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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte AARON J. KLISH

Appeal 2013-000814
Application 12/396,301¹
Technology Center 3600

Before ANTON W. FETTING, PHILIP J. HOFFMANN, and
BRUCE T. WIEDER, *Administrative Patent Judges*.

WIEDER, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the Examiner's rejection of claims 1–8, 10–25, 27, and 28. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE and enter a NEW GROUND OF REJECTION pursuant to our authority under 37 C.F.R. § 41.50(b).

CLAIMED SUBJECT MATTER

Appellant's claimed invention relates to "creating web user interfaces in a social web site" (Spec. ¶ 2.)

¹ According to Appellant, the real party in interest is Yahoo! Inc. (Appeal Br. 4.)

Claims 1, 13, and 19 are the only independent claims on appeal. Claim 1 is representative of the subject matter on appeal and reproduced below:

1. A method for creating a web user interface, the method comprising:
 - creating a library of products and service providers;
 - generating an endorsement object for a product or a service provider in the library, the endorsement object being generated by a first user of a social web site;
 - obtaining rules from the first user for sharing the endorsement object with other users in the social web site;
 - building a user interface for a second user, the user interface including a representation of the product or service provider associated with the endorsement object, the representation being made according to the obtained rules and to endorsement viewing rules defined for the second user; and
 - visually depicting the user interface for the second user on a display, wherein at least one method operation is executed by a processor.

REJECTIONS

Claims 1–8 and 10–12² are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Claims 1–8, 10–25, 27, and 28 are rejected under 35 U.S.C. § 102(b) as being anticipated by Allaire (US 2007/0038931 A1, pub. Feb. 15, 2007).

² The Examiner indicates that claims 1–12 are rejected under 35 U.S.C. § 101; but claim 9 is not pending. (*See* Final Office Action 6–8 and Summary.) We treat the reference to claim 9 in the § 101 rejection as inadvertent.

ANALYSIS

The 35 U.S.C. § 101 rejection

In rejecting claim 1–8 and 10–12 under § 101, the Examiner determined that the claims are not “tied to a particular machine and can be performed without the use of a particular machine or apparatus” and that the method steps of the claims “do not result in a transformation of a particular article to a different state or thing.” (Final Office Action 7.)

Appellant argues that “claim 1 is tied to a computer memory, and is patentable under 101” and that “claim 1 is tied to a network and to a computing device, and is patentable under § 101.” (Appeal Br. 8.)

At the time the Final Office Action was issued in this case, the applicable law stated “that the machine-or-transformation test is a useful and important clue, an investigative tool, for determining whether some claimed inventions are processes under § 101. The machine-or-transformation test is not the sole test for deciding whether an invention is a patent-eligible ‘process.’” *Bilski v. Kappos*, 130 S. Ct. 3218, 3227 (2010).

Because the machine-or-transformation test was applied as the sole test for deciding whether the invention is patent-eligible subject matter, we reverse the Examiner’s rejection of claims 1–8 and 10–12 under 35 U.S.C. § 101.

New Ground of Rejection

Pursuant to our authority under 37 C.F.R. § 41.50(b), we enter a NEW GROUND OF REJECTION against claims 1–8, 10–25, 27, and 28.

Subsequent to the filing of briefs in this appeal, the Supreme Court decided *Alice Corp. Pty Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347 (2014).

Alice applies a two-part framework, earlier set out in *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289 (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*, 134 S. Ct. at 2355.

Under the two-part 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, then the second part 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 2357 (citing *Mayo*, 132 S. Ct. at 1294, 1298).

Therefore, we must first determine whether the claims at issue are directed to a patent-ineligible concept.

While the Court in *Alice* did not elaborate on how it made its finding as to what the claims were directed, we find that this case’s claims themselves and the Specification provide enough information to inform one as to what they are directed.

The preamble to claim 1 recites that it is a method of creating a web user interface. The three steps in claim 1 result in providing a web user interface with an “endorsement object” to promote a product or a service provider. The Specification recites that the invention relates to “creating advertising web user interfaces.” (Spec. ¶ 2.) This evidence shows that claim 1 is directed to providing an advertisement in a web user interface, i.e., business promotion.

It follows from prior Supreme Court cases, and *Bilski* in particular, that the claims at issue here are directed to an abstract idea. Like the risk hedging in *Bilski*, the concept of business promotion is a fundamental economic practice long prevalent in our system of commerce. The use of a promotional advertisement is also a building block of the modern economy. Thus, business promotion, like hedging, is an “abstract idea.” *See Alice*, 134 S. Ct. at 2356.

As in *Alice*, we need not labor to delimit the precise contours of the “abstract ideas” category in this case. It is enough to recognize that there is no meaningful distinction in the level of abstraction between the concept of risk hedging in *Bilski* and the concept of advertising at issue here. Both are squarely within the realm of “abstract ideas” as the Court has used that term. *See id.* at 2357.

The remaining claims merely describe examples of advertisement information and tracking. Therefore, we conclude that the claims at issue are directed to a patent-ineligible concept.

We now apply the second part of the framework 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.*

The introduction of a computer into the claims does not alter the analysis at 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 “implement[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.”

Id. at 2358 (citations omitted).

“[T]he 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 generate an object, i.e., data, obtain rules, build a user interface, and display that interface amounts to electronic data presentation—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. In short, each step does no more than require a generic computer to perform generic computer functions.

Considered as an ordered combination, the computer components of Appellant’s method add nothing that is not already present when the steps are considered separately. Viewed as a whole, Appellant’s method claims simply recite the concept of advertising, i.e., business promotion, as performed by a generic computer. The method claims do not, for example, purport to improve the functioning of the computer itself. Nor do they effect an improvement in any other technology or technical field. Instead, the

claims at issue amount to nothing significantly more than an instruction to apply the abstract idea of business promotion using some unspecified, generic computer. That is not enough to transform an abstract idea into a patent-eligible invention. *See id.* at 2360.

The 35 U.S.C. § 102(b) rejection

Appellant argues that Allaire does not teach “generating an endorsement object for a product or a service provider in the library, the *endorsement object being generated by a first user . . .*” (Appeal Br. 10–11, emphasis added.)

In finding that Allaire discloses “the endorsement object being generated by a first user of a social web site,” the Examiner cites paragraph 132 of Allaire which discloses that “a user 12 might send an Email, SMS or IM message about a video that might be of interest to one or more contacts.” (Final Office Action 8, citing Allaire ¶ 132.) The Examiner also finds that “[u]sers may generate an endorsement object (e.g., a recommendation) through the personalization module.” (*Id.*, citing Allaire ¶ 135.) Paragraph 135 discloses that “[t]he personalization module 86 gathers user 12 recommendations based on explicit peer-supplied reviews and ratings” In other words, the Examiner finds that Allaire’s user 12 generates an endorsement object and thus corresponds to the “first user.”

Appellant next argues that Allaire does not teach “obtaining rules from the first user for sharing the endorsement object with other users” (Appeal Br. 11.)

The Examiner finds that “Allaire’s business solution teaches defining rules for the first user (*publisher*) for sharing endorsement object [sic] in the

social network.” (Answer 20, citing Allaire ¶ 75.) Paragraph 75 relates to the user platform providing “a variety of community tools for rating and reviewing content, sampling selected content (where enabled by the publisher) and remixing content to share with friends (where enabled by the publisher.)” In other words, the Examiner finds that the publisher 22 is the “first user” and that by enabling/not enabling sampling selected content, the first user/publisher is providing the rules “for sharing the endorsement object.” (See Final Office Action 6, “Content publisher may define the rules under which users may endorsement [sic] their products.”)

Thus, the Examiner finds that Allaire’s publisher 22 sets the rules for sharing the endorsement (“obtaining rules from the first user for sharing the endorsement object”). (Answer 20.) But the Examiner also finds that Allaire’s user 12 generates the endorsement object (“the endorsement object being generated by a first user”). (Final Office Action 8.) Since claim 1 requires that the rules be obtained from the first user and that the endorsement be generated by the first user, for Allaire to anticipate based on the Examiner’s findings, it must be inherent in Allaire that the user 12 and the publisher 22 may be the same. The Examiner does not explicitly make such a finding of inherency or clearly point to such a statement in Allaire.

Additionally, Appellant argues that “[a] user that downloads content from a database is different from a publisher that provides the content to the database.” (Reply 9.) Appellant further argues that “Allaire is silent with reference to rules from the first user for sharing the endorsement.” (Appeal Br. 12.)

Thus, we conclude that the Examiner has not presented a prima facie case that Allaire anticipates claim 1. Because independent claims 13 and 19

contain similar limitations, for the same reason, we reverse the rejection of claims 13 and 19 and dependent claims 2–8, 10–12, 14–18, 20–25, 27, and 28.

DECISION

The Examiner’s rejection of claims 1–8 and 10–12 under 35 U.S.C. § 101 is reversed.

The Examiner’s rejection of claims 1–8, 10–25, 27, and 28 under 35 U.S.C. § 103(a) is reversed.

We enter a NEW GROUND OF REJECTION of claims 1–8, 10–25, 27, and 28 under 35 U.S.C. § 101.

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). Section 41.50(b) provides that, “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.” Section 41.50(b) further provides that Appellants, **WITHIN TWO MONTHS FROM THE DATE OF THIS DECISION**, must exercise one of the following two options with respect to the new ground 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.

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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). *See* 37 C.F.R. § 1.136(a)(1)(iv).

REVERSED; 37 C.F.R. § 41.50(b)

Klh