UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
15/637,747	06/29/2017	Simon Phillips	P03672-US-UTIL (M01.475)	8558

125619 7590 03/18/2025

Mastercard International Incorporated
c/o Buckley, Maschoff & Talwalkar LLC
134 Main Street
Suite 301
New Canaan, CT 06840

EXAMINER	
BRINDLEY, BENJAMIN S	

ART UNIT	PAPER NUMBER
3695	

NOTIFICATION DATE	DELIVERY MODE
03/18/2025	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

colabella@bmtpatent.com
martin@bmtpatent.com
szpara@bmtpatent.com

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Application Number: 15/637,747
Filing Date: 29 Jun 2017
Appellant(s): MasterCard International Incorporated

Stephan J. Filipek
(Reg. No. 33,384)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 11/06/2024.

(1) Grounds of Rejection to be Reviewed on Appeal

The following ground(s) of rejection are applicable to the appealed claims.

35 U.S.C. 101

The ground(s) of rejection set forth in the Office action dated 05/10/2024, from which the appeal is taken have been modified by the advisory action dated 09/25/2024. A list of rejections withdrawn by the examiner (if any) is included under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

The presented claims on appeal are 1, 4 – 10, 13, 14, 16 and 18, with Claims 2, 3, 11, 12, 15, 17, 19 and 20 having been cancelled.

WITHDRAWN REJECTIONS

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner.

35 U.S.C. 112(b)

The 35 U.S.C. 112(b) rejection has been withdrawn. Appellant's remarks and amendments to the claims filed on 08/21/2024, adequately address the 35 U.S.C. 112(b) rejection as set forth in the Office action dated 05/10/2024.

(2) Response to Argument

In response to appellant's argument (argument – pages 14 and 15) asserting the claims to recite eligible subject matter, the underlying issue being addressed is directed to transaction detail data sharing, and risk management processing of the transaction which constitutes Certain Methods Of Organizing Human Activity. The 2019 Revised Patent Subject Matter Eligibility Guidance (2019 PEG) identifies commercial interactions and business relations within

the Certain Methods Of Organizing Human Activity grouping of abstract ideas, which have been deemed to be abstract by the courts.

In response to appellant's argument (argument – pages 15 and 16) asserting the claims to have been over-generalized, identification of specific claim limitations to include: receiving a receipt including data identifying purchased items, generating transaction data, transmitting transaction detail data via the internet to a server, conduct risk management processing of the transaction, receiving a response from the server, and transmitting payment credential information to a merchant terminal or payment processor, establishes the character of the claim with specific claim limitations as an abstract idea. Additionally, specification pages 4, 5, 8 and 9 identify applying operations via the use of general purpose computing systems and environments.

In response to appellant's argument (argument – pages 16 and 17) purporting the claims to solve a technological problem, risk management processing of a transaction subject to a price range does not provide a technological solution to a technological problem, as the claims provide generically computer implemented operations to a business field, with the focus of the instant claims not on such an improvement in computers as tools, but on certain independently abstract ideas that use computers as tools. As noted by the Appellant, the advantages provided of assurances of legitimate transactions that are transparent to the user, according to terms that are favorable to the merchant in case the transaction ultimately proves to be problematic, are not technological problems nor providing technological solutions. After receiving the information at the server, the server's "reliable and sophisticated risk management algorithms" are part of the identified abstract idea. Transmitting a price range data for each identified product item, so as to not reveal the exact price of any product, is still sending data over the internet for further processing and is not a technological solution.

In response to appellant's argument (argument – pages 17 and 18) asserting the claims to recite eligible subject matter as being a technological activity, while association to a claimed

technology may limit an abstract idea to a particular field, a general linking of an abstract idea to a claimed technology does not demonstrate patent eligibility.

In response to appellant's argument (argument – page 18) and cite of Uniloc, Uniloc was relative to eligibility of software claims under 35 U.S.C. 101. The claims on appeal neither present, nor are founded, in unique software. Claims 1, 4 – 10, 13, 14, 16 and 18 are process claims. The examiner notes, however, from the Uniloc decision that identification of eligibility as not being an abstract idea remains focused upon being an improvement in computer capabilities as opposed to being a process or system that qualifies as an abstract idea for which computers are invoked merely as a tool (see Uniloc USA, Inc. v. LG Electronics USA, Inc., 957 F.3d 1303,1306-07 (Fed Cir. 2020) (citing Customedia Technologies, LLC v. Dish Network Corporation, 951 F.3d 1359,1364 (Fed Cir. 2020.))

In response to appellant's argument (argument – pages 19 through 21) asserting the claims to improve computer operations, neither the claims nor the specification identifies elements beyond generic computer components performing generic computer functions, and there is no mention of performance metrics enhancement. Again, conducting risk management processing on a transaction remains business related, with the focus of the instant claims not on such an improvement in computers as tools, but on certain independently abstract ideas that use computers as tools.

In response to appellant's argument (argument – pages 21 and 22) asserting that the claims do not "tie up" any judicial exception, the appellant's reference to preemption is unpersuasive because the absence of preemption alone does not demonstrate patent eligibility, or make the idea less abstract (see In re OIP Technologies, Inc., v. Amazon.com Inc.).

In response to appellant's argument (argument – pages 22 and 23) and cite to Berkheimer; the 35 U.S.C. 101 rejection is not founded upon the grounds of being well understood, routine and conventional.

The 101 rejection has been argued by appellant as a claim set, with Claim 1 representative of all claims.

Further, Claims 1, 4 – 10, 13, 14, 16 and 18 remain subject to rejection under 35 U.S.C. 101 because the claimed invention is directed to judicial exception (i.e., an abstract idea) without significantly more. Claim 1 recites, in part, a transaction detail data sharing process by receiving a receipt including data identifying purchased items, generating transaction data, transmitting transaction detail data via the internet to a server, conduct risk management processing of the transaction, receiving a response from the server, and transmitting payment credential information to a merchant terminal or payment processor. The limitations of a transaction detail data sharing process by receiving a receipt including data identifying purchased items, generating data, transmitting data, conducting risk management, receiving and transmitting information to a merchant terminal or payment processor, are directed to concepts of organizing human activity via the use of generic computer components. Hence, it falls within the "Certain Methods of Organizing Human Activity" grouping of abstract ideas. Accordingly, the claim recites an abstract idea.

The judicial exception is not integrated into a practical application. In particular, the claim only recites additional elements such as a smartphone, a processor, a point of sale terminal, a server and a payment processor to perform operations. The generic computer components are recited at a high-level of generality (performing generic computer functions) such that it amounts to no more than mere instruction to apply the exception using generic computer components, and the additional elements do not integrate the abstract idea into a practical application because it does not impose any meaningful limits on practicing the abstract idea.

Next the claim as a whole is analyzed to determine whether any element, or combination of elements, is sufficient to ensure the claim amounts to significantly more than an abstract idea. Claim 1 does not include additional elements that are sufficient to amount to significantly more

than the judicial exception because the additional elements to perform operations amount to no more than mere instructions to apply the exception using generic computer components. Mere instruction to apply an exception using generic computer components cannot provide an inventive concept. The claim is not patent eligible.

Independent process Claim 10, and independent process Claim 16 are directed to an abstract idea as the Federal Circuit has held that an extended claim by claim analysis is not necessary where multiple claims are "substantially similar and linked to the same abstract idea." In this case, Claims 10 and 16 are substantially similar to process Claim 1.

Claims 4 – 9, 13, 14 and 18 are dependent from Claims 1, 10 and 16, and do not include additional elements that are sufficient to amount to significantly more than the judicial exception. Claims 4 – 9, 13, 14 and 18 also do not identify improvement to computer technology or computer functionality MPEP 2106.05(a), a particular machine MPEP 2106.05(b), or a particular transformation MPEP 2106.05(c). Given the above reasons, generic computing components associated with a transaction detail data sharing process by receiving a receipt including data identifying purchased items, generating data, transmitting data, conducting risk management, receiving and transmitting information to a merchant terminal or payment processor is not an inventive concept

Therefore, Claims 1, 4 – 10, 13, 14, 16 and 18 remain not drawn to eligible subject matter as they are directed to an abstract idea without significantly more.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/BENJAMIN S BRINDLEY/
Primary Examiner, Art Unit 3695

Conferees:

/CHRISTINE M BEHNCKE/
Supervisory Patent Examiner, Art Unit 3695

/KEVIN H FLYNN/
Quality Assurance Specialist, Art Unit 3600

Requirement to pay appeal forwarding fee. In order to avoid dismissal of the instant appeal in any application or ex parte reexamination proceeding, 37 CFR 41.45 requires payment of an appeal forwarding fee within the time permitted by 37 CFR 41.45(a), unless appellant had timely paid the fee for filing a brief required by 37 CFR 41.20(b) in effect on March 18, 2013.