

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte HUGH SVENDSEN

Appeal 2012-010845
Application 11/757,079
Technology Center 2400

Before ALLEN R. MacDONALD, ROBERT E. NAPPI, and
GARTH D. BAER, *Administrative Patent Judges*.

MacDONALD, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

Appellant appeals under 35 U.S.C. § 134(a) from a final rejection of claims 1–36. We have jurisdiction under 35 U.S.C. § 6(b).

Exemplary Claims

Exemplary claims 1, 13, and 25 under appeal read as follows
(formatting added):

1. A method of propagating a media item recommendation comprising the steps of:

[(A)] receiving from a recommender via a network a first media item recommendation message, wherein the first media item recommendation message comprises a media item identifier of a media item and presence information of the recommender;

[(B)] sending the first media item recommendation message to a first recipient via the network;

[(C)] receiving via the network a second media item recommendation message from the first recipient, wherein the second media item recommendation message comprises the media item identifier and the presence information of the recommender adapted by the first recipient; and

[(D)] sending the second media item recommendation message to a second recipient via the network.

13. A system for propagating a media item recommendation, comprising:

[(A)] a control system, wherein the control system is adapted to:

[(i)] receive from a recommender, via a network, a first media item recommendation message comprising a media item identifier of a media item and presence information of the recommender;

[(ii)] send the first media item recommendation message to a first recipient via the network;

[(iii)] receive, via the network, a second media item recommendation message from the first recipient, wherein the second media item recommendation message comprises the media item identifier and the presence information of the recommender adapted by the first recipient; and

[(iv)] send the second media item recommendation message to a second recipient via the network.

25. A computer-readable medium embodied in a non-transitory article of manufacture, comprising instructions for instructing a computer to:

[(A)] receive from a recommender a first media item recommendation message comprising a media item identifier of a media item and presence information of the recommender;

[(B)] send the first media item recommendation message to a first recipient;

[(C)] receive a second media item recommendation message from the first recipient, wherein the second media item recommendation message comprises the media item identifier and the presence information of the recommender adapted by the first recipient; and

[(D)] send the second media item recommendation message to a second recipient.

Rejections

1. The Examiner rejected claims 1–36 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Partovi (US 2008/0052371 A1), Farouki (US 2006/0259355 A1), and Howard (US 2008/0176562 A1).¹

¹ Separate patentability is argued for claim 3. Claims 2, 4–14, 16–26, and 28–36 are grouped with claim 1; Claims 15 and 27 are grouped with claim 3. Except for our ultimate decision, claims 2 and 4–36 are not discussed further herein.

Appellant's Contentions

1. Appellant contends that the Examiner erred in rejecting claim 1 under 35 U.S.C. § 103(a) because none of the cited references, either alone or in combination, disclose or suggest a second recommendation message having information that was in a first recommendation message. Br. 7–12.

2. Appellant also contends that the Examiner erred in rejecting claim 3 under 35 U.S.C. § 103(a) because none of the cited references, either alone or in combination, disclose or suggest that a first recipient of a first recommendation message modifies presence information claim. Br. 12–13.

Issue on Appeal

Did the Examiner err in rejecting claims 1 and 3 as being obvious?

ANALYSIS

We agree with the Appellant's above-recited contentions.

NEW GROUNDS OF REJECTION

Pursuant to our authority under 37 C.F.R. § 41.50(b), we reject claims 1–36 under 35 U.S.C. § 101, as being directed to ineligible subject matter.²

² We address claims 1–36 under 35 U.S.C. § 101 to highlight that, under *Alice*, where claims distinguish over conventional prior art based solely on information content (in this case, the information content of the received first and second message) with conventional prior art limitations appended thereto, the appended conventional prior art limitations may not be enough to supply an inventive concept. This interrelationship of information content and 35 U.S.C. § 101 was previously noted by our reviewing court in discussing the printed matter doctrine. *See In re Miller*, 418 F.2d 1392, 1396 (CCPA 1969) (“[Examiner’s] characterization of printed matter as

Legal Principles

A patent may be obtained for “any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof.” 35 U.S.C. § 101. The Supreme Court has held that this provision contains an important implicit exception: laws of nature, natural phenomena, and abstract ideas are not patentable. *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2354 (2014); *Gottschalk v. Benson*, 409 U.S. 63, 67 (1972) (“Phenomena of nature, though just discovered, mental processes, and abstract intellectual concepts are not patentable, as they are the basic tools of scientific and technological work.”). Notwithstanding that a law of nature or an abstract idea, by itself, is not patentable, the application of these concepts may be eligible for patent protection. *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1293–94 (2012). In *Mayo*, the Court stated that “to transform an unpatentable law of nature into a patent-eligible *application* of such a law, one must do more than simply state the law of nature while adding the words ‘apply it.’” *Mayo*, 132 S. Ct. at 1294 (citation omitted).

In *Alice*, the Supreme Court reaffirmed the framework set forth previously in *Mayo* “for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of these concepts.” *Alice*, 134 S. Ct. at 2355. The first step in the analysis is to “determine whether the claims at issue are directed to one of those patent-ineligible concepts.” *Id.* If the claims are directed to a

‘unpatentable’ is beside the point; no attempt is here being made to patent printed matter as such. The fact that printed matter by itself is not patentable subject matter, because [it is] non-statutory, is no reason for ignoring it when the claim is directed to a combination.”).

patent-ineligible concept, then the second step in the analysis is to consider the elements of the claims “individually and ‘as an ordered combination’ to determine whether the additional elements ‘transform the nature of the claim’ into a patent-eligible application.” *Id.* (quoting *Mayo*, 132 S. Ct. at 1298, 1297). In other words, the second step is to “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.’” *Id.* (brackets in original) (quoting *Mayo*, 132 S. Ct. at 1294). “A claim that recites an abstract idea must include ‘additional features’ to ensure ‘that the [claim] is more than a drafting effort designed to monopolize the [abstract idea].’” *Id.* at 2357 (brackets in original) (quoting *Mayo*, 132 S. Ct. at 1297). The prohibition against patenting an abstract idea “cannot be circumvented by attempting to limit the use of the formula to a particular technological environment or adding insignificant post-solution activity.” *Bilski v. Kappos*, 561 U.S. 593, 610–11 (2010) (citation and internal quotation marks omitted). The Court in *Alice* noted that “[s]imply appending conventional steps, specified at a high level of generality,’ was not ‘enough’ [in *Mayo*] to supply an ‘inventive concept.’” *Alice*, 134 S. Ct. at 2357 (quoting *Mayo*, 132 S. Ct. at 1300, 1297, 1294).

Analysis

We apply the framework as set forth by the Court in *Mayo* and reaffirmed by the Court in *Alice* for determining whether claims 1–36 are directed to patent-eligible subject matter.

Step one: Are the claims at issue directed to a patent-ineligible concept?

We conclude that they are: Claims 1–36 are directed to the abstract idea of a first and second “message” each having content “information” (i.e., data) comprising “a media item identifier of a media item and presence information.” “Data in its ethereal, non-physical form is simply information that does not fall under any of the categories of eligible subject matter under section 101.” *Digitech Image Techs., LLC v. Elec. for Imaging, Inc.*, 758 F.3d 1344, 1350 (Fed. Cir. 2014). Our conclusion, that claims 1–36 are directed to a patent-ineligible concept, is reinforced by Appellant’s argument directed to the Examiner’s rejection of claim 1 under 35 U.S.C. § 103. Appellant’s arguments are focused solely on the information content of the messages contained in claim 1. “None of the cited references, either alone or in combination, disclose or suggest a second recommendation message having information that was in a first recommendation message.” Br. 8. As we noted above, according to *Alice*, the question to be settled next is whether claim 1 recites an element, or combination of elements, that is enough to ensure that the claim is directed to significantly more than an abstract idea.

Step two: Is there something else in the claims that ensures that they are directed to significantly more than a patent-ineligible concept?

We conclude that claims 1–36, which merely require generic “network,” “control system,” and “computer-readable medium” implementation, fail to transform that abstract idea into a patent-eligible invention.

Taking the claim elements separately, these generic computer network elements are purely conventional. These claimed generic elements are well-

understood, routine, conventional elements previously known to the industry. In short, the claims do no more than require generic computer network elements to perform generic computer network functions.

Considered as an ordered combination, the computer components of Appellant's claims add nothing that is not already present when the elements are considered separately. Viewed as a whole, Appellant's claims simply recite the concept of sending and receiving particular data as performed by a generic computer network. The claims do not, for example, purport to improve the storage operation of the computer network itself, e.g., an inventive data structure is used. Nor do they effect an improvement in any other technology or technical field, e.g., a computer program for performing inventive functions is stored on the generic computer storage media. Instead, the claims at issue amount to nothing significantly more than an instruction to apply the abstract idea of sending and receiving particular abstract data using some unspecified, generic computer network elements. That is not enough to transform an abstract idea into a patent-eligible invention.

None of the hardware recited by the claims offers a meaningful limitation beyond generally linking the use of the data to a particular technological environment, that is, implementation via computer networks. Simply appending a conventional computer network, control system, or computer-readable medium, specified in general terms, is not enough to transform an abstract idea into a patent-eligible invention. *See Alice*, 134 S. Ct. at 2357–60. These recitations are similar to the recitation of a conventional “computer” discussed in *Alice*.

37 C.F.R. § 41.50(b)

This Decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that Appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

CONCLUSIONS

(1) Appellant has established that the Examiner erred in rejecting claims 1–36 as being unpatentable under 35 U.S.C. § 103(a).

(2) We reject claims 1–36 as being directed to ineligible subject matter under 35 U.S.C. § 101.

(3) Claims 1–36 are not patentable.

DECISION

The Examiner’s rejection of claims 1–36 is reversed.

New grounds of rejection are entered for claims 1–36.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

REVERSED
37 C.F.R. § 41.50(b)

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