

2015 WL 996303 (Patent Tr. & App. Bd.)

Patent Trial and Appeal Board

Patent and Trademark Office (P.T.O.)

EX PARTE STEVE BUSH, EDWARD JUNG, AND HOLLY KNIGHT

Appeal 2013-001110

[Application 11/541,430](#)¹

Technology Center 3600

February 27, 2015

*1 Before, [ANTON W. FETTING](#), [JOSEPH A. FISCHETTI](#), and BRUCE T. WIEDER
Administrative Patent Judges
[FISCHETTI](#)
Administrative Patent Judge

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants seek our review under [35 U.S.C. § 134](#) of the Examiner's nonfinal rejection of claims 1-9 and 74-89. We have jurisdiction under [35 U.S.C. § 6\(b\)](#). A telephonic hearing was held on February 12, 2015.

Claim 1 reproduced below, is representative of the subject matter on appeal.

1. A computer-based method performed by one or more computers programmed to identify common accounts, the method comprising:

assigning by one of the one or more computers a first user identifier to a first account, the first account being associated with a first node, the first node including a first computing device;

assigning by one of the one or more computers a second user identifier to a second account, the second account being associated with a second node, the second node including a second computing device;

receiving a request from the second node that includes the first user identifier;

determining whether the first account is already associated with the second node; and

upon determining that the first account is not already associated to the second node, determining whether the first and second accounts represent the same account; and

when it is determined that the first and second accounts represent the same account, combining by one of the one or more computers the first and second accounts into a single account.

THE REJECTION

The Examiner relies upon the following as evidence of unpatentability:

Armetta et al.	US 5,864,830	Jan. 26, 1999
Graves et al.	US 2003/0205616 A1	Nov. 6, 2003
Blagg et al.	US 7,050,996 B1	May 23, 2006

The following rejections are before us for review.

Claims 84-89 are rejected under [35 U.S.C. § 112](#), second paragraph.

Claims 1-9 are rejected under [35 U.S.C. § 101](#) non-statutory subject matter.

Claims 74-89 are rejected under [35 U.S.C. 102\(b\)](#) as being anticipated by Armetta.

*2 Claims 1-9 and 74-89 are rejected under [35 U.S.C. 103\(a\)](#) as being patentable over Armetta, in view of Graves and Blagg.

ANALYSIS

[35 U.S.C. § 101](#) REJECTION

We will reverse the rejection of claims 1-9 under [35 U.S.C. § 101](#).

Appellants argue patent eligible subject matter because:

claim 1 also explicitly recites in its body that several steps are performed by a computer. In particular, claim 1 recites “assigning by one of the one or more computers a first user identifier,” assigning by one of the one or more computers a second user identifier,” and “combining by one of the one or more computers the first and second accounts into a single account.”

(Appeal Br. 11, emphasis omitted).

We agree with Appellants. We find that the method of claims 1-9 are inextricably tied with a computer based communication and notification scheme interconnecting computers so as to combine one or more accounts into a single account using computer associated nodes, and thus covers more than the mere nominal recitation of a computer to obtain patent eligibility. See [Alice Corp. Pty. Ltd. v. CLS Bank Intern.](#), [134 S.Ct. 2347](#), 2350 (2014), quoting [Mayo Collaborative Services v. Prometheus Laboratories, Inc.](#), [132 S.Ct. 1289](#), 2353 (2012). Adding a nominal recitation of a computer to a claim covering an abstract concept is insufficient to make a claim patent eligible. See [Bancorp Servs. v. Sun Life Assurance Co.](#), [687 F.3d 1266](#), 1278 (Fed. Cir. 2012). See also [Mayo Collaborative Servs. v. Prometheus Labs., Inc.](#), [132 S. Ct. 1289](#), 1294 (2012) (a claim cannot simply state a law of nature (or an abstract idea) and add the words “‘apply it.’”)

[35 U.S.C. § 112](#) SECOND PARAGRAPH REJECTION

We will not sustain the rejection of claims 85-89 under [35 U.S.C. § 112](#) second paragraph. We agree with Appellants that the claim is proper under 112 second paragraph and disagree with the Examiner that claim 85 is a hybrid claim. We find nothing in claim 85 which states that the subject matter of the invention is mixed.

We will not sustain the rejection of claim 84 because it is clear from the scope of the claim that the two opposed limitations are offered in the alternative as conditional limitations and thus do not present a conflict as found by the Examiner.

35 U.S.C. § 102 REJECTION

We will reverse the rejection of claims 74-89 under **35 U.S.C. § 102(b)**. We disagree with the Examiner that the steps following the “:” in claim 74 “merely consists of stored data and since this data does not functionally related to the memory in which it is stored, it does not distinguish the claimed apparatus, method, and system from the prior art”. (Answer 8).

*3 Rather, we find that the component elements of claim 74 while described by way of computer-executable instructions on a medium device, nevertheless function as method limitations requiring Examiner findings showing how the prior art makes the steps obvious. Cf. **Alice Corp. Pty. Ltd. v CLS Bank Int'l.**, **134 S. Ct. 2347**, 2360 (2014).

35 U.S.C. § 103 REJECTION

Each of independent claims 1, 74, 78 and 84 require in one form or another the limitation of,
assigning by one of the one or more computers a first user identifier [credential] to a first account, the first account being associated with a first node, the first node including a first computing device;

assigning by one of the one or more computers a second user identifier to a second account, the second account being associated with a second

node, the second node including a second computing device;

receiving a request from the second node that includes the first user identifier;

determining whether the first account is already associated with the second node;....

The Examiner found that these limitations are disclosed by Armetta:

assigning a second user identifier to a second account, (column 3, lines 61- column 4, line 3 [terminal is a “node”], column 5, line 20-27, column 6, lines 24-31) receiving a request from the second node that includes the first user identifier; (Column 5, lines 20-35, and 60-65) determining whether the first account is already associated with the second” (Column 5, lines 60 -column 6 line 9).

(Answer 9).

We disagree with the Examiner. We find instead that while the satellite cards disclosed by Armetta have an account (“SAT_ACC”) set up and linked to and cross-referenced with the host credit card account (“HOST_ACC”) (Col. 5, ll. 20-35), there is no disclosure in Armetta of determining steps or related means that would serve to effect the prompting steps which would follow the determining steps when the corresponding if-then responses are warranted. Armetta simply discloses that the link exists without any determining step being made either before or after the disclosed linking. While the Examiner correctly construes the prompting steps which follow the determining step as conditional steps (Answer 10), the determining steps are not an optional step and must be disclosed in the prior art or shown to be an obvious or inherent in Armetta- which evidence the Examiner has not so provided in the record.

Since claims 2-9, 75-77, and 79-83 depend from one of claims 1, 74, 78, and 84, and since we cannot sustain the rejection of claims 1, 74, 78, and 84, the rejection of claims 2-9, 75-77, and 79-83 likewise cannot be sustained.

CONCLUSIONS OF LAW

We conclude the Examiner erred in rejecting claims 84-89 under [35 U.S.C. § 112](#), second paragraph.

*4 We conclude the Examiner erred in rejecting claims 1-9 under [35 U.S.C. § 101](#).

We conclude the Examiner erred in rejecting claims 74-89 under [35 U.S.C. 102\(b\)](#).

We conclude the Examiner erred in rejecting claims 1-9 and 74-89 under [35 U.S.C. 103\(a\)](#).

DECISION

The decision of the Examiner to reject claims 1-9 and 74-89 is reversed.

REVERSED.

Footnotes

[1](#) Appellants identify OpenDesign, Inc. as the real party in interest. Br. 1.

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