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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ROBERT THOMAS BORUCKI

Appeal 2018-001010
Application 12/924,841
Technology Center 3600

Before CARLA M. KRIVAK, HUNG H. BUI, and JON M. JURGOVAN, *Administrative Patent Judges*.

KRIVAK, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant[1] appeals under 35 U.S.C. § 134(a) from a Final Rejection of claims 11, 12, 16, and 17.[2] We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

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[1] The Appeal Brief identifies NCR Corporation as the real party in interest (App. Br. 2).

[2] Claims 18–20 have been allowed, and claims 1–10 and 13–15 have been cancelled (Final Act. 1; After-Final Amdt. 2, 3 (dated Feb. 14, 2017); and Adv. Act. 1–2 (dated Feb. 28, 2017)).

STATEMENT OF THE CASE

Appellant's invention is directed to a method "for automated profile-based transaction processing with an enterprise" by establishing one or more cloud-based transaction profiles defining a customer's options and settings for completing transactions with the enterprise (Spec. ¶¶ 4–5). When the customer accesses a self-service device of the enterprise to perform a transaction, "the cloud-based service is automatically contacted and the transaction is automatically completed on behalf of the customer at the self-service device using a particular one of the customer's transaction profiles" (Abstract).

Independent claim 11, reproduced below, is exemplary of the subject matter on appeal.

> 11. A processor-implemented method programmed in a non-transitory processor-readable medium and to execute on one or more processors configured to execute the method, comprising:
>
> identifying a customer interacting with a self-service device via a customer identifier;
>
> requesting, via a network, a transaction profile for a transaction commencing with the customer on the self-service device, the transaction profile requested of a cloud-transaction processing service located remotely over the network, the customer identifier also supplied to the cloud-transaction processing service, wherein requesting further includes providing an interface type to the cloud-transaction processing service, the customer identifier and the interface type used by the cloud-transaction processing service to locate the transaction profile;
>
> receiving the transaction profile from the cloud-transaction processing service, wherein receiving further includes acquiring the transaction profile from the cloud-transaction processing service as an executable script; and

> automatically completing the transaction on the self-service device for the customer by processing settings and options defined as preferences within the transaction profile and at least some of the preferences providing information for automatically answering-questions on behalf of the customer that are being asked by a cloud interface for the cloud-transaction processing service during the transaction that the customer is engaged in at the self-service device, and wherein automatically completing the transaction further includes processing the transaction profile as multiple profiles arranged hierarchically with at least one of the multiple profiles providing a global profile processed to partially populate values for the transaction defined in other ones of the multiple profiles, wherein automatically completing further includes executing the executable script to interact with an interface of the self-service device, the script when executed providing the settings and the options to the interface to automatically complete the transaction on behalf of the customer.

REJECTION

The Examiner rejected claims 11, 12, 16, and 17 under 35 U.S.C. § 101 as directed to non-statutory subject matter.

ANALYSIS

In rejecting claims 11, 12, 16, and 17 under 35 U.S.C. § 101, the Examiner determines the claims "are directed to the abstract idea of executing a transaction profile, which [is] . . . a method of organizing human activities" (Final Act. 4). The Examiner also finds the claims do not recite significantly more than the abstract idea because "[t]here is no indication that the [claimed] combination of elements improves the functioning of a computer or improves any other technology" (Final Act. 4–5).

Appellant argues claims 11, 12, 16, and 17 are not directed to the abstract idea asserted by the Examiner, but rather to an improved technological process for self-service device transaction processing (Reply Br. 2–3; App. Br. 12–13). Appellant asserts claim 11 recites "unconventional processing steps that confine the claim to a particular useful application" that improves the transactional capabilities of self-service devices (App. Br. 10; Reply Br. 2).

To determine whether subject matter is patentable under § 101, the Supreme Court has set forth a two part test "for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts" (*Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 134 S. Ct. 2347, 2355 (2014)). The first step in that analysis is to "determine whether the claims at issue are directed to one of those patent-ineligible concepts," such as an abstract idea (*id.*). The Court acknowledged in *Mayo* that "all inventions at some level embody, use, reflect, rest upon, or apply laws of nature, natural phenomena, or abstract ideas" (*Mayo Collaborative Services v. Prometheus Labs., Inc.*, 566 U.S. 66, 71 (2012)). We, therefore, look to whether the claims focus on a specific means or method that improves the relevant technology or are instead directed to a result or effect that is the abstract idea and merely invoke generic processes and machinery (*see Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1336 (Fed. Cir. 2016)). If the claims are not directed to an abstract idea, the inquiry ends. Otherwise, the inquiry proceeds to the second step where the elements of the claims are considered "individually and 'as an ordered combination' to determine whether the additional

elements 'transform the nature of the claim' into a patent-eligible application" (*Alice*, 134 S. Ct. at 2355 (quoting *Mayo*, 566 U.S. at 79, 78)).

Because there is no single definition of an "abstract idea" under *Alice* step 1, the PTO has recently synthesized, for purposes of clarity, predictability, and consistency, key concepts identified by the courts as abstract ideas to explain that the "abstract idea" exception includes the following *three groupings*: (1) mathematical concepts; (2) mental processes; and (3) certain methods of organizing human activity, such as a fundamental economic practice and commercial interactions (including sales activities and behaviors, and business relations). *See* 2019 REVISED PATENT SUBJECT MATTER ELIGIBILITY GUIDANCE, 84 Fed. Reg. 50, 52 (Jan. 7, 2019 ("PTO § 101 Memorandum")), effective January 7, 2019.

The PTO § 101 Memorandum further instructs "[c]laims that do not recite [subject] matter that falls within these enumerated groupings of abstract ideas should not be treated as reciting abstract ideas," except in rare circumstances (*see* PTO § 101 Memorandum, 84 Fed. Reg. at 53). Even if the claims recite any one of these three groupings of abstract ideas, these claims are still not "directed to" a judicial exception (abstract idea), and, thus, are patent-eligible "if the claim as a whole integrates the recited judicial exception into a practical application of that [judicial] exception" (*id.*). "[I]ntegration into a practical application" requires an additional element or a combination of additional elements in the claim to apply, rely on, or use the judicial exception in a manner that imposes a meaningful limit on the judicial exception, such that the claim is more than a drafting effort designed to monopolize the exception (*see* PTO § 101 Memorandum, 84 Fed. Reg. at 53–55; *see also* MANUAL OF PATENT EXAMINING PROCEDURE

(MPEP) § 2106.05(a)–(c) and (e) (9th Ed., Rev. 08.2017, Jan. 2018) (limitations indicative of "integration into a practical application") and MPEP § 2106.05(f)–(h) (limitations not indicative of "integration into a practical application")).

Having reviewed the evidence, we agree with the Examiner only in part. Particularly, we agree with the Examiner independent claim 11 as a whole recites a judicial exception of a method of *organizing human activity* by facilitating *sales and other commercial transactions* at self-service devices (e.g., drive-through and airline check-in kiosks) (*see* Spec. ¶¶ 1–4; Title). Thus, claim 11 recites subject matter that falls within the three types of abstract ideas identified by the PTO § 101 Memorandum.

Under the PTO § 101 Memorandum guidance, however, we disagree with the Examiner's finding that the claims are *directed to* the abstract idea (*see* Final Act. 4). Rather, we agree with Appellant the claims *integrate the judicial exception (abstract idea) into a practical application* (App. Br. 10, 12; Reply Br. 2). Particularly, claim 11 recites a combination of additional elements including requesting and receiving a client's transaction profile from a cloud-transaction processing service, and automatically completing the client's transaction on the self-service device/kiosk by executing the profile's executable script on the self-service device. The claim's additional elements integrate the method of organizing human activity into a practical application.

Our conclusion is supported by claim 11 and Appellant's Specification, which confirm an improved functionality of self-service devices. The improved functionality is realized by retrieving, from a remote cloud processing service, over a network, and executing the transaction

profile on the self-service device in real time, i.e., when the client starts an interaction with the self-service device. Particularly, Appellant's Specification describes a "[transaction profile's] script [that] engages an Application Programming Interface (API) of the self-service device and runs through its questions and functions providing the appropriate responses using the settings and options of the [client's] transaction profile" (Spec. ¶ 42). The executed transaction profile script "provides the settings and options to the [self-service device] interface to automatically complete the transaction on behalf of the customer" (Spec. ¶ 42). Thus, Appellant's claim 11 integrates the performance of commercial transactions into a process rooted in computer and network technologies. *See DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1257–58 (Fed. Cir. 2014) (holding patent-eligible a claim that "address[es] a business challenge (retaining website visitors)" by enabling visitors "to purchase products from the third-party merchant without actually entering that merchant's website," the claim providing a "solution . . . necessarily rooted in computer technology in order to overcome a problem specifically arising in the realm of computer networks"). Appellant's technique for automated profile-based transaction processing obviates a delay and inconvenience of manual self-service tasks at kiosk interfaces (*see* Spec. ¶¶ 17–18). Thus, Appellant's invention improves customer experience by reducing the annoyance of having to manually enter personal information and answer questions for every interaction with a self-service device (*see* Spec. ¶¶ 3, 17, 44).

Because claim 11 integrates the judicial exception into a practical application, we find claim 11 and its dependent claims 12, 16, and 17 are not

directed to a judicial exception (abstract idea) and are patent-eligible under § 101.[3]

DECISION

The Examiner's decision rejecting claims 11, 12, 16, and 17 under 35 U.S.C. § 101 is reversed.

REVERSED

[3] In the event of any further prosecution, the Examiner may want to consider an obviousness rejection under 35 U.S.C. § 103(a) and perform an additional prior art search in the art of self-service devices, such as ATMs (Automatic Teller Machines). For example, it may have been known to the skilled artisan at the time of Appellant's invention that ATM transactions could be performed using executable scripts having client-specific information, the scripts received from a processing device remote from the ATM. *See*, for example, Duncan (US 2004/0148337 A1, published July 29, 2004), which discloses transaction processing at an ATM having a script engine 18 executing scripts (*see* Duncan ¶¶ 30, 38 and claim 17) (*see* reference attached to this Opinion). A client's ATM banking transaction (*see* Duncan ¶¶ 38–39) is processed using an executable script with a client's banking details (¶¶ 23, 38, 39), the script being received from an agent infrastructure 16 ("Once the message is received from the script engine 18 at the agent system 16, it is processed and a response is returned to the script engine 18. This response includes the results data that is needed to provide the user with the banking information requested" (emphases omitted), *see* ¶¶ 33, 35, 37, 39). Additionally, "an agent script file" (¶ 31) in the agent infrastructure 16 "could be provided at a remote location" (¶¶ 31–32).