UNITED STATES PATENT AND TRADEMARK OFFICE

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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 MARC CASTRECHINI, MARKIYAN MALKO, and
HENRY HELGESON
_____

Appeal 2018-007900[1]
Application 14/214,518
Technology Center 3700
_____

Before HUBERT C. LORIN, NINA L. MEDLOCK, and
MATTHEW S. MEYERS, *Administrative Patent Judges*.

MEYERS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant[2] appeals under 35 U.S.C. § 134(a) from the Examiner's
Final Rejection of claims 10–13 and 19–21, which constitute all the claims
pending in this Application.[3] We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

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[1] Our decision references Appellant's Appeal Brief ("App. Br.," filed April
16, 2018) and Reply Brief ("Reply Br.," filed July 31, 2018), and the
Examiner's Answer ("Ans.," mailed May 31, 2018) and Final Office Action
("Final Act.," mailed May 16, 2017).
[2] Appellant identifies "Cayan LLC" as the real party in interest. App. Br. 3.
[3] Claim 3 is canceled and claims 1, 2, 4–9 and 14–18 are withdrawn. *See*
App. Br. 18–20.

CLAIMED INVENTION

Appellant's claimed invention relates "generally to payment processing and customer engagement platforms." Spec. ¶ 3.

Claim 10, reproduced below with bracketed notations, is the sole independent claim on appeal:

> 10. A computer-implemented payment collection method, comprising:
> [(a)]   at a server comprising a processor and memory storing instructions that, when executed by the processor, cause the server to:
>> [(b)]   receive a payment token request from a mobile electronic device;
>> [(c)]   generate a payment token associated with an account associated with the mobile electronic device;
>> [(d)]   send the payment token to the mobile electronic device;
>> [(e)]   receive a payment request including information from the payment token from a consumer engagement device;
>> [(f)]   retrieve, based at least in part on the payment token, payment information associated with the account;
>> [(g)]   authorize the payment request using the retrieved payment information; and
>> [(h)]   in response to authorizing the payment request, send a payment confirmation to the consumer engagement device.

REJECTIONS

1.   Claims 10–13 and 19–21 are rejected under 35 U.S.C. § 101 as directed to a judicial exception without significantly more.

2.   Claims 10–13 and 19–21 are rejected under 35 U.S.C. § 102(e) as anticipated by Brown et al. (US 2014/0100973 A1, pub. Apr. 10, 2014) ("Brown").

ANALYSIS

Patent-Ineligible Subject Matter

Appellant argues claims 10–13 and 19–21 as a group (s*ee* Appeal Br. 7–14; *see also* Reply Br. 2–6). We select independent claim 10 as representative. Claims 11–13 and 19–21 stand or fall with independent claim 10. *See* 37 C.F.R. § 41.37(c)(1)(iv).

Under 35 U.S.C. § 101, an invention is patent-eligible if it claims a "new and useful process, machine, manufacture, or composition of matter." 35 U.S.C. § 101. However, the Supreme Court has long interpreted 35 U.S.C. § 101 to include implicit exceptions: "[l]aws of nature, natural phenomena, and abstract ideas" are not patentable. *E.g.*, *Alice Corp. v. CLS Bank Int'l*, 573 U.S. 208, 216 (2014).

In determining whether a claim falls within an excluded category, we are guided by the Supreme Court's two-step framework, described in *Mayo* and *Alice*. *Alice*, 573 U.S. at 217–18 (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 75–77 (2012)). In accordance with that framework, we first determine what concept the claim is "directed to." *See id.* at 219 ("On their face, the claims before us are drawn to the concept of intermediated settlement, *i.e.*, the use of a third party to mitigate settlement risk."); *see also Bilski v. Kappos*, 561 U.S. 593, 611 (2010) ("Claims 1 and 4 in petitioners' application explain the basic concept of hedging, or protecting against risk.").

Concepts determined to be abstract ideas, and thus patent ineligible, include certain methods of organizing human activity, such as fundamental economic practices (*Alice*, 573 U.S. at 219–20; *Bilski*, 561 U.S. at 611); mathematical formulas (*Parker v. Flook*, 437 U.S. 584, 594–95 (1978)); and

mental processes (*Gottschalk v. Benson*, 409 U.S. 63, 69 (1972)). Concepts determined to be patent eligible include physical and chemical processes, such as "molding rubber products" (*Diamond v. Diehr*, 450 U.S. 175, 192 (1981)); "tanning, dyeing, making water-proof cloth, vulcanizing India rubber, smelting ores" (*id.* at 182 n.7 (quoting *Corning v. Burden*, 56 U.S. 252, 267–68 (1854))); and manufacturing flour (*Gottschalk*, 409 U.S. at 69 (citing *Cochrane v. Deener*, 94 U.S. 780, 785 (1876))).

If the claim is "directed to" an abstract idea, we turn to the second step of the *Mayo/Alice* framework, where "we must examine 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." *Alice*, 573 U.S. at 221 (quotation marks omitted). "A claim that recites an abstract idea must include 'additional features' to ensure 'that the [claim] is more than a drafting effort designed to monopolize the [abstract idea].'" *Id.* (alterations in original) (quoting *Mayo*, 566 U.S. at 77). "[M]erely requir[ing] generic computer implementation[] fail[s] to transform that abstract idea into a patent-eligible invention." *Id.*

The PTO recently published revised guidance on the application of § 101. 2019 REVISED PATENT SUBJECT MATTER ELIGIBILITY GUIDANCE, 84 Fed. Reg. 50 (Jan. 7, 2019) ("2019 Revised Guidance"). 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); and

(2) additional elements that integrate the judicial exception into a practical application, i.e., that "apply, rely on, or use 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 Guidance, 84 Fed. Reg. at 53; *see also* MPEP § 2106.05(a)–(c), (e)–(h).

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 2019 Revised Guidance.

Appellant argues that "the claimed invention is a *new technique* that is *an improvement in a fundamentally computer-based transaction processing system*" and thus "not merely an abstract idea or fundamental economic practice" (App. Br. 8). According to Appellant, the Examiner erred in determining that the present claims are directed to an abstract idea and the Examiner's characterization is "a gross oversimplification of the claims and attempts to describe them at a level of abstraction that is entirely untethered from the claim language" (*id.* at 9). We do not agree.

Under the first prong of step 2A of the 2019 Revised Guidance, we first determine if the claims recite an abstract idea. In this regard, we note that the Specification is titled "VAULT PLATFORM METHODS, APPARATUSES AND MEDIA," and states that "people find it

inconvenient to carry cash and/or electronic payment cards (e.g., credit cards, debit cards)" (Spec. ¶ 45). According to the Specification, the inventors addressed this problem by providing "VAULT PLATFORM METHODS, APPARATUSES AND MEDIA (hereinafter 'VP')" (*id.* ¶ 2). The Specification describes that "[t]he VP facilitates customer purchases of items by allowing customers to pay for items without having to carry cash or electronic payment cards" (*id.* ¶ 46). As part of the process, "[a] customer may register for a merchant's (e.g., a gym's) VP mobile app and provide payment information (e.g., credit card information) regarding a payment method that the customer wishes to use (e.g., when purchasing items from the merchant)" (*id.*). Then, "[w]hen the customer wishes to purchase an item (e.g., a soda from the gym's vending machine, a personal training session), the customer may use the merchant's VP mobile app to request a payment token (e.g., a [quick response] QR code)" (*id.*). The customer may utilize the customer's mobile device to transmit the payment token to the merchant's customer engagement device (CED), point of sale (POS) system, mobile device with POS software, and/or the like (*id.*). For example, the customer may "hold the QR code displayed on the mobile device's screen in front of the vending machine CED's camera, in front of a POS system's barcode reader, [or] in front of a POS mobile device's camera" (*id.*). The VP may facilitate retrieving the customer's registered payment information using the QR code and processing the purchase transaction using the retrieved payment information (*id.*).

Consistent with this description, independent claim 10 recites "[a] computer-implemented payment collection method," including "at a server comprising a processor and memory storing instructions that, when

executed by the processor, cause the server to" perform seven steps including: (b) "receive a payment token request from a mobile electronic device," (c) "generate a payment token . . . ," (d) "send the payment token to the mobile electronic device," (e) "receive a payment request . . . ," (f) "retrieve . . . payment information," (g) "authorize the payment request . . . ," and (h) "in response to authorizing the payment request, send a payment confirmation to the consumer engagement device."

Upon reviewing the Specification and the claim as whole, as summarized above, we agree with the Examiner that independent claim 10 recites broadly "collecting a payment" (Final Act. 5), which can be characterized as a "fundamental economic practice" (*id.*). Here, independent claim 10 receives information (i.e., a payment token request), generates information (i.e., a payment token), transmits information (i.e., the payment token), receives information (i.e., a payment request), retrieves information (i.e., payment information), analyzes information (i.e., authorizes the payment request), and transmits information (i.e., sends a payment confirmation). In other words, claim 10 recites a method for collecting payment by gathering, transmitting, analyzing, and generating the specified information.

Thus, it is clear that independent claim 10 recites a form of financial transaction that, under the Revised Guidance, falls under the category of "[c]ertain methods of organizing human activity" and more specifically "fundamental economic principles or practices . . . commercial or legal interactions (including agreements in the form of contracts; legal obligations; . . . sales activities or behaviors; business relations)." 2019 Revised Guidance, 84 Fed. Reg. at 52. Accordingly, independent

claim 10 recites an abstract idea. *Cf. buySAFE, Inc. v. Google, Inc.*, 765 F.3d 1350, 1355 (Fed. Cir. 2014) (guaranteeing transactions), *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1372–73 (Fed. Cir. 2011) (verifying the validity of credit card transactions over the Internet), and *Smart Sys. Innovation, Inc. v. Chicago Transit Auth.*, 873 F.3d 1364, 1371–72 (Fed. Cir. 2017) (forming and collecting data for financial transactions in a certain field); *Inventor Holdings, LLC v. Bed Bath & Beyond Inc.*, 876 F.3d 1372 (Fed. Cir. 2017) (claims directed to the use of a POS terminal to transmit transaction-related information and to process payments held invalid under 35 U.S.C. § 101).

Having concluded that claim 10 recites a judicial exception, i.e., an abstract idea, we turn to the second prong of step 2A of the 2019 Revised Guidance and determine whether the claim integrates the recited judicial exception into a practical application of the judicial exception. Here we look to see if, for example, (i) any additional elements of the claim reflects an improvement in the functioning of a computer or to another technological field, (ii) an application of the judicial exception with, or by use of, a particular machine, (iii) a transformation or reduction of a particular article to a different state or thing, or (iv) a use of the judicial exception in some other meaningful way beyond generally linking the use of the judicial exception to a particular technological environment. *See* 2019 Revised Guidance, 84 Fed. Reg. at 55; *see also* MPEP § 2106.05(a)–(c), (e)–(h).

We find no indication in the Specification, nor does Appellant direct us to any indication, that the steps recited in independent claim 10 invoke any assertedly inventive programming, require any specialized computer hardware or other inventive computer components, i.e., a particular machine,

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or effect a transformation or reduction of a particular article to a different state or thing. Nor do we find anything of record, short of attorney argument, that attributes any improvement in computer technology and/or functionality to the claimed invention or that otherwise indicates that the claimed invention "appl[ies], rel[ies] on, or us[es] 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 Guidance, 84 Fed. Reg. at 53.

Appellant argues that "there is no evidence or explanation as to how the claimed token-passing process is somehow so well-known and fundamental as to amount to a 'building block of human ingenuity'" (App. Br. 9). According to Appellant, "[t]hese processes are not old, well-established, fundamental ideas, nor has any evidence been cited suggesting that they are old, well-established, fundamental ideas" (*id.*). That argument is not persuasive of Examiner error because there is no requirement that Examiners show that the abstract idea recited by a claim is "well-known and fundamental." Indeed, "a claim for a *new* abstract idea is still an abstract idea." *Synopsys, Inc. v. Mentor Graphics Corp.*, 839 F.3d 1138, 1151 (Fed. Cir. 2016). And, Appellant cannot reasonably contend that collecting payment for goods or services is not a fundamental economic practice. *Cf. Inventor Holdings*, 876 F.3d at 1378 ("The idea that a customer may pay for items ordered from a remote seller at a third-party's local establishment is the type of fundamental business practice that, when implemented using generic computer technology, is not patent-eligible under *Alice*.").

The Federal Circuit has held that "[t]he patent eligibility inquiry may contain underlying issues of fact." *Berkheimer v. HP Inc.*, 881 F.3d 1360,

1365 (Fed. Cir. 2018) (quoting *Mortg. Grader, Inc. v. First Choice Loan Servs. Inc.*, 811 F.3d 1314, 1325 (Fed. Cir. 2016)) ("The § 101 inquiry 'may contain underlying factual issues.'"). "When there is no genuine issue of material fact regarding whether the claim element or claimed combination is well-understood, routine, [and] conventional to a skilled artisan in the relevant field, this issue can be decided on summary judgment as a matter of law." *Berkheimer*, 881 F.3d at 1368; *see also Aatrix Software, Inc. v. Green Shades Software, Inc.*, 890 F.3d 1354, 1368 (Fed. Cir. 2018) ("A factual allegation or dispute should not automatically take the determination out of the court's hands; rather, there needs to be justification for why additional evidence must be considered–the default being a legal determination."). Thus, evidence may be helpful where, for instance, facts are in dispute, but evidence is not always necessary.

Here, Appellant has not persuaded us that a factual dispute has arisen and evidence is necessary to resolve such a dispute. Appellant does not dispute the Examiner's specific determinations (*see, e.g.*, Final Act. 2–6 and 8–9; *see also* Ans. 3–5) that the claims contain generic computer components which perform generic computer functions. Nor would there necessarily be a genuine factual dispute had Appellant more specifically contested the Examiner's determination.

"In *Berkheimer*, there was such a genuine dispute for claims 4–7, but not for claims 1–3 and 9." *Berkheimer*, 890 F.3d at 1371 (Moore, J., concurring).

> [I]n accordance with *Alice*, we have repeatedly recognized the absence of a genuine dispute as to eligibility for the many claims that have been defended as involving an inventive concept based merely on the idea of using existing

computers or the Internet to carry out conventional processes,
with no alteration of computer functionality.

Id. at 1373 (Moore, J., concurring). Here, independent claim 10 provides for a "computer-implemented payment collection method" that calls for "at a server comprising a processor and memory storing instructions that, when executed by the processor, cause the server to" perform seven steps. Thus, the seven steps (b) through (h) are performed by the server. The first of these steps calls for the server to "receive a payment token request from a mobile electronic device." The second step calls for the server to "generate a payment token associated with an account associated with the mobile electronic device." The third step calls for the server to "send the payment token to the mobile electronic device." The fourth step calls for the server to "receive a payment request including information from the payment token from a consumer engagement device." The fifth step calls for the server to "retrieve, based at least in part on the payment token, payment information associated with the account." The sixth step calls for the server to "authorize the payment request using the retrieved payment information." The seventh step calls for the server to "in response to authorizing the payment request, send a payment confirmation to the consumer engagement device."

All of these functions are common to generic computers. "Taking the claim elements separately, the function performed by the computer at each step of the process is '[p]urely conventional.'" *Alice*, 573 U.S. at 225 (citing *Mayo*, 566 U.S. at 79). "Considered 'as an ordered combination,' the computer components of [Appellant's] method 'ad[d] nothing . . . that is not already present when the steps are considered separately." *Id*. *Cf. buySAFE*,

Inc. v. Google, Inc., 765 F.3d 1350, 1355 (Fed. Cir. 2014) (Stating "[t]hat a computer receives and sends the information over a network–with no further specification–is not even arguably inventive."); *In re Katz*, 639 F.3d 1303, 1316 (Fed. Cir. 2011) ("Absent a possible narrower construction of the terms 'processing,' 'receiving,' and 'storing,' discussed below, those functions can be achieved by any general purpose computer without special programming"); *Inventor Holdings*, 876 F.3d at 1378 (holding that considering claims reciting data retrieval, analysis, modification, generation, display, and transmission as an "'ordered combination'" reveals that they "amount to 'nothing significantly more' than an instruction to apply [an] abstract idea" using generic computer technology) (internal citation omitted).

Citing *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327 (Fed. Cir. 2016), Appellant argues that "even claims that merely run on general purpose computers (e.g., using computers as tools) may be patentable" (App. Br. 10). As the court in *Enfish* explained, the relevant inquiry is "whether the focus of the claims is on the specific asserted improvement in computer capabilities . . . or, instead, on a process that qualifies as an 'abstract idea' for which computers are invoked merely as a tool." *Enfish*, 822 F.3d at 1335–36. Appellant contends that "the claimed invention improves on *computer-related technology*, and in particular on *computer-implemented payment processing techniques*" (App. Br. 10) (emphasis added). But the fact that a claimed invention is computer-related or computer-implemented does not imply that the claims are patent-eligible. *See, e.g.*, *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1256 (Fed. Cir. 2014) ("[A]fter *Alice*, there can remain no doubt: recitation of generic computer limitations

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does not make an otherwise ineligible claim patent-eligible. The bare fact that a computer exists in the physical rather than purely conceptual realm is beside the point." (Internal citations and quotation marks omitted)).

Appellant argues that "the application describes a problem of making purchases without cash or bank cards" and "solving this problem with a technique that includes **generating a payment token** and **providing the payment token to a user's mobile device**, where the payment token is returned to the server to complete a transaction without a bank card" (App. Br. 10). *See also id.* at 11 ("The claims in the present application solve the problem of how to allow users to purchase items using a network-connected smartphone, and without a bank card, in a secure and efficient manner."). According to Appellant, this solution "improves a computer or other technology" (*id.* at 10). But Appellant has not adequately explained how generating a payment token and providing the payment token to a user's mobile device improves the capabilities of the mobile device, as opposed to merely using the mobile device as a tool to implement the abstract idea of collecting payment by receiving and displaying information. For example, Appellant has not offered any evidence or persuasive technical reasoning to explain how the claimed method improves the security or efficiency of the claimed server, mobile computing device, or consumer engagement device. Mere conclusory statements that are unsupported by factual evidence are entitled to little probative weight. *In re Geisler*, 116 F.3d 1465, 1470 (Fed. Cir. 1997); *see also In re De Blauwe*, 736 F.2d 699, 705 (Fed. Cir. 1984).

Appellant further argues that "[j]ust like the invention in *DDR*, the claimed invention is clearly directed to a particular way to achieve a desired

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outcome" (App. Br. 11). According to Appellant, the claims "provide the unique outcome of allowing a user to pay for items using a payment token that is generated by a server and sent to a mobile electronic device" and "[t]his process and outcome did not exist prior to the efforts of the inventors, as embodied in the rejected claims" (*id.*).

To the extent Appellant maintains that the claimed invention is patent-eligible because the claims provide a "unique outcome" that did not exist in the prior art, Appellant misapprehends the controlling precedent.

Neither a finding of novelty nor a non-obviousness determination automatically leads to the conclusion that the claimed subject matter is patent-eligible. Although the second step in the *Mayo/Alice* framework is termed a search for an "inventive concept," the analysis is not an evaluation of novelty or non-obviousness, but rather, a search for "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 (citation omitted). "Groundbreaking, innovative, or even brilliant discovery does not by itself satisfy the § 101 inquiry." *Ass'n for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576, 591 (2013). A novel and non-obvious claim directed to a purely abstract idea is, nonetheless, patent-ineligible. *See Mayo*, 566 U.S. at 90; *see also Diamond*, 450 U.S. at 188–89 ("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.").

We find no parallel to the claims in *DDR Holdings*. In that case, the Federal Circuit determined that the claims addressed the problem of

retaining website visitors who, if adhering to the routine, conventional functioning of Internet hyperlink protocol, would be transported instantly away from a host's website after clicking on an advertisement and activating a hyperlink. *DDR Holdings*, 773 F.3d at 1257. The court noted that "the claims at issue here specify how interactions with the Internet are manipulated to yield a desired result–a result that overrides the routine and conventional sequence of events ordinarily triggered by the click of a hyperlink." *Id.* at 1258. The Federal Circuit, thus, held that the claims were directed to statutory subject matter because they claim a solution "necessarily rooted in computer technology in order to overcome a problem specifically arising in the realm of computer networks." *Id.* at 1257.

Claim 10 does not, for example, purport to override the conventional sequence of events ordinarily triggered by the click of a hyperlink to recite an invention that is "not merely the routine or conventional use of the Internet." *DDR Holdings*, 773 F.3d at 1259. Nor does it purport to improve the functioning of the computer itself. Nor does it effect an improvement in any other technology or technical field. Instead, claim 10, viewed as a whole and in light of the Specification, amounts to nothing significantly more than an instruction to apply the abstract idea of "collecting a payment" using a generic computer (Final Act. 5), which under our precedents, is not enough to transform an abstract idea into a patent-eligible invention. *See Alice*, 573 U.S. at 226.

Turning to Step 2B of the of the 2019 Revised Guidance, we determine whether the additional elements (1) add a specific limitation or combination of limitations that is not well-understood, routine, and conventional activity in the field, which is indicative that an inventive

concept may be present or (2) simply append well-understood, routine, conventional activities previously known to the industry, specified at a high level of generality, to the judicial exception, which is indicative that an inventive concept may not be present. *See* 2019 Revised Guidance, 84 Fed. Reg. at 56.

The Examiner determined that "the only other element in the claims besides the abstract ideas identified above is the server and mobile electronic device." Final Act. 5. According to the Examiner, "the limitations, in the instant claims, are done by the generically recited server and mobile electronic device." *Id.* at 3; *see also* Ans. 5 ("the recited elements of the claims fail to provide 'something more' to the generic computer elements of the server and mobile electronic device."). We agree with the Examiner that the additional limitations of "a server comprising a processor and memory" and "a mobile electronic device" (*see* Final Act. 3–5) simply allow a generic computer to perform the claimed operations using generic computer functions. In the present invention, payment information is generated and transmitted for addressing a business problem of allowing users to purchase items using a network-connected smartphone.

Appellant argues that independent "claim 10 lists a particular method that includes a particular set of operations and communications to facilitate cardless, smartphone-based payment processing" (App. Br. 12). According to Appellant:

> Viewed together, this "ordered combination" of additional elements describes a unique process that receives a payment token request from a mobile electronic device, generates a payment token in response to the request, sends the payment token to the mobile electronic device, receives a payment

> request from a consumer engagement device (e.g., a merchant's
> computer system), and authorizes the payment.

Id. (reproducing Figure 4 of Appellant's Specification). Appellant contends that "the ordered combination describes an inventive process in which real-time purchasing is made possible, via a smartphone, without requiring a user to have bank cards or cash" and is therefore analogous to the situation in *BASCOM Global Internet Servs., Inc. v. AT&T Mobility LLC*, 827 F.3d 1341 (Fed. Cir. 2016) (*see* App. Br. 13–14). However, Appellant does not persuasively explain how, and we do not see how, Appellant's claim 10 parallels the claims in *BASCOM*, which recited a "non-conventional and non-generic arrangement of known, conventional pieces" within a network, the arrangement of elements being "a technical improvement over [the] prior art ways of filtering." *BASCOM*, 827 F.3d at 1350. Claim 10 does not require any specific arrangement of computer components on a network. Indeed, claim 10 does not recite any network. Claim 10 merely calls for a server to send and receive information, via some unspecified communication medium, to and from (1) a mobile electronic device and (2) a consumer engagement device. As described in the Specification, the claimed communication medium may comprise a web server communicating with a web browser via a computer network.[4] *Cf. Intellectual Ventures I LLC v.*

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[4] *See* Spec. ¶ 124 ("In some implementations, the operating environment component may include an information handling subcomponent. The information handling subcomponent may provide the VP with capabilities to serve, deliver, upload, obtain, present, download, and/or the like a variety of information."); *id.* ¶ 125 ("In some embodiments, the information handling subcomponent may facilitate the serving of information to users, VP components, nodes in a computer network, web browsers, and/or the like. For example, the information handling subcomponent may comprise a web

Capital One Bank (USA), 792 F.3d 1363, 1370 (Fed. Cir. 2015) (holding that "the interactive interface limitation is a generic computer element" that does not amount to an inventive concept because "the 'interactive interface' simply describes a generic web server with attendant software, tasked with providing web pages to and communicating with the user's computer").

Appellant's other arguments, including those directed to now superseded USPTO guidance, have been considered but are not persuasive of error. (*See* 2019 Guidance, 84 Fed. Reg. at 51 ("Eligibility-related guidance issued prior to the Ninth Edition, R–08.2017 of the MPEP (published Jan. 2018) should not be relied upon.").).

We are not persuaded, on the present record, that the Examiner erred in rejecting independent claim 10 under 35 U.S.C. § 101. Therefore, we sustain the Examiner's rejection of independent claim 10, and claims 11–13 and 19–21 which fall with independent claim 10.

Anticipation

We are persuaded by Appellant's argument that the Examiner erred in rejecting independent claim 10 as anticipated by Brown because "figures 1C, 1D, and 3B and the Abstract of Brown '973, which were cited against

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server such as Apache HTTP Server, Microsoft Internet Information Services (IIS), Oracle WebLogic Server, Adobe Flash Media Server, Adobe Content Server, and/or the like."); *id.* ¶ 126 ("In some embodiments, the information handling subcomponent may facilitate presentation of information obtained from users, VP components, nodes in a computer network, web servers, and/or the like. For example, the information handling subcomponent may comprise a web browser such as Microsoft Internet Explorer, Mozilla Firefox, Apple Safari, Google Chrome, Opera Mobile, Amazon Silk, Nintendo 3DS Internet Browser, and/or the like.")

claim 10, are not found anywhere in the applications to which Brown '973

claims priority (including Brown '293)" (Appeal Br. 15–16; *see also* Reply

Br. 6).

We begin by noting that the present application is a non-provisional

that claims benefit of priority to U.S. Provisional Application

No. 61/787,176, filed March 15, 2013.

We also note that the Brown reference, U.S. Application

No. 14/098,840, filed December 6, 2013, is a continuation-in-part and claims

benefit of multiple earlier applications including U.S. Application No.

12/983,186, filed December 31, 2010, now U.S. Patent No. 8,224,293 (the

'293 patent).

The Examiner takes the position that the rejection is proper because

the content of Brown '973, on which the Examiner relies, is supported by

disclosure in the earlier-filed '293 patent. *See* Final Act. 9–10; Ans. 5–6.

On this record, we agree with Appellant that the Examiner has not

established that the '293 patent application reasonably supports the portions

of Brown cited by the Examiner in making the rejections of certain claim

limitations. Although the '293 patent application antedates the present

application's earliest effective filing date, the Brown reference, relied upon

by the Examiner, constitutes prior art only for subject matter properly

supported by the earlier application in accordance with 35 U.S.C. § 112, first

paragraph. *See In re Giacomini*, 612 F.3d 1380, 1383–85 (Fed. Cir. 2010);

see also Ex parte Yamaguchi, 88 USPQ2d 1606, 1609 (BPAI 2008)

(precedential).

Here, the Examiner has not shown sufficiently that the '293 patent

application provides such support through any factual findings or reference

to the '293 patent. In this regard, the Examiner takes the position that "the 8,224,293 patent discloses the use of colorgrams on a mobile device for making financial transactions, and has a priority date of December 31, 2010" and "in the Brown '973 reference it is disclosed that a barcode matrix is a colorgram (paragraph [0018])." Ans. 6. However, as Appellant points out (App. Br. 15), the Examiner's rejection of claim 10 relies on portions of Brown beyond the disclosure of barcodes. For example, as to the limitation of "receive a payment request . . . from a consumer engagement device," the Examiner cites Figures 1C, 1D, and 3B. Final Act. 7. As to the Appellant's argument that the '293 patent lacks support for Figures 1C, 1D, and 3B of Brown, the Examiner provides no response in the Examiner's Answer (*see, e.g.*, Ans. 5–6). Thus, we agree with Appellant that on the record the Examiner has failed to establish that the Brown reference is prior art for the relied upon subject matter.

In view of the foregoing, we do not sustain the Examiner's rejection of independent claim 10 under 35 U.S.C. § 102(e). For the same reasons, we also do not sustain the Examiner's rejection of claims 11–13 and 19–21.

CONCLUSION

In summary:

Claims Rejected	Basis	Affirmed	Reversed
10–13, 19–21	§ 101	10–13, 19–21	
10–13, 19–21	§ 102(e) Brown		10–13, 19–21
Overall Outcome		10–13, 19–21	

DECISION

The Examiner's rejection of claim 10–13 and 19–21 under 35 U.S.C. § 101 is affirmed.

The Examiner's rejection of claims 10–13 and 19–21 under 35 U.S.C. § 102(e) is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED