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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
15/045,408	02/17/2016	Kenneth P. Weiss	W0537-701322	6442

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EXAMINER
CHOO, JOHANN Y

ART UNIT	PAPER NUMBER
3685	

NOTIFICATION DATE	DELIVERY MODE
01/27/2017	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):

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APPLE 1015

| Office Action Summary | Application No. 15/045,408 | Applicant(s) WEISS, KENNETH P. |
| | Examiner JOHANN CHOO | Art Unit 3685 | AIA (First Inventor to File) Status No |

-- 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 *11/1/2016*.
    ☐ 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) *1-14* 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) *1-14* 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 <u>allowable</u>, 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)
2) ☒ Information Disclosure Statement(s) (PTO/SB/08a and/or PTO/SB/08b)
3) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

DETAILED ACTION

This action is responsive to the application filed on 11/1/2016.

Claims 1-4, 6, 9, 12 have been amended.

Claims 1-14 are currently pending and have been examined.

Response to Amendment

Several 112(b) rejections have been withdrawn in response to applicant's amendments.

Response to Arguments

Applicant asserts that the claims recite more than the abstract idea because they recite "an electronic ID device configured to provide encrypted information to execute a secure transaction, comprising: a biometric sensor configured to receive a biometric". However, an electronic ID device configured to provide information to execute a transition is indeed a generic computer; Similarly, a biometric sensor is also widespread technology and at the time of applicant's invention would be considered a generic computing device/accessory found in numerous computing systems, especially in the realm of secure communications. Furthermore, processors, communication interfaces, etc. are all also generic computing devices/parts.

Applicant asserts that the claims are not abstract because there has been no abstract idea as recited in the claims and specified by the courts. However, in the previous rejection, it was specifically pointed out that the claim recites steps of "receive identifying information…", "communicate encrypted information", 'generate the encrypted information", etc. That is, the claims are directed to transmitting/receiving/collecting of data and processing/authenticating of transaction information which is similar to processing that information through a clearinghouse with the use of transforming one form of data to another, which have been noted as abstract ideas in the guidelines. As is laid out by the *Alice* test, the claim is first checked to see if there is a corresponding abstract idea, and then the technological aspects and limitations are a whole are considered to determine if there is significantly more than the abstract idea present.

Similarly, while a "biometric sensor" receiving a "biometric" from a user may not be fully done in a human mind, the use of authenticating information such as passwords, fingerprints, eye color, facial features, etc. may indeed be received by a human mind and checked with previous inputs in order to validate a user.

Applicant asserts that as the claims do not preempt the abstract idea, the claims are not considered routine and conventional. However, applicant is reminded that questions of preemption are inherent in and resolved by the two-part framework from Alice. Moreover, while a preemptive claim may be ineligible, the absence of complete preemption does not demonstrate that the claim is eligible.

Applicant asserts that there has been no reasoned explanation that supports that the additional elements would be well understood, routine, conventional activities. However, it was noted in the previous office action that The claim(s) does not include additional elements that are sufficient to amount to significantly more than the judicial exceptions because the additional elements or combination of elements in the claims other than the abstract idea per se, e.g. receiving/sending/collecting data, comparing/processing data, encrypting/decrypting data etc., amount to more than: (i) mere instructions to implement the idea on a computer, and/or (ii) **recitation of generic computer structure that serves to perform generic computer functions that are well-understood, routine, and conventional activities previously known to the pertinent industry.**

Applicant asserts that the dependent claims were not addressed adequately. However, the dependent claims were indeed addressed and specific limitations were indeed considered of the dependent claims. Applicant has provided no arguments as to what applicant considers to be significantly more than the abstract idea in any specific dependent claim, and as such, currently, the office has provided more than sufficient evidence that the dependent claims fall within the same abstract ideas as the independent claims without adding significantly more than the abstract ideas.

Applicant asserts that the teachings of Waugh do not disclose the use of encrypting with a private key a non-predictable value because Waugh teaches the use of a private key and therefore cannot include the key inside the message itself. However, as shown in the current rejection below, Waugh does teach that a message may be encrypted, and the message may include a variety of information.

Therefore it is obvious to one of ordinary skill in the art that the message of Waugh could include any variety of information, words, identifiers, etc. which would act as non-predictable values. Furthermore, as the intended definition of "non-predictable-value" is unclear, it is most certainly within the realm of obviousness that any message a user creates would constitute a "non-predictable value" and interpreted by the office.

Claim Rejections - 35 USC § 101

35 U.S.C. 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 1-14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claim does not fall within at least one of the four categories of patent eligible subject matter because the claimed invention is directed to a judicial exception (i.e., a law of nature, a natural phenomenon, or an abstract idea) without significantly more.

In the instant case, claims 1-14 are directed to a device. Hence, the claimed invention is directed towards one of the four statutory categories under 35 USC 101. Nevertheless, the claims also fall within the judicial exception of abstract idea. The claims are directed towards the abstract idea of sending/receiving information in order to process a transaction. More specifically, the claim recites steps of "receive a biometric", "receive identifying information…", "communicate encrypted information", "generate the encrypted information", etc. That is, the claims are directed to transmitting/receiving/collecting of data and processing/authenticating of transaction information through a clearing house and processing that information with the use of transforming one form of data to another similar in scope to *Cybersource* and *buySAFE*. The concept in the claims is not meaningfully different that those concepts found by the courts and guidelines to be abstract ideas.

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