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EXAMINER	
HILMANTEL, ADAM J	

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

Application Number: 18/463,541
Filing Date: 8 Sep 2023
Appellant(s): Mastercard International Incorporated

Stephan J. Filipek
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 23 April 2025.

(1) Grounds of Rejection to be Reviewed on Appeal

Every ground of rejection set forth in the Office action dated 24 October 2024 from which the appeal is taken is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

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

Claims 1-3, 5-8 and 10-12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to an abstract idea without significantly more.

Claims 1-3, 5-8 and 10-12 are rejected under 35 U.S.C. 103 as being unpatentable over Brockmann et al. (US 2017/0068952 A1) in view of Purves et al. (US 2015/0220914 A1).

(2) Response to Argument

Appellant presents a summary of the invention starting on page 2 of the Appeal Brief. Appellant's arguments substantially begin on page 8 of the Appeal Brief with an overview of

Applicable Law. Appellant's specific arguments begin on page 14 of the Appeal Brief.

Rejections under 35 U.S.C. §101

Appellant Argument A

Appellant argues that the analysis Examiner presented is flawed because only half of the elements were presented as reciting an abstract idea under Step 2A Prong One. Examiner respectfully disagrees. Step 2A Prong 1 requires examiners to evaluate whether a claim recites a judicial exception as the Appellant cited. The elements which examiner identified in Step 2A Prong 1 are those which describe the noted abstract idea which means that the claim recites an abstract idea. "The mere inclusion of a judicial exception such as a mathematical formula (which is one of the mathematical concepts identified as an abstract idea in MPEP § 2106.04(a)) in a claim means that the claim "recites" a judicial exception under Step 2A Prong One." See MPEP 2106.04(II)(A)(2). "When performing the analysis at Step 2A Prong One, it is sufficient for the examiner to provide a reasoned rationale that identifies the judicial exception recited in the claim and explains why it is considered a judicial exception (e.g., that the claim limitation(s) falls within one of the abstract idea groupings). Therefore, there is no requirement for the examiner to rely on evidence, such as publications or an affidavit or declaration under 37 CFR

1.104(d)(2), to find that a claim recites a judicial exception. Cf. Affinity Labs of Tex., LLC v. Amazon.com Inc., 838 F.3d 1266, 1271-72, 120 USPQ2d 1210, 1214-15 (Fed. Cir. 2016) (affirming district court decision that identified an abstract idea in the claims without relying on evidence); OIP Techs., Inc. v. Amazon.com, Inc., 788 F.3d 1359, 1362-64, 115 USPQ2d 1090, 1092-94 (Fed. Cir. 2015) (same); Content Extraction & Transmission LLC v. Wells Fargo Bank, N.A., 776 F.3d 1343, 1347, 113 USPQ2d 1354, 1357-58 (Fed. Cir. 2014) (same).” See MPEP 2106.07(a)(III). The omitted element(s) (if any) are elements in addition to the abstract idea (i.e. they are not abstract) which require further analysis under Step 2A Prong 2 in order to determine if they cause the recited abstract idea to be integrated into a practical application. See MPEP 2106.07(a)(II). The omitted element(s) (if any) are later enumerated under Step 2A Prong 2 as additional elements. The claims recite and/or describe a judicial exception. Appellant’s arguments with respect to the computer components and displaying step under Step 2A Prong One are moot as they were considered additional elements under the 101 analysis (See Final Office Action dated 24 October 2024 at pages 18-20) and required further analysis under Step 2A Prong Two.

Appellant Argument B

Appellant argues that under Step 2A Prong Two Claim 1 recites an improvement to the functionality of a mobile device processor of a consumer's mobile device by providing a novel process for managing payment card credentials provisioned to a plurality of Internet of Things (IoT) devices via companion applications. Examiner respectfully disagrees. Examiner notes that Appellant's purported improvement comes from potential improvements in the judicial exception, and not from improvements to computers or technology as the recitation of computing components in the claimed invention amounts to no more than invoking computers merely as a tool. See at least MPEP 2106.05(a)(I). The recitation of generic computing components to perform an otherwise ineligible judicial exception does not confer patent eligibility.

Appellant argues that the instant claims will not "tie up" the alleged excepted subject matter. Examiner respectfully disagrees. The Supreme Court has made clear that the principle of preemption is the basis for the judicial exceptions to patentability. Alice, 134 S. Ct at 2354 ("We have described the concern that drives this exclusionary principal as one of pre-emption"). For this reason, questions on preemption are inherent in and resolved by the § 101 analysis. The concern is that "patent law not inhibit further discovery by improperly tying up the future use of these building blocks of human ingenuity." Id.

(internal quotations omitted). In other words, patent claims should not prevent the use of the basic building blocks of technology—abstract ideas, naturally occurring phenomena, and natural laws. While preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility. In this case, the attempt to limit the breadth of the claims does not change the conclusion that the claims are directed to patent ineligible subject matter. Where a patent's claims are deemed only to disclose patent ineligible subject matter under the Mayo framework, as they are in this case, preemption concerns are fully addressed and made moot. Ariosa Diagnostics, Inc. v. Sequenom, Inc., 2015 U.S. App. LEXIS 9855, 17-18 (Fed. Cir. June 12, 2015).

Appellant argues that the device display list and interface imposes at least one meaningful limit on the alleged abstract idea and thus would not monopolize it. Examiner respectfully disagrees. “The analysis under Step 2A Prong Two is the same for all claims reciting a judicial exception, whether the exception is an abstract idea, a law of nature, or a natural phenomenon (including products of nature). Examiners evaluate integration into a practical application by: (1) identifying whether there are any additional elements recited in the claim beyond the judicial exception(s); and (2) evaluating those additional elements individually and in combination to determine whether

they integrate the exception into a practical application, using one or more of the considerations introduced in subsection I supra, and discussed in more detail in MPEP §§ 2106.04(d)(1), 2106.04(d)(2), 2106.05(a) through (c) and 2106.05(e) through (h).” See MPEP 2106.04(d)(II). As explained in the Final Office Action dated 24 October 2024 at page 22, the use of graphical user interface elements is implemented at a high level of generality (i.e. as simply using the technologies) such that it amounts to no more than generally linking the use of the judicial exception to a particular technological environment or field of use. These element(s) in combination do not add anything that is not already present when the steps are considered separately. Generally linking the use of the judicial exception to a particular techno logical environment or field of use is not indicative of integration into a practical application (See MPEP §2106.05(h)). Furthermore, the displaying step(s) are recited at a high-level of generality (i.e., as generally displaying) such that they amounts to no more than mere data gathering which is adding insignificant extra-solution activity. These element(s) in combination do not add anything that is not already pre-sent when the steps are considered separately. Simply adding insignificant extra-solution activity is not indicative of integration into a practical application (See MPEP § 2106.05(g).)

Appellant Argument C

Appellant argues that the claims involve a non-generic arrangement of known conventional pieces under Step 2B. Examiner respectfully disagrees. "Although the conclusion of whether a claim is eligible at Step 2B requires that all relevant considerations be evaluated, most of these considerations were already evaluated in Step 2A Prong Two. Thus, in Step 2B, examiners should:

• Carry over their identification of the additional element(s) in the claim from Step 2A Prong Two;

• Carry over their conclusions from Step 2A Prong Two on the considerations discussed in MPEP §§ 2106.05(a) - (c), (e) (f) and (h):

• Re-evaluate any additional element or combination of elements that was considered to be insignificant extra-solution activity per MPEP § 2106.05(g), because if such re-evaluation finds that the element is unconventional or otherwise more than what is well-understood, routine, conventional activity in the field, this finding may indicate that the additional element is no longer considered to be insignificant; and

• Evaluate whether any additional element or combination of elements are other than what is well-understood, routine, conventional activity in the field, or simply append well-understood, routine, conventional activities previously known to

the industry, specified at a high level of generality, to the judicial exception, per MPEP § 2106.05(d)" (See MPEP 2106.05(II)).

In both the prior Office Action, the conclusions from Step 2A Prong Two are equally applied in Step 2B which further re-evaluates additional elements which are considered to be insignificant extra-solution activity and evaluates these elements as per MPEP §2106.05(d) to be well-understood, routine, and conventional activity. Said elements which are considered to be insignificant extra-solution activity are evaluated as well-understood, routine, and conventional as per the evidentiary requirements detailed in MPEP §2106.07(a)(III) utilizing option (B) via citation to one or more of the court decisions discussed in MPEP §2106.05(d)(II). Thus, there are no further elements to evaluate under Step 2B. Most considerations relating to any additional elements were already evaluated in Step 2A Prong Two and thus do not require further re-evaluation in Step 2B.

Appellant argues that the claims overcome the prior art and thus recite a non-conventional process under Step 2B. Examiner respectfully disagrees with appellant's conclusion. Although the courts often evaluate considerations such as the conventionality of an additional element in the eligibility analysis, the search for an inventive concept should not be confused with a novelty or non-obviousness determination. See MPEP § 2106.05(I).

Although the second step in the Alice/Mayo 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. Furthermore, tests for whether an element is conventional under Step 2B only applies to the additional elements recited and not to the abstract idea present within the claims. Improvement of technology by virtue of novelty or non-obviousness is not a test of eligibility.

Appellant argues that when taken as an ordered combination, the claim elements provide unconventional steps that confine the alleged abstract idea to a particular useful combination to result in patent-eligible subject matter. Examiner respectfully disagrees. In order for additional elements to provide more than what is well-understood, routine, and conventional, the additional elements must in combination provide additional functionality that is not present when considering the elements

individually. Examiner notes that the additional elements do not in combination provide for additional functionality.

Rejections under 35 U.S.C. §103

Appellant provides a brief overview of the cited references. Appellant's specific arguments begin on page 22 of the Appel Brief.

Appellant Arguments

Appellant argues that Examiner admitted that Brockmann does not disclose the cited claim limitations. This is incorrect. Examiner stated "Although Brockmann does disclose sorting of payment credentials by various attributes and displaying said payment credentials using various graphical manipulation tools, they might not explicitly disclose said tools comprising tabs." (Final Office Action dated 23 April 2025 at page 30). Purves is solely relied on for the graphical user interface tool of "tabs". Brockmann already discloses tokens may be sorted into different wallets based on financial institution and may display tokens in wallet based on a particular entity (i.e. merchants and third parties) with which user may interact to modify tokens. See at least paragraphs [0030], [0075], [0117] and Fig. 5. Brockmann discloses payment credentials may be displayed or sorted based on a criteria or condition for display or sorting and/or based on one or more characteristics of the payment credential. See at least paragraphs [0117]. Brockmann discloses

storage location may be a characteristic. See at least paragraph [0120] and Figs. 9-10. Brockmann discloses a variety of dashboard graphical manipulation tools with which to display the various menus such as tables, drop down lists, list boxes, and toolbars which may enable the display of various panels in response to user input. See at least paragraph [0119]. Thus, Brockman is only deficient in the graphical tools used being tabs, which Purves clearly teaches that wallet menus may be implemented as tabs. See at least paragraph [0112], [0124] and Fig. 2m. It would be obvious to one of ordinary skill in the art before the effective filing date to display the sorting of credentials by storage location in Brockmann using tabs as taught by Purves because Brockmann additionally teaches the motivation that such graphical manipulation tools “or the like” may be used to enable user selection of parameters, navigation through the interface, user input of one or more parameters and display of confirmation or output and that the interface enables the user to modify parameters associated with individual payment credentials or modify parameters associated with a group of payment credentials in a dashboard altogether (see at least paragraph [0119]) and the tabs disclosed in Purves are one such graphical manipulation tool. Also, using the tabs from Purves as a graphical manipulation tool with the sorted data of Brockmann is merely a combination of old elements, and in the combination

each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); In re Merck & Co., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Appellant argues that the toggle disclosed in Brockman is distinctly different from suspending or deleting payment card credentials which are stored in a storage device of a first IoT device and that Brockmann fails to disclose deletion. Examiner notes it was not argued that the toggle solely provided both of said functionalities and respectively disagrees with appellant's conclusion. Brockmann discloses displaying a device list with payment credentials, displays which represent payment cards, storage locations (i.e. IoT device) and icons associated with each credential that user may interact with including the ability to deactivate a card (i.e. suspend) and delete payment credentials. See at least paragraph [0120] and Fig. 9. Brockmann discloses transmitting control signals reflecting user modification of a particular payment credential on an auxiliary device. See at least paragraph [0120]. "In some embodiments, the system enables the user to modify one or more parameters,

characteristics, limits and the like associated with the payment credentials, **delete** payment credentials and add payment credentials through the integrated interface." (Brockman at paragraph [0120] emphasis added) Brockman directly discloses deletion of payment credentials and discloses the cited limitations.

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

Respectfully submitted,

/ADAM HILMANTEL/
Examiner, Art Unit 3691

Conferees:

/ABHISHEK VYAS/
Supervisory Patent Examiner, Art Unit 3691

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Supervisory Patent Examiner, Art Unit 3685

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.