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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JEFFREY ANDREW KANTER, ERIC FALLER,
PETER XIU-DENG, NICHOLAS HAGE SCHROCK, and
OLAOLUWA OKELOLA

Appeal 2016-007040¹
Application 13/307,500²
Technology Center 3600

Before HUBERT C. LORIN, NINA L. MEDLOCK, and
ROBERT J. SILVERMAN, *Administrative Patent Judges*.

MEDLOCK, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner’s final rejection of claims 1, 3–7, 9–12, 14–18, 20, and 22. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ Our decision references Appellants’ Appeal Brief (“App. Br.,” filed October 29, 2015) and Reply Brief (“Reply Br.,” filed July 6, 2016), and the Examiner’s Answer (“Ans.,” mailed May 6, 2016) and Final Office Action (“Final Act.,” mailed January 8, 2015).

² Appellants identify Facebook, Inc. as the real party in interest. App. Br. 1.

CLAIMED INVENTION

Appellants' claimed invention "relate[s] generally to social networking systems, and in particular to changing the identity of a user in a social networking system" (Spec. ¶ 1).

Claims 1 and 12 are the independent claims on appeal. Claim 1, reproduced below with bracketed notations added, is illustrative of the claimed subject matter:

1. A computer-implemented method comprising:

[(a)] initiating a login session for a user with a social networking system, the user comprising a representation in the social networking system of a person, the social networking system storing a social network that includes a plurality of users and a plurality of non-user pages, each of the plurality of non-user pages administered by at least one of the plurality of users;

[(b)] sending to a user device for display to the user, social information personalized for the user that comprises a description of one or more social interactions performed by a first set of entities that are connected to the user in the social networking system;

[(c)] responsive to receiving a request from the user via the login session to change identities within the social networking system from the user to a non-user page administered by the user, changing, by a processor of the social networking system while staying within the login session, an identity within the social networking system from the user to the non-user page, the non-user page comprising a representation in the social networking system of an entity other than a person;

[(d)] identifying based on the request to change identities from the user to the non-user page, social information personalized for the non-user page that comprises a description of one or more social interactions performed by a second set of entities with content posted by one or more administrators of the non-user page to the social networking system as representatives of the entity, the second set of entities connected to the non-user

page in the social networking system, the second set of entities different than the first set of entities;

[(e)] sending, to the user device for display to the user, the identified social information personalized for the non-user page;

[(f)] receiving from the user a request to perform a social interaction within the social networking system; and

[(g)] performing the social interaction within the social networking system with an indication that the social interaction was performed by the non-user page.

REJECTIONS

Claims 1, 3–7, 9–12, 14–18, 20, and 22 are rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter.

Claims 1, 3, 6, 7, 12, 14, 17, 18, and 22 are rejected under 35 U.S.C. § 103(a) as unpatentable over the public activities of Hootsuite, i.e., Kimberly Yow, “Facebook Fan Pages Now Integrated With Hootsuite!” available at <http://www.howtousefacebookforbusiness.com/2009/12/hootsuite-adds-facebook-fan-page-integration/> (last visited Feb. 6, 2013) (“Yow”), “SwitchTip: Manage Multiple Facebook Pages with Hootsuite,” available at <http://web.archive.org/web/20100925040337/http://freelanceswitch.com/freebies/add-your-facebook-page-to-hootsuite> (last visited Feb. 6, 2013) (“SwitchTip”), and Hull et al. (US 2011/0289574 A1, pub. Nov. 24, 2011) (“Hull”).

Claims 4 and 15 are rejected under 35 U.S.C. § 103(a) as unpatentable over Yow, SwitchTip, Hull, and Leonardo Von Navorski, “How to Change a Business Profile on Facebook,” available at http://web.archive.org/web/20101223155209/http://www.ehow.com/how_7539600_change-business-profile-on-facebook (last visited Jan. 31, 2013) (“Navorski”).

Claims 5, 9–11, 16, and 20 rejected under 35 U.S.C. § 103(a) as unpatentable over Yow, SwitchTip, Hull, and Jacob Clifton, “How to Make a Fan Page on Facebook,” available at <https://computer.howstuffworks.com/internet/tips/how-to-make-fan-page-on-facebook.htm> (last visited Jan. 31, 2013) (“Clifton”).

ANALYSIS

Non-Statutory Subject Matter

Under 35 U.S.C. § 101, an invention is patent-eligible if it claims a “new and useful process, machine, manufacture, or composition of matter.” 35 U.S.C. § 101. The Supreme Court, however, has long interpreted § 101 to include an implicit exception: “[l]aws of nature, natural phenomena, and abstract ideas” are not patentable. *See, e.g., Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2354 (2014).

The Supreme Court, in *Alice*, reiterated the two-step framework previously set forth in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 566 U.S. 66 (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 Corp.*, 134 S. Ct. at 2355. The first step in that analysis is to “determine whether the claims at issue are directed to one of those patent-ineligible concepts.” *Id.* If the claims are not directed to a patent-ineligible concept, e.g., an abstract idea, the inquiry ends. Otherwise, the inquiry proceeds to the second step where the elements of the claims are considered “individually and ‘as an ordered combination’” to determine whether there are additional elements that

“transform the nature of the claim’ into a patent-eligible application.” *Id.* (quoting *Mayo*, 566 U.S. at 79, 78).

The Court acknowledged in *Mayo*, that “all inventions at some level embody, use, reflect, rest upon, or apply laws of nature, natural phenomena, or abstract ideas.” *Mayo*, 566 U.S. at 71. Therefore, the Federal Circuit has instructed that claims are to be considered in their entirety to determine “whether their character as a whole is directed to excluded subject matter.” *McRO, Inc. v. Bandai Namco Games Am., Inc.*, 837 F.3d 1299, 1312 (Fed. Cir. 2016) (quoting *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1346 (Fed. Cir. 2015)).

Here, in rejecting the pending claims under 35 U.S.C. § 101, the Examiner determined that that claims are directed to “changing identities in a social networking system,” which the Examiner determined is “a fundamental manipulation of data and is simply changing the way data is [sic] displayed to a user” and, therefore, an abstract idea (Final Act. 2). The Examiner also determined that the claims do not recite limitations that are “significantly more” than the abstract idea because the claims do not recite “an improvement to another technology or technical field, an improvement to the functioning of the computer itself, or meaningful limitations beyond generally linking the use of an abstract idea to a particular technological environment” (*id.*). Instead, according to the Examiner, “[t]he limitations are merely instructions to implement the abstract idea on a computer and require no more than a generic computer to perform generic computer functions that are well-understood, routine and conventional activities previously known to the industry” (*id.*).

Citing the USPTO's July 2015 Update: Subject Matter Eligibility, Appellants first charge that the § 101 rejection cannot be sustained because the Examiner has failed to meet "the examiner's burden under 35 U.S.C. § 132 to provide notice and reasons for the rejection" (App. Br. 11). In fact, the Examiner provided a reasoned analysis that identifies the judicial exception recited in the claims, i.e., an abstract idea, and explains why it is considered a judicial exception, and also explains why the additional elements in the claim do not amount to significantly more than the judicial exception (Final Act. 2). In doing so, we find that the Examiner set forth a proper rejection under § 101 such that the burden shifted to Appellants to demonstrate that the claims are patent-eligible. Appellants cannot reasonably maintain that the bases for the rejection were not understood. Indeed, Appellants' understanding is clearly manifested by their response, as set forth in the briefs.

We also are not persuaded of Examiner error to the extent that Appellants argue that the claims are patent-eligible because, when viewed as a whole, the claims "do not tie up all possible ways of changing identities" (App. Br. 12). There is no dispute that the Supreme Court has described "the concern that drives [the exclusion of abstract ideas from patent eligible subject matter] as one of pre-emption." *Alice Corp.*, 134 S. Ct. at 2354. But characterizing preemption as a driving concern for patent eligibility is not the same as characterizing preemption as the sole test for patent eligibility. "The Supreme Court has made clear that the principle of preemption is the basis for the judicial exceptions to patentability" and "[f]or this reason, questions on preemption are inherent in and resolved by the § 101 analysis." *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir.

2015) (citing *Alice*, 134 S. Ct. at 2354). “[P]reemption may signal patent ineligible subject matter, [but] the absence of complete preemption does not demonstrate patent eligibility.” *Id.*

Addressing step two of the *Mayo/Alice* framework, Appellants argue that even if the claims are directed to an abstract idea, the claims are, nonetheless, patent-eligible because the claims recite additional elements that amount to significantly more than the judicial exception (App. Br. 12). Appellants note that claim 1, for example, requires initiating a login session for a user, sending social information personalized for the user, staying within the login session during changing of identities to the non-user page, identifying social information personalized for the non-user page, and performing a social interaction as the non-user page (*id.* at 13). And Appellants argue that “[e]ach of these steps alone and when taken as a whole provide[s] more than the proposed abstract idea of ‘changing identifies in a social networking system’” (*id.*). Yet, we are not persuaded that these steps are additional limitations to be considered under step two of the *Mayo/Alice* test, as opposed to being merely part of the abstract idea itself. *See Mayo*, 566 U.S. at 72–73 (requiring that “a process that focuses upon the use of a natural law also contain *other* elements or a combination of elements, sometimes referred to as an ‘inventive concept,’ sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the natural law itself” (emphasis added) (internal citation omitted)).

We also cannot agree with Appellants that the present claims are analogous to the claims at issue in *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245 (Fed. Cir. 2014). The claims at issue in *DDR Holdings* were directed to retaining website visitors, and in particular to a system that

modified the conventional web browsing experience by directing a user of a host website who clicks an advertisement to a “store within a store” on the host website, rather than to the advertiser’s third-party website. *DDR Holdings*, 773 F.3d at 1257–58. The court determined “the claims address a business challenge (retaining website visitors) [that] is a challenge particular to the Internet.” *Id.* at 1257. The court also determined that the invention was “necessarily rooted in computer technology in order to overcome a problem specifically arising in the realm of computer networks,” and that the claimed invention did not simply use computers to serve a conventional business purpose. *Id.* Rather, there was a change to the routine, conventional functioning of Internet hyperlink protocol. *Id.*

Appellants argue that the present claims, like those in *DDR Holdings*, overcome a problem (i.e., allowing a user to change identities within a social networking system while staying within the same login session) only encountered with computer technology and online transactions (App. Br. 13–14; *see also* Reply Br. 3–4). Yet, we can find no parallel between the present claims and those in *DDR Holdings*.

Changing computing sessions by logging out and then logging back into a computer system may well be inconvenient. But we are not persuaded that this is a technical problem arising in the realm of computer networks in the same manner as the claims in *DDR Holdings*.

The court, moreover, cautioned in *DDR Holdings* that “not all claims purporting to address Internet-centric challenges are eligible for patent.” *DDR Holdings*, 773 F.3d at 1258. Thus, in *Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709 (Fed. Cir. 2014), although the patentee argued that its claims were “directed to a specific method of advertising and content distribution

that was previously unknown and never employed on the Internet before” (772 F.3d at 714), the court found that this alone could not render its claims patent-eligible where the claims merely recited the abstract idea of “offering media content in exchange for viewing an advertisement,” along with “routine additional steps such as updating an activity log, requiring a request from the consumer to view the ad, restrictions on public access, and use of the Internet.” *Id.* at 715–16.

Similarly here, we find that the invocation of the Internet is not sufficient to transform Appellants’ otherwise patent-ineligible abstract idea into patent-eligible subject matter. We find, as did the Examiner, that the claims are directed to the abstract idea of “changing identities,” and involve no more than changing the data that are displayed to a user. We are not persuaded that displaying particular data to a user depending on the identity of that user is a new problem or that it is unique to the Internet. Narrowing the abstract idea of “changing identities” to implementation in a social networking system, moreover, merely limits the use of the abstract idea to a particular technological environment, which the Court made clear in *Alice* is insufficient to transform an otherwise patent-ineligible abstract idea into a patent-eligible subject matter. *See Alice Corp.*, 134 S. Ct. at 2358.

We are not persuaded, on the present record, that the Examiner erred in rejecting claims 1, 3–7, 9–12, 14–18, 20, and 22 under 35 U.S.C. § 101. Therefore, we sustain the Examiner’s rejection.³

³ We need not, and do not reach the Examiner’s new ground of rejection under 35 U.S.C. § 101, entered in the Examiner’s Answer (*see* Ans. 3–5).

Obviousness

Independent Claims 1 and 12 and Dependent Claims 3, 6, 7, 14, 17, 18, and 22

We are persuaded by Appellants' argument that the Examiner erred in rejecting independent claims 1 and 12 under 35 U.S.C. § 103(a) because Hull, on which the Examiner relies, does not disclose or suggest

identifying based on the request to change identities from the user to the non-user page, social information personalized for the non-user page that comprises a description of one or more social interactions performed by a second set of entities with content posted by one or more administrators of the non-user page and "sending, to the user device for display to the user, the identified social information," as recited in claim 1, and similarly recited in claim 12 (App. Br. 5–8).

Hull is directed to a method and system for seeding contacts for a user's online social network (Hull ¶ 2), and discloses that, in one embodiment of the social networking system, several users, e.g., persons within one household or within one family, can be encompassed under a single master ID; each member of the group also can have an alias under the single master ID, which allows the group to utilize a single master ID while retaining individuality between the individual users (*id.* ¶ 86). Hull discloses that within the social network, an area is provided for users to receive and send messages to other users in their network (*id.* ¶ 122) and also discloses the concept of personas, i.e., that viewing of the social network user's personal information can be customized based on the user's relationship with the prospective viewer (*id.* ¶¶ 75, 84, 135–45). However, we agree with Appellants that there is nothing in the cited portion of Hull that discloses or suggests enabling a user to change between aliases and

more specifically that, based on a request to change identities from a user to a non-user page, social information personalized for the non-user page is identified and sent for display to the user, as called for in claims 1 and 12 (App. Br. 7).

Responding to Appellants' argument in the Answer, the Examiner states that the Yow reference is relied on to teach the changing of identities from a specific user to a non-user page (Ans. 5), and explains that the argued limitations have been broadly interpreted as "the custom tailoring of the social networking activities based on a selected persona or alias (the changing of identities as taught by Yow), as described by Hull" (*id.* at 5–6 (citing Hull ¶ 22)). Yet, as Appellants observe, in paragraph 22, Hull merely discloses a social networking area where a user can receive and send messages; there is no disclosure or suggestion in that paragraph that the messages displayed to the user are tailored according to a selected persona or alias (Reply Br. 6).

We note that Hull discloses the concept of personas in paragraph 75. But, that disclosure concerns a user's ability to limit or customize the viewing of his or her own personal information by other users, e.g., the user can set up one view for his/her personal contacts and a different view for his/her business associates (Hull ¶ 75). It does not concern what information is displayed to the user based on the user changing identities, as called for in the claims.

In view of the foregoing, we do not sustain the Examiner's rejection of independent claims 1 and 12 under 35 U.S.C. § 103(a). For the same reasons, we also do not sustain the Examiner's rejection of dependent claims 3, 6, 7, 14, 17, 18, and 22.

Dependent Claims 4, 5, 9–11, 15, 16, and 20

Claims 4, 5, and 9–11 and claims 15, 16, and 20 depend, directly or indirectly, from claims 1 and 12, respectively. The rejections of these dependent claims do not cure the deficiency in the rejection of independent claims 1 and 12. Therefore, we do not sustain the Examiner's rejections of claims 4, 5, 9–11, 15, 16, and 20 under 35 U.S.C. § 103(a) for the same reasons set forth above with respect to the independent claims.

DECISION

The Examiner's rejection of claims 1, 3–7, 9–12, 14–18, 20, and 22 under 35 U.S.C. § 101 is affirmed.

The Examiner's rejections of claims 1, 3–7, 9–12, 14–18, 20, and 22 under 35 U.S.C. § 103(a) are reversed.

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).

AFFIRMED