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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DAVID GANG

Appeal 2013-006658
Application 10/703,662
Technology Center 2400

Before ST. JOHN COURTENAY III, THU A. DANG, and
LARRY J. HUME, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1–14, 30–43, 69, 70, 75 and 77. Claims 15–29, 44–68, 71–74, and 76 were canceled. We have jurisdiction under 35 U.S.C. § 6(b).

We Affirm.

Invention

The invention on appeal relates to matching online members with shared interests (Spec. 1, Title, Technical Field).

Representative Claim

Claim 1, reproduced below, is representative of the claimed subject matter:

1. A method of identifying one or more matching members for a match recipient, the method comprising:

[a] maintaining a member profile for the match recipient, the member profile including at least one personal attribute corresponding to a hobby, gender, marital status, occupation, or location;

[b] accessing a contacts list maintained for the match recipient, the contacts list maintained for the match recipient including contact information;

[c] analyzing the accessed contacts list to identify one or more entities whose contact information is included in the match recipient's contacts list;

[d] *forming a group that is limited to the one or more entities identified from the match recipient's contacts list who are currently online;*

[e] *comparing the at least one personal attribute of the match recipient's member profile to member profiles of entities in the limited group to identify at least one matching member from among the entities in the limited group, wherein the matching member is an entity whose member profile has a personal attribute matching a personal attribute of the match recipient's member profile;*

[f] causing an identifier for the matching member to be displayed to the match recipient in a user interface for an online communication service; and

[g] *causing an icon to be displayed adjacent to the identifier of the matching member to the match recipient, the icon indicating a matching personal attribute shared by the matching member and the match recipient.*

App. Br. 16–17 (Steps lettered and contested limitations emphasized).

Rejections

R1. Claims 1–7, 10–14, 30–36, 39–43, 69, 70, 75, and 77 are rejected under 35 U.S.C. §103(a) as being obvious over the combination of *Weiner* (US Patent Application Publication No. 2003/0084103 A1; published May 1, 2003), *Work* (US Patent Application Publication No. 2002/0059201 A1; published May 16, 2002), *Werndorfer* (US Patent Application Publication No. 2004/0017396 A1; published Jan. 29, 2004), and *Oliver* (US Patent No. 6,480,885 B1; published Nov. 12, 2002).

R2. Claims 8, 9, 37 and 38 are rejected under 35 U.S.C. §103(a) as being obvious over the combination of *Weiner*, *Work*, *Werndorfer*, *Oliver*, and *Rouse* (US Patent Application Publication No. 2002/0087620 A1; published Jul. 4, 2002).

Grouping of Claims

Based on Appellant’s arguments (App. Br. 8–12, Reply Br. 2–9), we decide the appeal of claims 1–7, 10–13, 30–36, 39–42, 69, 70, 75, and 77, which are rejected under rejection R1, on the basis of representative independent claim 1. *See* 37 C.F.R. § 41.37(c)(1)(iv).

We address Rejection R1 of dependent claims 14 and 43, argued separately (App. Br. 12–13), *infra*.

We address Rejection R2 of dependent claims 8, 9, 37, and 38, not argued separately (App. Br. 14), *infra*.

ANALYSIS

We have considered all of Appellant’s arguments and any evidence presented. We disagree with Appellant’s arguments, and we adopt as our own: (1) the findings and reasons set forth by the Examiner in the action from which this appeal is taken, and (2) the reasons and rebuttals set forth in the Answer in response to Appellant’s arguments. (Ans. 2–7). However, we highlight and address specific findings and arguments for emphasis in our analysis below.

*Rejection R1 of representative Claim 1*¹

Issue: Under 103, did the Examiner err by finding the cited references would have taught or suggested contested limitations [d], [e], and [g], within the meaning of claim 1?

Limitation [d]

Appellant contends Werndorfer’s “Meta Contact”, as depicted in Figures 6 and 7, does not teach or suggest limitation [d]: “*forming a group that is limited to the one or more entities identified from the match*”

¹ In the event of further prosecution, we leave it to the Examiner to consider whether at least claim 1, and associated dependent claims, should be rejected under 35 U.S.C. § 101. To the extent claim 1 may require some unspecified conventional computer hardware to implement the method (i.e., reciting an “*online communication service*”), the Supreme Court guides: “if a patent’s recitation of a computer amounts to a mere instruction to ‘implemen[t]’ an abstract idea ‘on . . . a computer,’ . . . that addition cannot impart patent eligibility.” *Alice Corp. v. CLS Bank International*, 134 S. Ct. 2347, 2358, (2014), (quoting *Mayo*, 132 S. Ct. at 1301). Although the Board is authorized to reject claims under 37 C.F.R. § 41.50(b), no inference should be drawn when the Board elects not to do so. *See* Manual of Patent Examining Procedure (MPEP) §1213.02.

recipient's contacts list who are currently online." (App. Br. 9–10; Reply Br. 2–3; claim 1).

The Examiner further explains the basis for the rejection in the "Response to Argument:"

Figs. 6 and 7 of Werndorfer happen to show "meta contacts", but the relied upon elements of Figs. 6 and 7 are the groups "Online Contacts" and "Offline Contacts" shown in bolded text in each of Figs. 6 and 7. The "Online Contacts" and "Offline Contacts" of Figs. 6 and 7 correspond to the claimed "limited groups".

(Ans. 2; claim 1, emphasis added).

In the Reply Brief (3–4), Appellant responds:

The mere **display** of the Online Contacts, for the purpose of showing how to form a Meta Contact, cannot be reasonably construed to teach "**forming** a group that is limited to the one or more entities identified from the match recipient's contacts list **who are currently online**," for the purpose of "comparing the at least one personal attribute of the match recipient's member profile to member profiles of entities **in the limited group** to identify at least one matching member from among the entities **in the limited group**," as recited in independent claim 1 (emphases added), and similarly recited in independent claims 30 and 77. Therefore, the assertion that Werndorfer's disclosure of **displaying** the Online Contacts for the purpose of showing how to form a Meta Contact, provides a teaching of the claimed "forming" for the purpose of the claimed "comparing," is incorrect and untenable.

However, the Supreme Court guides: "In determining whether the subject matter of a patent claim is obvious, neither the particular motivation nor the avowed purpose of the patentee controls. What matters is the objective reach of the claim. If the claim extends to what is obvious, it is invalid under § 103." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 419

(2007). Our reviewing court further guides it is *irrelevant* that the prior art and the present invention may have *different purposes*. See *Nat'l Steel Car, Ltd. v. Canadian Pac. Ry., Ltd.*, 357 F.3d 1319, 1339 (Fed. Cir. 2004) (“A finding that two inventions were designed to resolve different problems . . . is insufficient to demonstrate that one invention teaches away from another.”). It is sufficient that references *suggest* doing what an appellant did, although the appellant's particular *purpose* was different from that of the references. *In re Heck*, 699 F.2d 1331, 1333 (Fed. Cir. 1983) (citing *In re Gershon*, 372 F.2d 535, 539 (CCPA 1967)). “Obviousness is not to be determined on the basis of purpose alone.” *In re Graf*, 343 F.2d 774 (CCPA 1965).

This reasoning is applicable here. Because Appellant's supporting argument (Reply Br. 3–4) is grounded on the *erroneous premise* that the *purpose of the claimed invention and the prior art must be the same*, on this record, we are not persuaded the Examiner erred. Regarding Appellant's additional assertion the Examiner has relied on impermissible hindsight reconstruction (Reply Br. 4), see our further discussion, *infra*.

Limitation [e] – Combinability of the cited References

Referring to limitation [e], Appellant contends: “the Examiner has relied on impermissible hindsight to construct the asserted combination of Werndorfer's teaching of Meta Contacts for simplified account management with Work's teaching of ‘search[ing]. . . to look for matches. . .’” (App. Br. 10; *See also*, Reply Br. 3–4).

As cited by the Examiner (Final Act. 4–5), we observe Work describes a “Contacts/ContactProfiles” database that “stores profiles of the

user's contacts" (§72), and a "Searches" database for storing "prior search parameters, results, and user responses to results so that searches may be reused, modified, and improved" (§72). Work additionally discloses that users are able to "[c]onnect with more of the right people to foster new relationships." (§50). Work further describes: "The profile builder may also permit users to generally describe their 'relationship networks' in addition to adding specific contacts who are members of their relationship networks." (§80). Paragraph 81 of Work particularly describes:

As part of a relationship management section, users may undertake activities to manage this section, including importing or manually entering contact records, adding hyperlinks to connect to, import from and browse accessible parts of profiles created by their contacts, describing relationships to their contacts, viewing graphical displays of information concerning their contacts (including, perhaps, the relationships of contacts to one another), keeping notes on interactions with said contacts, and other relationship management activities.

(*See* Final Act. 4–5, i.e., the paragraphs of Work cited by the Examiner).

The Examiner proffers a rationale to combine the cited references:

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify [the] profile comparison and matching disclosure of Weiner in view of Work with the subgrouping teachings of Werndorfer in order to provide additional information to users regarding their matches and contacts and to better inform users [of] the status of their matches and contacts.

(Final Act. 5; *see also* Final Act. 6).

We are cognizant our reviewing courts have not established a bright line test for hindsight. However, the U.S. Supreme Court guides: "[a] factfinder should be aware, of course, of the distortion caused by hindsight

bias and must be cautious of arguments reliant upon ex post reasoning.” *KSR*, 550 U.S. at 421 (2007) (citing *Graham v. John Deere Co.*, 383 U.S. 1, 36 (1966)). The Supreme Court also qualified the issue of hindsight by stating: “[r]igid preventative rules that deny factfinders recourse to common sense, however, are neither necessary under our case law nor consistent with it.” (*Id.*)

Hindsight Balancing Test

We see the hindsight question before us essentially as a balancing test. We consider whether the Examiner's proffered combination of references is merely: (1) “the predictable use of prior art elements according to their established functions,” (*KSR*, 550 U.S. at 417), consistent with common sense; or, (2) would an artisan reasonably have combined the cited references in the manner proffered by the Examiner, *but for* having the benefit of Appellant’s claims and/or Specification to use as a guide?

After reviewing the respective teachings and suggestions of the cited references, we find the preponderance of evidence supports the first prong of the balancing test, because we find the Examiner’s proffered modification of Weiner (¶¶ 47–48, 61, 83, 85), with the teachings of Work (¶¶ 48, 50, 72, 80–81, 157, 159, 160, 168–170), and Werndorfer (Figs 6–7), and further with the teachings of Oliver (Col. 23, ll. 35-52; Col 5, ll. 45–67), would have merely produced a *predictable, expected result*.²

² “If the patentee wanted to deviate from the standard practice ... some teaching of how to depart from the common practice would not only be expected, but is required.” *Edios Display, LLC v. AU Optronics Corp.*, --- F.3d ----, 2015 WL 1035284 (Fed. Cir. 2015).

The Supreme Court guides: “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR*, 550 U.S. at 416. “If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability.” *Id.* at 417.

This reasoning is applicable here. Moreover, Appellant has not provided objective evidence of secondary considerations which “operates as a beneficial check on hindsight” to support his contentions. *Cheese Sys., Inc. v. Tetra Pak Cheese and Powder Systems, Inc.*, 725 F.3d 1341, 1352 (Fed. Cir. 2013).

Therefore, contrary to Appellant’s contentions (App. Br. 10, Reply Br. 3–4), we find the Examiner provided sufficient *articulated reasoning* with some *rational underpinning* to support the proffered combination of references, and the ultimate legal conclusion of obviousness. *See* Final Act. 6. For at least these reasons, we are not persuaded the Examiner erred in combining the Weiner, Work, Werndorfer and Oliver references under § 103.

Limitation [g]

Claim 1 recites, in pertinent part, limitation [g], which Appellant contends is not taught or suggested by the Examiner’s proffered reference to Oliver (App. Br. 10–11, Reply Br. 4–6):

[g] causing *an icon to be displayed* adjacent to the identifier of the matching member to the match recipient, *the icon indicating a matching personal attribute* shared by the matching member and the match recipient.

As an initial matter of claim construction, we conclude the recited “icon to be displayed” is directed to *non-functional descriptive material* (NFDM), i.e., informational content intended for *human perception*.³ (Claim 1, emphasis added). Moreover, we conclude the claim as a whole is directed to analyzing and performing various *data operations* which lead to the last recited step [g]: “*causing an icon to be displayed . . . the icon indicating a matching personal attribute shared by the matching member and the match recipient.*” (Claim 1; limitation [g], emphasis added).

The PTAB has provided guidance in decisions regarding claims that differ from the prior art based only on NFDM. *See Ex parte Nehls*, 88 USPQ2d 1883, 1889 (BPAI 2008) (precedential) (“[T]he nature of the information being manipulated does not lend patentability to an otherwise unpatentable computer-implemented product or process.”); *Ex parte Mathias*, 84 USPQ2d 1276, 1279 (BPAI 2005) (informative) (“[N]onfunctional descriptive material cannot lend patentability to an invention that would have otherwise been anticipated by the prior art.”), *aff’d*, 191 Fed. Appx. 959 (Fed. Cir. 2006) (Rule 36); *Ex parte Curry*, 84 USPQ2d 1272, 1274 (BPAI 2005) (informative) (“Nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious.”), *aff’d*, No. 06-1003 (Fed. Cir. June 12, 2006) (Rule 36).

Our concerns regarding NFDM are focused principally on the claims on appeal in which the arguments presented urging patentability merely

³ *See* MPEP 2111.05, 9th ed., Mar. 2014 (“[W]here the claim as a whole is directed conveying a message or meaning to a human reader independent of the intended computer system, and/or the computer-readable medium merely serves as a support for information or data, no functional relationship exists.”).

contest purported differences between the type or informational content of the claimed *data*, and do not substantively contest: (1) purported differences between the claimed *structure(s)* and the prior art *structure(s)*, for *apparatus* claims, and/or (2) purported differences between the *acts* or *steps* of the claimed *method*, and the corresponding *acts* or *steps* found by the Examiner in the prior art.

If the claimed contested *data elements* are positively recited: (1) as actually being used to change or affect a machine function (for apparatus claims), or (2) as actually being used to change or affect the manner in which a step or act is performed (for method or process claims), then such data elements are generally considered by the USPTO and PTAB to be *functional descriptive material* and are given full patentable weight.⁴

Assuming *arguendo* that our reviewing court may give full patentable weight to the (NFDM) *informational content* of the contested *displayed icon* (limitation [g]), we find the preponderance of evidence supports the Examiner's underlying factual findings and ultimate legal conclusion of obviousness. In particular, we find denoting matching users using a displayed icon (as taught by Oliver, col 23, ll. 51–52), would have taught or *suggested*: “an icon to be displayed adjacent to the identifier of the matching member to the match recipient . . . ,” as recited in claim 1. (*See* Final Act. 6, Ans. 4).

⁴ *See* MPEP § 2111.05 (9th Ed., Mar. 2014). In our analysis herein, we consider the extrinsic MPEP descriptions regarding NFDM as underlying subsidiary facts which inform our claim construction for all claims before us on appeal.

For the aforementioned reasons, on this record, we are not persuaded the Examiner erred regarding any of the contested limitations. Nor are we persuaded the Examiner erred by improperly combining the cited references. Accordingly, we sustain the Examiner's rejection R1 of representative claim 1, and rejection R1 of the associated grouped claims, which fall with claim 1. (*See Grouping of Claims, supra*).

Rejection R1 of Dependent Claims 14 and 43

Claim 14 recites:⁵

14. The method of claim 13 wherein *identifying an intermediary member* comprises:

[a] identifying an entity whose contact information is in the contacts list of the match recipient;

[b] determining whether contact information of the matching member is in a contacts list of the entity; and

[c] *designating the entity as the intermediary member when the matching member's contact information is in the contacts list of the entity.*

(Steps lettered and contested limitation [c] emphasized).

Appellant does not advance substantive arguments traversing the Examiner's specific findings regarding the *combination* of Work and Werndorfer, as relied upon for teaching or suggesting *designating the entity* as the *intermediary member*, as claimed. (*See* claims 14 and 43; *see also* App. Br. 12–13). Instead, Appellant points to descriptions in Work (¶26) and Werndorfer (¶¶43–44), and merely asserts the recited contested claim

⁵ Claim 43 recites commensurate limitations.

limitations are not taught by the cited references. (*Id.*). However, “[a] statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim.” *See* 37 C.F.R. § 41.37(c)(1)(iv)(2012). Therefore, on this record, we are not persuaded the Examiner erred. (*See* Final Act. 9, 16). Accordingly, we sustain rejection R1 of dependent claims 14 and 43.

Rejection R2 of Claims 8, 9, 37, and 38

Appellant advances no substantive arguments regarding dependent claims 8, 9, 37, and 38. Instead, Appellant merely contends: “Rouse does not cure the deficiencies of Weiner, Work, Werndorfer, and Olivier.” (App. Br. 14). However, we find no deficiencies regarding the base combination of Weiner, Work, Werndorfer, and Olivier, for the same reasons discussed above regarding claim 1.

Therefore, on this record, we are not persuaded the Examiner erred. Accordingly, we sustain rejection R2 of claims 8, 9, 37 and 38.

DECISION

We affirm the Examiner’s decision rejecting claims 1–14, 30–43, 69, 70, 75 and 77 under § 103.

No time for taking any action connected with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv). *See* 37 C.F.R. § 41.50(f).

AFFIRMED