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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
16/217.005	12/11/2018	Tony Ventrice	EVS-1804	7691
36088	7590	06/30/2020	EXAMINER	
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Danville, CA 94506			PAPER NUMBER	
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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.

Office Action Summary

Application No.

16/217,005

Applicant(s)

Ventrice et al.

Examiner

RADU ANDREI

Art Unit

3682

AIA (FITF) Status

Yes

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTHS FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 5/16/2020.

A declaration(s)/affidavit(s) under **37 CFR 1.130(b)** was/were filed on _____.

2a) This action is **FINAL**.

2b) This action is non-final.

3) An election was made by the applicant in response to a restriction requirement set forth during the interview on _____; the restriction requirement and election have been incorporated into this action.

4) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims*

5) Claim(s) 1-20 is/are pending in the application.

5a) Of the above claim(s) _____ is/are withdrawn from consideration.

6) Claim(s) _____ is/are allowed.

7) Claim(s) 1-20 is/are rejected.

8) Claim(s) _____ is/are objected to.

9) Claim(s) _____ are subject to restriction and/or election requirement

* If any claims have been determined allowable, you may be eligible to benefit from the **Patent Prosecution Highway** program at a participating intellectual property office for the corresponding application. For more information, please see http://www.uspto.gov/patents/init_events/pph/index.jsp or send an inquiry to PPHfeedback@uspto.gov.

Application Papers

10) The specification is objected to by the Examiner.

11) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

Certified copies:

a) All b) Some** c) None of the:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. _____.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

** See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)

3) Interview Summary (PTO-413)

Paper No(s)/Mail Date _____.

2) Information Disclosure Statement(s) (PTO/SB/08a and/or PTO/SB/08b)

4) Other: _____.

Paper No(s)/Mail Date _____.

DETAILED ACTION

The present application, filed on 12/11/2018 is being examined under the AIA first inventor to file provisions.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/16/2020 has been entered.

The following is a non-final First Office Action on the Merits in response to Applicant's submission.

- a. Claims 1, 11 are amended

Overall, **Claims 1-20** are pending and have been considered below.

Claim Rejections - 35 USC § 101

35 USC 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-20 are rejected under 35 USC 101 because the claimed invention is not directed to patent eligible subject matter. The claimed matter is directed to a judicial exception (i.e. an abstract idea not integrated into a practical application) without significantly more.

Per Step 1 and Step 2A of the two-step eligibility analysis, independent Claim 1 and Claim 11 and the therefrom dependent claims are directed respectively to a computer

implemented method and to a system. Thus, on its face, each such independent claim and the therefrom dependent claims are directed to a statutory category of invention.

However, Claim 1, (which is repeated in Claim 11) is rejected under 35 U.S.C. 101 because the claim is directed to an abstract idea, a judicial exception, without reciting additional elements that integrate the judicial exception into a practical application. The claim recites communicating details regarding the at least one applicable offer to a point of sale terminal via the payment gateway; receiving confirmation that the at least one applicable offer has been applied at the point of sale; and clearing the at least one applicable offer from the database.

The limitations, as drafted, constitute a process that, under its broadest reasonable interpretation, covers commercial activity, but for the recitation of generic computer components. That is, the drafted process is comparable to an marketing, sales activities process, i.e. a process aimed at providing an offer and updating the offer database. If a claim limitation, under its broadest reasonable interpretation, covers performance of limitations of agreements in form of advertising, marketing, sales activities or behaviors, but for the recitation of generic computer components, then it falls within the “Certain Methods of Organizing Human Activity – Commercial or Legal Interactions (e.g. agreements in form of contracts, legal obligations, advertising, marketing, sales activities or behaviors, business relationships)” grouping of abstract ideas. Accordingly, the claim recites an abstract idea.

This abstract idea is not integrated into a practical application. In particular, stripped of those claim elements that are directed to an abstract idea, the remaining positively recited elements of the independent claims are directed to generating a household identification, receiving a database of offers, receiving a weight for the product, calculating a return on investment, determining a discount percentage, receiving payment data for at least one product from a payment gateway, accessing a correlation database linking the unique identifier with a household ID, matching the household ID to at least one offer applicable to the household. These claim elements amount to no more than insignificant extra-solution activity (MPEP 2106.05(g)).

The non-positively recited claim elements are the household, the subset of offers, the payment data. While these descriptive elements may provide further helpful context for the claimed invention, they do not serve to integrate the abstract idea into a practical application.

The recited computer elements, i.e. a system, an interface, are recited at a high-level of generality (i.e. as a generic computing device performing generic computer functions of

obtaining data, interpreting the obtained data and providing results), such that they amount to no more than mere instructions to apply the exception using generic computer components.

Accordingly, these additional claim elements do not integrate the abstract idea into a practical application, because (1) they do not effect improvements to the functioning of a computer, or to any other technology or technical field (see MPEP 2106.05 (a)); (2) they do not apply or use the abstract idea to effect a particular treatment or prophylaxis for a disease or a medical condition (see the *Vanda* memo); (3) they do not apply the abstract idea with, or by use of, a particular machine (see MPEP 2106.05 (b)); (4) they do not effect a transformation or reduction of a particular article to a different state or thing (see MPEP 2106.05 (c)); (5) they do not apply or use the abstract idea in some other meaningful way beyond generally linking the use of the identified abstract idea to a particular technological environment, such that the claim as a whole is more than a drafting effort designed to monopolize the exception (see MPEP 2106.05 (e) and the *Vanda* memo). Therefore, per Step 2A, Prong Two, the claim is directed to an abstract idea not integrated into a practical application.

Step 2B of the eligibility analysis concludes that the claim does not include additional elements that are sufficient to amount to significantly more than the judicial exception. Stripped of those claim elements that are directed to an abstract idea, not integrated into a practical application, the remaining positively recited elements of the independent claims are directed to generating a household identification, receiving a database of offers, receiving a weight for the product, calculating a return on investment, determining a discount percentage, receiving payment data for at least one product from a payment gateway, accessing a correlation database linking the unique identifier with a household ID, matching the household ID to at least one offer applicable to the household. When considered individually, these additional claim elements represent “Insignificant Extra-Solution (Pre-Solution and/or Post-Solution) Activity”, i.e. activities incidental to the primary process or product that are merely a nominal or tangential addition to the claims. Specifically, the limitations are considered pre-solution activity because they are mere gathering or pre-processing data/information in conjunction with the abstract idea. (MPEP 2106.05(g)) It is readily apparent that the claim elements are not directed to any specific improvements of the claims.

Furthermore, the independent claims contain descriptive limitations, not positively recited limitations of elements found in the independent claims and addressed above, such as

describing the nature, structure and/or content of the household, the subset of offers, the payment data. However, these elements do not require any steps or functions to be performed and thus do not involve the use of any computing functions. While these descriptive elements may provide further helpful context for the claimed invention, these elements do not serve to confer subject matter eligibility to the claimed invention since their individual and combined significance is still not heavier than the abstract concepts at the core of the claimed invention.

After stripping away the abstract idea claim elements, the additional positively recited steps and descriptive claim elements, the only remaining elements of the independent claims are directed to a system, an interface. When considered individually, these additional claim elements serve merely to implement the abstract idea using computer components performing computer functions. They do not constitute “Improvements to the Functioning of a Computer or to Any Other Technology or Technical Field”. (MPEP 2106.05(a)) It is readily apparent that the claim elements are not directed to any specific improvements of any of these areas.

When the independent claims are considered as a whole, as a combination, the claim elements noted above do not amount to any more than they amount to individually. The operations appear to merely apply the abstract concept to a technical environment in a very general sense – i.e. a computer receives information from another computer, processes that information and then sends a response based on processing results. The most significant elements of the claims, that is the elements that really outline the inventive elements of the claims, are set forth in the elements identified as an abstract idea. Therefore, it is concluded that the elements of the independent claims are directed to one or more abstract ideas and do not amount to significantly more. (MPEP 2106.05)

Further, Step 2B of the analysis takes into consideration all dependent claims as well, both individually and as a whole, as a combination.

Dependent Claim 2 (which is repeated in Claim 12) is not directed to any additional abstract ideas, but is directed to additional claim elements such as to collecting pharmacy identification, loyalty card information and credit card data from at least one retailer. Dependent Claim 3 (which is repeated in Claim 13) is not directed to any additional abstract ideas, but is directed to additional claim elements such as to linking the credit card data to the loyalty card data and pharmacy identification to correlate payment information to the household ID.

Dependent Claim 4 (which is repeated in Claim 14) is not directed to any additional abstract ideas, but is directed to additional claim elements such as to receiving at least one additional offer targeting the household. Dependent Claim 5 (which is repeated in Claim 15) is not directed to any additional abstract ideas, but is directed to additional claim elements such as to linking the at least one additional offer to the household ID in the correlation database. When considered individually, these additional claim elements represent “Insignificant Extra-Solution (Pre-Solution and/or Post-Solution) Activity”, i.e. activities incidental to the primary process or product that are merely a nominal or tangential addition to the claims. Specifically, the limitations are considered pre-solution activity because they are mere gathering or pre-processing data/information in conjunction with the abstract idea. (see MPEP 2106.05(g)) It is readily apparent that the claim elements are not directed to any specific improvements of the claims.

Dependent Claims 6-10 (which are repeated in Claims 16-20 respectively) are not directed to any abstract ideas and are not directed to any additional non-abstract claim elements. Rather, these non-positively recited claims provide further descriptive limitations of elements, such as describing the nature, structure and/or content of the payment gateway, the offer, the transferred funds, the unique identifier. However, these elements do not require any steps or functions to be performed and thus do not involve the use of any computing functions. While these descriptive elements may provide further helpful context for the claimed invention, these elements do not serve to confer subject matter eligibility to the invention since their individual and combined significance is still not heavier than the abstract concepts at the core of the claimed invention.

Moreover, the claims in the instant application do not constitute significantly more also because the claims or claim elements only serve to implement the abstract idea using computer components to perform computing functions (*Enfish*, see MPEP 2106.05(a)). Specifically, the computing system encompasses general purpose hardware and software modules, as disclosed in the application specification in fig24A, fig24B and [0188]-[0198], including among others processor, memory, random memory, read only memory, input/output devices, secondary storage device, keyboard, mouse, speaker, video display, track balls, microphones, tablets, styluses, sensors.

When the dependent claims are considered as a whole, as a combination, the additional elements noted above appear to merely apply the abstract concept to a technical environment in a very general sense – i.e. a computer receives information from another computer, processes that information and then sends a response based on processing results. The most significant elements of the claims, that is the elements that really outline the inventive elements of the claims, are set forth in the elements identified in the independent claims as an abstract idea. The fact that the computing devices are facilitating the abstract concept is not enough to confer statutory subject matter eligibility. In sum, the additional elements do not serve to confer subject matter eligibility to the invention since their individual and combined significance is still not heavier than the abstract concepts at the core of the claimed invention. Therefore, it is concluded that the dependent claims of the instant application do not amount to significantly more either. (see MPEP 2106.05)

In sum, Claims 1-20 are rejected under 35 USC 101 as being directed to non-statutory subject matter.

Response to Amendments/Arguments

Applicant's submitted remarks and arguments have been fully considered.

Applicant disagrees with the Office Action conclusions and asserts that the presented claims fully comply with the requirements of 35 U.S.C. § 101 regarding judicial exceptions. Further, Applicant is of the opinion that the prior art fails to teach Applicant's invention.

Examiner respectfully disagrees with the former.

With respect to the Claim Interpretation under 35 USC § 112(f).

The interpretation is withdrawn as a result of the amendments.

With respect to Applicant's Remarks as to the claims being rejected under 35 USC § 101.

Applicant submits:

- a. The pending claims are not directed to an abstract idea.
- b. The identified abstract idea is integrated into a practical application.
- c. The pending claims amount to significantly more.

Furthermore, Applicant asserts that the Office has failed to meet its burden to identify the abstract idea and to establish that the identified abstract idea is not integrated into a practical application and that the pending claims do not amount to significantly more.

Examiner responds – The arguments have been considered in light of Applicants' amendments to the claims. The arguments ARE NOT PERSUASIVE. Therefore, the rejection is maintained.

The pending claims, as a whole, are directed to an abstract idea not integrated into a practical application. This is because (1) they do not effect improvements to the functioning of a computer, or to any other technology or technical field (see MPEP 2106.05 (a)); (2) they do not apply or use the abstract idea to effect a particular treatment or prophylaxis for a disease or a medical condition (see the *Vanda* memo); (3) they do not apply the abstract idea with, or by use of, a particular machine (see MPEP 2106.05 (b)); (4) they do not effect a transformation or reduction of a particular article to a different state or thing (see MPEP 2106.05 (c)); (5) they do not apply or use the abstract idea in some other meaningful way beyond generally linking the use of the identified abstract idea to a particular technological environment, such that the claim as a whole is more than a drafting effort designed to monopolize the exception (see MPEP 2106.05 (e) and the *Vanda* memo).

In addition, the pending claims do not amount to significantly more than the abstract idea itself.

As such, the pending claims, when considered as a whole, are directed to an abstract idea not integrated into a practical application and not amounting to significantly more.

More specific:

Applicant submits "Applicants note that the claims mention promotional activity, but are directed to the backend system of managing the transactions of the offers." Examiner has carefully considered, but doesn't find Applicant's arguments persuasive. The sequence of steps of the method disclosed by independent claim 1 ends with the steps:

“receiving payment data for at least one product associated with a redeemed offer of the subset of offers from a payment gateway, wherein the payment data includes a unique identifier; accessing a correlation database linking the unique identifier with the household ID; matching the household ID to the redeemed offer applicable to the at least one product; communicating details regarding the redeemed offer to a point of sale terminal via the payment gateway; receiving confirmation that the redeemed offer has been applied at the point of sale; and clearing the redeemed offer from the database.”

All but the last step point to providing an offer and checking if the offer is redeemed. The step “clearing the redeemed offer from the database” is actually the only one point to “managing the transactions of the offer.”

Applicant submits arguments based on analogies with Example 37, Example 40, Example 41, Example 42 from January 2019. Examiner has carefully considered, but doesn't find Applicant's arguments persuasive. It is not proper practice to go and find a particular Example from the Office published material and use the specific arguments from that Example to determine eligibility of a particular claimed invention, unless the particular claimed invention uniquely matches the subject matter claimed in that particular Example, which in the instant situation it does not. The Office periodically publishes Examples with detailed analyses only to serve as rational and argumentation models to determine eligibility.

Applicant submits “Sharing information between people is “a method of organizing human activity” per the USPTO's own guidelines. **Improving** this abstract idea in a specific way (here real-time and standardizing the format) is sufficient for integrating the abstract concept into a practical application.” Examiner has carefully considered, but doesn't find Applicant's arguments persuasive. Applicant argues that the claims are patent-eligible because they result in an improvement in the technology field. Examiner respectfully disagrees. It is not clear that the claims are directed to an improvement to an existing technology. The claims appear directed to an improvement to providing offers. The technological improvements identified by the courts in Diehr, Enfish, and Bascom are significantly different than programming a computer to provide offers. The disclosure fails to explicitly discuss an improvement to any underlying technology executing the identified abstract idea. The original disclosure fails to discuss prior art offer

providing engines. In spite of disclosing some perceived advantages which allegedly are brought about by the instant application, the original disclosure fails to discuss prior art offer providing engines. The original disclosure therefore does not suggest that the particular offer providing engine structures being claimed is an improvement over prior art systems. The fact that the disclosure failed to identify a problem and the fact that the original disclosure fails to indicate how or why the claimed arrangement of system elements enables an improvement suggests that the claimed invention is not directed to this improvement. Instead, it appears Applicant has attempted to identify, after the fact, some unsubstantiated benefit of the claimed matter in an effort to exhibit the claims are directed to a technological improvement. (see MPEP 2106.05(a); (i) specification requirements in regard to the improvements (should describe the improvement): *McRO v Bandai* – specification provides explanation, *Affinity Labs* – specification does not provide explanation; (ii) claim requirements in regard to the improvements (should recite the improvement): *Enfish* – claim reflects the improvement, *Intellectual Ventures* – claim does not reflect the improvement).

Applicant submits “As the claims provide a *specific improvement* over the prior art ...” Examiner has carefully considered, but doesn’t find Applicant’s arguments persuasive. On pages 12-13 of the October 2019 Update, the USPTO states:

An important consideration to evaluate when determining whether the claim as a whole integrates a judicial exception into a practical application is whether the claimed invention improves the functioning of a computer or other technology In short, first the specification should be evaluated to determine if the disclosure provides sufficient details such that one of ordinary skill in the art would recognize the claimed invention as providing an improvement. The specification need not explicitly set forth the improvement, but it must describe the invention such that the improvement would be apparent to one of ordinary skill in the art Second, if the specification sets forth an improvement in technology, the claim must be evaluated to ensure that the claim itself reflects the disclosed improvement. (Emphasis added)

That is, the claimed invention may integrate the judicial exception into a practical application by demonstrating that it improves the relevant existing technology although it may not be an improvement over well-understood, routine, conventional activity. (Emphasis added)

It becomes self-evident that there are no meaningful limitations in the claims that transform the judicial exception into a patent eligible application such that the claims amount to

significantly more than the judicial exception itself. Therefore, the rejection under 35 U.S.C. § 101 is maintained.

With respect to Applicant's Remarks as to the claims being rejected under 35 USC § 112(a).

The rejection is withdrawn.

With respect to Applicant's Remarks as to the claims being rejected under 35 USC § 103.

The rejection is withdrawn.

Examiner has reviewed and considered all of Applicant's remarks. The rejection is maintained, necessitated the fact that the rejection of the claims under 35 USC § 101 has not been overcome.

Inquiries

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Radu Andrei whose telephone number is 313.446.4948. The examiner can normally be reached on Monday – Friday 8:30am – 5pm EST. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Waseem Ashraf can be reached at (571)270-3948. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

As detailed in MPEP 502.03, communications via Internet e-mail are at the discretion of the applicant. Without a written authorization by applicant in place, the USPTO will not respond via Internet e-mail to any Internet correspondence which contains information subject to the confidentiality requirement as set forth in 35 U.S.C. 122. A paper copy of such correspondence will be placed in the appropriate patent application. The following is a sample authorization form which may be used by applicant:

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/Radu Andrei/
Primary Examiner, AU 3682