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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte PATRICK LEE FAITH, MARK STEVEN CARLSON, and
KRISHNA P. KOGANTI

Appeal 2019-002817
Application 12/757,461
Technology Center 3600

Before MURRIEL E. CRAWFORD, JOSEPH A. FISCHETTI, and
ROBERT J. SILVERMAN, *Administrative Patent Judges*.

FISCHETTI, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant seeks our review under 35 U.S.C. § 134 of the Examiner's final rejection of claims¹. We have jurisdiction under 35 U.S.C. § 6(b).

SUMMARY OF DECISION

We AFFIRM.

¹ We use the word "Appellant" to refer to "Applicant" as defined in 37 C.F.R. § 1.42(a). Appellant identifies the real party in interest as VISA U.S.A. Inc. Appeal Br. 3.

THE INVENTION

Appellant states, “[t]he present invention relates to a data processing system, and more particularly to a system for managing tailored marketing to users of wireless devices adapted to wirelessly access a computer network.” Spec. ¶ 1.

Claim 1 is representative of the subject matter on appeal.

1. A system for managing tailored marketing to users of wireless devices adapted to wirelessly access a computer network, comprising:

- a user database storing a plurality of user records, each user record initially storing a user identifier and a device identifier that identifies a wireless device of a user;

- a management module executable by a processor, the management module being adapted to:

- transmit marketing information including a unique code to a selected wireless device while the selected wireless device is playing media content, the marketing information causing the selected wireless device to display the marketing information, the marketing information and the unique code being transmitted to the selected wireless device while the user record associated with the selected wireless device contains the user identifier and the device identifier of the selected wireless device but does not contain any financial account identifier associated with the user of the selected wireless device, and the unique code uniquely identifying the marketing information transmitted to the selected wireless device from other marketing information transmitted by the management module;

- store the unique code in the user record that contains the device identifier identifying the selected wireless device;

- receive a transaction authorization request for obtaining authorization to perform a financial transaction in response to the marketing information transmitted to the selected wireless device, the transaction authorization request containing the unique code that was transmitted with the marketing information and a financial account identifier that is not part of the user record associated with the device identifier of the

selected wireless device when the marketing information was transmitted to the selected wireless device;

query the user database using the received unique code to determine the user record that contains the unique code;

link the financial account identifier to the selected wireless device by adding the received financial account identifier that was previously not part of the user record into the determined user record after receiving the transaction authorization request that includes the unique code;

obtain, via the stored financial account identifier, user information about the user of the selected wireless device;

generate, based on the obtained user information, multiple tailored marketing information for transmission to the selected wireless device; and

track usage of the multiple tailored marketing information transmitted to the selected wireless device in a usage field of the user record that is associated with the selected wireless device, the usage field having a value indicating a number of times that the financial account identifier has been used to perform a financial transaction in response to the multiple tailored marketing information transmitted to the selected wireless device.

Appeal Br. 18–19.

THE REJECTION

The Examiner relies upon the following as evidence of unpatentability:

Mankoff	US 2003/0028518 A1	Feb. 6, 2003
Kirkland	US 2005/0033850 A1	Feb. 10, 2005
Silhavy	US 2005/0108521 A1	May 19, 2005
Amjadi	US 2007/0174259 A1	July 26, 2007
Logan	US 2008/0097632 A1	Apr. 24, 2008
Lin	US 2010/0121697 A1	May 13, 2010

The following rejections are before us for review.

Claims 1-11, 14-39 and 41-43 are rejected under 35 U.S.C. § 101.

Claims 1–3, 6, 8–10, 14–16, 18, 20–28, 31, 33–35, 37–39, 41, are rejected under 35 U.S.C. § 103(a) as being unpatentable over Mankoff (US 2003/0028518 A1) further in view of Logan (US 2008/0097632 A1) further in view of Official Notice. Final Act. 4.

Claims 4, 7, 19, 29, 32 and 43 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Mankoff, in view of Logan, in view of Official Notice and further in view of Kirkland (US 2005/0033850 A1). Final Act 9.

Claims 5, 17, and 30 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Mankoff in view of Logan in view of Official Notice and further in view of Amjadi (US 2007/0174259 A1). Final Act 10.

FINDINGS OF FACT

We adopt the Examiner's findings as set forth on pages 2–4 in the Final Office Action² and on pages 3–5 in the Examiner's Answer, concerning only the 35 U.S.C. § 101 rejection.

ANALYSIS

35 U.S.C. § 101 REJECTION

We will affirm the rejection of claims 1–11, 14–39 and 41–43 under 35 U.S.C. § 101.

The Appellant argues independent claim 1 as representative (Appeal Br. 8), thus making claim 1 the representative independent claim for this

² All references to the Final Office Action refer to the Final Office Action mailed on April 23, 2018.

group (independent claims 1, 16 and 26), and so the remaining claims and the claims which depend thereon stand or fall with claim 1. *See* 37 C.F.R. § 41.37(c)(1)(iv) (2015).

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: “[I]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*. *Id.* 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, 67 (1972)). Concepts determined to be patent eligible include physical and chemical processes, such as “molding rubber products” (*Diamond v. Diehr*, 450 U.S. 175, 191

(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 (*Benson*, 409 U.S. at 69 (citing *Cochrane v. Deener*, 94 U.S. 780, 785 (1876))).

In *Diehr*, the claim at issue recited a mathematical formula, but the Supreme Court held that “[a] claim drawn to subject matter otherwise statutory does not become nonstatutory simply because it uses a mathematical formula.” *Diehr*, 450 U.S. at 176; *see also id.* at 191 (“We view respondents’ claims as nothing more than a process for molding rubber products and not as an attempt to patent a mathematical formula.”). Having said that, the Supreme Court also indicated that a claim “seeking patent protection for that formula in the abstract . . . is not accorded the protection of our patent laws, . . . and this principle cannot be circumvented by attempting to limit the use of the formula to a particular technological environment.” *Id.* (citing *Benson* and *Flook*); *see, e.g., Diehr*, 450 U.S. at 187 (“It is now commonplace that an *application* of a law of nature or mathematical formula to a known structure or process may well be deserving of patent protection.”).

If the claim is “directed to” an abstract idea, we turn to the second step of the *Alice* and *Mayo* 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) (“Guidance”). Under the 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 (*see* Manual of Patent Examining Procedure (“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 Guidance.

The U.S. Court of Appeals for the Federal Circuit has explained that “the ‘directed to’ inquiry applies a stage-one filter to claims, considered in light of the [S]pecification, based on whether ‘their character as a whole is directed to excluded subject matter.’” *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335 (Fed. Cir. 2016) (quoting *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1346 (Fed. Cir. 2015)). It asks whether the focus of the claims is on a specific improvement in relevant technology

or on a process that itself qualifies as an “abstract idea” for which computers are invoked merely as a tool. *See id.* at 1335–36.

In so doing, as indicated above, we apply a “directed to” two prong test: 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.” Guidance at 53; *see also* MPEP § 2106.05(a)–(c), (e)–(h).

The Specification states, “it would be desirable to provide a system and method for more effectively sending marketing information which are tailored to individual users of the wireless devices.” Spec. ¶ 5. The Specification further states:

However, persons of ordinary skill in the art will appreciate that the novel features disclosed herein apply to all types of marketing information including, but not limited to, special sales, promotions, brand awareness building or the like. In addition, persons of ordinary skill in the art will appreciate that instead of a credit card, any type of a financial presentation device can be used to perform a financial transaction with a merchant. A financial presentation device is a device that can be presented to a seller of goods or services for payment, and includes, but are not limited to, credit cards, debit cards, prepaid cards, electronic benefit cards, charge cards, virtual cards, smart cards, key chain devices, personal digital assistants, cell phones, and stored value devices.

Spec. ¶ 19.

The preamble describes claim 1 as being “for managing tailored marketing to users of wireless devices.” Claim 1.

Understood in light of the Specification, claim 1, recites, in pertinent

part,

a user database storing a plurality of user records, each user record initially storing a user identifier and a device identifier...; ...transmit marketing information including a unique code to a selected wireless device while the selected wireless device is playing media content, the marketing information causing ... display [of] the marketing information, the marketing information and the unique code being transmitted...while the user record associated with the selected wireless device contains the user identifier and the device identifier of the selected wireless device but does not contain any financial account identifier associated with the user of the selected wireless device, and the unique code uniquely identifying the marketing information transmitted... from other marketing information transmitted...; store the unique code in the user record that contains the ...identifier...; receive a transaction authorization request for obtaining authorization to perform a financial transaction in response to the marketing information transmitted..., the transaction authorization request containing the unique code that was transmitted with the marketing information and a financial account identifier that is not part of the user record associated with the device identifier... when the marketing information was transmitted to the selected wireless device; query the user database using the received unique code to determine the user record that contains the unique code; link the financial account identifier ...by adding the received financial account identifier that was previously not part of the user record into the determined user record after receiving the transaction authorization request that includes the unique code; obtain, via the stored financial account identifier, user information about the user...; generate, based on the obtained user information, multiple tailored marketing information ...; and track usage of the multiple tailored marketing information ...in a usage field of the user record that is associated with the selected wireless device, the usage field having a value indicating a number of times that the financial account identifier has been used to perform a financial transaction in response to the multiple tailored marketing

information transmitted to the selected wireless device.

Thus, the Examiner found the claims are for “obtaining financial account identifier by transmitting a marketing information.” Final Act. 2. The Examiner then determined that the claims are similar to:

‘collecting information, analyzing it and displaying certain results of the collected [] analysis’ (Electric Power Group) as described in the steps ‘storing records ... , transmitting code ... , receiving code and financial account. ... , querying user database ... , storing identifier in a user record ... , obtaining financial account. ... , tracking usage’.

‘tailoring content based on information about the user’ (Int. Ventures v. Capital One Bank) as described in the steps ‘transmitting marketing information ... , generating tailored marketing information and tracking the marketing information’.

Id. at 3.

Based on the Examiner’s findings and the intrinsic evidence set forth above, we find that claim 1 is directed to collecting information, analyzing it and displaying certain results of the collected analysis using a unique code to associate one information with another because claim 1, at the least, requires, “link the financial account identifier to the selected wireless device by adding the received financial account identifier that was previously not part of the user record into the determined user record after receiving the transaction authorization request that includes the unique code.” Such association of information using an identifier and a unique code is a mental process. These steps mimic human thought processes of selecting certain information over others, i.e., evaluation, and creating perhaps with paper and pencil, graphic data interpretation perceptible only in the human mind. *See In re TLI Commc’ns LLC Patent Litig.*, 823 F.3d 607, 611 (Fed. Cir. 2016);

FairWarning IP, LLC v. Iatric Sys., Inc., 839 F.3d 1089, 1093–94 (Fed. Cir. 2016). The Federal Circuit has held similar concepts to be abstract. Thus, for example, the Federal Circuit has held that abstract ideas include the concepts of collecting data, analyzing the data, and reporting the results of the collection and analysis, including when limited to particular content. *See, e.g., Intellectual Ventures I LLC v. Capital One Fin. Corp.*, 850 F.3d 1332, 1340–41 (Fed. Cir. 2017) (identifying the abstract idea of organizing, displaying, and manipulating data); *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1354 (Fed. Cir. 2016) (characterizing collecting information, analyzing information by steps people go through in their minds, or by mathematical algorithms, and presenting the results of collecting and analyzing information, without more, as matters within the realm of abstract ideas). Thus, under the first prong, claim 1 recites the patent ineligible judicial exception of at least a mental process. *See* Guidance, 84 Fed. Reg. at 52.

In addition, we find that, because the claim also covers “generate, based on the obtained user information, multiple tailored marketing information,” and “receive a transaction authorization request for obtaining authorization to perform a financial transaction,” claim 1 also is directed to a commercial and legal interaction. Generating multiple tailored marketing information based on user input is similar to the concepts of customizing information based on known user information in *Intellectual Ventures I LLC v. Capital One Bank (USA)*, 792 F.3d 1363, 1369–70 (Fed. Cir. 2015) and customizing a user interface based on user selections in *Affinity Labs of Texas, LLC v. Amazon.com Inc.*, 838 F.3d 1266, 1271 (Fed. Cir. 2016). Commercial transactions even those which narrow “long-familiar

commercial transactions do[] not make the idea non-abstract for section 101 purposes.” *buySAFE, Inc. v. Google, Inc.*, 765 F.3d 1350, 1355 (Fed. Cir. 2014). Accordingly, claim 1 is also directed to a commercial and legal interaction. Commercial or legal interactions are certain forms of methods of organizing human activities, which is a judicial exception that falls within the purview of the abstract ideas articulated in the recent Guidance. Guidance, 84 Fed. Reg. at 52.

Turning to the second prong of the “directed to” test, claim 1 only generically requires “a wireless device,” “a processor” and “a computer network.” These components are described in the Specification at a high level of generality. *See* Spec. ¶¶ 19 and 20, Figs. 1, 2. We fail to see how the generic recitations of these most basic computer components and/or of a system so integrates the judicial exception as to “impose[] a meaningful limit on the judicial exception, such that the claim is more than a drafting effort designed to monopolize the judicial exception.” Guidance 84 Fed. Reg. at 53. We also find no indication in the Specification that the claimed invention effects a transformation or reduction of a particular article to a different state or thing.

Thus, we find that the claims recite the judicial exceptions of a mental process and commercial or legal interactions that are not integrated into a practical application.

That the claims do not preempt all forms of the abstraction or may be limited to tailored marketing data, does not make them any less abstract. *See OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1362–63 (Fed. Cir. 2015) (“And that the claims do not preempt all price optimization or may be

limited to price optimization in the e-commerce setting do not make them any less abstract.”).

Turning to the second step of the *Alice* analysis, because we find that the claims are directed to abstract ideas/judicial exceptions, the claims must include an “inventive concept” in order to be patent-eligible, i.e., there must be an element or combination of elements sufficient to ensure that the claim in practice amounts to significantly more than the abstract idea itself. *See Alice*, 573 U.S. at 217–18 (quoting *Mayo Collaborative Servs.*, 566 U.S. at 72–73).

Concerning this step the Examiner found,

Furthermore, there is no improvement to another technology or technical field, no improvements to the functioning of the computer itself, and no meaningful limitations beyond generally linking the use of an abstract idea to a particular technical environment, and the claims require no more than a generic computer to perform generic computer functions that are well understood, routine and conventional. Therefore, based on the two-part *Alice Corp.* analysis, there are no meaningful limitations in the claims that transform the exception (i.e., abstract idea) into a patent eligible application.

(Final Act. 3–4).

We agree with the Examiner. “[T]he relevant question is whether the claims here do more than simply instruct the practitioner to implement the abstract idea . . . on a generic computer.” *Alice*, 573 U.S. at 225. They do not.

Taking the claim elements separately, the function performed by the computer at each step of the process is purely conventional. Using a computer to transmit, store, receive, query, link, track and apply decision criteria to data amounts to electronic data query and retrieval—one of the

most basic functions of a computer. All of these computer functions are well-understood, routine, conventional activities previously known to the industry. *See Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1354 (Fed. Cir. 2016); *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”). In short, each step does no more than require a generic computer to perform generic computer functions. The claims do not, for example, purport to improve the functioning of the computer itself. In addition, as we stated above, the claims do not affect an improvement in any other technology or technical field. The Specification spells out different generic equipment and parameters that might be applied using this concept and the particular steps such conventional processing would entail based on the concept of information access under different scenarios (*see, e.g.*, Spec. ¶¶ 19 and 20, Figs. 1, 2). Thus, the claims at issue amount to nothing significantly more than instructions to apply the abstract idea using some unspecified, generic computer. Under our precedents, that is not enough to transform an abstract idea into a patent-eligible invention. *See Alice*, 573 U.S. at 226.

Considered as an ordered combination, the computer components of Appellant’s claims add nothing that is not already present when the steps are considered separately. The sequence of data reception-analysis (to transmit, store, receive, query, link, track and apply decision criteria to data amounts) and storing is equally generic and conventional or otherwise held to be abstract. *See Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 715 (Fed. Cir.

2014) (sequence of receiving, selecting, offering for exchange, display, allowing access, and receiving payment recited an abstraction), *Inventor Holdings, LLC v. Bed Bath & Beyond, Inc.*, 876 F.3d 1372, 1378 (Fed. Cir. 2017) (holding that sequence of data retrieval, analysis, modification, generation, display, and transmission was abstract), *Two-Way Media Ltd. v. Comcast Cable Commc'ns, LLC*, 874 F.3d 1329, 1339 (Fed. Cir. 2017) (holding sequence of processing, routing, controlling, and monitoring was abstract). The ordering of the steps is, therefore, ordinary and conventional.

Thus, the claims at issue amount to nothing significantly more than instructions to apply the abstract ideas of a fundamental economic practice and a commercial or legal interaction using some unspecified, generic computer. Under our precedents, that is not enough to transform an abstract idea into a patent-eligible invention. *See Alice*, 573 U.S. at 225–26.

We have reviewed all the arguments Appellant has submitted concerning the patent eligibility of the claims before us that stand rejected under 35 U.S.C. § 101. (App. Br. 7–13, Reply Br. 2–5). We find that our analysis above substantially covers the substance of all the arguments, which have been made. But, for purposes of completeness, we will address various arguments in order to make individual rebuttals of same.

Appellants argue:

Under Part II of the subject matter eligibility analysis, page 3 of Final Office Action asserts that ‘the abstract idea of preparing data, calculating data, separating data, building predictive models, choosing predictive models, predicting results, communicating budget allocations, bidding and adjusting, etc. by a computer and has not been applied in an eligible manner.’ However, none of the pending claims recite these functions.

App. Br. 8 (emphasis omitted).

Based on the record before us, we determine that fundamentally, the Examiner correctly determined that “[t]he applicant[’s] claimed invention is for obtaining financial account identifier by transmitting a marketing information” (Final Act. 2), and the Examiner found:

Under Part I, in the instant case, the independent claims includes the steps storing user records, transmitting marketing information and code, storing code, receiving a request, querying database, linking account identifier with a user record, obtaining user information, generating tailored marketing information, tracking usage of marketing information.

Id. Thus, in the Part I analysis, the Examiner stated the correct claim 1 language appurtenant to the “directed to” subject matter. Our analysis above confirms that the Part I *Alice* analysis was done correctly. In our view, that the Examiner does not carry forward the same abstract idea claim language into the Part II analysis does not constitute error because it is clear from the record what that language is. The language which Appellant finds problematic appears to be the Examiner’s generalization of mental step characteristics in the Part II analysis. But, the Examiner’s characterization of what abstract idea is clearly set forth in the Part I analysis. In essence, the operative and required language in the Examiner’s Part II finding is “the abstract idea [] has not been applied in an eligible manner.” (Final Act. 3)

Citing to *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327 (Fed. Cir. 2016) and *McRO v. Bandai Namco Games America*, 837 F.3d 1299 (Fed. Cir. 2016), Appellant argues, “Appellant disagree[s] that the claims are patent ineligible just because the claim limitations can be performed by a generic computer.” (Appeal Br. 8).

We disagree with Appellant because the question under *McRO* is whether the claims as a whole “focus on a specific means or method that

improves the relevant technology” or are “directed to a result or effect that itself is the abstract idea and merely invoke generic processes and machinery.” *McRO*, 837 F.3d at 1314. In this case, claim 1 as a whole, is focused on satisfying certain contingencies for extracting selected data in to a financial transaction and tracking usage of the multiple tailored marketing information using an assigned identifier, and not a particular way of programming or designing the software or a computer circuit. In other words, nothing in claim 1 purports to improve computer functioning or “effect an improvement in any other technology or technical field.” *Alice*, 573 U.S. at 225.

We also disagree with Appellant that under the holding in *Enfish* our decision would be different. (Appeal Br. 8). Appellant’s argument that its claims are directed to an improvement in computer technology like that of claim 17 in *Enfish* and therefore are patent eligible. In *Enfish*, the invention at issue was directed at a wholly new type of logical model for a computer database: a self-referential table that allowed the computer to store many different types of data in a single table and index that data by column and row information. *Enfish*, 822 F.3d at 1330–32. In finding the claims “not directed to an abstract idea,” but “to a specific improvement to the way computers operate,” the Federal Circuit noted that “the claims are not simply directed to *any* form of storing tabular data, but instead are specifically directed to a *self-referential* table for a computer database.” *Enfish*, 822 F.3d at 1336–37 (emphasis in original). We find nothing in the claims before us arising to this level of technical improvement in the claimed “user database,” “management module” and “wireless device,” which arises to the level of technical proficiency as found in *Enfish*.

Concerning Appellant's citation to *Ex Parte Barous*, Appeal No. 2016-003320 of App. No. 10/397,778 (PTAB Aug. 1, 2016) (Appeal Br. 9, 10), we are not bound by a non-precedential decision of another panel of the Board.

Appellant further argues, "even if each individual limitation is a generic computer function, the claims must also be considered as an ordered combination." (Appeal Br. 10).

First, as found above, we find no evidence that the ordering of the steps is anything but ordinary and conventional. Second, although we agree with Appellant that the claims must be read, as a whole, we nevertheless find, on balance, that claim 1 is directed to extracting selected data in a financial transaction and tracking usage of the multiple tailored marketing information using an assigned identifier, for the reasons specified above with respect to our "directed to" findings. As found *supra*, claim 1 only includes the following generically recited device limitations: "user database," "processor," "management module" and "wireless device." What remains in the claim after disregarding these device limitations, are abstractions, i.e., transmit marketing information including a unique code, obtain, via the stored financial account identifier, user information about the user, track usage of the multiple tailored marketing information. "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) (citing *Mayo*, 566 U.S. at 90). To the extent Appellant is arguing that these additional elements constitute an inventive concept, such features cannot constitute the "inventive concept." *Berkheimer v. HP, Inc.*, 890 F.3d 1369, 1374 (Fed. Cir. 2018) (Moore, J., concurring) ("It is clear from *Mayo* that the 'inventive concept'

cannot be the abstract idea itself, and *Berkheimer* . . . leave[s] untouched the numerous cases from this court which have held claims ineligible because the only alleged ‘inventive concept’ is the abstract idea.”); *see also BSG Tech. LLC v. BuySeasons, Inc.*, 899 F.3d 1281, 1290 (Fed. Cir. 2018) (“It 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.”).

Citing to *Berkheimer v. HP Inc.*, 881 F.3d 1360, 1368 (Fed. Cir. 2018), Appellant argues,

The Final Office Action provided no evidence to support how the claim limitations individually or as an ordered combination are routine and conventional, and the cited art, as discussed further below, is deficient as failing to show that the combination of the claimed features were known.
(Appeal Br. 10).

We disagree with Appellant. In *Berkheimer*, the Federal Circuit made clear that “not every § 101 determination contains genuine disputes over the underlying facts material to the § 101 inquiry.” *Berkheimer v. HP Inc.*, 881 F.3d 1360, 1368 (Fed. Cir. 2018). In fact, the Federal Circuit in *Berkheimer* did not require evidentiary support for independent claim 1 because “[t]he limitations [of claim 1] amount to no more than performing the abstract idea of parsing and comparing data with conventional computer components.” *Id.* at 1370.

Appellant lists various claim limitations in support of its “significantly more” argument without providing evidence that they are improvements in the computer technology. (Appeal Br. 11–12). As found above, we find that considered as an ordered combination, the computer components of Appellant’s claims add nothing that is not already present when the steps are

considered separately. The Appellants do not provide adequate evidence to the contrary. *See* Br. 11–12. And there is no further specification of particular technology for performing the steps. *See Affinity Labs of Texas, LLC*, 838 F.3d at 1263; *see also English*, 822 F.3d. at 1336 (focusing on whether the claim is “an improvement to the computer functionality itself, not on economic or other tasks for which a computer is used in its ordinary capacity.”)

Appellant next argues,

In contrast to conventional techniques, at the time when the marketing information is first transmitted to the wireless device in claim 1, little is known about the user, and the marketing information is NOT targeted with personal information about the user. To provide the system with user information such that subsequent marketing information can be tailored to the particular user, the non-targeted marketing information includes a unique code.

(Appeal Br. 12).

We disagree with Appellant. The concept of targeted marketing is itself an abstract idea. Matching consumers with a given product or service “has been practiced as long as markets have been in operation.” *Tuxis Techs., LLC v. Amazon.com, Inc.*, No. CV 13–1771–RGA, 2014 WL 4382446, at *5 (D. Del. Sept. 3, 2014); *see also OpenTV, Inc. v. Netflix Inc.*, 76 F.Supp.3d 886, 893 (N.D. Cal. 2014) (“The concept of gathering information about one’s intended market and attempting to customize the information then provided is as old as the saying, ‘know your audience.’”).

For the reasons identified above, we determine there are no deficiencies in the Examiner’s determination of patent ineligibility of the rejected claims. Therefore, we will sustain the Examiner’s § 101 rejection of claims 1–11, 14–39, 41–43.

35 U.S.C. § 103(a) REJECTION

Each of independent claims 1, 16, and 26 requires, in one form or another, “receiv[ing] a transaction authorization request for obtaining authorization to perform a financial transaction in response to the marketing information transmitted to the selected wireless device, the transaction authorization request containing a financial account identifier that is not part of the user record associated with the device identifier of the selected wireless device when the marketing information was transmitted to the selected wireless device.”

Appellant argues the following:

Appellant is also unable to identify which portion of claim 1 recites optional features that need not be performed, because claim 1 does not recite any optional language such as ‘can,’ ‘or,’ etc. Furthermore, Appellant disagrees that whether the financial account identifier is part of the user record or not does not affect the structure of the system. For example, a database that does not contain the financial account identifier as part of the user record would take up less computer memory than a database that does store the financial account identifier. Thus, the presence of the financial account identifier does affect the structure of the system. Moreover, when claim 1 is considered as an ordered combination as a whole, it is the presence of the financial account identifier that enables the tailored marketing information to be generated. Thus, whether the financial account identifier is being stored in the user record of the database affect the system’s ability to generate tailored marketing information, and goes to the essence of the claimed technique. As such, Appellant submits that this limitation cannot be simply ignored, and the rejection under 35 U.S.C. 103 should be reversed for at least these reasons.

(App. Br. 14–15).

The Examiner found, concerning these limitations that Matotek

discloses, the following:

The claim does not recite additional step that need to be performed, beside the step of receiving an authorization request containing a code and a financial account identifier, that would differentiate the claim from the prior art. Whether the financial account identifier used for the transaction (any type of payment method such as credit card, debt card, prepaid card etc.) is part of a user record (in a database) does not change the use of a payment account for a transaction or the request of the authorization for a transaction. The prior art performs the identified function in substantially the same way and produces substantially the same result as the corresponding elements i.e. receiving a financial account identifier (for a transaction) and receiving an authorization request (including the account identifier).

(Answer 4–5).

Claim Construction

During examination of a patent application, pending claims are given their broadest reasonable construction consistent with the specification. *In re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969); *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1369 (Fed. Cir. 2004).

We begin with the language of the claims. The general rule is that terms in the claims are to be given their ordinary and accustomed meaning. *Johnson Worldwide Assocs. v. Zebco Corp.*, 175 F.3d 985, 989 (Fed. Cir. 1999). The phrase in question is set forth above. According to the claim language, the recited “transaction authorization request” must contain “the unique code that was transmitted with the marketing information and a financial account identifier.” The claim further goes onto to recite, “link the *financial account identifier* to the selected wireless device by adding the received financial account identifier that was previously not part of the user

record into the determined user record *after receiving* the transaction authorization request that includes the *unique code*.” Thus, contrary to the Examiner’s construction, the claim does require the recited financial account identifier and the unique code to complete the linking step recited two steps later in the claim. This interpretation is consistent with the Specification which states that both items are required to be sent to the management module 71, and if not “control passes” so that monitoring by the monitoring module 71 continues. *See* Specification ¶ 51.

Thus, according to our interpretation of the independent claims, we cannot agree with the Examiner’s construction that “[t]he claim does not recite additional step that need to be performed, beside the step of receiving an authorization request containing a code and a financial account identifier, that would differentiate the claim from the prior art.” Therefore, we will not sustain the Examiner’s obviousness rejection of independent claims 1, 16, and 26.

Because claims 2–11, 14–15, 17–25, 27–39, 41–43 depend from claim 1, and because we cannot sustain the Examiner’s obviousness rejection of claim 1, the Examiner’s obviousness rejection of the dependent claims likewise cannot be sustained.

CONCLUSION

Claims Rejected	Basis	Affirmed	Reversed
1–11, 14–39 and 41–43	35 U.S.C. § 101	1–11, 14–39 and 41–43	

1-11, 14-39 and 41-43	35 U.S.C. § 103(a)		1-11, 14-39 and 41-43
<u>Overall Outcome</u>		1-11, 14-39 and 41-43	

DECISION

Because we have affirmed at least one ground of rejection with respect to each claim on appeal, the Examiner's decision is affirmed. *See* 37 C.F.R. § 41.50(a)(1).

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