

**United States Court of Appeals  
for the Federal Circuit**

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IN RE: BOLORO GLOBAL LIMITED  
*Appellant*

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2019-2349, 2019-2351, 2019-2353

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Appeals from the United States Patent and Trademark Office,  
Patent Trial and Appeal Board, in Nos.  
14/222,613; 14/222,615; and 14/222,616.

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**APPELLANT BOLORO'S OPPOSED MOTION TO REMAND IN  
LIGHT OF *ARTHREX, INC. v. SMITH & NEPHEW, INC.***

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January 2, 2020

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Appellant Boloro Global Limited (“Boloro”) respectfully requests that that this Court vacate the Patent Trial and Appeal Board’s (“the Board’s”) decisions below, and remand this appeal to the Board for new hearings before a differently constituted panel in light of the Court’s recent decision in *Arthrex, Inc. v. Smith & Nephew, Inc.*, No. 18-2140, 941 F.3d 1320 (Fed. Cir. Oct. 31, 2019). In *Arthrex*, this Court “agree[d] that the appointment of the Board’s Administrative Patent Judges (‘APJs’) by the Secretary of Commerce violates the Appointments Clause] and conclude[d] that the statute as currently constructed makes the APJs principal officers.” *Id.* at 1325. The Court also held that, “where the final decision was rendered by a panel of APJs who were not constitutionally appointed,” and “where the parties presented an Appointments Clause challenge on appeal,” the decision below “must be vacated and remanded.” *Id.* at 1340. The Court in *Arthrex* further instructed that, on remand, “a new panel of APJs must be designated and a new hearing granted.” *Id.*

Under *Arthrex*, the Board’s decisions in this appeal must be vacated and remanded to the Board for a new hearing before a differently constituted panel. On April 1, 2019, a majority of a panel of

the Board (composed of APJs Crawford, Weider and Meyers) issued its final decisions in the three patent applications on appeal, affirming the rejections of the Examiner under 35 U.S.C. 101. See Ex. A (Decision on Appeal in U.S. Application Ser. No. 14/222,613 (“the ‘613 application”) (Apr. 1, 2019)) at 16; Ex. B (Decision on Appeal in U.S. Application Ser. No. 14/222,615 (“the ‘615 application”) (Apr. 1, 2019)) at 18; Ex. C (Decision on Appeal in U.S. Application Ser. No. 14/222,616 (“the ‘616 application”) (Apr. 1, 2019)) at 18. However, APJ Weider dissented from the majority’s affirmance of the rejections under 101 in all three proceedings. See Ex. A at 20, Ex. B at 22, and Ex. C at 4 (of the dissent)). The same majority of the panel then denied rehearing on June 27, 2019 in each of the cases. Ex. D (Decision on Rehearing in the ‘613 application) (June 27, 2019)) at 7; Ex. E (Decision on Rehearing in the ‘615 application) (June 27, 2019)) at 7; Ex. F (Decision on Rehearing in the ‘616 application) (June 27, 2019)) at 8. APJ Weider again dissented from the majority’s opinion in all three decisions. Appellant timely appealed the decisions on the Board to this Court on August 27, 2019. Appellant’s opening brief is currently due on January 6, 2020.

As in *Arthrex*, the Board’s final decisions below were rendered when “the current structure of the Board violate[d] the Appointments Clause.” 941 F.3d at 1335. The APJs who presided over the hearings in the *ex parte* appeals and issued the final decisions in those applications were “principal officers” under the Appointments Clause, yet were neither appointed by the President nor confirmed by the Senate. Under *Arthrex*, “[b]ecause the Board’s decision ... was made by a panel of APJs that were not constitutionally appointed at the time the decision was rendered,” the proper remedy is to “vacate and remand the Board’s decision without reaching the merits.” *Id.* at 1338-1339. On remand, “a new panel of APJs must be designated and a new hearing granted.” *Id.* at 1340.

While the Board in *Arthrex* was presiding over an *inter partes* review, the Court’s analysis in that case, that the APJs who presided over the proceeding were “principal officers” under the Appointments Clause, also holds true in these *ex parte* appeals. In determining that the APJs in *Arthrex* were “principal officers,” this Court held that a determinative factor was the exercise of “significant authority pursuant to the laws of the United States.” *Id.* at 1327-1328 (quoting *Buckley v.*

*Valeo*, 424 U.S. 1, 125–26 (1976)). As part of that analysis, the Court held:

The APJs exercise significant discretion when carrying out their function of deciding *inter partes* reviews. They oversee discovery, 37 C.F.R. § 42.51, apply the Federal Rules of Evidence, 37 C.F.R. § 42.62(a), and hear oral arguments, 37 C.F.R. § 42.70. And at the close of review proceedings, the APJs issue final written decisions containing fact findings and legal conclusions, and ultimately deciding the patentability of the claims at issue. See 35 U.S.C. § 318(a).

*Id.* at 1328.

APJs in *ex parte* appeals carry out similar functions when they hear oral arguments under 37 C.F.R. § 41.47 and, at the close of the appeal proceedings, issue final written decisions containing fact findings and legal conclusions. See 37 C.F.R. § 41.50. Although not specifically addressed in *Arthrex*, in *ex parte* appeals, the PTAB also has the power: (1) to disqualify counsel (37 C.F.R. § 41.5(b)); (2) to admit people *pro hac vice* (37 C.F.R. § 41.5(a) “authorize a person other than a registered practitioner to appear as counsel in a specific proceeding”); and (3) to “order appellant to additionally brief any matter that the Board considers to be of assistance in reaching a reasoned decision on the pending appeal” (37 C.F.R. § 41.50(d)). The PTAB then ultimately decides the patentability of the claims at issue. See 35 U.S.C. § 6(b)(1).

Furthermore, after a decision, under 35 U.S.C. § 6(c), also “[o]nly the Patent Trial and Appeal Board may grant rehearings.”

In the context of these appeals in particular, the APJs also exercised significant authority by virtue what they were being asked to render judgment on. The only issue before them on rehearing was whether to ignore the actual statutory language of 35 U.S.C. § 101 as written by Congress and to instead substitute their own judgment for Congress’ by deciding whether to “affirm[] the rejection of [the] claims under 35 U.S.C. § 101 as being directed to *judicially-excepted* subject matter.” Ex. D at 2 (emphasis added). That is, without being appointed like Article III federal judges, they were being asked to act like Article III judges in determining the applicability of a *judicial* exception.

The extent of that authority, without oversight by the Director, is brought into focus by the fact that the panel members themselves *disagreed* as to whether the judicial exception applied. That is, at least one of the panel members must, by definition, have been contradicting the decision of what the Director would have done because there was a split among the panel.

As in *Arthrex*, Appellant has timely raised its Appointments Clause challenge “before the first body capable of providing it with the relief”—this Court. 941 F.3d at 1339. Indeed, this Court has already applied *Arthrex* in appeals from the Board’s final decision in other cases up to and including the filing of the principal brief, holding that vacatur and remand “for proceedings consistent with this court’s decision in *Arthrex*” is appropriate where appellant “has raised an Appointments Clause challenge in its opening brief.” *Uniloc 2017 LLC v. Facebook Inc.*, No. 18-2251, 783 Fed. Appx. 1020 (Fed. Cir. Oct. 31, 2019) (non-precedential); see also *Bedgear, LLC v. Fredman Bros. Furniture Co.*, No. 18-2082, 783 Fed. Appx. 1029 (Fed. Cir. Nov. 7, 2019) (non-precedential). The same result should follow here, where Appellant raised its Appointment Clause challenge before filing its opening brief.

The briefing in this appeal has not yet commenced. Because a decision to vacate and remand for an Appointments Clause violation is made “without reaching the merits,” *Arthrex*, 941 F.3d at 1339, judicial efficiency will be well served in granting this motion. There is no utility in having the parties brief the merits of this appeal when the Court would not reach the merits. That is particularly so here, where a

dissenting opinion shows that a differently constituted panel may well reach a different result than the majority of the panel did.

The USPTO has indicated that it opposes this motion. Finally, since this motion, “if granted, would terminate the appeal, the time to serve and file the next brief due is suspended.” Fed. Cir. R. 31(c).

### CONCLUSION

This Court should vacate the Board’s decisions below and remand the cases in this consolidated appeal to the Board for proceedings consistent with *Arthrex, Inc. v. Smith & Nephew, Inc.*, No. 18-2140, 941 F.3d 1320 (Fed. Cir. Oct. 31, 2019).

Respectfully submitted,

Dated: January 2, 2020

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## **CERTIFICATE OF INTEREST**

Counsel for Appellant certifies the following:

**1. The full name of party represented by me:**

Boloro Global Limited

**2. The name of the real party in interest (please only include any real party in interest NOT identified in Question 3) represented by me is:**

Boloro Global Limited

**3. Parent corporations and publicly held companies that own 10% or more of stock in the party:**

None

**4. The names of all law firms and the partners or associates that appeared for the party or amicus now represented by me in the trial court or agency or are expected to appear in this court (and who have not or will not enter an appearance in this case) are:**

None

**5. The title and number of any case known to counsel to be pending in this or any other court or agency that will directly affect or be directly affected by this court's decision in the pending appeals. See Fed. Cir. R. 47.4(a)(5) and 47.5(b):**

USPTO Application Serial No. 16/426,064, filed May 30, 2019

Dated: January 2, 2020

/s/ Michael R. Casey  
Michael R. Casey  
*Counsel for Appellant*

**CERTIFICATE OF COMPLIANCE WITH TYPE-VOLUME  
LIMITATION**

This motion was printed using a 14 point Century Schoolbook Font. This motion complies with the type-volume limitation of Federal Rule of Appellate Procedure 27. According to MS Word 2010, the word processing system used to prepare this document, the motion contains 1,363 words.

Dated: January 2, 2020

/s/ Michael R. Casey  
Michael R. Casey  
*Counsel for Appellant*

**CERTIFICATE OF FILING AND SERVICE**

The undersigned hereby certifies that, on the 2nd day of January, 2020, I electronically filed the foregoing document using the United States Court of Appeals for the Federal Circuit's CM/ECF system, which will at the time of filing serve and send notice to all registered CM/ECF users.

/s/ Michael R. Casey  
Michael R. Casey  
*Counsel for Appellant*

**LIST OF EXHIBITS**

<b>Exhibit</b>	<b>Description</b>
A	Decision on Appeal in U.S. Application Ser. No. 14/222,613 (Apr. 1, 2019)
B	Decision on Appeal in U.S. Application Ser. No. 14/222,615 (Apr. 1, 2019)
C	Decision on Appeal in U.S. Application Ser. No. 14/222,616 (Apr. 1, 2019)
D	Decision on Rehearing in U.S. Application Ser. No. 14/222,613 (June 27, 2019)
E	Decision on Rehearing in U.S. Application Ser. No. 14/222,615 (June 27, 2019)
F	Decision on Rehearing in U.S. Application Ser. No. 14/222,616 (June 27, 2019)
G	<i>Uniloc 2017 LLC v. Facebook Inc.</i> , 783 Fed. Appx. 1020 (No. 18-2251, Fed. Cir. October 31, 2019)
H	<i>Bedgear, LLC v. Fredman Bros. Furniture Co.</i> , 783 Fed. Appx. 1029 (No. 18-2082, Fed. Cir. November 7, 2019)

# EXHIBIT A



## 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.
14/222,613	03/22/2014	Karim Anwar Rammal	151670-001 US CON1	1373

95628 7590 04/01/2019  
 The Villamar Firm PLLC  
 3424 Washington Drive  
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EXAMINER
RANKINS, WILLIAM E

ART UNIT	PAPER NUMBER
3694	

NOTIFICATION DATE	DELIVERY MODE
04/01/2019	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):

crvillamar@villamars.com  
 bevillamar@villamars.com  
 baravenwood@villamars.com

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* KARIM ANWAR RAMMAL<sup>1</sup>

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Appeal 2017-003513  
Application 14/222,613  
Technology Center 3600

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Before MURRIEL E. CRAWFORD, BRUCE T. WIEDER, and  
MATTHEW S. MEYERS, *Administrative Patent Judges*.

Opinion for the Board filed by CRAWFORD, *Administrative Patent Judge*.

Opinion Dissenting filed by Wieder, *Administrative Patent Judge*.

CRAWFORD, *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 claims 1–19. We have jurisdiction under 35 U.S.C. § 6(b). Appellant appeared for Oral Hearing on February, 14, 2019.

SUMMARY OF DECISION

We AFFIRM.

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<sup>1</sup> The Real Party in Interest in this appeal is NET2TEXT LTD.

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### THE INVENTION

Appellant's claims generally relate to methods and systems for conducting secure purchase and payment transactions, and more particularly to a method, system and computer program product for conducting secure purchase and payment transactions using a mobile phone. (Spec. ¶ 2).

Claim 1 is representative of the subject matter on appeal.

1. A computer implemented system for processing payments for goods or services, the system comprising:

a payment processor implemented by first circuitry configured to receive a payment request for goods or services from a merchant, wherein the payment request includes a mobile phone number associated with a mobile phone account of a user;

a mobile operator implemented by second circuitry configured to service the mobile phone account of the user; and

a mobile phone of the user implemented by third circuitry and connected to a mobile network of the mobile operator,

wherein the first circuitry of the payment processor, based on the payment request, is further configured to send a payment authorization request to the mobile operator implemented by the second circuitry configured to service the mobile phone account of the user;

the second circuitry of the mobile operator, based on the payment authorization request, is further configured to send, over the mobile network of the mobile operator, a payment authorization request text message to the mobile phone of the user requesting authorization for payment based on the payment request;



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the third circuitry of the mobile phone of the user, based on the payment authorization request text message, is configured to send over the mobile network of the mobile operator, a payment authorization text message including a personal identification number of the user associated with the mobile phone number of the user to the mobile phone operator for authorization of payment based on the payment request;

the second circuitry of the mobile operator is further configured to receive the payment authorization text message including the personal identification number of the user over the mobile network of the mobile operator for verification;

the first circuitry of the payment processor is further configured to receive a payment authorization from the mobile phone operator based on the payment authorization text message authorizing or not authorizing the payment based on the payment request;

the first circuitry of the payment processor is further configured to, if the payment authorization from the mobile phone operator authorizes the payment based on the payment request, pay the merchant for the goods or services from an account of the mobile phone operator, wherein the mobile phone operator charges the mobile phone account of the user for the payment;

the first circuitry of the payment processor is further configured to, if the payment authorization from the mobile phone operator does not authorize the payment based on the payment request or if the payment authorization text message is not received by the mobile operator over the mobile network of the mobile operator within a predetermined period of time, decline to pay the merchant for the goods or services; and

wherein no financial information of the user nor the personal identification number of the user are sent to the payment processor.

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### THE REJECTIONS

Claims 1–19 are rejected under 35 U.S.C. § 101 as directed to a judicial exception without significantly more.<sup>2</sup>

Claims 1, 5, and 9 are rejected under 35 U.S.C. § 112, first paragraph.

### ANALYSIS

#### *REJECTION UNDER 35 U.S.C. §112, FIRST PARAGRAPH*

The Examiner concludes that the claims recite a mobile operator implemented by second circuitry and that as the mobile operator is interpreted as a carrier such as Verizon or AT&T and therefore, the mobile operator itself could not be comprised of application specific circuitry. (Final Act. 11). We will not sustain this rejection because we agree with the Appellant that the Specification provides support for the recitations.

#### *35 U.S.C. § 101 REJECTION*

We will sustain the rejection of claims 1–19 under 35 U.S.C. § 101.

#### The Supreme Court

set forth a framework for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts. First, . . . determine whether the claims at issue are directed to one of those patent-ineligible concepts. . . . If so, . . . then ask, “[w]hat else is there in the claims before us?” . . . To answer that question, . . . consider the elements of each claim both individually and “as

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<sup>2</sup> The Examiner has withdrawn a rejection of claims 9–12 under 35 U.S.C. § 101 as directed to software per se. (Final Act. 2; *cf.* Non-Final Action, mailed November 17, 2014). The Examiner also has withdrawn a non-statutory double patenting rejection over claims 1–12. (*See* Ans. 5).

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an ordered combination” to determine whether the additional elements “transform the nature of the claim” into a patent-eligible application. . . . [The Court] described step two of this analysis as a search for an “‘inventive concept’”—*i.e.*, 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.”

*Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2355 (2014) (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 72–73 (2012)) (citations omitted).

To perform this test, we must first determine whether the claims at issue are directed to a patent-ineligible concept. 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.’” *See Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335 (Fed. Cir. 2016) (quoting *Internet Patents Corp.*, 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 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 judicial exception is integrated into a practical application. *2019 Revised Patent Subject Matter Eligibility Guidance*, 84 FR 50, pp 50–57 (Jan. 7, 2019)

The Examiner determines that the claims are directed to payment processing which is an abstract idea. (Final Act. 7). The Examiner found

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“the claims do not include limitations amounting to significantly more than the abstract idea.” (*Id.* at 8).

We note that the Specification discloses that the claims are directed to conducting secure purchase and payment transactions (Spec. ¶ 2). The Specification identifies that “security, fraud and identity theft are major concerns” for consumers while using credit and debit cards. (Spec. ¶¶ 3, 4, 6). According to the Specification, other alternative options such as “money transfer using a third independent financial entity, E-mail payments, and mobile wallet applications that act as intermediaries or interfaces between a customer’s financial institution (typically a bank or a credit card company) and the retailer/merchant)” also share the same drawbacks as credit and debit cards. (Spec. ¶ 4). However, these alternative payment options may also include “unreasonable hidden costs that are additionally charged by credit cards, mobile wallets and other financial instruments that are above and beyond what the retailer is already charging.” (Spec. ¶ 6). The Specification further discloses that “[c]onventional systems of payment and methods using mobile phones” are also known in the art, but “have limitations, including requiring downloading of complex software, need to use hi-tech mobile phones, need for additional security codes, hidden costs, and additional charges by the customer's bank or credit card company.” (Spec. ¶ 7).

To address these limitations and concerns, transactions are processed in exemplary independent claim 1 by the mobile phone, the mobile operator, and the payment processor in a way such that no personal information is sent to the payment processor, i.e., “[t]he present method as described above virtually presents an anti-fraudulent payment system that provides peace of mind and convenience to customers as they and their mobile operator are the

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only ones who know the PIN Code to authorize payments to retailers.”

(Spec. ¶¶ 2, 20, 34). To accomplish this, the mobile operator checks the customer’s mobile number account balance, and if found sufficient to pay for the purchase, sends a text message to the customer on their mobile number giving them details of the retailer and the total amount payable. If the customer agrees to the purchase, the customer sends a unique PIN code to the mobile operator and the mobile operator then agrees to pay the payment processor. (Spec. ¶¶ 20–21). As such, the payment process is between the mobile operator and the payment processor with the mobile operator essentially acting as an intermediary debiting/charging the customer’s mobile account for the amount of the purchase. (Spec. ¶¶ 23–24).

The recitations in claim 1 demonstrate further that the claimed subject matter relates to conducting secure purchase and payment transactions. For example, claim 1 recites a “mobile operator”, a “payment processor” and a “mobile phone.” Claim 1 further recites that the “payment processor . . . configured to receive a payment request for goods and services from a merchant,” and that the payment processor includes “circuitry configured to send a payment authorization request to a mobile operator.” The mobile operator includes “circuitry configured to send . . . a payment authorization request text message to a mobile phone.” Claim 1 also recites “the mobile phone . . . based on the payment authorization request text message, . . . is configured to send . . . a payment authorization text message.” Claim 1 also recites that the payment processor is configured “to receive a payment authorization from the mobile phone operator based on the payment authorization” and that “no financial information of the user nor the personal identification number of the user are sent to the payment

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processor.” As claim 1 is directed to steps of conducting secure purchase and payment transactions, claim 1 is directed to sales activity which is a certain method of organizing human activity. Therefore, we agree with the Examiner that the claims are directed to a judicial exception. *See 2019 Revised Patent Subject Matter Eligibility Guidance*, 84 FR at 52.

Turning to the second prong of the “directed to test”, we note that claim 1 requires a “payment processor,” a “mobile operator,” and a “mobile phone” to perform the steps of claim 1. These recitations do not affect an improvement in the functioning of the processor, mobile operator of phone or other technology. In addition, claim 1 does not recite a particular machine or manufacture. In fact, Appellant’s Specification discloses that all or a portion of the devices and subsystems of the exemplary embodiments can be conveniently implemented using one or more general purpose computer systems, microprocessors, digital signal processors, or micro-controllers. (Spec. ¶ 49). The mobile operator is disclosed as the mobile phone service provider/operator/carrier with a processor which is configured to send, receive, process and store data (Spec. ¶ 16, ). No improvement to the mobile operator is disclosed or claimed. These recitations do not impose meaningful limits on the judicial exception, such that the claim is more than a drafting effort designed to monopolize the judicial exception. *2019 Revised Patent Subject Matter Eligibility Guidance* at 55. Thus, claim 1 is directed to an abstract idea.

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 that is sufficient to ensure that the claim in practice amounts to significantly more than the abstract idea itself.

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See *Alice*, 134 S. Ct. at 2355 (alteration in original) (quoting *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 72–73 (2012)).

The introduction of a processor, a mobile phone and a mobile operator into the claims does not alter the analysis at *Alice* step two.

[T]he mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention. Stating an abstract idea “while adding the words ‘apply it’” is not enough for patent eligibility. Nor is limiting the use of an abstract idea “to a particular technological environment.” Stating an abstract idea while adding the words “apply it with a computer” simply combines those two steps, with the same deficient result. Thus, if a patent’s recitation of a computer amounts to a mere instruction to “implemen[t]” an abstract idea “on . . . a computer,” that addition cannot impart patent eligibility. This conclusion accords with the preemption concern that undergirds our § 101 jurisprudence. Given the ubiquity of computers, wholly generic computer implementation is not generally the sort of “additional featur[e]” that provides any “practical assurance that the process is more than a drafting effort designed to monopolize the [abstract idea] itself.”

*Alice*, 134 S. Ct. at 2358 (alterations in original) (citations omitted).

Instead, “the relevant question is whether the claims here do more than simply instruct the practitioner to implement the abstract idea . . . on a generic computer.” *Id.* at 2359. They do not.

Taking the claim elements separately, the functions performed by the computers at each step of the process are purely conventional. Using a computer to retrieve, select, and apply decision criteria to data and modify the data as a result amounts to electronic data query and retrieval—one of

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the most basic functions of a computer. All of these computer functions are well-understood, routine, conventional activities previously known to the trading industry. *See Elec. Power Grp.*, 830 F.3d at 1354; *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. As to the data operated upon, “even if a process of collecting and analyzing information is ‘limited to particular content’ or a particular ‘source,’ that limitation does not make the collection and analysis other than abstract.” *SAP Am. Inc. v. InvestPic, LLC*, 890 F.3d 1016, 1022 (Fed. Cir. 2018).

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-access/display 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.



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The claims do not, for example, purport to improve the functioning of the mobile phone, payment processor or mobile operator. As we stated above, the claims do not affect an improvement in any other technology or technical field. The Specification spells out that the devices and subsystems of the exemplary embodiments can be implemented on the World Wide Web. In addition, the devices and subsystems of the exemplary embodiments can be implemented by the preparation of application-specific integrated circuits or by interconnecting an appropriate network of conventional component circuits, as will be appreciated by those skilled in the electrical art(s). Thus, the exemplary embodiments are not limited to any specific combination of hardware circuitry and/or software. (Spec. ¶49). Thus, the claims at issue amount to nothing significantly more than instructions to apply the abstract idea using some unspecified, generic computers. Under our precedents, that is not enough to transform an abstract idea into a patent-eligible invention. *See Alice*, 134 S. Ct. at 2360.

We have reviewed all the arguments (Appeal Br. 9–19; Reply Br. 5–9) Appellant has submitted concerning the patent eligibility of the claims before us that stand rejected under 35 U.S.C. § 101. 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.

We are not persuaded of error on the part of the Examiner by Appellant's argument that the claims are not directed to an abstract idea because the claims are not directed to a contractual relationship, hedging or mitigating settlement risk. (Brief 11). Even if the Appellant is correct, claim 1 is directed to conducting secure purchase and payment transactions which is a sales activity and thus is a method of organizing human activities

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which is an abstract idea. *2019 Revised Patent Subject Matter Eligibility Guidance*, 84 FR at 52.

We are not persuaded of error on the part of the Examiner by Appellant's argument that the claims are rooted in computer technology and are analogous to the claims in *DDR Holdings, LLC v. Hotels.com, L.P.* 773 F.3d 1245 (Fed. Cir. 2014). (Brief 13). In *DDR Holdings*, the Court evaluated the eligibility of claims "address[ing] the problem of retaining website visitors that, if adhering to the routine, conventional functioning of Internet hyperlink protocol, would be instantly transported away from a host's website after 'clicking' on an advertisement and activating a hyperlink." *DDR*, 773 F.3d at 1257. There, the Court found that the claims were patent eligible because they transformed the manner in which a hyperlink typically functions to resolve a problem that had no "pre-Internet analog." *Id.* at 1258. The Court cautioned, however, "that not all claims purporting to address Internet-centric challenges are eligible for patent." *Id.* For example, in *DDR Holdings* the Court distinguished the patent-eligible claims at issue from claims found patent-ineligible in *Ultramercial*. See *DDR*, 773 at 1258–59 (citing *Ultramercial*, 772 F.3d 709, 715–16 (Fed. Cir. 2014)). As noted there, the *Ultramercial* claims were "directed to a specific method of advertising and content distribution that was previously unknown and never employed on the Internet before." *Id.* at 1258 (quoting *Ultramercial*, 772 F.3d at 715–16). Nevertheless, those claims were patent ineligible because they "merely recite[d] the abstract idea of 'offering media content in exchange for viewing an advertisement,' along with 'routine additional steps such as updating an activity log, requiring a request from the consumer to view the ad, restrictions on public access, and use of the Internet.'" *Id.*

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Appellant's asserted claims are analogous to claims found eligible in *Ultramercial* and distinct from claims found ineligible in *DDR*. The ineligible claims in *Ultramercial* recited "providing [a] media product for sale at an Internet website;" "restricting general public access to said media product;" "receiving from the consumer a request to view [a] sponsor message;" and "if the sponsor message is an interactive message, presenting at least one query to the consumer and allowing said consumer access to said media product after receiving a response to said at least one query." *Ultramercial*, 772 F.3d at 712. Similarly, Appellant's claims recite receiving, analyzing, modifying, and transmitting data. This is precisely the type of Internet activity found ineligible in *Ultramercial*.

We are not persuaded of error on the part of the Examiner by Appellant's argument that the claims include an element or combination of elements that amount to significantly more than the judicial exception. (Brief 15-16). The Appellant argues that the present invention includes benefits such as increased flexibility, faster search times and smaller memory requirements. The Federal Circuit has found claims that "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" are "directed to an improvement of an existing technology . . . achiev[ing] other benefits over conventional databases, such as increased flexibility, faster search times, and smaller memory requirements." *Enfish*, 822 F.3d at 1337. However, the heart of the claimed invention must be focused on the underlying technology itself and *how* the underlying technology is altered "in a way that leads to an improvement in the technology." *Intellectual Ventures I LLC v. Erie Indem. Co.*, 850 F.3d 1315, 1328 (Fed. Cir. 2017) (citing *Enfish*, 822 F.3d 1327); *see also TLI Commc'ns*, 823 F.3d at 612.

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The advantages that Appellant touts do not concern an improvement to computer capabilities, but instead relate to an improvement to the process for conducting payments for which a computer system is used as a tool in its ordinary capacity. In this case, a generic graphical user interface performs the well-understood function of receiving user input, and a generic computer system performs routine data processing steps. Appellant fails to identify, and we do not find, any indication in the record that the claimed invention improves computer functionality, requires specialized computer hardware or other inventive components, invokes inventive programming, or is otherwise directed to something other than the abstract idea identified by the Examiner.

We are not persuaded of error on the part of the Examiner by Appellant's argument that the claims are novel. (Brief 17). To the extent Appellant maintains that the limitations of claim 1 necessarily amount to "significantly more" than an abstract idea because the claimed apparatus is allegedly patentable over the prior art, Appellant misapprehend the controlling precedent. 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." *Alice*, 134 S. Ct. at 2355. A novel and nonobvious claim directed to a purely abstract idea is, nonetheless, patent-ineligible. *See Mayo*, 566 U.S. 66, 72–73.

We are not persuaded of error on the part of the Examiner by Appellant's argument is that the claims perform functions that were not known in the art and therefore the claims recite significantly more than any

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abstract idea. Specifically, Appellant argues that the elements of the system are configured or programmed in a way to perform the functions that were not known in the art. (Brief 17). Appellant's argument does not apprise us of error because Appellant conflates the conventionality of the steps that the processor performs and the conventionality of the computer functions required to implement the steps. In this regard, Appellant does not explain how the computers involved in the present invention perform functions other than the conventional transmission, storage, and analysis of data which are well known functions of any computer.

Claim 1 recites a process in which the payment is made between the mobile operator and a payment processor with the payment being authorized by a user PIN without revealing any personal information of the customer. There is no improvement to the mobile phone, mobile operator or the payment processor.

In addition, we agree with the Examiner, that it is well known and conventional to use a PIN code to authorize a payment using a mobile phone as demonstrated by the prior art of Goldthwaite (US 2004/0019564) which is discussed by the Examiner in this application.<sup>3</sup> As such, the sequence of events recited in claim 1 are well known and conventional. Therefore, we

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<sup>3</sup> In a related application (U.S. Application No.: 14/222,615 (“’615 Application”); Appeal No.: 2017-003902), the Examiner also discussed “prior art as evidenced by the prior art associated with the prosecution of the parent case 13/148,043 now patent 8,862, 792,” (’615 Application Examiner’s Answer, mailed, November 22, 2016, at 5), “[u]sing a PIN code to authorize a financial transaction through a mobile phone using sms” (’615 Application Examiner’s Answer 7 (citing paragraphs 11 and 93 of US Patent Pub. No. 2007/0107044 to Yuen)), and “[b]illing to a mobile operator” (’615 Application Examiner’s Answer 9 (citing paragraph 7 of US Patent Pub. No. 2006/0149644 to Sulmar; paragraphs 38 and 65 of US Patent Pub. No. 2001/0037264 to Husemann)).

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agree with the Examiner that claim 1 does not include an inventive concept.

In view of the foregoing, we will sustain the rejection as it is directed to claim 1. We will also sustain this rejection as it is directed to the remaining claims subject to this rejection because the Appellant has not argued the separate eligibility of these claims.

#### CONCLUSIONS OF LAW

We conclude that the Examiner did err in rejecting claims 1, 5, and 9 under 35 U.S.C. § 112, first paragraph.

We conclude that the Examiner did not err in rejecting claims 1–19 under 35 U.S.C. § 101.

#### DECISION

The decision of the Examiner to reject claims 1–19 is affirmed.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* KARIM ANWAR RAMMAL

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Appeal 2017-003513  
Application 14/222,613  
Technology Center 3600

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Before MURRIEL E. CRAWFORD, BRUCE T. WIEDER, and  
MATTHEW S. MEYERS, *Administrative Patent Judges*.

WIEDER, *Administrative Patent Judge*, dissenting.

I respectfully dissent from the majority opinion affirming the  
Examiner's rejection of claims 1–19 under 35 U.S.C. § 101.

In analyzing whether a claim recites patent-eligible subject matter, we  
apply a two-step framework, earlier set out in *Mayo Collaborative Services*  
*v. Prometheus Laboratories, Inc.*, 566 U.S. 66 (2012), “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*, 573 U.S. 208, 217 (2014).

Under the two-step framework, it must first be determined if “the  
claims at issue are directed to a patent-ineligible concept.” *Id.* If the claims

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are determined to be directed to a patent-ineligible concept, e.g., an abstract idea, then the second step of the framework is applied to determine if “the elements of the claim . . . contain[] an ‘inventive concept’ sufficient to ‘transform’ the claimed abstract idea into a patent-eligible application.” *Id.* at 221 (citing *Mayo*, 566 U.S. at 72–73, 79).

With regard to step one of the *Alice* framework, we apply a “directed to” two prong test to: 1) evaluate whether the claim recites a judicial exception, i.e., a law of nature, natural phenomenon, or abstract idea, 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.” *See 2019 Revised Patent Subject Matter Eligibility Guidance*, 84 Fed. Reg. 50, 54 (Jan. 7, 2019) (hereinafter “2019 Guidance”).

With regard to the first prong of the 2019 Guidance, I agree with the majority opinion “that the Specification discloses that the claims are directed to conducting secure purchase and payment transactions.” (Opinion 6 (citing Spec. ¶ 2).) I also agree with the majority opinion that “claim 1 is directed to conducting secure purchase and payment transactions which is a sales activity and thus is a method of organizing human activities which is an abstract idea.” (Opinion 11–12; *see also id.* at 7–8.)

With regard to the second prong, I do not agree with the majority opinion that the recitations in claim 1 “do not impose meaningful limits on the judicial exception, such that the claim is more than a drafting effort designed to monopolize the judicial exception.” (Opinion 8 (citing 2019 Guidance at 55).)



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Claim 1 recites “a payment processor implemented by first circuitry configured to receive a payment request,” “a mobile operator implemented by second circuitry configured to service the mobile phone account of the user,” “a mobile phone of the user implemented by third circuitry and connect to a mobile network of the mobile operator,” “the first circuitry . . . is further configured to send a payment authorization request to the mobile operator,” “the second circuitry . . . is further configured to send, *over the mobile network of the mobile operator*, a payment authorization request text message to the mobile phone,” “the third circuitry of the mobile phone . . . is configured to send, *over the mobile network of the mobile operator*, a payment authorization text message,” “the second circuitry . . . is further configured to receive the payment authorization text message . . . *over the mobile network of the mobile operator*,” “wherein no financial information of the user nor the personal identification number of the user are sent to the payment processor.” (Emphasis added.)

Claim 1 refers to four entities: a mobile phone of a user, a merchant, a payment processor, and a mobile operator. Claim 1 does not recite via what method or system information is sent between (1) the merchant and the payment processor, or (2) the payment processor and the mobile operator. But claim 1 does recite that information sent between (3) the mobile operator and the mobile phone of the user is sent via a mobile network of the mobile operator. (*See Claim 1.*) In short, claim 1 recites a specific network via which the recited communications between the mobile operator and the mobile phone of the user, i.e., the payment request and authorization text messages, are sent.

In view of the recitation in claim 1 of a specific network via which the recited communications between the mobile operator and the mobile phone

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of the user are sent, I would, in this case, determine that claim 1 imposes a meaningful limit on the abstract idea to which claim 1 is directed, i.e., “conducting secure purchase and payment transactions” (*see* Opinion 11-12; *see also id.* at 7–8), “such that the claim is more than a drafting effort designed to monopolize the judicial exception” (*see* 2019 Guidance at 54).

I respectfully dissent from the affirmance of the rejection under § 101.

# EXHIBIT B



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14/222,615	03/22/2014	Karim Anwar Rammal	151670-001 US CON2	6573

  

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The Villamar Firm PLLC 3424 Washington Drive Falls Church, VA 22041		

  

EXAMINER	
RANKINS, WILLIAM E	

  

ART UNIT	PAPER NUMBER
3694	

  

NOTIFICATION DATE	DELIVERY MODE
04/01/2019	ELECTRONIC

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

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 baravenwood@villamars.com

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* KARIM ANWAR RAMMAL

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Appeal 2017-003902  
Application 14/222,615<sup>1</sup>  
Technology Center 3600

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Before MURRIEL E. CRAWFORD, BRUCE T. WIEDER,  
MATTHEW S. MEYERS, *Administrative Patent Judges*.

Opinion for the Board filed by CRAWFORD, *Administrative Patent Judge*.

Opinion Dissenting filed by Wieder, *Administrative Patent Judge*.

CRAWFORD, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant seeks our review under 35 U.S.C. § 134(a) of the Examiner's final rejection of claims 1–19. We have jurisdiction under 35 U.S.C. § 6(b). Appellant appeared for oral hearing on February 14, 2019.

SUMMARY OF DECISION

We AFFIRM.

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<sup>1</sup> The Real Party in Interest in this appeal is NET2TEXT LTD.

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### THE INVENTION

Appellant's claims are directed to methods and systems for conducting secure purchase and payment transactions, and more particularly to a method, system and computer program product for conducting secure purchases and payment transactions using a mobile phone. (Spec. ¶ 2).

Claim 1 is representative of the subject matter on appeal.

Claim 1: A computer implemented system for processing payments for goods or services, the system comprising:

- a mobile operator servicing a mobile phone account of a user,

- wherein a payment processor receives a payment request for goods or services from a merchant, and the payment request includes a mobile phone number associated with the mobile phone account of the user;

- the payment processor, based on the payment request, is implemented by first circuitry configured to send a payment authorization request to a mobile operator servicing the mobile phone account of the user;

- the mobile operator, based on the payment authorization request, is implemented by second circuitry configured to send, over a mobile network of the mobile operator, a payment authorization request text message to a mobile phone of the user connected to the mobile network of the mobile operator requesting authorization for payment based on the payment request;

- the mobile phone of the user based on payment authorization request text message, is implemented by third circuitry configured to send, over the mobile network of the mobile operator, a payment authorization text message including a personal identification number of the user associated with the mobile phone number of the user to the mobile phone operator for authorization of payment based on the payment request;

- the second circuitry of the mobile operator is further configured to receive the payment authorization text message including the personal identification number of the user over

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the mobile network of the mobile operator for verification;  
the first circuitry of the payment processor is further configured to receive a payment authorization from the mobile phone operator based on the payment authorization text message for authorizing or not authorizing the payment based on the payment request;

the first circuitry of the payment processor is further configured to, if the payment authorization from the mobile phone operator authorizes the payment based on the payment request, pay the merchant for the goods or services from an account of the mobile phone operator, wherein the mobile phone operator charges the mobile phone account of the user for the payment;

the first circuitry of the payment processor is further configured to, if the payment authorization from the mobile phone operator does not authorize the payment based on the payment request or if the payment authorization text message is not received by the mobile operator over the mobile network of the mobile operator within a predetermined period of time, decline to pay the merchant for the goods or services; and

wherein no financial information of the user nor the personal identification number of the user are sent to the payment processor.

#### THE REJECTIONS

Claims 1–19 under 35 U.S.C. § 112(a), first paragraph.

Claims 1–19 are rejected under 35 U.S.C. § 101 as directed to a judicial exception without significantly more.<sup>2</sup>

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<sup>2</sup> The Examiner rejected claims 1–12 on the ground of nonstatutory double patenting over claims 1–12 of U.S. Patent No. 8,682,792 and provisionally rejected claims 1–19 over claims 1–19 of copending Application No. 14/222,613 and Application No. 14/222,616. (Final Act. 10). Appellant argues that this rejection is moot because Appellant filed a terminal disclaimer which has been entered. *See* Reply Br. 5. The Patent Office's application database shows a terminal disclaimer filed and approved in this

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## ANALYSIS

### *REJECTION UNDER 35 U.S.C. §112, FIRST PARAGRAPH*

The Examiner concludes that the claims recite a mobile operator implemented by second circuitry and that as the mobile operator is interpreted as a carrier such as Verizon or AT&T, the mobile operator itself could not be comprised of application specific circuitry. (Final Act. 11).

We will not sustain this rejection because we agree with the Appellant that one would appreciate that the inventors had possession of the claimed feature at the time the present application was filed. (App. Br. 8). Specifically, we agree with the Appellant that mobile operators are implemented using circuitry, which is a fact that is well appreciated in the art. (Reply Br. 3).

### *REJECTION UNDER 35 U.S.C. § 101*

We will sustain the rejection of claims 1–19 under 35 U.S.C. § 101.

#### The Supreme Court

set forth a framework for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts. First, . . . determine whether the claims at issue are directed to one of those patent-ineligible concepts. . . . If so, . . . then ask, “[w]hat else is there in the claims before us?” . . . To answer that question, . . . consider the elements of each claim both individually and “as an ordered combination” to determine whether the additional elements “transform the nature of the

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application on June 14, 2019. Therefore, we will not review these rejections.



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claim” into a patent-eligible application. . . . [The Court] described step two of this analysis as a search for an “‘inventive concept’”—*i.e.*, 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.”

*Alice Corp. v. CLS Bank Int’l*, 573 U.S. 208, 217–18 (2014) (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 72–73 (2012)) (citations omitted).

To perform this test, we must first determine whether the claims at issue are directed to a patent-ineligible concept. 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.’” *See Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335 (Fed. Cir. 2016) (quoting *Internet Patents Corp.*, 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 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 judicial exception is integrated into a practical application. *2019 Revised Patent Subject Matter Eligibility Guidance*, 84 Fed. Reg. 50 (Jan. 7, 2019).

The Examiner determines that the claims are directed to a fundamental economic practice similar to mitigating settlement risk or creating a contractual relationship. (Final Act. 7). The Examiner also

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determines that the claims are directed to methods and systems for conducting secure purchase and payment transactions. (Ans. 4). The Examiner finds that the additional elements or combination of elements in the claims other than the abstract idea per se amount to no more than the instructions to implement the idea on a computer, and/or a recitation of generic computer structure that serves to perform generic computer functions that are well-understood, routine and conventional activities previously known. (Final Act. 8).

We note that the Specification discloses that the claims are directed to conducting secure purchase and payment transactions. (Spec. ¶ 2). The Specification identifies that “security, fraud and identity theft are major concerns” for consumers while using credit and debit cards. (Spec. ¶¶ 3, 4, 6). According to the Specification, other alternative options such as “money transfer using a third independent financial entity, E-mail payments, and mobile wallet applications that act as intermediaries or interfaces between a customer’s financial institution (typically a bank or a credit card company) and the retailer/merchant)” also share the same drawbacks as credit and debit cards. (Spec. ¶ 4). However, these alternative payment options may also include “unreasonable hidden costs that are additionally charged by credit cards, mobile wallets and other financial instruments that are above and beyond what the retailer is already charging.” (Spec. ¶ 6). The Specification further discloses that “[c]onventional systems of payment and methods using mobile phones” are also known in the art, but “have limitations, including requiring downloading of complex software, need to use hi-tech mobile phones, need for additional security codes, hidden costs,

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and additional charges by the customer's bank or credit card company.”  
(Spec. ¶ 7).

To address these limitations and concerns, transactions are processed in exemplary independent claim 1 by the mobile phone, the mobile operator, and the payment processor in a way such that no personal information is sent to the payment processor, i.e., “[t]he present method as described above virtually presents an anti-fraudulent payment system that provides peace of mind and convenience to customers as they and their mobile operator are the only ones who know the PIN Code to authorize payments to retailers.” (Spec. ¶¶ 2, 20, 34). To accomplish this, the mobile operator checks the customer’s mobile number account balance, and if found sufficient to pay for the purchase, sends a text message to the customer on their mobile number giving them details of the retailer and the total amount payable. If the customer agrees to the purchase, the customer sends a unique PIN code to the mobile operator and the mobile operator then agrees to pay the payment processor. (Spec. ¶¶ 20–21). As such, the payment process is between the mobile operator and the payment processor with the mobile operator essentially acting as an intermediary debiting/charging the customer’s mobile account for the amount of the purchase. (Spec. ¶¶ 23–24). From this disclosure it follows that the claimed invention is directed to conducting secure purchase payment transactions as determined by the Examiner.

The recitations in claim 1 demonstrate further that the claimed subject matter relates to conducting secure purchase and payment transactions. For example, claim 1 recites a “mobile operator”, a “payment processor” and a “mobile phone.” Claim 1 further recites that the “payment processor

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receives a payment request for goods and services from a merchant,” and that the payment processor includes “circuitry configured to send a payment authorization request to a mobile operator.” The mobile operator includes “circuitry configured to send . . . a payment authorization request text message to a mobile phone.” Claim 1 also recites “the mobile phone . . . based on the payment authorization request text message . . . configured to send . . . a payment authorization text message.” The payment processor is configured “to receive payment authorization from the mobile phone operator based on the payment authorization.” As such, claim 1 is directed to conducting secure purchase and payment transactions and thus is a sales activity. Therefore, we agree with the Examiner that the claims are directed to a method of organizing human activity. Certain methods of organizing human activity such as fundamental economic practices are included in the abstract idea exception. *See 2019 Revised Patent Subject Matter Eligibility Guidance*, 84 Fed. Reg. at 52.

Turning to the second prong of the “directed to test”, we note that claim 1 requires a “payment processor,” a “mobile operator,” and a “mobile phone” to perform the steps of claim 1. These recitations do not affect an improvement in the functioning of the processor, mobile operator of phone or other technology. In addition, claim 1 does not recite a particular machine or manufacture. In fact, Appellant’s Specification discloses that all or a portion of the devices and subsystems of the exemplary embodiments can be conveniently implemented using one or more general purpose computer systems, microprocessors, digital signal processors, or micro-controllers. (Spec. ¶ 49). The mobile operator is disclosed as the mobile phone service provider/operator/carrier which has a processor which is

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configured to send, receive, process and store data (Spec. ¶ 16,). No improvement to the mobile operator is disclosed or claimed. These recitations “do not impose meaningful limits on the judicial exception, such that the claim is more than a drafting effort designed to monopolize the judicial exception.” *See 2019 Revised Patent Subject Matter Eligibility Guidance*, 84 Fed. Reg. at 55. Thus, claim is directed to a judicial exception without a practical application.

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 that is sufficient to ensure that the claim in practice amounts to significantly more than the abstract idea itself. *See Alice*, 573 US 208 at 218 (alteration in original) (quoting *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 72–73 (2012)).

The introduction of a processor, a mobile phone and a mobile operator into the claims does not alter the analysis at *Alice* step two.

[T]he mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention. Stating an abstract idea “while adding the words ‘apply it’” is not enough for patent eligibility. Nor is limiting the use of an abstract idea “to a particular technological environment.” Stating an abstract idea while adding the words “apply it with a computer” simply combines those two steps, with the same deficient result. Thus, if a patent’s recitation of a computer amounts to a mere instruction to “implemen[t]” an abstract idea “on . . . a computer,” that addition cannot impart patent eligibility. This conclusion accords with the preemption concern that undergirds our § 101 jurisprudence. Given the

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ubiquity of computers, wholly generic computer implementation is not generally the sort of “additional featur[e]” that provides any “practical assurance that the process is more than a drafting effort designed to monopolize the [abstract idea] itself.”

*Alice*, 573 US 208. at 223–224 (alterations in original) (citations omitted).

Instead, “the relevant question is whether the claims here do more than simply instruct the practitioner to implement the abstract idea . . . on a generic computer.” *Id.* at 225.

Taking the claim elements separately, the functions performed by the computers at each step of the process are purely conventional. Using a computer to retrieve, select, and apply decision criteria to data and modify the data as a result, 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.*, 830 F.3d at 1354; *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. As to the data operated upon, “even if a process of collecting and analyzing information is ‘limited to particular content’ or a particular ‘source,’ that limitation does not make the collection and analysis other than abstract.” *SAP Am. Inc. v. InvestPic, LLC*, 890 F.3d 1016, 1022 (Fed. Cir. 2018).

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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-access/display 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 steps of claim 1 are, therefore, ordinary and conventional.

The claims do not, for example, purport to improve the functioning of the mobile phone, payment processor or mobile operator. As we stated above, the claims do not affect an improvement in any other technology or technical field. The Specification spells out the devices and subsystems of the exemplary embodiments can be implemented on the World Wide Web. The exemplary embodiments are not limited to any specific combination of hardware circuitry and/or software but can be implemented using one or more general purpose computer system, microprocessor, digital signal processors, micro-controllers, and the like, programmed according to the teachings of the exemplary embodiments of the present invention. (Spec. ¶49). Thus, the recitation of the mobile operator, the payment processor and mobile phone and the associated circuitry recited in claim 1 amount to nothing significantly more than instructions to apply the abstract idea of

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payment processing using some unspecified, generic computers. Under our precedents, that is not enough to transform an abstract idea into a patent-eligible invention. *See Alice*, 573 U.S. 208. at 226.

We have reviewed all the arguments (App. Br. 9–19, Reply Br. 5–9) Appellant has submitted concerning the patent eligibility of the claims before us that stand rejected under 35 U.S.C. § 101. 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 the same.

We are not persuaded of error on the part of the Examiner by Appellant’s argument that the claims are not directed to an abstract idea because claim 1 is not directed to a contractual relationship, hedging or mitigating settlement risk. (App. Br. 11). Even if the Appellant is correct, the claims *are* directed to conducting secure purchases and payment transactions, which is a sales activity and thus is a method of organizing human activities, i.e. an abstract idea. *2019 Revised Patent Subject Matter Eligibility Guidance*, 84 Fed. Reg. at 52.

We are not persuaded of error on the part of the Examiner by Appellant’s argument that the claims are rooted in and are analogous to the claims in *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245 (Fed. Cir. 2014). (App. Br. 13). In *DDR Holdings*, the Court evaluated the eligibility of claims “address[ing] the problem of retaining website visitors that, if adhering to the routine, conventional functioning of Internet hyperlink protocol, would be instantly transported away from a host’s website after ‘clicking’ on an advertisement and activating a hyperlink.” *DDR*, 773 F.3d at 1257. There, the Court found that the claims



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were patent eligible because they transformed the manner in which a hyperlink typically functions to resolve a problem that had no “pre-Internet analog.” *Id.* at 1258. The Court cautioned, however, “that not all claims purporting to address Internet-centric challenges are eligible for patent.” *Id.* For example, in *DDR Holdings* the Court distinguished the patent-eligible claims at issue from claims found patent-ineligible in *Ultramercial*. *See id.* at 1258–59 (citing *Ultramercial*, 772 F.3d 709, 715–16). As noted there, the *Ultramercial* claims were “directed to a specific method of advertising and content distribution that was previously unknown and never employed on the Internet before.” *Id.* at 1258 (quoting *Ultramercial*, 772 F.3d at 715–16). Nevertheless, those claims were patent ineligible because they “merely recite[d] the abstract idea of ‘offering media content in exchange for viewing an advertisement,’ along with ‘routine additional steps such as updating an activity log, requiring a request from the consumer to view the ad, restrictions on public access, and use of the Internet.’” *Id.*

Appellant’s asserted claims are analogous to claims found ineligible in *Ultramercial* and distinct from claims found eligible in *DDR Holdings*. The ineligible claims in *Ultramercial* recited “providing [a] media product for sale at an Internet website;” “restricting general public access to said media product;” “receiving from the consumer a request to view [a] sponsor message;” and “if the sponsor message is an interactive message, presenting at least one query to the consumer and allowing said consumer access to said media product after receiving a response to said at least one query.” *Ultramercial*, 772 F.3d at 712. Similarly, Appellant’s asserted

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claims recite receiving, analyzing, modifying, and transmitting data. This is precisely the type of Internet activity found ineligible in *Ultramercial*.

We are not persuaded of error on the part of the Examiner by Appellant's arguments that the claims include an element or combination of elements that amount to significantly more than the judicial exception. (App. Br. 15). The Appellant argues that the present invention includes benefits such as increased flexibility, faster search times and smaller memory requirements. (App. Br. 14). Yet, the advantages that Appellant touts do not concern an improvement to computer capabilities, but instead relate to an improvement to the process for conducting payments for which a computer system is used as a tool in its ordinary capacity. Here, a generic graphical user interface performs the well-understood function of receiving user input, and a generic computer system performs routine data processing steps. Appellant fails to identify, and we do not find, any indication in the record that the claimed invention improves computer functionality, requires specialized computer hardware or other inventive components, invokes inventive programming, or is otherwise directed to something other than the abstract idea identified by the Examiner.

We are not persuaded of error on the part of the Examiner by Appellant's argument that the claims are novel and distinguish over the prior art cited by the Examiner. (App. Br. 17, Reply Br. 8–11). To the extent Appellant maintains that the limitations of claim 1 necessarily amount to “significantly more” than an abstract idea because the claimed apparatus is allegedly patentable over the prior art, Appellant misapprehend the controlling precedent. Although the second step in the *Alice/Mayo* framework is termed a search for an “inventive concept,” the analysis is not

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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.” *Alice*, 573 U.S. 208 at 217–18. A novel and nonobvious claim directed to a purely abstract idea is, nonetheless, patent-ineligible. *See Mayo*, 132 S. Ct. at 1304. We note, that contrary to the arguments presented by the Appellant on pages 8–9 of the Reply Brief, the Examiner has not cited prior art against the instant claims to show obviousness but rather to establish that the use of a transaction process that uses a PIN code for authorization and in which no personal identification number of users is sent to the payment processor and a process in which a mobile phone is used to make purchases are well-known and conventional. (*See, e.g.*, Ans. 6–10).

We are not persuaded of error on the part of the Examiner by Appellant’s argument that the claims perform functions that were not known in the art and therefore the claims recite significantly more than any abstract idea. Specifically, Appellant argues that the elements of the system are configured or programmed in a way to perform the functions that were not known in the art. (App. Br. 17). Appellant’s argument does not apprise us of error because Appellant conflates the conventionality of the steps that the processor performs and the conventionality of the computer functions required to implement the steps. In this regard, Appellant does not explain how the computers involved in the present invention perform functions other than the conventional transmission, storage, and analysis of data, which are well known functions of any computer.

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We do not agree with the Appellant that the claims are analogous to the claims in *BASCOM Global Internet Servs. v. AT&T Mobility LLC*, 827 F.3d 1341 (Fed. Cir. 2016). (Reply Br. 12). Appellant argues that sending a payment authorization including a PIN of the user to the mobile phone operator which then sends a payment authorization to the payment processor does not merely select information by content and source. Specifically, Appellant argues that the sequence of events in the instant process differs from the routine and conventional sequence of events for conducting mobile payments.

In *BASCOM*, the Federal Circuit followed the Supreme Court's guidance for determining whether the claims recite an inventive concept set forth in *Alice Corp. v. CLS Bank Int'l*, 573 U.S. 208, 221–227 (2014). In *Alice*, the Supreme Court explained that, under the second step of the patent-eligibility analysis, “the relevant question is whether the claims do more than simply instruct the practitioner to implement the abstract idea of intermediated settlement on a generic computer.” 573 U.S. 208, 225 (2014). The Supreme Court also provided examples of claims that represent more than instructions to implement an abstract idea on a generic computer, such as claims that purport to improve the functioning of the computer itself and claims that effect an improvement in any other technology or technical field. *Id.* at 225.

Turning to *BASCOM*, the Federal Circuit held “[t]he inventive concept described and claimed in the '606 patent is the installation of a filtering tool at a specific location, remote from end-users, with customizable filtering features specific to each end user.” 827 F.3d at 1350. In determining this feature to be an inventive concept, the Federal Circuit

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explained that the remote location of a filtering tool having customizable user-specific filtering features provides the filtering tool both the benefits of a filter on a local computer and the benefits of a filter on the ISP server and is a technical improvement over prior art ways of filtering content. *Id.* at 1350–51. Notably, the Federal Circuit specifically determined that “the claims may be read to ‘improve[] an existing technological process.’” *Id.* at 1351 (citing *Alice*, 573 U.S. 208 at 223).

In *BASCOM* it was filtering by an ISP server which was the focus of the claims, whereas claim 1 focuses on processing exchanging data between a mobile operator and a payment processor regarding a payment which is authorized by a user PIN. Claim 1 recites a process in which the payment is made between the mobile operator and a payment processor with the payment being authorized by a user PIN without revealing any personal information of the customer. There is no improvement to the mobile phone, mobile operator or the payment processor.

In addition, we agree with the Examiner’s findings that the sequence of events recited in the claim are well known and conventional as demonstrated by “prior art as evidenced by the prior art associated with the prosecution of the parent case 13/148,043 now patent 8,862, 792” (Ans. 5), “[u]sing a PIN code to authorize a financial transaction through a mobile phone using sms” (Ans. 7 (citing paragraphs 11 and 93 of US Patent Pub. No. 2007/0107044 to Yuen)), and “[b]illing to a mobile operator” (Ans. 9 (citing paragraph 7 of US Patent Pub. No. 2006/0149644 to Sulmar; paragraphs 38 and 65 of US Patent Pub. No. 2001/0037264 to Husemann)). As such, the sequence of events recited in claim 1 is well known and conventional. Therefore, we agree with the Examiner that claim 1 does not

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include an inventive concept.

In view of the foregoing, we will sustain this rejection of claim 1. We will also sustain the rejection of the remaining claims because the Appellant has not argued the separate eligibility of these claims.

#### DECISION

The rejection of claims 1–19 under 35 U.S.C. §112, first paragraph is not affirmed.

The rejection of claims 1–19 under 35 U.S.C. §101 is affirmed.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* KARIM ANWAR RAMMAL

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Appeal 2017-003902  
Application 14/222,615  
Technology Center 3600

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Before MURRIEL E. CRAWFORD, BRUCE T. WIEDER, and  
MATTHEW S. MEYERS, *Administrative Patent Judges*.

WIEDER, *Administrative Patent Judge*, dissenting.

I respectfully dissent from the majority opinion affirming the  
Examiner's rejection of claims 1–19 under 35 U.S.C. § 101.

In analyzing whether a claim recites patent-eligible subject matter, we  
apply a two-step framework, earlier set out in *Mayo Collaborative Services*  
*v. Prometheus Laboratories, Inc.*, 566 U.S. 66 (2012), “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*, 573 U.S. 208, 217 (2014).

Under the two-step framework, it must first be determined if “the  
claims at issue are directed to a patent-ineligible concept.” *Id.* If the claims  
are determined to be directed to a patent-ineligible concept, e.g., an abstract

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idea, then the second step of the framework is applied to determine if “the elements of the claim . . . contain[] an ‘inventive concept’ sufficient to ‘transform’ the claimed abstract idea into a patent-eligible application.” *Id.* at 221 (citing *Mayo*, 566 U.S. at 72–73, 79).

With regard to step one of the *Alice* framework, we apply a “directed to” two prong test to: 1) evaluate whether the claim recites a judicial exception, i.e., a law of nature, natural phenomenon, or abstract idea, 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.” *See 2019 Revised Patent Subject Matter Eligibility Guidance*, 84 Fed. Reg. 50, 54 (Jan. 7, 2019) (hereinafter “2019 Guidance”).

With regard to the first prong of the 2019 Guidance, I agree with the majority opinion “that the Specification discloses that the claims are directed to conducting secure purchase and payment transactions.” (Opinion 6 (citing Spec. ¶ 2).) I also agree with the majority opinion that “the claims are directed to conducting secure purchases and payment transactions, which is a sales activity and thus is a method of organizing human activities, i.e. an abstract idea.” (Opinion 12 (emphasis omitted); *see also id.* at 8.)

With regard to the second prong, I do not agree with the majority opinion that the recitations in claim 1 “do not impose meaningful limits on the judicial exception, such that the claim is more than a drafting effort designed to monopolize the judicial exception.” (Opinion 8 (citing 2019 Guidance at 55).)



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Claim 1 recites that “the payment processor . . . is implemented by first circuitry configured to send a payment authorization request to a mobile operator,” that “the mobile operator . . . is implemented by second circuitry configured to send, *over a mobile network of the mobile operator*, a payment authorization request text message to a mobile phone of the user,” “the mobile phone . . . payment authorization request text message, is implemented by third circuitry configured to send, *over the mobile network of the mobile operator*, a payment authorization text message,” “the second circuitry . . . is further configured to receive the payment authorization text message . . . *over the mobile network of the mobile operator*,” “wherein no financial information of the user nor the personal identification number of the user are sent to the payment processor.” (Emphasis added.)

Claim 1 refers to four entities: a mobile phone of a user, a merchant, a payment processor, and a mobile operator. Claim 1 does not recite via what method or system information is sent between (1) the merchant and the payment processor, or (2) the payment processor and the mobile operator. But claim 1 does recite that information sent between (3) the mobile operator and the mobile phone of the user is sent via a mobile network of the mobile operator. (*See* Claim 1.) In short, claim 1 recites a specific network via which the recited communications between the mobile operator and the mobile phone of the user, i.e., the payment request and authorization text messages, are sent.

In view of the recitation in claim 1 of a specific network via which the recited communications between the mobile operator and the mobile phone of the user are sent, I would, in this case, determine that claim 1 imposes a meaningful limit on the abstract idea to which claim 1 is directed, i.e.,

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“conducting secure purchases and payment transactions” (*see* Opinion 12; *see also id.* at 8), such that “the claim is more than a drafting effort designed to monopolize the judicial exception” (*see* 2019 Guidance at 54).

I respectfully dissent from the affirmance of the rejection under § 101.

# EXHIBIT C



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14/222,616	03/22/2014	Karim Anwar Rammal	151670-001 US CON3	6514

  

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RANKINS, WILLIAM E	

  

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* KARIM ANWAR RAMMAL

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Appeal 2017-004916  
Application 14/222,616<sup>1</sup>  
Technology Center 3600

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Before MURRIEL E. CRAWFORD, BRUCE T. WIEDER, and  
MATTHEW S. MEYERS, *Administrative Patent Judges*.

Opinion for the Board filed by CRAWFORD, *Administrative Patent Judge*.

Opinion Dissenting filed by WIEDER, *Administrative Patent Judge*.

CRAWFORD, *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 claims 1–19. We have jurisdiction under 35 U.S.C. § 6(b).

SUMMARY OF DECISION

We AFFIRM.

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<sup>1</sup> The Real Party in Interest in this appeal is NET2TEXT LTD.

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### THE INVENTION

The present invention generally relates to methods and systems for conducting secure purchase and payment transactions, and more particularly to a method, system and computer program product for conducting secure purchase and payment transactions using a mobile phone. (Spec. ¶ 002).

Claim 1 is representative of the subject matter on appeal.

Claim 1 (Rejected): A computer implemented system for processing payments for goods or services, the system comprising:

a mobile phone of a user including a mobile phone number associated with a mobile phone account of the user,

wherein a payment processor implemented by first circuitry is configured to receive a payment request for goods or services from a merchant, the payment request including the mobile phone number associated with the mobile phone account of the user;

the first circuitry of the payment processor, based on the payment request, is further configured to send a payment authorization request to a mobile operator implemented by second circuitry and configured to service the mobile phone account of the user;

the second circuitry of the mobile operator, based on the payment authorization request, is configured to send, over a mobile network of the mobile operator, a payment authorization request text message to the mobile phone of the user implemented by third circuitry and connected to the mobile network of the mobile operator, the payment authorization request text message

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requesting authorization for payment based on the payment request;

the third circuitry of the mobile phone of the user, based on the payment authorization request text message, is configured to send, over the mobile network of the mobile operator, a payment authorization text message including a personal identification number of the user associated with the mobile phone number of the user to the mobile phone operator for authorization of payment based on the payment request;

the second circuitry of the mobile operator is further configured to receive the payment authorization text message including the personal identification number of the user over the mobile network of the mobile operator for verification;

the first circuitry of the payment processor is further configured to receive a payment authorization from the mobile phone operator based on the payment authorization text message authorizing or not authorizing the payment based on the payment request;

the first circuitry of the payment processor is further configured to, if the payment authorization from the mobile phone operator authorizes the payment based on the payment request, pay the merchant for the goods or services from an account of the mobile phone operator, wherein the mobile phone operator charges the mobile phone account of the user for the payment;

the first circuitry of the payment processor is further configured to, if the payment authorization from the mobile phone operator does not authorize the payment based on the

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payment request or if the payment authorization text message is not received by the mobile operator over the mobile network of the mobile operator within a predetermined period of time, decline to pay the merchant for the goods or services; and

wherein no financial information of the user nor the personal identification number of the user are sent to the payment processor.

#### THE REJECTIONS<sup>2</sup>

Claims 1, 5 and 9 are rejected under 35 U.S.C. §112, first paragraph.

Claims 1–19 are rejected under 35 U.S.C. § 101 as directed to a judicial exception without significantly more.

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<sup>2</sup> The Examiner has withdrawn a rejection of claims 9–12 under 35 U.S.C. § 101 as directed to software per se. (Final Act. 2; *cf.* Non-Final Action, mailed November 17, 2014). The Examiner also has withdrawn a non-statutory double patenting rejection over claims 1–12. (*See* Ans. 5).



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### ANALYSIS

#### *REJECTION UNDER 35 U.S.C. §112, FIRST PARAGRAPH*

The Examiner concludes that the claims recite a mobile operator implemented by second circuitry and that as the mobile operator is interpreted as a carrier such as Verizon or AT&T and therefore, the mobile operator itself could not be comprised of application specific circuitry. (Final Act. 11). We will not sustain this rejection because we agree with the Appellant that the Specification provides support for the recitations.

#### *REJECTION UNDER 35 U.S.C. §101*

We will sustain the rejection of claims 1–19 under 35 U.S.C. § 101.

#### The Supreme Court

set forth a framework for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts. First, . . . determine whether the claims at issue are directed to one of those patent-ineligible concepts. . . . If so, . . . then ask, “[w]hat else is there in the claims before us?” . . . To answer that question, . . . consider the elements of each claim both individually and “as an ordered combination” to determine whether the additional elements “transform the nature of the claim” into a patent-eligible application. . . . [The Court] described step two of this analysis as a search for an “‘inventive concept’”—*i.e.*, 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.”

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*Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2355 (2014) (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 72–73 (2012)) (citations omitted).

To perform this test, we must first determine whether the claims at issue are directed to a patent-ineligible concept. 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.’” *See Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335 (Fed. Cir. 2016) (quoting *Internet Patents Corp.*, 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 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 judicial exception is integrated into a practical application. *2019 Revised Patent Subject Matter Eligibility Guidance*, 84 FR 50, pp 50–57, PTO–2018–0053 (Jan. 7, 2019).

The Examiner determines that the claims are directed to payment processing which the Examiner concludes is a fundamental economic practice. (Final Act. 7). The Examiner found that the additional elements or combination of elements in the claims other than the abstract idea per se amount to no more than the instructions to implement the idea on a computer, and/or recitation of generic computer structure that serves to perform generic computer functions that are well-understood, routine and conventional activities previously known. (Final Act. 8).

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We note that the Specification discloses that the claims are directed to conducting secure purchase and payment transactions (Spec. ¶ 2). The Specification identifies that “security, fraud and identity theft are major concerns” for consumers while using credit and debit cards. (Spec. ¶¶ 3, 4, 6). According to the Specification, other alternative options such as “money transfer using a third independent financial entity, E-mail payments, and mobile wallet applications that act as intermediaries or interfaces between a customer’s financial institution (typically a bank or a credit card company) and the retailer/merchant)” also share the same drawbacks as credit and debit cards. (Spec. ¶ 4). However, these alternative payment options may also include “unreasonable hidden costs that are additionally charged by credit cards, mobile wallets and other financial instruments that are above and beyond what the retailer is already charging.” (Spec. ¶ 6). The Specification further discloses that “[c]onventional systems of payment and methods using mobile phones” are also known in the art, but “have limitations, including requiring downloading of complex software, need to use hi-tech mobile phones, need for additional security codes, hidden costs, and additional charges by the customer's bank or credit card company.” (Spec. ¶ 7).

To address these limitations and concerns, transactions are processed in exemplary independent claim 1 by the mobile phone, the mobile operator, and the payment processor in a way such that no personal information is sent to the payment processor, i.e., “[t]he present method as described above virtually presents an anti-fraudulent payment system that provides peace of mind and convenience to customers as they and their mobile operator are the only ones who know the PIN Code to authorize payments to retailers.” (Spec. ¶¶ 2, 20, 34). To accomplish this, the mobile operator checks the

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customer's mobile number account balance, and if found sufficient to pay for the purchase, sends a text message to the customer on their mobile number giving them details of the retailer and the total amount payable. If the customer agrees to the purchase, the customer sends a unique PIN code to the mobile operator and the mobile operator then agrees to pay the payment processor. (Spec. ¶¶ 20–21). As such, the payment process is between the mobile operator and the payment processor with the mobile operator essentially acting as an intermediary debiting/charging the customer's mobile account for the amount of the purchase. (Spec. ¶¶ 23–24). From this disclosure it follows that the claimed invention is directed to conducting secure purchase and payment transactions as determined by the Examiner.

The recitations in claim 1 demonstrate further that the claimed subject matter relates to conducting secure purchase and payment transactions. For example, claim 1 recites a “mobile operator”, a “payment processor” and a “mobile phone.” Claim 1 further recites that the “payment processor is configured to receive a payment request for goods and services from a merchant,” and that the payment processor includes “circuitry configured to send a payment authorization request to a mobile operator.” The mobile operator includes “circuitry configured to send . . . a payment authorization request text message to a mobile phone.” Claim 1 also recites “the mobile phone . . . based on the payment authorization request text message . . . is configured to send . . . a payment authorization text message.” The payment processor is configured “to receive payment authorization from the mobile phone operator based on the payment authorization.” Claim 1 also recites “wherein no financial information of the user nor the personal identification number of the user is sent to the payment processor.” Claim 1 is directed to

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conducting secure purchase and payment transactions which is a sales activity. Sales activity is a certain method of organizing human activity and is a judicial exception. *See 2019 Revised Patent Subject Matter Eligibility Guidance*, 84 FR at 52.

Turning to the second prong of the “directed to test”, we note that claim 1 requires a “payment processor,” a “mobile operator,” and a “mobile phone” to perform the steps of claim 1. These recitations do not affect an improvement in the functioning of the processor, mobile operator of phone or other technology. In addition, claim 1 does not recite a particular machine or manufacture. In fact, Appellant’s Specification discloses that all or a portion of the devices and subsystems of the exemplary embodiments can be conveniently implemented using one or more general purpose computer systems, microprocessors, digital signal processors, or micro-controllers. (Spec. ¶ 49). The mobile operator is disclosed as the mobile phone service provider/operator/carrier with a processor which is configured to send, receive, process and store data (Spec. ¶ 16). No improvement to the mobile operator is disclosed or claimed. These recitations do not impose meaningful limits on the judicial exception, such that the claim is more than a drafting effort designed to monopolize the judicial exception.” *2019 Revised Patent Subject Matter Eligibility Guidance* at 55. Thus, claim 1 is directed to a judicial exception and thus recites an abstract idea without a practical application.

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 that is sufficient to ensure that the claim in practice amounts to significantly more than the abstract idea itself.

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See *Alice*, 134 S. Ct. at 2355 (alteration in original) (quoting *Mayo*

*Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 72–73 (2012)).

The introduction of a processor, a mobile phone and a mobile operator into the claims does not alter the analysis at *Alice* step two.

[T]he mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention. Stating an abstract idea “while adding the words ‘apply it’” is not enough for patent eligibility. Nor is limiting the use of an abstract idea “to a particular technological environment.” Stating an abstract idea while adding the words “apply it with a computer” simply combines those two steps, with the same deficient result. Thus, if a patent’s recitation of a computer amounts to a mere instruction to “implemen[t]” an abstract idea “on . . . a computer,” that addition cannot impart patent eligibility. This conclusion accords with the preemption concern that undergirds our § 101 jurisprudence. Given the ubiquity of computers, wholly generic computer implementation is not generally the sort of “additional featur[e]” that provides any “practical assurance that the process is more than a drafting effort designed to monopolize the [abstract idea] itself.”

*Alice*, 134 S. Ct. at 2358 (alterations in original) (citations omitted).

Instead, “the relevant question is whether the claims here do more than simply instruct the practitioner to implement the abstract idea . . . on a generic computer.” *Id.* at 2359. 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 retrieve, select, and apply decision criteria to data and modify the data as a result amounts to electronic data query and retrieval—one of

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the most basic functions of a computer. All of these computer functions are well-understood, routine, conventional activities previously known to the trading industry. *See Elec. Power Grp.*, 830 F.3d at 1354; *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. As to the data operated upon, “even if a process of collecting and analyzing information is ‘limited to particular content’ or a particular ‘source,’ that limitation does not make the collection and analysis other than abstract.” *SAP Am. Inc. v. InvestPic, LLC*, 890 F.3d 1016, 1022 (Fed. Cir. 2018).

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-access/display 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.

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The claims do not, for example, purport to improve the functioning of the mobile phone, payment processor or mobile operator. As we stated above, the claims do not affect an improvement to any other technology or technical field.

The Specification spells out that the devices and subsystems of the exemplary embodiments can be implemented on the World Wide Web. In addition, the devices and subsystems of the exemplary embodiments can be implemented by the preparation of application-specific integrated circuits or by interconnecting an appropriate network of conventional component circuits, as will be appreciated by those skilled in the electrical art(s). Thus, the exemplary embodiments are not limited to any specific combination of hardware circuitry and/or software. (Spec. ¶49). Thus, the claims at issue amount to nothing significantly more than instructions to apply the abstract idea of secure payment processing using some unspecified, generic computers. Under our precedents, that is not enough to transform an abstract idea into a patent-eligible invention. *See Alice*, 134 S. Ct. at 2360.

We have reviewed all the arguments (Appeal Br. 8–19; Reply Br. 5–11) Appellant has submitted concerning the patent eligibility of the claims before us that stand rejected under 35 U.S.C. § 101. 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.

We are not persuaded of error on the part of the Examiner by Appellant’s argument that the claims are directed to an abstract idea because claim 1 is not directed to a contractual relationship, hedging or mitigating settlement risk. (Brief 11). Even if the Appellant is correct, the claims are



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directed to conducting secure purchase and payment transactions which is a sales activity and thus is a method of organizing human activities which is an abstract idea. *2019 Revised Patent Subject Matter Eligibility Guidance*, 52.

We are not persuaded of error on the part of the Examiner by Appellant's argument that the claims are rooted in and are analogous to the claims in *DDR Holdings, LLC v. Hotels.com, L.P.* 773 F.3d 1245 (Fed. Cir. 2014). (Brief 13). In *DDR Holdings*, the Court evaluated the eligibility of claims "address[ing] the problem of retaining website visitors that, if adhering to the routine, conventional functioning of Internet hyperlink protocol, would be instantly transported away from a host's website after 'clicking' on an advertisement and activating a hyperlink." *DDR*, 773 F.3d at 1257. There, the Court found that the claims were patent eligible because they transformed the manner in which a hyperlink typically functions to resolve a problem that had no "pre-Internet analog." *Id.* at 1258. The Court cautioned, however, "that not all claims purporting to address Internet-centric challenges are eligible for patent." *Id.* For example, in *DDR Holdings* the Court distinguished the patent-eligible claims at issue from claims found patent-ineligible in *Ultramercial*. See *DDR*, 773 at 1258–59 (citing *Ultramercial*, 772 F.3d 709, 715–16 (Fed. Cir. 2014)). As noted there, the *Ultramercial* claims were "directed to a specific method of advertising and content distribution that was previously unknown and never employed on the Internet before." *Id.* at 1258 (quoting *Ultramercial*, 772 F.3d at 715–16). Nevertheless, those claims were patent ineligible because they "merely recite[d] the abstract idea of 'offering media content in exchange for viewing an advertisement,' along with 'routine additional steps such as updating an

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activity log, requiring a request from the consumer to view the ad, restrictions on public access, and use of the Internet.” *Id.*

Appellant’s asserted claims are analogous to claims found ineligible in *Ultramercial* and distinct from claims found eligible in *DDR Holdings*. The ineligible claims in *Ultramercial* recited “providing [a] media product for sale at an Internet website;” “restricting general public access to said media product;” “receiving from the consumer a request to view [a] sponsor message;” and “if the sponsor message is an interactive message, presenting at least one query to the consumer and allowing said consumer access to said media product after receiving a response to said at least one query.” *Ultramercial*, 772 F.3d at 712. Similarly, Appellant’s asserted claims recite receiving, analyzing, modifying, and transmitting data. This is precisely the type of Internet activity found ineligible in *Ultramercial*.

We are not persuaded of error on the part of the Examiner by Appellant’s argument that the claims include an element or combination of elements that amount to significantly more than the judicial exception. (Brief 14). The Appellant argues that the present invention includes benefits such as increased flexibility, faster search times and smaller memory requirements. Yet, the advantages that Appellant touts do not concern an improvement to computer capabilities, but instead relate to an improvement to the process for conducting payments for which a computer system is used as a tool in its ordinary capacity. In this case, a generic graphical user interface performs the well-understood function of receiving user input, and a generic computer system performs routine data processing steps. Appellant fails to identify, and we do not find, any indication in the record that the claimed invention improves computer functionality, requires specialized

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computer hardware or other inventive components, invokes inventive programming, or is otherwise directed to something other than the abstract idea identified by the Examiner.

We are not persuaded of error on the part of the Examiner by Appellant's argument that the claims are novel. (Brief 17). To the extent Appellant maintains that the limitations of claim 1 necessarily amount to "significantly more" than an abstract idea because the claimed apparatus is allegedly patentable over the prior art, Appellant misapprehends the controlling precedent. 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." *Alice*, 134 S. Ct. at 2355. A novel and nonobvious claim directed to a purely abstract idea is, nonetheless, patent-ineligible. *See Mayo* 566 U.S. 66, 72–73.

We are not persuaded of error on the part of the Examiner by Appellant's argument that the claims perform functions that were not known in the art and therefore the claims recite significantly more than any abstract idea. (Brief 17). Specifically, Appellant argues that the elements of the system are configured or programmed in a way to perform the functions that were not known in the art. (Brief 17). Appellant's argument does not apprise us of error because Appellant conflates the conventionality of the steps that the processor performs and the conventionality of the computer functions required to implement the steps. In this regard, Appellant does not explain how the computers involved in the present invention perform

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functions other than the conventional transmission, storage, and analysis of data which are well known functions of any computer.

We do not agree with the Appellant that the claims are analogous to the claims in *BASCOM Global Internet Servs. v. AT&T Mobility LLC*, 827 F.3d 1341 (Fed. Cir. 2016). (Reply 11). Appellant argues that sending a payment authorization including a PIN of the user to the mobile phone operator which then sends a payment authorization to the payment processor does not merely select information by content and source. Specifically, Appellant argues that the sequence of events in the instant process differs from the routine and conventional sequence of events for conducting mobile payments.

In *BASCOM*, the Federal Circuit followed the Supreme Court's guidance for determining whether the claims recite an inventive concept set forth in *Alice Corp. Pty. Ltd. v. CLS Bank International*, 134 S. Ct. 2347, 2357–60 (2014). In *Alice*, the Supreme Court explained that, under the second step of the patent-eligibility analysis, “the relevant question is whether the claims here do more than simply instruct the practitioner to implement the abstract idea of intermediated settlement on a generic computer.” *Alice* 134 S. Ct. 2347, 2359 (2014). The Supreme Court also provided examples of claims that represent more than instructions to implement an abstract idea on a generic computer, such as claims that purport to improve the functioning of the computer itself and claims that effect an improvement in any other technology or technical field. *Id.* at 2359–60.

Turning to *BASCOM*, the Federal Circuit held “[t]he inventive concept described and claimed in the '606 patent is the installation of a

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filtering tool at a specific location, remote from end-users, with customizable filtering features specific to each end user.” 827 F.3d at 1350. In determining this feature to be an inventive concept, the Federal Circuit explained that the remote location of a filtering tool having customizable user-specific filtering features provides the filtering tool both the benefits of a filter on a local computer and the benefits of a filter on the ISP server and is a technical improvement over prior art ways of filtering content. *Id.* at 1350–51. Notably, the Federal Circuit specifically determined that “the claims may be read to ‘improve[] an existing technological process.’” *Id.* at 1351 (citing *Alice*, 134 S. Ct. at 2358).

In *BASCOM* it was filtering by an ISP server which was the focus of the claims, whereas claim 1 focuses on processing and exchanging data between a mobile operator and a payment processor regarding a payment which is authorized by a user PIN. Claim 1 recites a process in which the payment is made between the mobile operator and a payment processor with the payment being authorized by a user PIN without revealing any personal information of the customer. There is no improvement to the mobile phone, mobile operator or the payment processor.

In addition, we agree with the Examiner, that it is well known and conventional to use a PIN code to authorize a payment using a mobile phone as demonstrated by the prior art of Goldthwaite (US 2004/0019564) which is discussed by the Examiner.<sup>3</sup> As such, the sequence of events recited in

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<sup>3</sup> In a related application (U.S. Application No.: 14/222,615 (“’615 Application”); Appeal No.: 2017-003902), the Examiner also discussed “prior art as evidenced by the prior art associated with the prosecution of the parent case 13/148,043 now patent 8,862, 792,” (’615 Application Examiner’s Answer, mailed, November 22, 2016, at 5), “[u]sing a PIN code to authorize a financial transaction through a mobile phone using sms” (’615

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claim 1 is well known and conventional. Therefore, we agree with the Examiner that claim 1 does not include an inventive concept.

In view of the foregoing, we will sustain the Examiner's rejection of claim 1 under 35 U.S.C. §101. We will also sustain the rejection as it is directed to the remaining claims because the Appellant has not argued the separate eligibility of these claims.

#### CONCLUSIONS OF LAW

We conclude the Examiner did err in rejecting claims 1, 5 and 9 under 35 U.S.C. § 112, first paragraph.

We conclude that the Examiner did not err in rejecting claims 1–19 under 35 U.S.C. § 101.

#### DECISION

The Examiner's rejection under 35 U.S.C. §112 is not affirmed.

The Examiner's rejection under 35 U.S.C. §101 is affirmed.

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

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Application Examiner's Answer 7 (citing paragraphs 11 and 93 of US Patent Pub. No. 2007/0107044 to Yuen)), and "[b]illing to a mobile operator" ('615 Application Examiner's Answer 9 (citing paragraph 7 of US Patent Pub. No. 2006/0149644 to Sulmar; paragraphs 38 and 65 of US Patent Pub. No. 2001/0037264 to Husemann)).

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* KARIM ANWAR RAMMAL

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Appeal 2017-004916  
Application 14/222,616  
Technology Center 3600

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Before MURRIEL E. CRAWFORD, BRUCE T. WIEDER, and  
MATTHEW S. MEYERS, *Administrative Patent Judges*.

WIEDER, *Administrative Patent Judge*, dissenting.

I respectfully dissent from the majority opinion affirming the  
Examiner's rejection of claims 1–19 under 35 U.S.C. § 101.

In analyzing whether a claim recites patent-eligible subject matter, we  
apply a two-step framework, earlier set out in *Mayo Collaborative Services*  
*v. Prometheus Laboratories, Inc.*, 566 U.S. 66 (2012), “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*, 573 U.S. 208, 217 (2014).

Under the two-step framework, it must first be determined if “the  
claims at issue are directed to a patent-ineligible concept.” *Id.* If the claims

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are determined to be directed to a patent-ineligible concept, e.g., an abstract idea, then the second step of the framework is applied to determine if “the elements of the claim . . . contain[] an ‘inventive concept’ sufficient to ‘transform’ the claimed abstract idea into a patent-eligible application.” *Id.* at 221 (citing *Mayo*, 566 U.S. at 72–73, 79).

With regard to step one of the *Alice* framework, we apply a “directed to” two prong test to: 1) evaluate whether the claim recites a judicial exception, i.e., a law of nature, natural phenomenon, or abstract idea, 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.” *See 2019 Revised Patent Subject Matter Eligibility Guidance*, 84 Fed. Reg. 50, 54 (Jan. 7, 2019) (hereinafter “2019 Guidance”).

With regard to the first prong of the 2019 Guidance, I agree with the majority opinion “that the Specification discloses that the claims are directed to conducting secure purchase and payment transactions.” (Opinion 7 (citing Spec. ¶ 2).) I also agree with the majority opinion that “the claims are directed to conducting secure purchase and payment transactions which is a sales activity and thus is a method of organizing human activities which is an abstract idea. (Opinion 12–13; *see also id.* at 8–9.)

With regard to the second prong, I do not agree with the majority opinion that the recitations in claim 1 “do not impose meaningful limits on the judicial exception, such that the claim is more than a drafting effort designed to monopolize the judicial exception.” (Opinion 9 (citing 2019 Guidance at 55).)



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Claim 1 recites “a mobile phone of a user . . . associated with a mobile phone account,” “a payment processor implemented by first circuitry is configured to receive a payment request,” “the first circuitry . . . is further configured to send a payment authorization request to a mobile operator implemented by second circuitry,” “second circuitry . . . is configured to send, *over a mobile network of the mobile operator*, a payment authorization request text message to the mobile phone,” “third circuitry of the mobile phone . . . is configured to send, *over the mobile network of the mobile operator*, a payment authorization text message,” “the second circuitry . . . is further configured to receive the payment authorization text message . . . *over the mobile network of the mobile operator*,” “the first circuitry . . . is further configured to receive a payment authorization from the mobile operator,” “wherein no financial information of the user nor the personal identification number of the user are sent to the payment processor.” (Emphasis added.)

Claim 1 refers to four entities: a mobile phone of a user, a merchant, a payment processor, and a mobile operator. Claim 1 does not recite via what method or system information is sent between (1) the merchant and the payment processor, or (2) the payment processor and the mobile operator. But claim 1 does recite that information sent between (3) the mobile operator and the mobile phone of the user is sent via a mobile network of the mobile operator. (*See* Claim 1.) In short, claim 1 recites a specific network via which the recited communications between the mobile operator and the mobile phone of the user, i.e., the payment request and authorization text messages, are sent.

In view of the recitation in claim 1 of a specific network via which the recited communications between the mobile operator and the mobile phone

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of the user are sent, I would, in this case, determine that claim 1 imposes a meaningful limit on the abstract idea to which claim 1 is directed, i.e., “conducting secure purchase and payment transactions (*see* Opinion 12–13; *see also id.* at 8–9), such that “the claim is more than a drafting effort designed to monopolize the judicial exception” (*see* 2019 Guidance at 54).

I respectfully dissent from the affirmance of the rejection under § 101.

# EXHIBIT D



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
14/222,613	03/22/2014	Karim Anwar Rammal	151670-001 US CON1	1373
95628	7590	06/27/2019		
The Villamar Firm PLLC 3424 Washington Drive Falls Church, VA 22041			EXAMINER RANKINS, WILLIAM E	
			ART UNIT 3694	PAPER NUMBER
			NOTIFICATION DATE 06/27/2019	DELIVERY MODE ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* KARIM ANWAR RAMMAL

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Appeal 2017-003513  
Application 14/222,613 <sup>1</sup>  
Technology Center 3600

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Before MURRIEL E. CRAWFORD, BRUCE T. WIEDER, and  
MATTHEW S. MEYERS, *Administrative Patent Judges*.

Opinion for the Board filed by CRAWFORD, *Administrative Patent Judge*.

Opinion Dissenting filed by WIEDER, *Administrative Patent Judge*.

CRAWFORD, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

STATEMENT OF THE CASE<sup>2</sup>

The Appellant filed a Request for Rehearing under 37 C.F.R. § 41.52 of the  
Decision on Appeal.

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<sup>1</sup> According to Appellant, the real party in interest is Appeal Br. Aug. 16, 2016.

<sup>2</sup> This Decision references the Appellant's Request for Rehearing ("Req.," filed May 30, 2019) and the Board Decision ("Dec.," mailed Apr. 1, 2019).

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Application 14/222,613

In the Decision on Appeal, the Board affirmed the rejection of claims under 35 U.S.C. § 101 as being directed to judicially-excepted subject matter. Judge Wieder dissented from the majority opinion.

We note at the outset that a Request for Rehearing “must state with particularity the points believed to have been misapprehended or overlooked by the Board.” 37 C.F.R. § 41.52(a). A Request for Rehearing is not an opportunity to rehash arguments raised in the Appeal Brief or in the Reply Brief. Neither is it an opportunity to merely express disagreement with a decision without setting forth points believed to have been misapprehended or overlooked. Arguments not raised in the briefs before the Board and evidence not previously relied on in the briefs also are not permitted except in the limited circumstances set forth in §§ 41.52(a)(2) through (a)(4). *Id.* To the extent the Appellant presents supplemental or new arguments in the Request, those arguments are untimely and, as such, will not be considered except where the arguments are based on a recent relevant decision of either this Board or a federal court, or on an allegation that the Board’s decision contains an undesignated new ground of rejection. *See id.*

Appellant argues that our decision overlooks that there is no evidence to support our findings on “meaningful limits” in accordance with the *2019 Revised Patent Subject Matter Eligibility*, 84 FR 50, pp 50-57, PTO-2018-0053 (Jan. 7, 2019) (“*Guidance*”). (Req. 2).

The *Guidance* states that only if a judicial exception recited in a claim is not integrated into a practical application in a manner that imposes a meaningful limit on the judicial exception does the claim recite an abstract idea. *Id.* at 53. The *Guidance* explains that the exemplary considerations which are indicative of a judicial exception being integrated into a practical application are if an additional

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element: (1) reflects an improvement in the functioning of a computer or an improvement to other technology or technical field; (2) applies or uses a judicial exception to effect a particular treatment or prophylaxis for a disease; (3) implements a judicial exception with a particular machine; (4) effects a transformation or reduction of a particular article to a different state or thing; and (5) applies or uses the judicial exception in some other meaningful way beyond generally linking the use of the judicial exception to a particular environment, such that the claims as a whole is more than a drafting effort designed to monopolize the exception.

Appellant argues that we overlooked that the claims address limitations and concerns of previous solutions in a way such that no personal information is sent to the payment processor. (Req. 3). Appellant argues that a meaningful limit is imposed by the specific network via which the recited communications between the mobile operator and mobile phone of the user are sent.

We did not overlook that the claims address limitations and concerns of previous solutions in a way that no personal information is sent to the payment processor. On page 8 of the decision, we found that the present invention claims a payment process between the mobile operator and the payment processor with the mobile operator essentially acting as an intermediary debiting/charging the customer's mobile account for the amount of the purchase.

We determined that the claims did not integrate the judicial exception into a practical application so as to impose a meaningful limits on the judicial exception. Following the *Guidance* we considered whether the claim included an additional element that reflects an improvement in the functioning of the computer or an improvement to other technology. We determined on page 8 of the Decision that it

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did not. This was supported by evidence. Specifically, we relied on the disclosure in the Specification at paragraph 49 that the all or a portion of the devices or subsystems can be implemented using one or more general purpose computer systems, microprocessors, digital signal processors or microprocessor. In addition, we relied on evidence in paragraph 16 of the Specification that there is no improvement to the actual mobile phone and operator recited. This paragraph discloses that the present invention allows the 4 billion plus and growing mobile phone users worldwide to pay for goods and services through their mobile phone service provider, using their mobile phone number and/or mobile phone account number (also referred to as “mobile number” or “mobile phone number”) securely for goods and/or services they purchase locally and/or globally. The system enables online and offline commerce transactions using mobile phone numbers, with customers being billed by their mobile phone service provider/operator/carrier (*also* referred to as “mobile operator”). This disclosure is evidence that the mobile phones and operators recited in the claim are those that are in used locally and globally and not some improved mobile phone and/or operator. As such, we did rely on evidence that the recitation of a processor in claim 1 does not integrate the judicial exception into a practical application.

We do not agree with Appellant that we overlooked that a specific network in which the recited communications between the mobile operator and the mobile phone of the user imposes a meaningful limitation on the judicial exception. As we noted above, there is no improvement recited in claim 1 of the mobile operator, mobile phone and payment processor. The invention is directed to making purchases more secure. The invention does this by having the purchase communication be made by the mobile operator and the payment processor thereby



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shielding the personal information of the consumer from the payment processor. This is not directed to an improvement in the mobile operator, mobile phone of payment processor, but merely the way that the invention uses the unimproved mobile operator, mobile phone and payment processor to shield the personal information of the consumer and thereby make the purchase more secure. This is done by the mobile operator acting as an intermediary between the mobile phone and the payment processor. As such, the communication process of the claimed invention makes a payment more secure by not passing any personal information between the mobile phone and the payment processor. This communication process, like the mobile phone, mobile operator and payment processor is not improved. As we stated in our Decision on page 15, the communication process whereby a mobile phone and mobile operator make purchases thereby preventing personal information from being sent to the payment processor was also not improved. We further note that the communication between the various components is done using ordinary text messages (Spec. ¶ 18). As such, there is no improvement claimed to the way the data are communicated.

In addition, we agree with the Examiner that while references may not have been combined to form a prior art rejection of the claims, references exist which show the use of mobile phone numbers to initiate transactions and the billing of purchases to mobile phone accounts as well as the use of text messages for authorization of transactions. (Final Act. 8).

As the mobile operator is not improved, the recitations of “second circuitry” is not a recitation of an improved mobile operator. The Specification clearly discloses that invention is not limited to any specific combination of hardware circuitry and/or software. (Specification 49).

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We are not convinced of error on our part by Appellant's argument that the fact that alternative systems covered by the judicial exception could instead send personal information to the payment processor is evidence that the claims will not monopolize the judicial exception.

While preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility.” *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015); *see also OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1362–63 (Fed. Cir. 2015) (“[T]hat 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.”). And, “[w]here 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*, 788 F.3d at 1379.

Lastly, we do not agree that that it was a violation of due process to not analyze on a claim by claim basis all the claims at issue in light of the *Guidance*. Consideration of each claim individually does not require a separate written analysis for each individual claim. We decline to find error here in the *Decision* to not address the patent-eligibility of each claim inasmuch as the claims are all directed to the same abstract idea of conducting secure purchase and payment transactions. *See Content Extraction & Transmission LLC v. Wells Fargo Bank, Nat. Ass'n*, 776 F.3d 1343, 1348 (Fed. Cir. 2014) (explaining that when all claims are directed to the same abstract idea, “addressing each claim of the asserted patents [is] unnecessary.”). In addition, Appellant did not argue the separate eligibility of the remaining claims.

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In any case, we agree with the Examiner that the remaining claims are directed to the same judicial exception of processing secure payment transactions. (Final Act. 8). While these claims recite several limitations to further define the circuitry and the content of the payment authorization request text message, for example, they are nonetheless directed to processing secure payment transactions. For example, claim 2 further defines the second circuitry, but is directed to processing secure payment transactions. Claim 3 further defines the content of the payment authorization request text message, but also is directed to processing secure payment transactions.

In view of the foregoing, we decline to make any changes in our *Decision*.

#### CONCLUSION

We have carefully considered the Request but, for the foregoing reasons, we do not find it persuasive as to error in the Board's decision to affirm the rejection of claims under 35 U.S.C. § 101.

DENIED

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* KARIM ANWAR RAMMAL

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Appeal 2017-003513  
Application 14/222,613  
Technology Center 3600

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Before MURRIEL E. CRAWFORD, BRUCE T. WIEDER, and  
MATTHEW S. MEYERS, *Administrative Patent Judges*.

WIEDER, *Administrative Patent Judge*, dissenting.

I respectfully dissent from the majority decision. I would grant Appellant's request for rehearing.

# EXHIBIT E



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
14/222,615	03/22/2014	Karim Anwar Rammal	151670-001 US CON2	6573

  

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EXAMINER	
RANKINS, WILLIAM E	

  

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* KARIM ANWAR RAMMAL

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Appeal 2017-003902  
Application 14/222,615<sup>1</sup>  
Technology Center 3600

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Before MURRIEL E. CRAWFORD, BRUCE T. WIEDER, and  
MATTHEW S. MEYERS, *Administrative Patent Judges*.

Opinion for the Board filed by CRAWFORD, *Administrative Patent Judge*.

Opinion Dissenting filed by WIEDER, *Administrative Patent Judge*.

CRAWFORD, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

STATEMENT OF THE CASE<sup>2</sup>

The Appellant filed a Request for Rehearing under 37 C.F.R. § 41.52  
of the Decision on Appeal.

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<sup>1</sup> According to Appellant, the real party in interest is NET2TEXT LTD.  
Appeal Br. 1.

<sup>2</sup> This Decision references the Appellant's Request for Rehearing  
("Request," filed May 30, 2019) and the Board Decision ("Decision," mailed  
April 1, 2019).

Appeal 2017-003902  
Application 14/222,615

In the Decision on Appeal, the Board affirmed the rejection of claims under 35 U.S.C. § 101 as being directed to judicially-excepted subject matter. Judge Wieder dissented from the majority opinion.

We note at the outset that a Request for Rehearing “must state with particularity the points believed to have been misapprehended or overlooked by the Board.” 37 C.F.R. § 41.52(a). A Request for Rehearing is not an opportunity to rehash arguments raised in the Appeal Brief or in the Reply Brief. Neither is it an opportunity to merely express disagreement with a decision without setting forth points believed to have been misapprehended or overlooked. Arguments not raised in the briefs before the Board and evidence not previously relied on in the briefs also are not permitted except in the limited circumstances set forth in §§ 41.52(a)(2) through (a)(4). *Id.* To the extent the Appellant presents supplemental or new arguments in the Request, those arguments are untimely and, as such, will not be considered except where the arguments are based on a recent relevant decision of either this Board or a Federal Court, or on an allegation that the Board’s decision contains an undesignated new ground of rejection. *See id.*

Appellant argues that our decision overlooks that there is no evidence to support our findings on “meaningful limits” in accordance with the *2019 Revised Patent Subject Matter Eligibility*, 84 FR 50, pp. 50–57, PTO-2018-0053 (Jan. 7, 2019) (“*Guidance*”). (Request 2).

The *Guidance* states that only if a judicial exception recited in a claim is not integrated into a practical application in a manner that imposes a meaningful limit on the judicial exception does the claim recite an abstract idea. *Id.* at 53. The *Guidance* states that the exemplary considerations which are indicative of a judicial exception being integrated into a practical



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application if an additional element are: (1) reflects an improvement in the functioning of a computer or an improvement to other technology or technical field; (2) applies or uses a judicial exception to effect a particular treatment or prophylaxis for a disease; (3) implements a judicial exception with a particular machine; (4) effects a transformation or reduction of a particular article to a different state or thing; and (5) applies or uses the judicial exception in some other meaningful way beyond generally linking the use of the judicial exception to a particular environment, such that the claims as a whole is more than a drafting effort designed to monopolize the exception. *Id.* at 55.

Appellant argues that we overlooked that the claims address limitations and concerns of previous solutions in a way such that no personal information is sent to the payment processor. (Request 3). Appellant argues that a meaningful limit is imposed by the specific network via which the recited communications between the mobile operator and mobile phone of the user are sent. *Id.*

We did not overlook that the claims address limitations and concerns of previous solutions in a way that no personal information is sent to the payment processor. On page 7 of the Decision, we found that the present invention claims a payment process between the mobile operator and the payment processor with the mobile operator essentially acting as an intermediary debiting/charging the customer's mobile account for the amount of the purchase.

We determined that the claims did not integrate the judicial exception into a practical application so as to impose a meaningful limits on the judicial exception. Following the *Guidance*, we considered whether the

Appeal 2017-003902  
Application 14/222,615

claim included an additional element that reflects an improvement in the functioning of the computer or an improvement to other technology. We determined on page 9 of the Decision that it did not. This was supported by evidence. Specifically, we relied on the disclosure in the Specification at paragraph 49 that all or a portion of the devices or subsystems can be implemented using one or more general purpose computer systems, microprocessors, digital signal processors, or microprocessor. In addition, we relied on evidence in paragraph 16 of the Specification that there is no improvement to the actual mobile phone and operator recited. This paragraph discloses that the present invention allows the 4 billion plus and growing mobile phone users worldwide to pay for goods and services through their mobile phone service provider, using their mobile phone number and/or mobile phone account number (also referred to as “mobile number” or “mobile phone number”) securely for goods and/or services they purchase locally and/or globally. The method enables online and offline commerce transactions using mobile phone numbers, with customers being billed by their mobile phone service provider/operator/carrier (also referred to as “mobile operator”). This disclosure is evidence that the mobile phones and operators recited in the claim are those that are in use locally and globally, and not some improved mobile phones and/or operators. As such, we did rely on evidence that the recitation of a processor in claim 1 does not integrate the judicial exception into a practical application.

We do not agree with Appellant that we overlooked that a specific network in which the recited communications between the mobile operator and the mobile phone of the user impose a meaningful limitation on the judicial exception. As we noted above, there is no improvement recited in

Appeal 2017-003902  
Application 14/222,615

claim 1 of the mobile operator, mobile phone, and payment processor. The invention is directed to making purchases more secure. The invention does this by having the purchase communication be made by the mobile operator and the payment processor thereby shielding the personal information of the consumer from the payment processor. This is not directed to an improvement in the mobile operator, mobile phone, or payment processor, but merely to the way that the invention uses the unimproved mobile operator, mobile phone, and payment processor to shield the personal information of the consumer and, thereby, make the purchase more secure. This is done by the mobile operator acting as an intermediary between the mobile phone and the payment processor. As such, the communication process of the claimed invention makes a payment more secure by not passing any personal information between the mobile phone and the payment processor. This communication process, like the mobile phone, mobile operator, and payment processor is not improved. As we stated in our Decision on page 15, the communication process whereby a mobile phone and mobile operator exchange text messages to make purchases, thereby preventing personal information from being sent to the payment processor, was also not improved. We further note that the communication between various components is done using ordinary text messages. (Spec. ¶ 18). As such, there is no improvement in the way the data are communicated.

In addition, we agree with the Examiner that while references may not have been combined to form a prior art rejection of the claims, references exist which show the use of mobile phone numbers to initiate transactions

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Application 14/222,615

and the billing of purchases to mobile phone accounts as well as the use of text messages for authorization of transactions. (Final Act. 8).

As the mobile operator is not improved, the recitations of “second circuitry” is not a recitation of an improved mobile operator. The Specification clearly discloses that invention is not limited to any specific combination of hardware circuitry and/or software. (Specification 49).

We are not convinced of error on our part by Appellant’s argument that the fact that alternative systems covered by the judicial exception could instead send personal information to the payment processor is evidence that the claims will not monopolize the judicial exception.

“While preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility.” *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015); *see also OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1362–63 (Fed. Cir. 2015) (“[T]hat 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.”). And, “[w]here 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*, 788 F.3d at 1379.

Lastly, we do not agree that it was a violation of due process to not analyze on a claim by claim basis all the claims at issue in light of the *Guidance*. Consideration of each claim individually does not require a separate written analysis for each individual claim. We decline to find error here in the Decision to not address the patent-eligibility of each claim inasmuch as the claims are all directed to the same abstract idea of

Appeal 2017-003902  
Application 14/222,615

conducting secure purchase and payment transactions. *See Content Extraction & Transmission LLC v. Wells Fargo Bank, Nat'l Ass'n*, 776 F.3d 1343, 1348 (Fed. Cir. 2014) (explaining that when all claims are directed to the same abstract idea, “addressing each claim of the asserted patents [is] unnecessary.”). In addition, Appellant did not argue the separate eligibility of the remaining claims.

In any case, we agree with the Examiner that the remaining claims are directed to the same judicial exception of processing secure payment transactions. (Final Act. 8). While these claims recite several limitations referring to circuitry and the content of the payment authorization request text message, for example, they are nonetheless directed to processing secure payment transactions. For example, claim 2 further defines the second circuitry, but is directed to processing secure payment transactions. Claim 3 further defines the content of the payment authorization request text message, but also is directed to processing secure payment transactions.

In view of the foregoing, we decline to make any changes in our Decision.

#### CONCLUSION

We have carefully considered the Request but, for the foregoing reasons, we do not find it persuasive as to error in the Board’s decision to affirm the rejection of claims under 35 U.S.C. § 101.

DENIED

Appeal 2017-003902  
Application 14/222,615

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* KARIM ANWAR RAMMAL

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Appeal 2017-003902  
Application 14/222,615  
Technology Center 3600

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Before MURRIEL E. CRAWFORD, BRUCE T. WIEDER, and  
MATTHEW S. MEYERS, *Administrative Patent Judges*.

WIEDER, *Administrative Patent Judge*, dissenting.

I respectfully dissent from the majority decision. I would grant  
Appellant's request for rehearing.

# EXHIBIT F



## UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
14/222,616	03/22/2014	Karim Anwar Rammal	151670-001 US CON3	6514

  

95628	7590	06/27/2019
The Villamar Firm PLLC 3424 Washington Drive Falls Church, VA 22041		

  

EXAMINER	
RANKINS, WILLIAM E	

  

ART UNIT	PAPER NUMBER
3694	

  

NOTIFICATION DATE	DELIVERY MODE
06/27/2019	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):

crvillamar@villamars.com  
 bevillamar@villamars.com  
 baravenwood@villamars.com



UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* KARIM ANWAR RAMMAL

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Appeal 2017-004916  
Application 14/222,616 <sup>1</sup>  
Technology Center 3600

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Before MURRIEL E. CRAWFORD, BRUCE T. WIEDER,  
MATTHEW S. MEYERS, *Administrative Patent Judges*.

Opinion for the Board filed by CRAWFORD, *Administrative Patent Judge*.

Opinion Dissenting filed by WIEDER, *Administrative Patent Judge*.

CRAWFORD, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

STATEMENT OF THE CASE<sup>2</sup>

The Appellant filed a Request for Rehearing under 37 C.F.R. § 41.52  
of the Decision on Appeal.

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<sup>1</sup> According to Appellant, the real party in interest is NET2TEXT LTD  
Appeal Br. 1.

<sup>2</sup> This Decision references the Appellant's Request for Rehearing ("Req.,"  
filed May 30, 2019) and the Board Decision ("Dec.," mailed Apr. 01, 2019).

Appeal 2017-004916  
Application 14/222,616

In the Decision on Appeal, the Board affirmed the rejection of claims under 35 U.S.C. § 101 as being directed to judicially-excepted subject matter. Judge Wieder dissented from the majority opinion.

We note at the outset that a Request for Rehearing “must state with particularity the points believed to have been misapprehended or overlooked by the Board.” 37 C.F.R. § 41.52(a). A Request for Rehearing is not an opportunity to rehash arguments raised in the Appeal Brief or in the Reply Brief. Neither is it an opportunity to merely express disagreement with a decision without setting forth points believed to have been misapprehended or overlooked. Arguments not raised in the briefs before the Board and evidence not previously relied on in the briefs also are not permitted except in the limited circumstances set forth in §§ 41.52(a)(2) through (a)(4). *Id.* To the extent the Appellant presents supplemental or new arguments in the Request, those arguments are untimely and, as such, will not be considered except where the arguments are based on a recent relevant decision of either this Board or a federal court, or on an allegation that the Board’s decision contains an undesignated new ground of rejection. *See id.*

Appellant argues that our decision overlooks that there is no evidence to support our findings on “meaningful limits” in accordance with the *2019 Revised Patent Subject Matter Eligibility*, 84 FR 50, pp 50-57, PTO-2018-0053 (Jan. 7, 2019) (“*Guidance*”). (Request 2).

The *Guidance* states that only if a judicial exception recited in a claim is not integrated into a practical application in a manner that imposes a meaningful limit on the judicial exception does the claim recite an abstract idea. *Id.* at 53. The *Guidance* explains that the exemplary considerations

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Application 14/222,616

which are indicative of a judicial exception being integrated into a practical application are if an additional element: (1) reflects an improvement in the functioning of a computer or an improvement to other technology or technical field; (2) applies or uses a judicial exception to effect a particular treatment or prophylaxis for a disease; (3) implements a judicial exception with a particular machine; (4) effects a transformation or reduction of a particular article to a different state or thing; and (5) applies or uses the judicial exception in some other meaningful way beyond generally linking the use of the judicial exception to a particular environment, such that the claims as a whole is more than a drafting effort designed to monopolize the exception.

Appellant argues that we overlooked that the claims address limitations and concerns of previous solutions in a way such that no personal information is sent to the payment processor. Appellant argues that a meaningful limit is imposed on the judicial exception by the specific network via which the recited communications between the mobile operator and mobile phone of the user are sent.

We did not overlook that the claims address limitations and concerns of previous solutions in a way that no personal information is sent to the payment processor. On page 8 of the Decision, we found that the present invention claims a payment process between the mobile operator and the payment processor with the mobile operator essentially acting as an intermediary debiting/charging the customer's mobile account for the amount of the purchase.

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Application 14/222,616

We determined that the claims did not integrate the judicial exception into a practical application so as to impose a meaningful limit on the judicial exception. Following the *Guidance* we considered whether the claim included an additional element that reflects an improvement in the functioning of the computer or an improvement to other technology. We determined on page 9 of the Decision that it did not. This was supported by evidence. Specifically, we relied on the disclosure in the Specification at paragraph 49 that all or a portion of the devices or subsystems of the instant invention can be implemented using one or more general purpose computer systems, microprocessors, digital signal processors or microprocessor. In addition, we relied on evidence in paragraph 16 of the Specification that there is no improvement to the actual mobile phone and operator recited. This paragraph discloses that the present invention allows the 4 billion plus and growing mobile phone users worldwide to pay for goods and services through their mobile phone service provider, using their mobile phone number and/or mobile phone account number (also referred to as “mobile number” or “mobile phone number”) securely for goods and/or services they purchase locally and/or globally. The novel system and method enables online and offline commerce transactions using mobile phone numbers, with customers being billed by their mobile phone service provider/operator/carrier (also referred to as “mobile operator”). This disclosure is evidence that the mobile phones and operators recited in the claim are those that are in use locally and globally and not improved mobile phones and/or operators. As such, we did rely on evidence that the recitation

Appeal 2017-004916  
Application 14/222,616

of a processor in claim 1 does not integrate the judicial exception into a practical application.

We do not agree with Appellant that we overlooked that a specific network in which the recited communications between the mobile operator and the mobile phone of the user imposes a meaningful limitation on the judicial exception. As we noted above, there is no improvement recited in claim 1 of the mobile operator, mobile phone and payment processor, and therefore, there is no improved circuitry recited.

The invention is directed to making purchases more secure. The invention does this by having the purchase communication be made by the mobile operator and the payment processor thereby shielding the personal information of the consumer from the payment processor. This is not directed to an improvement in the mobile operator, mobile phone of payment processor, but merely the way that the invention uses the unimproved mobile operator, mobile phone and payment processor to shield the personal information of the consumer and thereby make the purchase more secure. This is done by the mobile operator acting as an intermediary between the mobile phone and the payment processor. As such, the communication process of the claimed invention makes a payment more secure by not passing any personal information between the mobile phone and the payment processor. This communication process, like the mobile phone, mobile operator and payment processor is not improved. As we stated in our Decision at page 17, the communication process whereby a mobile phone and mobile operator exchange text messages to make purchases thereby preventing personal information from being sent to the

Appeal 2017-004916  
Application 14/222,616

payment processor was also not improved. We further note that the communication between the various components is done using ordinary text messages. (Spec. ¶ 18). As such, there is no improvement in the way the data are communicated.

In addition, we agree with the Examiner that while references may not have been combined to form a prior art rejection of the claims, references exist which show the use of mobile phone numbers to initiate transactions and the billing of purchases to mobile phone accounts as well as the use of text messages for authorization of transactions. (Final Act. 8).

As the mobile operator is not improved, the recitations of “second circuitry” is not a recitation of an improved mobile operator. The Specification clearly discloses that invention is not limited to any specific combination of hardware circuitry and/or software. (Specification 49).

We are not convinced of error on our part by Appellant’s argument that the fact that alternative systems covered by the judicial exception could instead send personal information to the payment processor is evidence that the claims will not monopolize the judicial exception.

While preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility.” *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015); *see also OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1362–63 (Fed. Cir. 2015) (“[T]hat 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.”). And, “[w]here a patent's claims are deemed only to disclose patent ineligible subject matter under the *Mayo* framework,

Appeal 2017-004916  
Application 14/222,616

as they are in this case, preemption concerns are fully addressed and made moot.” *Ariosa*, 788 F.3d at 1379.

Lastly, we do not agree that that it was a violation of due process to not analyze on a claim by claim basis all the claims at issue in light of the *Guidance*. Consideration of each claim individually does not require a separate written analysis for each individual claim. We decline to find error here in the Decision to not address the patent-eligibility of each claim inasmuch as the claims are all directed to the same abstract idea of conducting secure purchase and payment transactions. *See Content Extraction & Transmission LLC v. Wells Fargo Bank, Nat. Ass'n*, 776 F.3d 1343, 1348 (Fed. Cir. 2014) (explaining that when all claims are directed to the same abstract idea, “addressing each claim of the asserted patents [is] unnecessary.”). In addition, Appellant does not argue the separate eligibility of the remaining claims.

In any case, we agree with the Examiner that the remaining claims are directed to the same judicial exception of processing secure payment transactions. (Final Act. 8). While these claims recite several limitations that further define the circuitry and/or the content of the payment authorization request text message, for example, they are nonetheless directed to processing secure payment transactions. For example, claim 2 further defines the functions of the second circuitry, but is directed to processing secure payment transactions. Claim 3 further defines the content of the payment authorization request text message but also is directed to processing secure payment transactions.

Appeal 2017-004916  
Application 14/222,616

In view of the foregoing, we decline to make any changes in our  
*Decision*.

#### CONCLUSION

We have carefully considered the Request but, for the foregoing reasons, we do not find it persuasive as to error in the Board's decision to affirm the rejection of claims under 35 U.S.C. § 101.

DENIED



UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* KARIM ANWAR RAMMAL

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Appeal 2017-004916  
Application 14/222,616  
Technology Center 3600

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Before MURRIEL E. CRAWFORD, BRUCE T. WIEDER, and  
MATTHEW S. MEYERS, *Administrative Patent Judges*.

WIEDER, *Administrative Patent Judge*, dissenting.

I respectfully dissent from the majority decision. I would grant  
Appellant's request for rehearing.

# EXHIBIT G

No Shepard's Signal™  
As of: January 2, 2020 10:30 PM Z

**Uniloc 2017 LLC v. Facebook, Inc.**

United States Court of Appeals for the Federal Circuit

October 31, 2019, Decided

2018-2251

**Reporter**

783 Fed. Appx. 1020 \*; 2019 U.S. App. LEXIS 33090 \*\*

UNILOC 2017 LLC, Appellant v. FACEBOOK, INC.,  
WHATSAPP, INC., Appellees

**Notice:** THIS DECISION WAS ISSUED AS UNPUBLISHED OR NONPRECEDENTIAL AND MAY NOT BE CITED AS PRECEDENT. PLEASE REFER TO *FEDERAL RULES OF APPELLATE PROCEDURE RULE 32.1* GOVERNING THE CITATION TO UNPUBLISHED OPINIONS.

**Prior History:** [**\*\*1**] Appeal from the United States Patent and Trademark Office, Patent Trial and Appeal Board in No. IPR2016-01756.

**Core Terms**

court's decision, VACATED

**Counsel:** For UNILOC 2017 LLC, Appellant: James Etheridge, Ryan S. Loveless, Brett Mangrum, Etheridge Law Group, Southlake, TX.

For FACEBOOK, INC., WHATSAPP, INC., Appellees: Heidi Lyn Keefe, Attorney, Andrew Carter Mace, Esq., Attorney, Mark R. Weinstein, Cooley LLP, Palo Alto, CA; Yuan Liang, Phillip Edward Morton, Attorney, Cooley LLP, Washington, DC.

**Opinion**

[**\*1021**] PER CURIAM.

**ORDER**

In light of this court's decision in *Arthrex, Inc. v. Smith & Nephew, Inc.*, No. 18-2140 (Fed. Cir. Oct. 31, 2019) and the fact that Uniloc has raised an Appointments Clause challenge in its opening brief in this case,

IT IS ORDERED THAT:

1. The oral argument scheduled for November 4, 2019 is cancelled and the case is removed from the calendar.
2. The Patent Trial and Appeal Board's decision in No. IPR2016-01756 is vacated and the case is remanded to the Board for proceedings consistent with this court's decision in *Arthrex*.

FOR THE COURT

October 31, 2019

Date

**JUDGMENT**

THIS CAUSE having been considered, it is

ORDERED AND ADJUDGED:

**VACATED AND REMANDED**

ENTERED BY ORDER OF THE COURT

October 31, 2019

783 Fed. Appx. 1020, \*1021; 2019 U.S. App. LEXIS 33090, \*\*1

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End of Document

# EXHIBIT H



Neutral

As of: January 2, 2020 10:31 PM Z

**Bedgear, LLC v. Fredman Bros. Furniture Co.**

United States Court of Appeals for the Federal Circuit

November 7, 2019, Decided

2018-2082, 2018-2083, 2018-2084

**Reporter**

783 Fed. Appx. 1029 \*; 2019 U.S. App. LEXIS 33299 \*\*; 2019 WL 5806893

BEDGEAR, LLC, Appellant v. FREDMAN BROS.  
FURNITURE COMPANY, INC., Appellee

**Counsel:** K. LEE MARSHALL, Bryan Cave Leighton  
Paisner LLP, San Francisco, CA, argued for appellant.  
Also represented by JOSEPH J. RICHETTI,  
ALEXANDER DAVID WALDEN, New York, NY.

**Notice:** THIS DECISION WAS ISSUED AS  
UNPUBLISHED OR NONPRECEDENTIAL AND MAY  
NOT BE CITED AS PRECEDENT. PLEASE REFER TO  
*FEDERAL RULES OF APPELLATE PROCEDURE*  
*RULE 32.1* GOVERNING THE CITATION TO  
UNPUBLISHED OPINIONS.

JASON R. MUDD, Erise IP, P.A., Overland Park, KS,  
argued for appellee. Also represented by ERIC ALLAN  
BURESH.

**Judges:** Before NEWMAN, DYK, and STOLL, Circuit  
Judges. Opinion concurring in the judgment filed by  
Circuit Judge DYK, in which Circuit Judge NEWMAN  
joins.

**Subsequent History:** As Amended November 12,  
2019.

**Opinion**

**Prior History:** **[\*\*1]** Appeals from the United States  
Patent and Trademark Office, Patent Trial and Appeal  
Board in Nos. IPR2017-00350, IPR2017-00351,  
IPR2017-00352.

**[\*1030]** PER CURIAM.

Bedgear, LLC v. Fredman Bros. Furniture Co., 2019  
U.S. Dist. LEXIS 29313 (E.D.N.Y., Feb. 25, 2019)

In its opening brief, Bedgear, LLC argues that the three  
final written decisions at issue in this appeal exceed the  
scope of the Patent Trial and Appeal Board's authority  
and violate the Constitution's Appointments Clause. See  
Appellant's Br. 66 (citing U.S. Const. art. II, § 2, cl. 2).  
This court recently decided this issue in Arthrex, Inc. v.  
Smith & Nephew, Inc., No. 18-2140, 941 F.3d 1320,  
2019 U.S. App. LEXIS 32613 (Fed. Cir. Oct. 31, 2019).  
Accordingly, the Board's decisions in Nos. IPR2017-  
00350, IPR2017-00351, and IPR2017-00352 are  
vacated and the case is remanded to the Board for  
proceedings consistent with this court's decision in  
*Arthrex*.

**Core Terms**

appointed, removal, retroactivity, invalid, inferior officer,  
new hearing, decisions, court's decision, vacated,  
cases, cure

**VACATED AND REMANDED**

783 Fed. Appx. 1029, \*1030; 2019 U.S. App. LEXIS 33299, \*\*1

COSTS

No costs.

Concur by: DYK

**Concur**

DYK, Circuit Judge, with whom Circuit Judge **[\*\*2]** NEWMAN joins, concurring in the judgment.

I agree that the panel here is bound to follow Arthrex, Inc. v. Smith & Nephew, Inc., No. 2018-2140, 941 F.3d 1320, 2019 U.S. App. LEXIS 32613, 2019 WL 5616010 (Fed. Cir. Oct. 31, 2019). But, even putting to one side the question of whether Administrative Patent Judges ("APJs") would have been improperly appointed (if not subject to at will removal), it seems to me that the remedy aspect of *Arthrex* (requiring a new hearing before a new panel) is not required by Lucia v. S.E.C., 138 S. Ct. 2044, 201 L. Ed. 2d 464 (2018), imposes large and unnecessary burdens on the system of *inter partes* review, requiring potentially hundreds of new proceedings, and involves unconstitutional prospective decision-making.

I

In *Arthrex*, the panel held that the appointment of Administrative Patent Judges ("APJs") would be unconstitutional if subject to the removal provisions of title 5. The panel avoids this result by holding that those removal provisions are unconstitutional as applied to APJs, and that the unconstitutional removal provision may be severed from the remainder of the statute "to render the APJs inferior officers and remedy the constitutional appointment problem." Arthrex, 941 F.3d 1320, 2019 U.S. App. LEXIS 32613, 2019 WL 5616010, at \*1. Instead of holding past actions by APJs valid, the *Arthrex* majority held those past actions invalid and remanded for a new hearing before a new panel "[b]ecause the Board's decision **[\*\*3]** in this case was made by a panel of APJs that were not constitutionally appointed at the time the decision was rendered." Arthrex, 941 F.3d 1320, 2019 U.S. App. LEXIS 32613, 2019 WL 5616010, at \*11.

This holding is in part constitutional interpretation and part statutory construction. In essence, the panel improperly makes the application of its decision

prospective only, so that only PTAB decisions after the date of the panel's opinion are rendered by a constitutionally appointed panel. In my view, the panel improperly declined to make its ruling retroactive so that the actions of APJs in the past were compliant with the constitution and the statute. In this respect, I think that the **[\*1031]** panel in *Arthrex* ignored governing Supreme Court authority.

II

I first address the *Arthrex* panel's claim that *Lucia* mandates remanding for a new hearing. In *Lucia*, the issue was whether Securities and Exchange Commission ("SEC") Administrative Law Judges ("ALJs") were inferior officers that had to be appointed by an agency head—the SEC. Lucia, 138 S. Ct. at 2051 & n.3 (2018). The Supreme Court held that "[t]he Commission's ALJs are 'Officers of the United States,' subject to the *Appointments Clause*." Id. at 2055. The ALJs were found to be unconstitutionally appointed as "Officers of the United States" because they were appointed by **[\*\*4]** "[o]ther staff members, rather than the Commission proper." Id. at 2046, 2051.

While the case was pending, "the SEC issued an order 'ratify[ing]' the prior appointments of its ALJs," thus curing the constitutional defect.<sup>1</sup> Id. at 2055 n.6 (alteration in original) (quoting SEC Order, *In re: Pending Administrative Proceedings* (Nov. 30, 2017), <https://www.sec.gov/litigation/opinions/2017/33-10440.pdf>). The Supreme Court nevertheless held that "the 'appropriate' remedy for an adjudication tainted with an appointments violation is a new 'hearing before a properly appointed' official." Id. at 2055 (quoting Ryder v. United States, 515 U.S. 183, 188, 115 S. Ct. 2031, 132 L. Ed. 2d 136 (1995)).

The difference between *Lucia* and *Arthrex* is that the fix in *Lucia* was an agency fix, whereas the fix in *Arthrex* is a judicial fix. Agencies and legislatures generally act only prospectively, while a judicial construction of a statute or a holding that a part of the statute is unconstitutional and construing the statute to permit severance are necessarily retrospective as well as prospective.

III

<sup>1</sup> The Court declined to decide whether the agency cured the defect when it "ratified" the appointments. Lucia, 138 S. Ct. at 2055 n.6.

783 Fed. Appx. 1029, \*1031; 2019 U.S. App. LEXIS 33299, \*\*4

As the Supreme Court concluded in Rivers v. Roadway Exp., Inc., 511 U.S. 298, 114 S. Ct. 1510, 128 L. Ed. 2d 274 (1994), "[i]n construing a statute, courts are 'explaining [their] understanding of what the statute has meant continuously since the date when it became law.'" Id. at 313 n.12 (emphasis added). The same is true as to constitutional [\*5] decisions, as Harper v. Virginia Dep't of Taxation, 509 U.S. 86, 113 S. Ct. 2510, 125 L. Ed. 2d 74 (1993) confirmed: "[B]oth the common law and our own decisions' have 'recognized a general rule of retrospective effect for the constitutional decisions of this Court.'" Id. at 94 (alteration in original) (quoting Robinson v. Neil, 409 U.S. 505, 507, 93 S. Ct. 876, 35 L. Ed. 2d 29 (1973)). As Justice Scalia put it in his concurrence in the later Reynoldsville decision:

In fact, what a court does with regard to an unconstitutional law is simply to ignore it. It decides the case "disregarding the [unconstitutional] law," Marbury v. Madison, 5 U.S. 137, 1 Cranch 137, 178, 2 L. Ed. 60 (1803) (emphasis added), because a law repugnant to the Constitution "is void, and is as no law," Ex parte Siebold, 100 U.S. 371, 376, 25 L. Ed. 717 (1880).

Reynoldsville Casket Co. v. Hyde, 514 U.S. 749, 760, 115 S. Ct. 1745, 131 L. Ed. 2d 820 (1995) (Scalia, J., concurring) (alterations in original). In other words, "[w]hen [a] court applies a rule of federal law to the parties before it, that rule is the controlling interpretation of federal law and must be given full retroactive effect in all cases [\*1032] still open on direct review and as to all events, regardless of whether such events predate or postdate [the court's] announcement of the rule." Harper, 509 U.S. at 97 (1993).<sup>2</sup>

The requirement for retroactivity applies to remedies as well, such as the remedy in this case. In Reynoldsville Casket Co. v. Hyde, 514 U.S. 749, 115 S. Ct. 1745, 131 L. Ed. 2d 820 (1995), the Court reversed an Ohio Supreme Court decision declining to apply a constitutional decision as to a limitations period retroactively. The Court [\*6] rejected the respondent's argument that the Ohio Supreme Court's decision was based on "remedy" rather than "non-retroactivity" and

held that accepting the Ohio Supreme Court's "remedy" would "create what amounts to an ad hoc exemption from retroactivity." Id. at 758. The Court noted only four circumstances where retroactive application of a constitutional ruling is not outcome-determinative.<sup>3</sup> None is remotely relevant to Arthrex.

Thus, to be consistent with Harper, the statute here must be read as though the PTAB judges had always been constitutionally appointed, "disregarding" the unconstitutional removal provisions. Marbury v. Madison, 5 U.S. 137, 1 Cranch 137, 178, 2 L. Ed. 60 (1803). Since no Congressional or agency action is required in order to render the appointment of the PTAB judges constitutional, when the PTAB judges decided cases in the past, they did not act improperly. Thus, the past opinions rendered by the PTAB should be reviewed on the merits, not vacated for a new hearing before a different panel.

#### IV

While the Circuits appear to be divided as to the retroactivity issue in Appointments Clause and similar cases,<sup>4</sup> the very [\*1033] Supreme Court decisions

<sup>3</sup> Namely, where there is: "(1) an alternative way of curing the constitutional violation, or (2) a previously existing, independent legal basis (having nothing to do with retroactivity) for denying relief, or (3) as in the law of qualified immunity, a well-established general legal rule that trumps the new rule of law, which general rule reflects both reliance interests and other significant policy justifications, or (4) a principle of law, such as that of 'finality' . . . , that limits the principle of retroactivity itself." Reynoldsville, 514 U.S. at 759.

<sup>4</sup> In Collins v. Mnuchin, 938 F.3d 553 (5th Cir. 2019), the en banc Fifth Circuit found that the Federal Housing Finance Agency ("FHFA") was unconstitutionally structured because Congress "[g]rant[ed] both removal protection and full agency leadership to a single FHFA Director." 938 F.3d at 591. It declined to invalidate prior agency actions. Id. at 592. It concluded that the only appropriate remedy, and one that "fixes the . . . purported injury," is a declaratory judgment "removing the 'for cause' provision found unconstitutional." Id. 595.

<sup>2</sup> Harper overruled prior caselaw that provided for exceptions allowing prospective application of a new rule of law in constitutional and other cases. Reynoldsville Casket Co. v. Hyde, 514 U.S. 749, 752, 115 S. Ct. 1745, 131 L. Ed. 2d 820 (1995) ("Harper overruled [a prior Supreme Court decision] insofar as the [prior] case (selectively) permitted the prospective-only application of a new rule of law.").

In Intercollegiate Broadcasting and Kuretski, the D.C. Circuit reached the opposite result. See Intercollegiate Broad. Sys., Inc. v. Copyright Royalty Bd., 684 F.3d 1332, 401 U.S. App. D.C. 407 (D.C. Cir. 2012); Kuretski v. Comm'r, 755 F.3d 929, 410 U.S. App. D.C. 287 (D.C. Cir. 2014). In Intercollegiate Broadcasting, the D.C. Circuit found that the appointments of the Copyright Royalty Judges in the Library of Congress



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relied on in *Arthrex* have given retroactive effect to statutory constructions or constitutional decisions that remedied [\*\*7] potential *Appointment Clause* violations. In *Free Enterprise Fund v. Public Co. Accounting Oversight Bd.*, 561 U.S. 477, 130 S. Ct. 3138, 177 L. Ed. 2d 706 (2010), the SEC's Public Company Accounting Oversight Board had instituted an investigation against an accounting firm, Beckstead and Watts ("B&W"). *Id.* at 487. B&W and another affiliated organization, Free Enterprise Fund, filed suit, asking the district court to enjoin the investigation as improperly instituted because members of the Board had not been constitutionally appointed. *Id.* The Supreme Court found that the statutory removal protections afforded to members of the Board were unconstitutional. *Id.* at 484. "By granting the Board executive power without the Executive's oversight [i.e., by limiting removal], this Act subverts the President's ability to ensure that the laws are faithfully executed—as well as the public's ability to pass judgment on his efforts." *Id.* at 498. But the Court severed the unconstitutional removal provisions from the remainder of the statute, leaving the rest of relevant act fully operational and constitutional. *Id.* at 509.

The Court did not view this action as fixing the problem only prospectively. It refused to invalidate or enjoin the prior actions of the Board in instituting the investigation, explaining [\*\*8] that "properly viewed, under the Constitution, . . . the Board members are inferior officers" and "have been validly appointed by the full Commission." *Id.* at 510, 513. The Court remanded for further proceedings, but explained that Plaintiffs are only "entitled to declaratory relief sufficient to ensure that the reporting requirements and auditing standards to which they are subject will be enforced only by a constitutional agency accountable to the Executive." *Id.* at 513.<sup>5</sup>

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violated the *Appointments Clause* because they could be removed only for cause. *Intercollegiate Broad. Sys., Inc.*, 684 F.3d at 1334. The court invalidated the for-cause restriction on the removal of the judges, rendering them "validly appointed inferior officers." *Id.* at 1340-41. Yet, the D.C. Circuit declared that "[b]ecause the Board's structure was unconstitutional at the time it issued its determination, we vacate and remand the determination." *Id.* at 1342. These two cases were not based on Supreme Court precedent, did not consider the Supreme Court precedent suggesting a different result, and were an apparent departure from the Court's rulings in similar circumstances.

<sup>5</sup> On remand, the parties agreed that the Supreme Court's decision did not require invalidating the Board's prior actions. The agreed-upon judgment stated: "[a]ll relief not specifically granted by this judgment is hereby DENIED." See Judgment

So too in *Edmond*, past actions by the Coast Guard Court of Criminal Appeals were not set aside. The criminal defendants' convictions had been affirmed by the Coast Guard Court of Criminal Appeals. *Edmond v. United States*, 520 U.S. 651, 655, 117 S. Ct. 1573, 137 L. Ed. 2d 917 (1997). The defendants contended that the Coast Guard Court of Criminal Appeals judges had not been properly appointed, rendering the convictions invalid. See *id.* The issue was "whether Congress ha[d] authorized the Secretary of Transportation to appoint civilian [judges to] the Coast Guard Court of Criminal Appeals, and if so, whether this authorization [wa]s constitutional under the *Appointments Clause of Article II* [because the judges were inferior officers]." *Id.* at 653.

The Court construed the relevant statutes so that "Article [\*\*9] 66(a) d[id] not give Judge Advocates General authority to appoint Court of Criminal Appeals judges; [and] that § 323(a) d[id] give the Secretary of Transportation authority to do so." *Id.* at 658. The Court explained that "no other way to interpret Article 66(a) that would make it consistent with [\*\*1034] the Constitution" because "Congress could not give the Judge Advocates General power to 'appoint' even inferior officers of the United States." *Id.* The Court then found that the judges of the Coast Guard Court of Criminal Appeals are inferior officers and that "[their] judicial appointments [by the Secretary] . . . are therefore valid." *Id.* at 666. Most significantly, the Court did not remand for a new hearing but rather "affirm[ed] the judgment of the Court of Appeals for the Armed Forces." *Id.* Nowhere did the Court suggest that the actions taken before the Court's construction were rendered invalid.

In *Appointments Clause* cases, the Supreme Court has required a new hearing only where the appointment's defect had not been cured<sup>6</sup> or where the cure was the

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Order, *Free Enter. Fund v. Pub. Co. Accounting Oversight Bd.*, C.A. No. 06-0217-JR (D.D.C. Feb. 23, 2011), ECF No. 66.

<sup>6</sup> See *Ryder v. United States*, 515 U.S. 177, 182-83, 115 S. Ct. 2031, 132 L. Ed. 2d 136 (1995) (declining to apply the *de facto officer* doctrine to preserve rulings made by an unconstitutionally appointed panel); *Nguyen v. United States*, 539 U.S. 69, 77, 83, 123 S. Ct. 2130, 156 L. Ed. 2d 64 (2003) (declining to leave "undisturbed" the judgments of an unconstitutionally composed panel); *N.L.R.B. v. Noel Canning*, 573 U.S. 513, 519, 520, 134 S. Ct. 2550, 189 L. Ed. 2d 538 (2014) (affirming the DC Circuit in vacating an NLRB order finding a violation because the Board lacked a quorum as "the President lacked the power to make the [Board] recess appointments here at issue"); see also *Bandimere v. Sec. &*

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result of non-judicial action.<sup>7</sup> The contrary decision in *Arthrex* is inconsistent with binding Supreme Court precedent and creates a host of problems in identifying the point in time when **[\*\*10]** the appointments became valid.<sup>8</sup>

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I respectfully suggest that *Arthrex* was wrongly decided on the issue of remedy. As a result of the *Arthrex* construction, APJs were properly appointed by the Secretary of Commerce and their prior decisions are not invalid.

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End of Document

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*Exch. Comm'n*, 844 F.3d 1168, 1171, 1188 (10th Cir. 2016) (setting aside opinion of an improperly appointed SEC ALJ where "the SEC conceded the ALJ had not been constitutionally appointed").

<sup>7</sup> See *Lucia*, 138 S. Ct. at 2055 n.6; see also *Jones Bros., Inc. v. Sec'y of Labor*, 898 F.3d 669, 679 (6th Cir. 2018) (improperly appointed ALJ's decision vacated despite Mine Commission's attempt to cure the improper appointment during judicial review).

<sup>8</sup> The difficulty of identifying at what point in time the appointments became effective is evident. Is it when then panel issues the decision, when the mandate issues, when en banc review is denied, when certiorari is denied, or (if there is an en banc proceeding) when the en banc court affirms the panel, or (if the Supreme Court grants review) when the Supreme Court affirms the court of appeals decision?