We reverse the Examiner's decision rejecting claims 1 and 19 under 35 U.S.C. § 112, second paragraph.

We affirm the Examiner's decision rejecting claims 1, 2, 4, and 6–19 under 35 U.S.C. § 101.

We affirm the Examiner's decision rejecting claims 1, 2, 4, and 6–19 under 35 U.S.C. § 103(a).

We affirm the Examiner's decision rejecting claims 1, 2, 4, and 6–19.

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. § 41.50(f).

AFFIRMED