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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte PASCAL BOUDALIER¹

Appeal 2016-008599
Application 12/597,290
Technology Center 3600

Before JOHN A. JEFFERY, LARRY J. HUME, and SCOTT B. HOWARD,
Administrative Patent Judges.

HUME, *Administrative Patent Judge.*

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) of the Final Rejection of claims 1, 3, 5–10, 12, 13, 15, 16, and 18–22, which are all claims pending in the application. Appellant has canceled claims 2, 4, 11, 14, and 17. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ According to Appellant, the real party in interest is Hewlett Packard Enterprise Development LP. Br. 1.

STATEMENT OF THE CASE²

The Invention

Appellant's disclosed embodiments and claimed invention "relate to obtaining feedback for an accessed information item." Original Specification ("Orig. Spec.," filed Oct. 23, 2009) 1, ll. 5–6 ("FIELD OF THE INVENTION").

Exemplary Claims

Claims 1 and 6, reproduced below, are representative of the subject matter on appeal (*emphases* added to contested limitations):

1. A method comprising:

determining that a user has accessed an information item on a web server, said information item being one of a review and a comment published on said web server;

associating said user to said information item;

providing an accessed-information-delayed-feedback-prompt that is designed to obtain feedback on said accessed information item at a later time that is dependent upon said accessed information item, including determining a predetermined context at which said user is most likely to provide said feedback when prompted, based on a user profile of historical information regarding said user including preferences of said user, said predetermined context including a time of day at which said user is most likely to provide said feedback when prompted;

² Our Decision relies upon Appellant's Appeal Brief ("Br.," filed Dec. 1, 2015); Examiner's Answer ("Ans.," mailed May 18, 2016); Final Office Action ("Final Act.," mailed July 1, 2015); and the Substitute Specification ("Spec.," filed Oct. 23, 2009). We note Appellant did not file a Reply Brief in response to the factual findings and legal conclusions in the Examiner's Answer.

at said later time, provisioning, to said user, said accessed-information-delayed-feedback-prompt, *including matching a current context of said user to said predetermined context;*

obtaining feedback in response to said provisioning of said accessed-information-delayed-feedback-prompt that is designed to obtain said obtained feedback on said accessed information item at said later time that is dependent upon said accessed information item; and

publishing said obtained feedback to said information item on said web server to make said obtained feedback available to other users.

6. A non-transitory computer usable storage medium comprising instructions that when executed provide a method for obtaining feedback for an accessed information item, said method comprising:

determine that a user has access an information item on a web server, said information item being one of a review and a comment published on said web server;

associate said user to said information item;

assign a first context to said accessed information item, said first context being that at which said user is most likely to provide said feedback when prompted, said first context including a time of day at which said user is most likely to provide said feedback when prompted;

monitor a current second context of said user;

determine a later time by identifying a time when said current second context matches said assigned first context;

provide an accessed-information-delayed-feedback-prompt that is designed to obtain feedback on said accessed information item at said later time that is dependent upon said accessed information item;

at said later time, provision, to said user, said accessed-information-delayed-feedback-prompt;

obtain feedback in response to said provisioning of said accessed-information-delayed-feedback-prompt that is designed to obtain said obtained feedback on said accessed information item at said later time that is dependent upon said accessed information item; and

publishing said obtained feedback to said information item on said web server to make said obtained feedback available to other users,

wherein said associate said assign, said identify, said monitor, said determine, said provide, said provision and said obtain are performed by one or more processing circuitries.

Prior Art

The Examiner relies upon the following prior art as evidence in rejecting the claims on appeal:

Falk et al. ("Falk")	US 2001/0037206 A1	Nov. 1, 2001
Potenza	US 2002/0173934 A1	Nov. 21, 2002
Gross	US 2006/0155575 A1	July 13, 2006
Simons et al. ("Simons")	US 2007/0027830 A1	Feb. 1, 2007
Farkas et al. ("Farkas")	US 2008/0046320 A1	Feb. 21, 2008
Abbott et al. ("Abbott")	US 2009/0282030 A1	Nov. 12, 2009

Rejections on Appeal

R1. Claims 1, 3, 5–10, 12, 13, 15, 16, and 18–22 stand rejected under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter. Final Act. 4.³

R2. Claims 1, 3, 5–10, 12, 13, 15, 16, and 18–22 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Final Act. 8.

R3. Claims 1, 3–5, 7–9, 11, 12, 15, 16, 21, and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Simons, Falk, Gross, and Farkas. Final Act. 13.

R4. Claims 6, 10, and 18–20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Simons, Falk, Gross, Farkas, and Potenza. Final Act. 26.

R5. Claims 3, 9, and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Simons, Falk, Gross, Farkas, and Abbott. Final Act. 29.

CLAIM GROUPING

Based on Appellant's arguments (Br. 5–17), we decide the appeal of patent-ineligible subject matter Rejection R1 of claims 1, 3, 5–10, 12, 13, 15, 16, and 18–22 on the basis of representative claim 1; we decide the appeal of obviousness Rejection R3 of claims 1, 3–5, 7–9, 11, 12, 15, 16, 21,

³ The Examiner states Rejection R1 is for non-statutory subject matter under § 101. Final Act. 4. We note, however, a more accurate characterization of the rejection under § 101 in this Appeal is for patent-ineligibility, as the claims are directed to a judicial exception to the otherwise statutory classes of inventions.

and 22 on the basis of representative claim 1; and we decide the appeal of obviousness Rejection R4 of claims 6, 10, and 18–20 on the basis of representative claim 6. We decide indefiniteness Rejection R2 of claims 1, 3, 5–10, 12, 13, 15, 16, and 18–22, *infra*.

Remaining claims 3, 9, and 18 in obviousness Rejection R5, not argued separately, stand or fall with the respective independent claim from which they depend.⁴

ISSUES AND ANALYSIS

In reaching this decision, we consider all evidence presented and all arguments actually made by Appellant. We do not consider arguments Appellant could have made but chose not to make in the Briefs, and we deem any such arguments waived. 37 C.F.R. § 41.37(c)(1)(iv).

Based upon our review of the record, we find a preponderance of the evidence supports particular arguments advanced by Appellant with respect to indefiniteness Rejection R2 of claims 1, 3, 5–10, 12, 15, 16, and 18–22, and obviousness Rejections R3–R5 of claims 1, 3–10, 11, 12, 15, 16, and 18–22, for the specific reasons discussed below.⁵

However, we disagree with Appellant's arguments with respect to patent-ineligible subject matter Rejection R1 of claims 1, 3, 5–10, 12, 13,

⁴ "Notwithstanding any other provision of this paragraph, the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately." 37 C.F.R. § 41.37(c)(1)(iv). In addition, when Appellant does not separately argue the patentability of dependent claims, the claims stand or fall with the claims from which they depend. *In re King*, 801 F.2d 1324, 1325 (Fed. Cir. 1986).

⁵ We note indefiniteness Rejection R2 of dependent claim 13 is affirmed.

15, 16, and 18–22 and, unless otherwise noted, with respect to Rejection R1, we incorporate by reference herein and 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 Examiner's Answer in response to Appellant's arguments.

We highlight and address specific findings and arguments regarding claims 1 and 6 for emphasis as follows.

1. § 101 Rejection R1 of Claims 1, 3, 5–10, 12, 13, 15, 16, and 18–22

Issue 1

Appellant argues (Br. 5–9) the Examiner's rejection of claim 1 under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter is in error. These contentions present us with the following issue:

Did the Examiner err in concluding claim 1 is drawn to a judicial exception, i.e, an abstract idea, without significantly more, sufficient to transform the abstract idea into a patent-eligible invention?

Analysis

Alice Framework

Section 101 provides that anyone who "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. 35 U.S.C. § 101. The Supreme Court has repeatedly emphasized that patent protection should not extend to claims that monopolize "the basic tools of scientific and technological work." *Gottschalk v. Benson*, 409 U.S. 63, 67 (1972); *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 71 (2012);

Alice Corp. Pty. Ltd. v. CLS Bank Int'l, 134 S. Ct. 2347, 2354 (2014).

Accordingly, laws of nature, natural phenomena, and abstract ideas are not patent-eligible subject matter.

The Supreme Court's two-part *Mayo/Alice* framework guides us in distinguishing between patent claims that impermissibly claim the "building blocks of human ingenuity" and those that "integrate the building blocks into something more." *Alice*, 134 S. Ct. at 2354 (internal quotation marks, citation, and bracketing omitted). First, we "determine whether the claims at issue are directed to . . . [a] patent-ineligible concept[]." *Id.* at 2355. If so, we "examine the elements of the claim to determine whether it contains an 'inventive concept' sufficient to 'transform' the claimed abstract idea into a patent-eligible application." *Id.* at 2357 (quoting *Mayo*, 566 U.S. at 72, 79). While the two steps of the *Alice* framework are related, the "Supreme Court's formulation makes clear that the first-stage filter is a meaningful one, sometimes ending the § 101 inquiry." *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016). We note the Supreme Court "has not established a definitive rule to determine what constitutes an 'abstract idea'" for the purposes of step one. *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1334 (Fed. Cir. 2016) (citing *Alice*, 134 S. Ct at 2357).

However, our reviewing court has held claims ineligible as directed to an abstract idea when they merely collect electronic information, display information, or embody mental processes that could be performed by humans. *Elec. Power Grp.*, 830 F.3d at 1353–54 (collecting cases). At the same time, "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. Abstract ideas may include, but are not limited to, fundamental

economic practices, methods of organizing human activities, an idea of itself, and mathematical formulas or relationships. *Alice*, 134 S. Ct. at 2355–57. Under this guidance, we must, therefore, ensure at step one that we articulate what the claims are directed to with enough specificity to ensure the step one inquiry is meaningful. *Id.* at 2354 ("[W]e tread carefully in construing this exclusionary principle lest it swallow all of patent law").

Under the "abstract idea" step, we must evaluate "the 'focus of the claimed advance over the prior art' to determine if the claim's 'character as a whole' is directed to excluded subject matter." *Affinity Labs of Texas, LLC v. DIRECTV, LLC*, 838 F.3d 1253, 1257–58 (Fed. Cir. 2016) (internal citation omitted). If the claims are not directed to a patent-ineligible concept, the inquiry ends. *See Visual Memory LLC v. NVIDIA Corp.*, 867 F.3d 1253, 1262 (Fed. Cir. 2017). If the concept is directed to a patent-ineligible concept, we proceed to the "inventive concept" step. For that second step, we must "look with more specificity at what the claim elements add, in order to determine 'whether they identify an "inventive concept" in the application of the ineligible subject matter' to which the claim is directed." *Affinity Labs*, 838 F.3d at 1258 (quoting *Elec. Power Grp.*, 830 F.3d at 1353).

Alice Step 1 — Abstract Idea

Our reviewing court has held claims ineligible as being directed to an abstract idea when they merely collect electronic information, display information, or embody mental processes that could be performed by humans. *Elec. Power Grp.*, 830 F.3d at 1353–54 (collecting cases). At the same time, "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. Under this guidance, we must, therefore, ensure at step one that we articulate what the claims are directed to with enough specificity to ensure the step one inquiry is meaningful. *Alice*, 134 S. Ct. at 2354 ("[W]e tread carefully in construing this exclusionary principle lest it swallow all of patent law").

Appellant contends:

[T]he Examiner's rejection fails . . . [the first step of the *Mayo/Alice*] test. The Examiner has not decided exactly what the abstract idea the claim language is directed to, and further provides no explanation whatsoever as to why the claim language is directed to an abstract idea. The Examiner simply alleges that the idea is "obtaining user feedback for accessed information" . . . is an abstract idea because it is a "fundamental economic practice," or in the alternative because it is a "method of organizing human activities".

Br. 5 (citing Final Act. 4). In addition, Appellant contends, "the Examiner provides *no* reasoning whatsoever as to how obtaining user feedback for accessed information is an abstract idea." Br. 6.

Under the "abstract idea" step, we must evaluate "the 'focus of the claimed advance over the prior art' to determine if the claim's 'character as a whole' is directed to excluded subject matter." *Affinity Labs*, 838 F.3d at 1257 (internal citation omitted).

Turning to the claimed invention, claim 1 recites:

A method comprising:
determining that a user has accessed an information item
. . . [that is] one of a review and a comment . . . ;
associating said user to said information item;

providing [a] . . . feedback-prompt . . . to obtain feedback on said accessed information item at a later time . . . , including determining a predetermined context at which said user is most likely to provide said feedback when prompted . . . said predetermined context including a time of day at which said user is most likely to provide said feedback when prompted;

at said later time, provisioning, to said user, said accessed-information-delayed-feedback-prompt . . . ;

obtaining feedback in response to said provisioning of said accessed-information-delayed-feedback-prompt . . . ; and

publishing said obtained feedback. . . .

Claim 1.

In response to Appellant's contentions, the Examiner concludes the appealed claims are directed to a judicial exception, i.e., an abstract idea without significantly more because "[c]laim 1 recites an abstract idea of obtaining feedback based on [an] accessed information item." Ans. 5. The claim includes the steps of "determining that a user has accessed an information [item], associating the user to said information item, providing a prompt, obtaining feedback from the user, and publishing the obtained feedback," and such concepts of obtaining feedback have been identified by the courts as abstract ideas, e.g., collecting information about an activity and comparing collected information with stored information. *Id.*; *see also id. at* 6.

The Examiner determined the claimed invention "appears to include the steps of the combination of the *SmartGene* and *Cyberfone* cases wherein

the option is to send a prompt at a later time to the user for collecting feedback at the user's convenience."⁶ Ans. 6 (emphases added).

Under step one, we agree with the Examiner that the inventions claimed in each of independent claims 1, 6, and 7 are directed to an abstract idea, i.e., methods of organizing human activity, including collecting information about an activity and comparing collected information with stored information. *See* Ans. 5–6.

As the Specification describes,

[a]ccording to various embodiments of the invention there is provided a method comprising: associating a user and an information item accessed by the user; and delaying provision to the user of a prompt to provide feedback on the accessed information item until a later time that is dependent upon the accessed information item.

Spec. ¶ 15.⁷

We find this type of activity, i.e., obtaining feedback from a consumer/customer at a later time, includes longstanding conduct that existed well before the advent of computers and the Internet, and could be carried out by a human with pen and paper, e.g., using a paper reminder or "tickler." *See CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1375 (Fed. Cir. 2011) ("That purely mental processes can be unpatentable,

⁶ *See SmartGene, Inc. v. Advanced Biological Labs., SA*, 555 Fed.Appx. 950 (Fed. Cir. 2014) (non-precedential); *Cyberfone Sys., LLC v. CNN Interactive Grp., Inc.*, 558 Fed.Appx. 988 (Fed. Cir. 2014) (non-precedential).

⁷ *See also* Spec. "**Abstract**"; "[a] method comprising: associating a user and an information item accessed by the user; and delaying provision to the user of a prompt to provide feedback on the accessed information item until a later time that is dependent upon the accessed information item."

even when performed by a computer, was precisely the holding of the Supreme Court in *Gottschalk v. Benson*").⁸

Our reviewing court has previously held other patent claims ineligible for reciting similar abstract concepts. For example, while the Supreme Court has enhanced the § 101 analysis since *CyberSource* in cases like *Mayo* and *Alice*, they continue to "treat[] analyzing information by steps people go through in their minds, or by mathematical algorithms, without more, as essentially mental processes within the abstract-idea category." *Synopsys, Inc. v. Mentor Graphics Corp.*, 839 F.3d 1138, 1146–47 (Fed. Cir. 2016) (alteration in original) (quoting *Elec. Power Grp.*, 830 F.3d at 1354).

In this regard, the claims are similar to claims our reviewing court has found patent ineligible in *Electric Power Group*., 830 F.3d at 1353–54 (collecting information and "analyzing information by steps people go through in their minds, or by mathematical algorithms, without more, . . . [are] essentially mental processes within the abstract-idea category").

Therefore, in agreement with the Examiner, we conclude claim 1 involves nothing more than identifying, collecting, storing, comparing, and generating data, without any particular inventive technology — an abstract idea. *See Elec. Power Grp.*, 830 F.3d at 1354. We further refer to *Content Extraction*, where the Federal Circuit has provided additional guidance on the issue of statutory subject matter by holding claims to collecting data, recognizing certain data within the collected data set, and storing that

⁸ *CyberSource* further guides that "a method that can be performed by human thought alone is merely an abstract idea and is not patent-eligible under § 101." *CyberSource*, 654 F.3d at 1373.

recognized data in memory were directed to an abstract idea and therefore unpatentable under § 101. *Content Extraction & Transmission LLC v. Wells Fargo Bank, N.A.*, 776 F.3d 1343 (Fed. Cir. 2014).

Accordingly, on this record, and under step one of *Alice*, we agree with the Examiner's conclusion the claims are directed to an abstract idea.

Alice Step 2 — Inventive Concept

If the claims are directed to a patent-ineligible concept, as we conclude above, we proceed to the "inventive concept" step. For that step we must "look with more specificity at what the claim elements add, in order to determine 'whether they identify an "inventive concept" in the application of the ineligible subject matter' to which the claim is directed." *Affinity Labs*, 838 F.3d at 1258 (quoting *Elec. Power Grp.*, 830 F.3d at 1353).

In applying step two of the *Alice* analysis, our reviewing court guides we must "determine whether the claims do significantly more than simply describe . . . [the] abstract method" and, thus, transform the abstract idea into patentable subject matter. *Ulramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 715 (Fed. Cir. 2014). We look to see whether there are any "additional features" in the claims that constitute an "inventive concept," thereby rendering the claims eligible for patenting even if they are directed to an abstract idea. *Alice*, 134 S. Ct. at 2357. Those "additional features" must be more than "well-understood, routine, conventional activity." *Mayo*, 566 U.S. at 79.

In arguing under Step 2 of the *Alice* analysis, Appellant alleges the claims are directed to statutory subject matter because they address a

business challenge particular to the Internet and are "rooted in computer technology to overcome a problem particular to computer networks." Br. 7.

Evaluating representative claim 1 under Step 2, we agree with the Examiner that it lacks an inventive concept that transforms the abstract idea of identifying, collecting, storing, comparing, and generating data, i.e., managing user feedback, into a patent-eligible application of that abstract idea. *See* Ans. 7–8.⁹

We agree with the Examiner because, as in *Alice*, we find the recitation of managing user feedback using "a web server" (claim 1); "a non-

⁹ The Examiner concludes:

[T]he method claims simply recite the concept of obtaining user feedback for accessed information, as performed by a generic computer (see ¶¶ [0036-0038]) above. As shown in the specification, and ¶¶ [0012-0083], 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 managing a business, by various data processing mechanism using some unspecified, generic computer.

As for the use of a system, as shown in Fig. 1, to carry out the steps (a)-(f) above, it does not impose meaningful limits on the claims. Specifically, the storage device merely stores the data, and the computer system just performs insignificant, conventional, and routine steps (e.g., store, acquire, extract, attach, identify, and identify) these pre- and post-solution activities do not impose meaningful limits on the scope of the claims and are not integral to the invention as a whole.

Ans. 5–6. We note Appellant does not rebut the Examiner's findings and conclusions by filing a Reply Brief.

transitory computer usable medium," "a web server," and "one or more processing circuitries" (claim 6); or "a web server," "memory," and "processing circuitry" (claim 7) are simply not enough to transform the patent-ineligible abstract idea here into a patent-eligible invention. *See Alice*, 134 S. Ct. at 2357 ("[C]laims, which merely require generic computer implementation, fail to transform [an] abstract idea into a patent-eligible invention"). We conclude that providing a computer-based prompt to the customer does not provide "significantly more" as suggested by the Step 2 *Alice* analysis, and particularly does not improve the underlying computer/network technology.¹⁰

¹⁰ As evidence of the conventional nature of the claimed network components and processes, we highlight Appellant's Specification, i.e.,

[t]he processing circuitry 12 may be implemented using any suitable combination of hardware, firmware and software. In the example illustrated, the processing circuitry is one or more processors of a computer that reads a computer program 18 from the memory 14. In other implementations, the processing circuitry 12 may be provided by hardware, for example, an application specific integrated circuit.

(Spec. ¶ 28); [t]he content server 6 may be a web-server" (Spec. ¶ 25); and

[f]igure 2 schematically illustrates one of various potential implementations of the system 8. The illustrated system 8 comprises processing circuitry 12; an input/output interface 16 and a memory 14 configured to store a computer program 18, one or more data structures 19 associating one or more users and one or more information items and one or more user profiles.

Spec. ¶ 27.

Accordingly, based upon the analysis above, on this record, we are not persuaded of error in the Examiner's conclusion that the appealed claims are directed to patent-ineligible subject matter. Therefore, we sustain the Examiner's § 101 rejection of independent claim 1, and grouped claims 3, 5–10, 12, 13, 15, 16, and 18–22, which fall therewith. *See Claim Grouping, supra.*

2. § 112, ¶ 2, Rejection R2 of Claims 1, 3, 5–10, 12, 13, 15, 16, 18–22

Issue 2

Appellant argues (Br. 10–11) the Examiner's rejection of claim 1 under 35 U.S.C. § 112, second paragraph, as being indefinite is in error. These contentions present us with the following issue:

Did the Examiner err in concluding the recited "obtain[ing] feedback on said accessed information item at a later time that is dependent upon said accessed information item, including determining a *predetermined context* at which said user is most likely to provide said feedback when prompted" and "matching a *current context* of said user to said predetermined context" (*emphases added*) lack definiteness?

Analysis

Appellant contends the Examiner is conflating claim breadth with indefiniteness because the claim does not define the phrase "current context." Br. 10. Further, "[t]he claim language recites a current context and a predetermined context, and recites that the current context is matched to the predetermined context. There is no lack of precision and no unreasonable certainty – and thus no lack of definiteness – in such claim language." Br. 11.

Based upon our reading of the Specification (*e.g.*, *see* Spec. ¶¶ 58–59), we agree with Appellant's arguments. We agree with Appellant because we find the use of the phrase "current context" in claim 1 contemplates a current time and/or location, and the "pre-determined context" is defined within the claim itself, *i.e.*, "determining a predetermined context at which said user is most likely to provide said feedback when prompted," which we interpret to mean a time and/or place at which the user is judged as being more amenable to providing feedback. *See* claim 1. Independent claims 6 and 7 recite similar definite claim language.

Therefore, based upon the findings above, on this record, we are persuaded of at least one error in the Examiner's conclusion that the claims under Rejection R2 are indefinite. Therefore, we do not sustain the Examiner's indefiniteness rejection of independent claims 1, 6, and 7, and dependent claims 3, 5, 8–10, 12, 15, 16, 18–22 which stand therewith.

However, claim 13 depends from canceled claim 4, and we sustain the indefiniteness Rejection R2 of claim 13.

3. § 103 Rejection R3 of Claims 1, 3–5, 7–9, 11, 12, 15, 16, 21, and 22

Issue 3

Appellant argues (Br. 12–16) the Examiner's rejection of claim 1 under 35 U.S.C. § 103(a) as being obvious over the combination of Simons, Falk, Gross, and Farkas is in error. These contentions present us with the following issue:

Did the Examiner err in finding the cited prior art combination teaches or suggests a method that includes, *inter alia*, the steps of:

providing an accessed-information-delayed-feedback-prompt that is designed to obtain feedback on said accessed information item at a later time that is dependent upon said accessed information item, including determining a predetermined context at which said user is most likely to provide said feedback when prompted, based on a user profile of historical information regarding said user including preferences of said user, said predetermined context including a time of day at which said user is most likely to provide said feedback when prompted,

as recited in claim 1?

Analysis

Appellant contends:

[A] salient aspect to the invention as recited in claim 1 is provisioning a prompt designed to obtain feedback from a user who has previously accessed an information item, at a later time as to a time of day when the user is most likely to provide this feedback. This aspect of the claimed invention is not suggested by the applied art.

Br. 13. Appellant further argues the Examiner's reliance (Final Act. 18 (citing Simons ¶¶ 31, 32, Fig. 4)) upon the supposed inherent nature of a "delayed feedback prompt" in Simons constitutes error. Br. 13. We agree with Appellant that Simon's prompt is not explicitly or inherently generated at a time when the user is most likely to provide this feedback.

Appellant additionally contends the Examiner's reliance upon an explicit teaching of prompting a user at a later time in Falk is misplaced, and does not teach or suggest the disputed limitation. *Id.* Appellant points out that Falk teaches "pre-generating" questions regarding purchase details to avoid the questions being generated too slowly once user feedback is ultimately sought and provided, i.e., Falk pre-generates the questions and

stores them, but does not teach or suggest prompting the user to provide delayed feedback at a time they are most likely to respond. Br. 13–14 (citing Falk ¶ 36).

In Falk, a user does not provide feedback until he or she *desires* to do so, which at best suggests that the user will go back and on his or her own initiative initiate the feedback process — that is, in Falk, *the user determines when to provide feedback*. By comparison, in the claimed invention, the user's memory is jogged via the user being explicitly *prompted* at the time when the user is most likely to provide feedback — that is, in the claimed invention, *the claimed invention determines the best time at which to prompt for feedback*. Falk thus does not teach when to prompt the user to provide feedback, but rather when to pre-generate the questions to speed response when the customer actually does provide feedback on his or her own accord.

Br. 14.

We find Appellant's arguments to be persuasive in this regard because, while Falk prompts the user at a later time to provide feedback, such a prompt is not taught or suggested to be provided at a time the user is most likely to respond based upon a "predetermined context," as variously required in each of independent claims 1 and 7. We find this issue to be dispositive of the appeal of Rejection R3 under § 103.

Therefore, based upon the findings above, on this record, we are persuaded of at least one error in the Examiner's reliance on the cited prior art combination to teach or suggest the disputed limitation of claim 1, such that we find error in the Examiner's resulting legal conclusion of obviousness. Therefore, we do not sustain the Examiner's obviousness

rejection of independent claim 1, and grouped claims 3–5, 7–9, 11, 12, 15, 16, 21, and 22 which stand therewith. *See Claim Grouping, supra.*

4. § 103 Rejection R4 of Claims 6, 10, and 18–20

Issue 4

Appellant argues (Br. 16–17) the Examiner's rejection of claim 6 under 35 U.S.C. § 103(a) as being obvious over the combination of Simons, Falk, Gross, Farkas, and Potenza is in error. These contentions present us with the following issue:

Did the Examiner err in finding the cited prior art combination teaches or suggests "[a] non-transitory computer usable storage medium comprising instructions that when executed provide a method for obtaining feedback for an accessed information item" in which the steps, *inter alia*, "provide an accessed-information-delayed-feedback-prompt that is designed to obtain feedback on said accessed information item at said later time that is dependent upon said accessed information item," and "assign a first context to said accessed information item, said first context being that at which said user is most likely to provide said feedback when prompted, said first context including a time of day at which said user is most likely to provide said feedback when prompted," as recited in claim 6?

Analysis

Appellant contends:

Claim 6 recites subject matter similar to that of claim 1, and therefore is patentable over the base combination of Simon, Falk, Gross, and Farkas for the reasons that have been described above in relation to the third ground of rejection. Applicant further notes that as to the salient aspect of claim 6

with respect to determining the context at which a user is most likely to provide feedback, including determining the time at which the user is most likely to provide feedback, and prompting the user at that time, Potenza does not cure the deficiencies of the base combination of Simon, Falk, Gross, and Farkas. Potenza discusses a scenario in which a user leaves feedback, but if there is not a matching transaction regarding which the feedback has been left, then the transaction is ignored. Potenza thus teaches that if I review an item, but there is no record I purchased the item, then my review is ignored.

Br. 16–17.

We find Appellant's arguments to be persuasive in this regard for the same reasons discussed above with respect to *Issue 3*, Rejection R3 of independent claims 1 and 7. We find Potenza does not cure the deficiencies of Simons, Falk, Gross, and Farkas, as discussed above.

Therefore, based upon the findings above, on this record, we are persuaded of at least one error in the Examiner's reliance on the cited prior art combination to teach or suggest the disputed limitation of claim 6, such that we find error in the Examiner's resulting legal conclusion of obviousness. Therefore, we do not sustain the Examiner's obviousness rejection of independent claim 6, and grouped claims 10 and 18–20 which stand therewith. *See Claim Grouping, supra.*

5. Rejection R5 of Claims 3, 9, and 18

While Appellant does not provide any substantive or separate arguments directed to obviousness Rejection R5 of claims 3, 9, and 18 under § 103, in light of our reversal of the rejections of independent claims 1, 6, and 7, *supra*, we also reverse obviousness Rejection R5 under § 103 of claims 3, 9, and 18, which variously and ultimately depend from claims 1, 6,

and 7. On this record, the Examiner has not shown how the additionally cited Abbot reference overcomes the aforementioned deficiencies with Simons, Falk, Gross, Farkas, and Potenza, as discussed above regarding claims 1, 6, and 7.

CONCLUSIONS

(1) The Examiner did not err with respect to patent-ineligible subject matter Rejection R1 of claims 1, 3, 5–10, 12, 13, 15, 16, and 18–22 under 35 U.S.C. § 101, and we sustain the rejection.

(2) The Examiner erred with respect to indefiniteness Rejection R2 of claims 1, 3, 5–10, 12, 15, 16, and 18–22 under 35 U.S.C. § 112, second paragraph, and we do not sustain the rejection. However, the Examiner did not err in rejecting claim 13 for indefiniteness, and we sustain the rejection.

(3) The Examiner erred with respect to obviousness Rejections R3 through R5 of claims 1, 3–12, 15, 16, and 18–22 under 35 U.S.C. § 103(a) over the cited prior art combinations of record, and we do not sustain the rejections.

Because we have affirmed at least one ground of rejection with respect to each claim on appeal, we affirm the Examiner's decision. *See* 37 C.F.R. § 41.50(a)(1).

Appeal 2016-008599
Application 12/597,290

DECISION

We affirm the Examiner's decision rejecting claims 1, 3, 5–10, 12, 13, 15, 16, and 18–22.

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). *See* 37 C.F.R. § 41.50(f).

AFFIRMED