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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
14/949,416	11/23/2015	Ravi Loganathan	090850-003910US-0962393	4602
20350	7590	08/31/2020	EXAMINER	
KILPATRICK TOWNSEND & STOCKTON LLP			CHEIN, ALLEN C	
Mailstop: IP Docketing - 22			ART UNIT	
1100 Peachtree Street			PAPER NUMBER	
Suite 2800			3687	
Atlanta, GA 30309			NOTIFICATION DATE	
			DELIVERY MODE	
			08/31/2020	
			ELECTRONIC	

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte RAVI LOGANATHAN, RONALD SCOTT ALCORN,
JIE HE, STEVE FLEMING, and JEFF PARENT

Appeal 2020-000740
Application 14/949,416
Technology Center 3600

Before JOHN A. JEFFERY, JOHN A. EVANS, and CATHERINE
SHIANG, *Administrative Patent Judges*.

EVANS, *Administrative Patent Judge*.

DECISION ON APPEAL
STATEMENT OF THE CASE

Jurisdiction

Appellant¹ seeks our review under 35 U.S.C. § 134(a) of the
Examiner’s non-final rejection of Claims 13 and 15–18, all pending claims.
Appeal Br. 3. We have jurisdiction under 35 U.S.C. § 6(b).

¹ We use the word “Appellant” to refer to “applicant” as defined in
37 C.F.R. § 1.42 (2017). Appellant states the real party in interest is Early
Warning Services, LLC. Appeal Br. 3.

We AFFIRM.²

Summary of the Invention

The claims relate to a method of fraud detection. *See* Abstract.

Invention

Claim 13 is independent. Claims App. An understanding of the invention can be derived from a reading of Claim 13, which is reproduced in Table 1, *infra*.

References

Name	Publication Number	Date
Moorman	US 2008/0086409 A1	Apr. 10, 2008
Hodgin	US 2011/0191219 A1	Aug 4, 2011
Baker	US 2011/0270744 A1	Nov. 3, 2011

Nigel Morris-Cotterill, “Think Again Money Laundering,”
<http://foreignpolicy.com/2009/11/19/think-again-money-laundering/>
 (“Morris”).

U.S. Bank Routing Number Database (5/9/2013),
<https://web.archive.org/web/20130509032229/http://data-lists.com/bank-routing-number-database/> (“Routing Number Database”).

² Rather than reiterate the arguments of Appellant and the Examiner, we refer to the Appeal Brief (filed June 25, 2019, “Appeal Br.”), the Reply Brief (filed November 4, 2019, “Reply Br.”), the Examiner’s Answer (mailed September 5, 2019, “Ans.”), the Non-Final Action (mailed January 30, 2019, “Non-Final Act.”), and the Specification (filed November 23, 2015, “Spec.”) for their respective details.

HSBC, “Drug Money and Terrorist Laundering,”

<https://web.archive.org/web/20130313093741/https://en.wikipedia.org/wiki/HSBC> (“HSBC”).

*Rejections*³

Claims Rejected	35 U.S.C. §	References/Basis
13–18 ⁴	101	Subject Matter Eligibility Non-Final Act. 3–6.
13, 15–17 ⁵	103(a), Obviousness	Moorman, Morris, Routing Number Database, Hodgins, HSBC. Non-Final Act. 7–14.
18	103	Moorman, Morris, Routing Number Database, Hodgins, Baker. Non-Final Act. 14–15.

ANALYSIS

We have reviewed the rejections of Claims 13 and 15–18 in light of Appellant’s arguments that the Examiner erred. We have considered in this Decision only those arguments Appellant actually raised in the Briefs. Any other arguments which Appellant could have made but chose not to make in the Briefs are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(iv). We provide the following explanation to highlight and address specific

³ The Application was examined under the AIA first inventor to file provisions. Non-Final Act. 2.

⁴ The header of the rejection refers to Claim 14 the merits of which we do not reach as it was previously cancelled.

⁵ Claims 15 and 16 are not mentioned in the header of the rejection, but are discussed in the body thereof.

arguments and findings primarily for emphasis. We consider Appellant’s arguments as they are presented in the Appeal Brief and the Reply Brief.

CLAIMS 13 AND 15–18: INELIGIBLE SUBJECT MATTER

Appellant argues the merits of the claims as a group with reference to the limitations of Claim 13. Appeal Br. 4, 7. Therefore, we decide the appeal of the § 101 rejection on the basis of illustrative Claim 13 and refer to the rejected claims collectively herein as “the claims.” *See* 37 C.F.R. § 41.37(c)(1)(iv); *In re King*, 801 F.2d 1324, 1325 (Fed. Cir. 1986).

We reviewed the record *de novo*. *SiRF Tech., Inc. v. Int’l Trade Comm’n*, 601 F.3d 1319, 1331 (Fed. Cir. 2010) (“Whether a claim is drawn to patent-eligible subject matter is an issue of law that we review *de novo*.”). Based upon our review of the record in light of recent policy guidance with respect to patent-eligible subject matter rejections under 35 U.S.C. § 101,⁶ we affirm the rejection of Claims 13 and 15–18 for the specific reasons discussed below. Appellant argues: “the Office Action improperly commingles the steps of the *Alice* analysis to arrive at its conclusion, and uses incorrect standards for patent eligibility.” Appeal Br. 4. Our analysis, below, based upon the cited Guidance, renders Appellant’s argument moot.

35 U.S.C. § 101

Section 101 provides that a patent may be obtained for “any new and useful process, machine, manufacture, or composition of matter, or any new

⁶ *See* 2019 Revised Patent Subject Matter Eligibility Guidance, 84 Fed. Reg. 50 (Jan. 7, 2019) (“Revised Guidance”). “All USPTO personnel are, as a matter of internal agency management, expected to follow the guidance.” *Id.* at 51; *see also* October 2019 Update at 1 (October 2019 Update: Subject Matter Eligibility) (hereinafter “October 2019 Update”).

and useful improvement thereof.” 35 U.S.C. § 101. The Supreme Court has long recognized, however, that § 101 implicitly excludes “[l]aws of nature, natural phenomena, and abstract ideas” from the realm of patent-eligible subject matter, as monopolization of these “basic tools of scientific and technological work” would stifle the very innovation that the patent system aims to promote. *Alice Corp. v. CLS Bank Int’l*, 573 U.S. 208, 216 (2014) (quoting *Ass’n for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576, 589 (2013)); see also *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 72–78 (2012); *Diamond v. Diehr*, 450 U.S. 175, 185 (1981).

Under the mandatory Revised Guidance, we reconsider whether Appellant’s claims recite:

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 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 reach the issue of 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.

A. Whether the claims recite a judicial exception

The Revised Guidance extracts and synthesizes key concepts identified by the courts as abstract ideas to explain that the abstract-idea exception includes the following groupings of subject matter:

(a) mathematical concepts,⁷ i.e., mathematical relationships, mathematical formulas, equations,⁸ and mathematical calculations⁹; (b) certain methods of organizing human activity—fundamental economic principles or practices (including hedging, insurance, mitigating risk); commercial or legal interactions (including agreements in the form of contracts; legal obligations; advertising, marketing or sales activities or behaviors; business relations); managing personal behavior or relationships or interactions between people (including social activities, teaching, and following rules or instructions)¹⁰; and (c) mental processes—concepts performed in the human mind (including observation, evaluation, judgment, opinion).¹¹

⁷ *Bilski v. Kappos*, 561 U.S. 593, 611 (2010) (“The concept of hedging . . . reduced to a mathematical formula . . . is an unpatentable abstract idea . . .”).

⁸ *Diehr*, 450 U.S. at 191 (“A mathematical formula as such is not accorded the protection of our patent laws . . .”); *Parker v. Flook*, 437 U.S. 584, 594 (1978) (“[T]he discovery of [a mathematical formula] cannot support a patent unless there is some other inventive concept in its application.”).

⁹ *SAP Am., Inc. v. InvestPic, LLC*, 898 F.3d 1161, 1163 (Fed. Cir. 2018) (holding that claims to a “series of mathematical calculations based on selected information” are directed to abstract ideas).

¹⁰ *Alice*, 573 U.S. at 219–20 (concluding that use of a third party to mediate settlement risk is a “fundamental economic practice” and thus an abstract idea); see Revised Guidance, at 52 n.13 for a more extensive listing of “[c]ertain methods of organizing human activity” that have been found to be abstract ideas.

¹¹ *Mayo*, 566 U.S. at 71 (“[M]ental processes[] and abstract intellectual concepts are not patentable, as they are the basic tools of scientific and

The preamble of independent Claim 13 recites: “A method, comprising.” The limitations recited in the body of the claim are analyzed in Table I against the categories of abstract ideas as set forth in the Revised Guidance. As set forth in Table I below, we find limitations [b]–[i] of independent Claim 1 recite abstract ideas, i.e., “mental processes.”

Table I

Claim 1	Revised Guidance
[a] ¹² maintaining one or more computerized databases holding records of check-based financial transactions and other information;	An additional element that adds insignificant extra-solution activity to the judicial exception, i.e., mere data-gathering. <i>See</i> 84 Fed. Reg. at 55.
[b] identifying from the one or more computerized databases a number of checks that have been drawn on U.S. subsidiaries of international financial institutions;	Mental processes, i.e., concepts performed in the human mind (including an observation, evaluation, judgment, opinion). <i>See</i> 84 Fed. Reg. at 52.
[c] for each of the identified checks, identifying the owner of the account into which the check was deposited;	Mental processes, i.e., concepts performed in the human mind (including an observation, evaluation, judgment, opinion). <i>See</i> 84 Fed. Reg. at 52.
[d] for each of a number of identified account owners, counting the number of the identified checks deposited into one or more accounts owned by the respective identified owner; and	Mental processes, i.e., concepts performed in the human mind (including an observation, evaluation, judgment, opinion). <i>See</i> 84 Fed. Reg. at 52.

technological work.” (quoting *Gottschalk v. Benson*, 409 U.S. 63, 67 (1972))).

¹² Step designators, e.g., “[a],” were added to facilitate discussion.

<p>[e] producing a report of the respective number of identified checks deposited into one or more accounts owned by the respective identified owners;</p>	<p>Mental processes, i.e., concepts performed with a pen and paper. <i>See</i> 84 Fed. Reg. at 52.</p>
<p>[f] wherein identifying a number of checks that have been drawn on U.S. subsidiaries of international financial institutions further comprises, for each of a number of checks being investigated: identifying the check drawee financial institution from a routing number of a respective check;</p>	<p>Mental processes, i.e., concepts performed in the human mind (including an observation, evaluation, judgment, opinion). <i>See</i> 84 Fed. Reg. at 52.</p>
<p>[g] looking up the name of the drawee financial institution in the one or more computerized databases;</p>	<p>Mental processes, i.e., concepts performed in the human mind (including an observation, evaluation, judgment, opinion). <i>See</i> 84 Fed. Reg. at 52.</p>
<p>[h] searching the name of the drawee financial institution for one or more keywords indicating that the drawee financial institution is an international financial institution; and</p>	<p>Mental processes, i.e., concepts performed in the human mind (including an observation, evaluation, judgment, opinion). <i>See</i> 84 Fed. Reg. at 52.</p>
<p>[i] identifying the respective check as having been drawn on a U.S. subsidiary of an international financial institution based in part on the results of the keyword search.</p>	<p>Mental processes, i.e., concepts performed in the human mind (including an observation, evaluation, judgment, opinion). <i>See</i> 84 Fed. Reg. at 52.</p>

Step 2A(ii): Judicial Exception Integrated into a Practical Application?

If the claims recite a patent-ineligible concept, as we conclude above,

we proceed to the “practical application” *Step 2A(ii)* wherein the “claims are considered in their entirety to ascertain whether their character as a whole is directed to excluded subject matter.” *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1312 (Fed. Cir. 2016) (quotes and citation omitted). This test determines whether the recited judicial exception is integrated into a practical application of that exception by: (a) identifying whether there are any additional elements recited in the claim beyond the judicial exception(s); and (b) evaluating those additional elements individually and in combination to determine whether they integrate the exception into a practical application.

Appellant argues: “the Office Action appears to assume that only hardware elements can restrict a claim to a practical application. This position has no basis in law.” Appeal Br. 6. Appellant further argues: “the Office Action improperly discounts the method steps in its analysis, and that the method steps of claim 13 limit it to a practical application of any purported abstract idea.” *Id.*

Our analysis considers each claimed element, separately in Table I, above, and the claims, as a whole, below, thus, rendering Appellant’s argument moot.

For the reasons that follow, we conclude that Appellant’s claims do not integrate the judicial exception into a practical application.

MPEP § 2106.05(a) “*Improvements to the Functioning of a Computer or to Any Other Technology or Technical Field*”

“In determining patent eligibility, examiners should consider whether the claim ‘purport(s) to improve the functioning of the computer itself’ or ‘any other technology or technical field.’” MPEP § 2106.05(a).

Appellant recognizes limitations that may constitute “significantly more” include improvements to the functioning of a computer used to implement the claimed invention.” *See* Appeal Br. 5. However, Appellant fails to direct our attention to limitations that may improve the functioning of the implementing computer, or to any other technology. For example, Appellant discloses:

A computer system 101 is coupled to one or more databases 102. Databases 102 may be organized in any suitable manner. For example, all of the stored information may be considered to be one large database 102, or the information may be considered to be organized into a number of specialized databases.

Spec., ¶ 17.

Although we find the individual limitations [b]–[i] are directed to mental processes, the claims as a whole are directed to “[c]ertain methods of organizing human activity,” i.e., “commercial or legal interactions [] including . . . advertising, marketing or sales activities or behaviors; business relations.” *See* 84 Fed. Reg. at 52. Because, as Appellant discloses: [e]mbodiments of the invention provide methods and systems for analyzing information about financial transactions involving certain kinds of accounts. Such techniques may be helpful in uncovering fraud such as money laundering.” Spec., ¶ 14. The *FairWarning* court¹³ also noted that the claimed rules here were unlike those in *McRO* because they “are the same questions (though perhaps phrased with different words) that humans in analogous situations detecting fraud have asked for decades, if not centuries.” 839 F.3d. at 1094–95.

¹³ *FairWarning IP, LLC v. Iatric Sys., Inc.*, 839 F.3d 1089 (Fed. Cir. 2016).

MPEP § 2106.05(b): Particular Machine

The *Bilski* machine-or-transformation test is only applicable to method (process) claims. However, “[r]egardless of what statutory category (‘process, machine, manufacture, or composition of matter,’ 35 U.S.C. § 101) a claim’s language is crafted to literally invoke, we look to the underlying invention for patent-eligibility purposes.” *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1374 (Fed. Cir. 2011). Here, Claim 13, the sole independent claim, claims a method. We therefore, analyze the machine prong of the *Bilski* machine-or-transformation test.

Appellant discloses generic machines and software are suitable:

a computer system 900 such as may be used, in whole, in part, or with various modifications, to provide the functions of the system 100.

Spec., ¶ 101.

The computer system 900 may also comprise software elements, shown as being located within a working memory 970, including an operating system 974 and/or other code 978. Software code 978 may be used for implementing functions of various elements of the architecture as described herein. For example, software stored on and/or executed by a computer system, such as system 900, can be used in implementing the processes. . . .

Spec., ¶ 104.

We find no indication, nor does Appellant so direct our attention, that the claimed invention relies on non-generic devices or non-generic software. We, therefore, conclude Appellant’s claims fail to satisfy the machine prong of the *Bilski* machine-or-transformation test.

MPEP § 2106.05(c): Particular Transformation

This section of the MPEP guides: “Another consideration when determining . . . whether a claim recites significantly more . . . is whether the claim effects a transformation or reduction of a particular article to a different state or thing.” “Transformation and reduction of an article to a different state or thing is *the clue* to the patentability of a process claim that does not include particular machines.” *Bilski*, 561 U.S. at 658 (quoting *Benson*, 409 U.S. at 70).

The claims select and analyze certain electronic data. Specifically, Claim 13 maintains a computerized database records of check-based financial transactions and produces a report that identifies a number of checks that have been drawn on U.S. subsidiaries of international financial institutions. The selection and analysis of electronic data is not a “transformation or reduction of an *article* into a different state or thing constituting patent-eligible subject matter[.]” *In re Bilski*, 545 F.3d 943, 962 (Fed. Cir. 2008) (emphasis added); *see also CyberSource*, 654 F.3d at 1375 (“The mere manipulation or reorganization of data . . . does not satisfy the transformation prong.”). Applying this guidance here, we conclude Appellant’s method claims fail to satisfy the transformation prong of the *Bilski* machine-or-transformation test.

MPEP § 2106.05(e): Other Meaningful Limitations

This section of the MPEP guides:

Diamond v. Diehr provides an example of a claim that recited meaningful limitations beyond generally linking the use of the judicial exception to a particular technological environment. 450 U.S. 175 . . . (1981). In *Diehr*, the claim was directed to the use of the Arrhenius equation (an abstract idea or law of

nature) in an automated process for operating a rubber-molding press. 450 U.S. at 177-78 The Court evaluated additional elements such as the steps of installing rubber in a press, closing the mold, constantly measuring the temperature in the mold, and automatically opening the press at the proper time, and found them to be meaningful because they sufficiently limited the use of the mathematical equation to the practical application of molding rubber products. 450 U.S. at 184, 187 In contrast, the claims in *Alice Corp. v. CLS Bank International* did not meaningfully limit the abstract idea of mitigating settlement risk. 573 U.S. . . . In particular, the Court concluded that the additional elements such as the data processing system and communications controllers recited in the system claims did not meaningfully limit the abstract idea because they merely linked the use of the abstract idea to a particular technological environment (i.e., “implementation via computers”) or were well-understood, routine, conventional activity.

MPEP § 2106.05(e).

“[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. Similarly as in *Alice*, we find that “[t]aking the claim elements separately, the function performed by the computer at each step of the process is “[p]urely conventional.”” 573 U.S. at 225 (citation omitted). “In short, each step does no more than require a generic computer to perform generic computer functions.” *Id.*

We find that Appellant’s claims do not add meaningful limitations beyond generally linking the use of the judicial exception to a particular technological environment.

MPEP § 2106.05(f): Mere Instructions to Apply an Exception

Appellant does not persuasively argue that their claims do any more than to merely invoke generic computer components merely as a tool in which the computer instructions apply the judicial exception.

MPEP § 2106.05(g): Insignificant Extra-Solution Activity

The claims acquire and display data, which are classic examples of insignificant extra-solution activity. *See, e.g., Bilski*, 545 F.3d at 963 (en banc), *aff'd sub nom, Bilski*, 561 U.S. 593.

MPEP § 2106.05(h): Field of Use and Technological Environment

[T]he Supreme Court has stated that, even if a claim does not wholly pre-empt an abstract idea, it still will not be limited meaningfully if it contains only insignificant or token pre- or post-solution activity—such as identifying a relevant audience, a category of use, field of use, or technological environment.

Ultramercial, Inc. v. Hulu, LLC, 722 F.3d 1335, 1346 (Fed. Cir. 2013) (citation omitted).

We find the claimed data-manipulation is simply a field of use that attempts to limit the abstract idea to a particular technological environment. We are unpersuaded by Appellant's arguments because the mere application of an abstract idea in a particular field is not sufficient to integrate the judicial exception into a practical application. *See* 84 Fed. Reg. at 55 n.32. In view of the foregoing, we conclude the claims are “directed to” a judicial exception.

B. *Well-understood, routine, conventional*

Because the claims recite a judicial exception and do not integrate that

exception into a practical application, we must then reach the issue of whether the claim adds a specific limitation beyond the judicial exception that is not “well-understood, routine, conventional” in the field. 84 Fed. Reg. at 56. As discussed above, the written description describes the claimed computer system consistent with its being “well-understood, routine, [and] conventional.”

C. Specified at a high level of generality

It is indicative of the absence of an inventive concept where the claims simply append well-understood, routine, conventional activities previously known to the industry, specified at a high level of generality, to the judicial exception. 84 Fed. Reg. at 56.

The claims fail to recite any specific steps of an algorithm, nor does Appellant cite any Specification disclosure for the required specificity.

We find the limitations are specified at such a high level of generality consistent with the absence of an inventive concept. Considering the claim limitations as an ordered combination adds nothing to the abstract idea that is not already present when the limitations are considered separately. *See Mayo*, 566 U.S. at 79. The ordered combination of limitations amounts to nothing more than certain mental processes implemented with generic computer components that operate “in a conventional way.” *See also Alice*, 573 U.S. at 225–26. Therefore, we conclude that none of the claim limitations, viewed “both individually and as an ordered combination,” amount to significantly more than the judicial exception in order to sufficiently transform the nature of the claims into patent-eligible subject matter. *See Alice*, 573 U.S. at 217 (internal quotations omitted) (quoting *Mayo*, 566 U.S. at 79).

In view of the foregoing, we sustain the rejection of Claims 13 and 15–18 under 35 U.S.C. § 101.

CLAIMS 13 AND 15–17: OBVIOUSNESS OVER MOORMAN, MORRIS,
ROUTING NUMBER DATABASE, HODGIN, AND HSBC.

Claim 13, the sole independent claim, recites, *inter alia*, “identifying from the one or more computerized databases a number of checks that have been drawn on U.S. subsidiaries of international financial institutions.”

The Examiner finds Moorman teaches a portion of this limitation, i.e., “identifying from the one or more computerized databases a number of checks that have been drawn.” Non-Final Act. 8. The Examiner finds Moorman does not teach the remainder of the limitation, i.e., “on U.S. subsidiaries of international financial institutions,” but cites Morris for this portion of the claimed limitation. Non-Final Act. 9 (citing Morris, 1) (“And the globalization of financial-services companies means that money placed in a bank branch in a less regulated jurisdiction is easily transferred internally within the organization to a branch in a more regulated jurisdiction.”). The Examiner further finds Morris discloses “a U.S. Senate subcommittee report found that several major U.S. banks . . . had not paid sufficient attention to correspondent accounts held by foreign banks that were linked to money laundering, tax evasion, and fraud.” *Id.*

Appellant argues Moorman is concerned with outgoing checks, but analyze the source of any checks. Appeal Br. 9. Appellant further argues whereas Morris discloses corresponding accounts are linked to money laundering, Morris fails to teach any analysis of where the money comes from. *Id.*; see Reply Br. 4.

The Examiner finds all the steps of Moorman and Morris relate to money laundering. Ans. 7.

We agree with Appellant that whereas Moorman and Morris each relates to money laundering, the cited portions of the prior art fail to teach the disputed limitation of the method. In view of the foregoing, we decline to sustain the rejection of Claims 13 and 15–17.

CLAIM 18: OBVIOUSNESS OVER MOORMAN, MORRIS,
ROUTING NUMBER DATABASE, HODGIN, BAKER.

The Examiner does not apply Baker to teach the disputed limitation. See Ans. 7–10. In view of the foregoing, we decline to sustain the rejection of Claim 18.

DECISION SUMMARY

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
13, 15–18	101	Eligibility	13, 15–18	
13, 15–17	103	Moorman, Morris, Routing Number Database, Hodgin, HSBC		13, 15–17
18	103	Moorman, Morris, Routing Number Database, Hodgin, Baker.		18
Overall Outcome			13, 15–18	

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TIME PERIOD FOR RESPONSE

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). *See* 37 C.F.R. § 41.50(f).

AFFIRMED