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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MICHAEL SALOMON MORTON
and JEREMY FALLER

Appeal 2017-001754
Application 13/610,236[1]
Technology Center 3600

Before: ANTON W. FETTING, JOSEPH A. FISCHETTI, and KENNETH G. SCHOPFER, *Administrative Patent Judges*.

FISCHETTI, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134 of the Examiner's Final rejection of claims 16–30. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

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[1] Appellants identify Google Inc. as the real party in interest. Br. 3.

SUMMARY OF DECISION

THE INVENTION

Appellants' claims relate generally to the field of electronic media. Spec. ¶ 1.

Claim 16 reproduced below, is representative of the subject matter on appeal.

> 16. A computer system for processing comments corresponding to a plurality of portions of an electronic book, the system comprising:
>
> one or more hardware processors;
>
> an aggregation module configured to receive a plurality of comments, each comment corresponding to at least one of the plurality of portions and authored by a corresponding one of a plurality of users, the aggregation module further configured to interact with the one or more hardware processors to group the comments responsive to characteristics of the users that authored the comments;
>
> an analysis module configured to interact with the one or more hardware processors to generate reader-specific comments corresponding to each of the plurality of portions, based on the comments as grouped by the aggregation module; and
>
> a presentation module configured to interact with the one or more hardware processors to generate presentation information for presentation on a display of a client device based on the reader-specific comments.

THE REJECTION

The Examiner relies upon the following as evidence of unpatentability:

Kanderkar et al. ("Kanderkar")	US 2012/0210203 A1	Aug. 16, 2012
Patterson et al. ("Patterson")	US 2012/0221441 A1	Aug. 30, 2012
Mbenkum et al. ("Mbenkum")	US 2012/0324392 A1	Dec. 20, 2012

The following rejections are before us for review.

Claims 16–30 are rejected under 35 U.S.C. §101 as being directed to an abstraction.

Claims 16–30 are rejected under 35 U.S.C. §103(a) as being unpatentable over Kandekar, Mbenkum, and Patterson. Final Act. 3–13

FINDINGS OF FACT

1. We adopt the Examiner's findings as set forth on pages 2–8 of the Final Action and pages 2–7 of the Answer.

2. Kandekar discloses

> In an example of generating a content summary, the content summary may be generated based on user-specific information. For example, the media summary generator 118 may receive or gather information about a user that has accessed or opened the e-book 116. The information may include a profile of the user, gaze-tracking information for the user, annotations of the user,

> social network information of the user, the like, or combinations thereof. The media summary generator 118 may use this information for generating a content summary for a media item, such as the e-book 116, in accordance with embodiments of the present disclosure.
>
> Kandekar ¶ 34 (emphasis omitted).

3. Kandekar discloses

> Embodiments of the present disclosure enable an electronic device, such as an e-book reader, to identify or receive identification of a position within a media item residing on the electronic device, to generate a content summary for a portion of the media item based on the identified position, and to present the content summary to a user of the electronic device. For example, an e-book reader may identify a bookmarked position within an e-book, generate a content summary for a portion of the e-book that precedes the bookmarked position, and display the content summary to a reader. Other embodiments of the present disclosure enable the electronic device to generate a content summary based on user-specific information or time since the user last read or accessed the media item.
>
> Kandekar ¶ 20.

4. Patterson discloses

> As mentioned above, user profile data 310 is usable on a per-student basis and is also capable of being aggregated for various populations of

> subscribers. The population can be the entire subscriber population, or any selected subset thereof, such as targeted subscribers based on any combination of demographic or behavioral characteristics, or content selections. System-wide usage data includes trends and patterns in usage habits for any desired population. For example, correlations can be made between electronic textbooks and add-ons that students choose (presumably related in some way to those textbooks). In one embodiment, when a user obtains a new textbook, such data are used to recommend other related items the user might also be interested in obtaining Valuation of items, relative rankings of items, and other synthesized information can also be obtained from such data.
>
> Patterson ¶ 49 (emphasis omitted).

ANALYSIS

35 U.S.C. § 101 REJECTION

We will sustain the rejection of claims 16–30 under 35 U.S.C. § 101.

The Supreme Court

> set forth a framework for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts. First, . . . determine whether the claims at issue are directed to one of those patent-ineligible concepts. [] If so, we then ask, "[w]hat else is there in the claims before us?" [] To answer that question, []consider the elements

> of each claim both individually and "as an ordered combination" to determine whether the additional elements "transform the nature of the claim" into a patent-eligible application. [The Court] described step two of this analysis as a 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."

Alice Corp. Pty. Ltd. v. CLS Bank Int'l, 134 S.Ct. 2347, 2355 (2014) (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 72–73 (2012)).

To perform this test, we must first determine whether the claims at issue are directed to a patent-ineligible concept.

Although the Court in *Alice* made a direct finding as to what the claims were directed to, we determine that this case's claims themselves and the Specification provide enough information to inform one as to what they are directed to.

The steps in representative claim 16 result in: generating presentation information for presentation on a display of a client device based on the reader-specific comments.

The Examiner found that the claims are directed to an abstract idea of "collecting comment data, recognizing certain comment data within the collected data set, using categories to organize, store, and transmit comment information." Final Act. 2. The Specification states:

> Traditionally, feedback on such media objects has been provided by expert reviewers. With the growth of the Internet, "crowd sourced" feedback has become increasingly popular. Typical crowd sourcing of feedback entails users (rather than professional reviewers) entering ratings and reviews into a feedback collection system. For example, the GOOGLE PLAY STORE™ enables users to rate a book with a score from one to five and provide a written review. These ratings and reviews are aggregated and made available to other users to inform their decisions regarding whether to purchase a particular book.

Spec. ¶ 3. Thus, all this evidence shows that claim 16 is directed to crowd sourcing feedback of electronic books based on comments grouped by users' characteristics. It follows from prior Supreme Court cases, and *Gottschalk v. Benson*, 409 U.S. 63 (1972), in particular, that the claims at issue here are directed to an abstract idea. Crowd sourcing feedback by user characteristics is a method of organizing human behavior, because it controls feedback by filtering human perception by user characteristics. It is also a fundamental economic principle because the "ratings and reviews are aggregated and made available to other users to inform their decisions regarding whether to purchase a particular book." Spec. ¶ 3. The patent-ineligible end of the 35 U.S.C. § 101 spectrum includes methods of organizing human activities and fundamental economic principles. *See Alice Corp. Pty. Ltd.*, 134 S.Ct. at 2355–57. Thus, crowd sourcing feedback of

electronic books based on comments grouped by users' characteristics is an "abstract idea" beyond the scope of section 101.

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 an intermediated settlement in *Alice* and the concept of crowd sourcing feedback of electronic books based on comments grouped by users' characteristics, at issue here. Both are squarely within the realm of "abstract ideas" as the Court has used that term. That the claims do not preempt all forms of the abstraction or may be limited to electronic books, does not make them any less abstract. *See OIP Technologies, Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1360–61 (Fed. Cir. 2015).

Claim 16, unlike the claims found non-abstract in prior cases, uses generic computer technology to perform data reception, transmission, and linkage and does not recite an improvement to a particular computer technology. *See, e.g.*, *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1314–15 (Fed. Cir. 2016) (Finding claims not abstract because they "focused on a specific asserted improvement in computer animation.").

The introduction of a computer into the claims does not alter the analysis at *Mayo* 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 "implemen[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."

Alice, 134 S.Ct. 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 retrieve, select, and apply decision criteria to data and modify the data as a result amounts to electronic data query and retrieval—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. *See Electric Power Group v. Alstom S.A.,* 830 F.3d 1354 (Fed. Cir. 2016)*; see also In re Katz Interactive Call Processing Patent Litig*, 639 F.3d

1303, 1316 (Fed. Cir. 2011) ("Absent a possible narrower construction of the terms 'processing,' 'receiving,' and 'storing,' []those functions can be achieved by any general purpose computer without special programming."). In short, each step does no more than require a generic computer to perform generic computer functions. As to the data operated upon, "even if a process of collecting and analyzing information is 'limited to particular content' or a particular 'source,' that limitation does not make the collection and analysis other than abstract." *SAP Am. Inc. v. InvestPic, LLC*, 890 F.3d 1016, 1022 (Fed. Cir. 2018) (citation omitted).

Considered as an ordered combination, the computer components of Appellants' method add nothing that is not already present when the steps are considered separately. The sequence of data reception-analysis-access/display is equally generic and conventional or otherwise held to be abstract. *See Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 715 (Fed. Cir. 2014) (Sequence of receiving, selecting, offering for exchange, display, allowing access, and receiving payment recited an abstraction.); *Inventor Holdings, LLC v. Bed Bath & Beyond, Inc.*, 876 F.3d 1372, 1378 (Fed. Cir. 2017) (Sequence of data retrieval, analysis, modification, generation, display, and transmission.); *Two-Way Media Ltd. v. Comcast Cable Commc'ns, LLC*, 874 F.3d 1329, 1339 (Fed. Cir. 2017) (Sequence of processing, routing, controlling, and monitoring.). The ordering of the steps is, therefore, ordinary and conventional.

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. The Specification spells out different generic equipment and parameters that might be applied using this concept and the particular steps such conventional processing would entail based on the concept of information access under different scenarios. *See, e.g.*, Spec. ¶¶18–20. The Specification does not describe any particular improvement in the manner a computer functions, at least with respect to the claims in the instant application. Instead, the claims at issue amount to nothing significantly more than instructions to apply the abstract idea of information access using some unspecified, generic computer. Under our precedents, that is not enough to transform an abstract idea into a patent-eligible invention. *See Alice Corp. Pty. Ltd.*, 134 S.Ct. at 2360.

As to the system claims, they

> are no different from the method claims in substance. The method claims recite the abstract idea implemented on a generic computer; the system claims recite a handful of generic computer components configured to implement the same idea. This Court has long "warn[ed] . . . against" interpreting § 101 "in ways that make patent eligibility 'depend simply on the draftsman's art.'"

Id.

We have reviewed all the arguments (Appeal Br. 12–15) Appellants have submitted concerning the patent eligibility of the claims before us that stand rejected under 35 U.S.C. § 101. We find that our analysis above

substantially covers the substance of all the arguments, which have been made. But, for purposes of completeness, we will address various arguments in order to make individual rebuttals of same.

Appellants argue:

> Consequently, the Final Office Action fails to 'clearly articulat[e] the reason(s)' for the rejection. Second, the May 2016 Memorandum cautioned that [E]xaminers 'should be familiar with any cited decision relied upon in making or maintaining a rejection to ensure that the rejection is reasonably tied to the facts of the case and avoid relying upon language taken out of context.' May 2016 Memorandum, p. 3. The Examiner has not asserted, let alone explained, how the claims are similar to the 'basic concept of data recognition and storage' identified as an abstract idea in Content Extraction & Transmission v. Wells Fargo Bank, NA.

Appeal Br. 13–14.

We disagree with Appellants. In rejecting the pending claims under section 101, the Examiner analyzed the claims using the *Mayo/Alice* two-step framework, consistent with the guidance set forth in the USPTO's 2015 UPDATE TO PATENT SUBJECT MATTER ELIGIBILITY, IV and the MAY 2016 MEMORANDUM, II. *See* Answer 4. Specifically, the Examiner notified Appellants that the claims are broadly "directed to an abstract idea for collecting comment data, recognizing certain comment data within the collected data set, using categories to organize, store, and transmit comment information." Final Act. 2. Turning to step two, the Examiner determined

that the

> claims do not include additional elements that are sufficient to amount to significantly more than the judicial exception because the additional element or combination of elements in the claims other than the abstract idea per se amounts to no more than: (i) mere instructions to implement the idea on a computer including a computer system, and/or (ii) recitation of generic computer structure, such as a processor, that serves to perform generic computer functions, including receiving data, aggregating and processing data and transmitting data, that are well-understood, routine, and conventional activities previously known to the pertinent industry.

Id. at 2–3.

All that is required of the Office to meet its *prima facie* burden of production is that the Examiner set forth the statutory basis of the rejection and the reference or references relied upon in a sufficiently articulate and informative manner as to meet the notice requirement of 35 U.S.C. § 132. As the statute itself instructs, the Examiner must "notify the applicant," "stating the reasons for such rejection," "together with such information and references as may be useful in judging the propriety of continuing prosecution of his application." 35 U.S.C. § 132; *see In re Jung*, 637 F.3d 1356, 1363 (Fed. Cir. 2011). Here, as we found above, the Examiner has made these findings as required by the statute. *See* Final Act. 2–3.

In this regard also, there is no requirement that the Examiner must provide evidentiary support in every case before a conclusion can be made that a claim is directed to an abstract idea.[2]

The Examiner in support of its position that the "claims are directed to an abstract idea and the addition of a display is merely a recitation of generic computing system to perform generic computing functions without providing significantly more," cites to a series of cases in the Examiner's Answer. *See* Ans. 2–4. Appellants in reply, attempt to distinguish its claims from those involved in the cases cited by the Examiner on pages 13 and 14 of the Appeal Brief. We have reviewed these arguments and find them unpersuasive. For example, the court in *Enfish* framed the question as "whether the focus of the claims is on [a] specific asserted improvement in computer capabilities . . . or, instead, on a process that qualifies as an 'abstract idea' for which computers are invoked merely as a tool." *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335–1336 (Fed. Cir. 2016). Here, as found *supra*, we find nothing in the claims that is directed to an

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[2] *See, e.g.*, MPEP 2106.07(a)(III) (2018) ("The courts consider the determination of whether a claim is eligible (which involves identifying whether an exception such as an abstract idea is being claimed) to be a question of law. Thus, the court does not require 'evidence' that a claimed concept is a judicial exception, and generally decides the legal conclusion of eligibility without resolving any factual issues.") (citations omitted.)

improvement in computer capabilities.

35 U.S.C. § 103 REJECTION

The Appellants argued claims 16–19, 22–25, and 27–30 as a group. Appeal Br. 9. Appellants argue claim 16 as the representative claim for this group, and the remaining claims standing or falling with claim 16. *See id.*, *see also*, 37 C.F.R. § 41.37(c)(1)(iv) (2015).

Claim 16 recites in pertinent part "processors to group the comments responsive to characteristics of the users that authored the comments." Appeal Br. 16, Claims App.

Appellants argue,

> Kandekar discloses 'generat[ing] a content summary based on **user-specific information**.' Kandekar, ¶ [0020]. Kandekar discloses tailoring a content summary generated for a user based on information about that user; it is silent as to grouping comments responsive to the characteristics of the authors of those contents.

Appeal Br. 8.

Appellants further argue,

> The cited paragraphs of Patterson do not address 'group[ing] comments responsive to characteristics of the users that authored the comments' but instead address (i) a 'collaboration subsystem 240 . . . that allow[s] students to work together. . . . [U]sers can share their annotations and notes with their study group' (paragraph [0035]); (ii) 'User profile data storage 310 includes information about an individual user (e.g., a student), to facilitate the

> payment and collaborative aspects of system 100…. In one embodiment, when a user obtains a new textbook, such data are used to recommend other related items the user might also be interested in obtaining" (paragraph [0049]). However, Patterson makes no mention of grouping user comments based on characteristics of the authors of those comments.

Appeal Br. 8–9.

The Examiner however found concerning Kandekar that,

> each comment corresponding to at least one of the plurality of portions (portion of the content, [0033]) and authored by a corresponding one of a plurality of users (annotations of the user [0034]), the aggregation module further configured to interact with the one or more hardware processors (processor, 122) to group the comments responsive to characteristics of the users (generating a content summary based on user-specific information, [0034];

Final Act. 4. And, the Examiner found that in Kandekar "[t]he user comments and annotations, bookmarked positions and characteristics are grouped [0037] [0094] and characteristics and demographic information is utilized to generate the reader specific, user created annotations and summary, [0095]." Final Act. 11.

The Examiner also found, "Patterson explicitly discloses the user author characteristics are utilized [] for grouping comments." (Answer 6). "Patterson discloses receiving user/author comments, [0033] and grouping

comments responsive to characteristics of the authors [0035] [0043] [0045] [0049]." (Final Act. 6).

We disagree with Appellants because Kandekar explicitly discloses "generating a content summary, the content summary may be generated based on user-specific information." (FF. 2). Even assuming that this does not equate to "group[ing] the comments responsive to characteristics of the users", the Examiner also relies on Patterson for this feature. Answer 6, Final Act. 6. We find that one of ordinary skill in the art looking to Kandekar and Patterson would arrive at the claimed "processors to group the comments responsive to characteristics of the users that authored the comments." Appeal Br. 16, Claims App. This is because Patterson explicitly discloses

> user profile data 310 is usable on a per-student basis and is also capable of being aggregated for various populations of subscribers. The population can be the entire subscriber population, or any selected subset thereof, such as targeted subscribers based on any combination of demographic or behavioral characteristics, or content selections the user author characteristics are utilized in for grouping comments.

FF. 4. We find that one of ordinary skill in the art looking to Kandekar's disclosure of generating a content summary based on user-specific information (FF. 2, 3), and Patterson's disclosure of aggregation for various populations of subscribers (FF. 4), would arrive at the claimed "group[ing] the comments responsive to characteristics of the users that authored the

comments" because understanding the source of the review would be inferred as part of the survey. *See KSR Int'l. Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) (In making the obviousness determination one "can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.").

Concerning claim 20, the Examiner found, Mbenkum discloses, "[c]omparing the first set of comments to the second set of comments to determine a similarity therebetween (track the relationships between comments in order to create threaded discussions and rate comments, [0047])." (Final Act. 7).

Appellants argue, *inter alia*,

> the only reference to 'similarity' in paragraph [0044] is that '[t]he page notes window 450 similarly list the available page notes,' which is not relevant to this analysis. Paragraph [0047] states in most pertinent part, '[t]he comment database entity 332 would then track the relationships between comments 332 in order to create threaded discussions about the current chapter.'

(Appeal Br. 11).

We disagree with Appellants. Appellant's Specification does not specifically define the term "similarity", nor does it utilize the term contrary to its customary meaning. The ordinary and customary definition of the

word "similar" is, "having characteristics in common."[3] We find that one of ordinary skill in the art would have understood that the disclosed tracking of relationships between comments to create a thread constitutes "a similarity" because these relationships are based on the common characteristic of being tracked.

Appellants also argue that,

> Paragraph [0027] likewise states that 'page notes 346 can relate to other notes 346, thereby allowing the creation of threaded, back-and-forth discussions within the book's community.' These cannot be considered to be comments 'corresponding to a plurality of references, the electronic book not being one of the plurality of references' as set forth in claim 20.

(Appeal Br. 11).

The Examiner found that Mbenkum discloses the limitation of the electronic book not being one of the plurality of references, finding,

> [r]eceiving a first set of comments, authored by the specific reader, corresponding to a plurality of references (each user can make multiple user community additions including page notes, chapter comments, book reviews and ratings about any book, [0018]), the electronic book not being one of the plurality of references (any book, [0018]; journal article, news report, [0010]; user A submits note, [0014] [0035])

(Final Act. 7).

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[3] https://www.merriam-webster.com/dictionary/similar (last visited 7/17/2018)

We are unpersuaded by Appellants' arguments because Appellants argue paragraph 27 of Mbenkum which was not cited by the Examiner in mapping this claim limitation to Mbenkun. What was cited by the Examiner were paragraphs 10, 18, 14 and 35. *See id.* The Examiner has found that Mbenkun discloses "any book", and thus meets the claim requirement. *Id.* Accordingly, we find the Examiner has made its prima facie case.

CONCLUSIONS OF LAW

We conclude the Examiner did not err in rejecting claims 16–30 under 35 U.S.C. § 101.

We conclude the Examiner did not err in rejecting claims 16–30 under 35 U.S.C. § 103.

DECISION

The decision of the Examiner to reject claims 16–30 is affirmed.

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).

AFFIRMED.