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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* LEE LINDEN and BENJAMIN LEWIS

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Appeal 2017-002222  
Application 13/684,084  
Technology Center 3600

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Before CARL W. WHITEHEAD JR, JASON V. MORGAN and  
ADAM J. PYONIN, *Administrative Patent Judges*.

WHITEHEAD JR., *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants are appealing the final rejection of claims 1–20 under 35 U.S.C. § 134(a). Appeal Brief 2. We have jurisdiction under 35 U.S.C. § 6(b) (2012).

We affirm.

*Introduction*

The invention is directed to “the field of e-commerce, and more specifically to a new and useful method for advertising a gift to a sender in the field of e-commerce.” Specification, paragraph 4.

*Illustrative Claim*

1. A method comprising:

identifying, by at least one processor, a set of communications from a set of users of a social networking system and directed to a recipient from within the social networking system;

identifying, by the at least one processor, indicators of a gift-appropriate event of the recipient within the set of communications;

determining, by the at least one processor, that a threshold number of communications from the set of communications that include an identified indicator of the gift-appropriate event have been sent within a predetermined time period;

in response to the threshold number of communications with the identified indicator of the gift-appropriate event being sent within the predetermined time period, selecting, by at least one processor, a gift for the recipient based on factors tracked by the social networking system;

selecting, by the at least one processor, a potential gift sender, outside the set of users, based on a determined relationship between the potential gift sender and the recipient;

transmitting, by the at least one processor and via the social networking system, an electronic notification to the potential gift sender, the electronic notification comprising a recommendation for the selected gift for the recipient and allowing the potential gift sender to electronically purchase the gift from a third-party vendor without leaving the social networking system;

identifying, by the at least one processor, whether the potential gift sender has purchased the gift for the recipient;

detecting, by the at least one processor, after transmission of the electronic notification to the potential gift sender but prior to purchase of the gift by the potential gift sender, an update event;

identifying, by the at least one processor, that the detected update event relates to a change to one or more of the factors based on which the gift was selected;

modifying, by the at least one processor, the recommendation in response to the update event; and

transmitting, by the at least one processor and via the social networking system, an updated electronic notification to the potential gift sender that includes the modified recommendation.

#### *Rejection on Appeal<sup>1</sup>*

Claims 1–20 stand rejected under 35 U.S.C. §101 because the claimed invention is directed to a judicial exception (i.e., a law of nature, a natural phenomenon, or an abstract idea) without significantly more. Final Action 2.

#### ANALYSIS

Rather than reiterate the arguments of Appellants and the Examiner, we refer to the Appeal Brief (filed April 21, 2016), the Reply Brief (filed November 28, 2016), the Answer (mailed September 27, 2016) and the Final Action (mailed September 21, 2015) for the respective details.

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<sup>1</sup> The 35 U.S.C. §112 rejection was withdrawn by the Examiner. Advisory Action. 35 U.S.C. §103 rejection was withdrawn by the Examiner. Final Action 6.

35 U.S.C. §101 Rejection

The Supreme Court has set forth an analytical “framework 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. 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, 71–73 (2012)). In the first step of the analysis, we determine whether the claims at issue are “directed to” a judicial exception, such as an abstract idea. *Alice*, 134 S. Ct. at 2355. If not, the inquiry ends. *Thales Visionix Inc. v. U.S.*, 850 F.3d 1343, 1346 (Fed. Cir. 2017); *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1339 (Fed. Cir. 2016). If the claims are determined to be directed to an abstract idea, then we consider under step two whether the claims contain an “inventive concept” sufficient to “transform the nature of the claim into a patent-eligible application.” *Alice*, 134 S. Ct. at 2355 (quotations and citation omitted).

Noting that the two stages involve “overlapping scrutiny of the content of the claims,” the Federal Circuit has described “the first-stage inquiry” as “looking at the ‘focus’ of the claims, their ‘character as a whole,’” and “the second-stage inquiry (where reached)” as “looking more precisely at what the claim elements add—specifically, whether, in the Supreme Court’s terms, they identify an ‘inventive concept’ in the application of the ineligible matter to which (by assumption at stage two) the claim is directed.” *Electric Power Grp, LLC v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016). In considering whether a claim is directed to an abstract idea, we acknowledge, as did the Court 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. We, therefore, look to:

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(1) whether the claims focus on a specific means or method that improves the relevant technology, or (2) are directed to a result or effect that itself is the abstract idea, in which the claims merely invoke generic processes and machinery. *See Enfish*, 822 F.3d at 1336.

*Step One: Whether the Claims Are Directed to a Patent-Ineligible Concept (Abstract Idea)*

The Examiner finds that the claims are directed to “*the concept of recommending gifts to a gift sender to be given to a recipient based upon analysis of collected data related to mutual communication between the two who are part of a social networking system*” and finds the claimed concept “represents certain methods involving human activity related to commercial practices found to be abstract ideas by the Supreme Court.” Answer 4. The Examiner further finds:

[N]arrowing of the claims by adding familiar conventional steps and activities such as collecting analyzing data, identifying and determining certain options from the analyzed data based upon certain criteria, transmitting and receiving messages, organizing purchase of gift items, detecting changes in the collected data and modifying and updating options based upon detected changes so that the claims do not preempt all practices of “*recommending gifts to a gift sender to be given to a recipient based upon analysis of collected data related to mutual communication between the two*” **or may be limited to in the computing setting do not make them any less abstract.**

Answer 4.

Appellants contend:

Under step one, Applicant’s claims are not abstract, but concretely specify how to identify gift-appropriate events from communications within a social networking system, recommend both a gift and potential gift sender-along with updated recommendations-based on tracked factors and relationships from within that system, and provide the potential gift sender

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with an option to purchase the recommended gift from within the social networking system.

Appeal Brief 7.

Appellants argue that:

Here, as in *DDR*<sup>2</sup>, Applicant’s claims are concrete (and not abstract) because they solve a business challenge unique to the Internet. The pending claims address a problem that could not exist outside a computer network-identifying gifting events and potential gift senders from communications within a social networking system and preventing third-party purchase links from directing users to “other gifting venues” and thereby “siphon users away from [the] social networking system.” *Specification* ¶ [0005].

Additionally, as in *DDR*, the Applicant’s claims present a solution “necessarily rooted in computer technology,” *id* at 1257, by both drawing on the technological resources of a social networking system and introducing new ways to update gift recommendations on that system.

Appeal Brief 9.

We do not find Appellants’ arguments persuasive. The Federal Circuit has repeatedly confirmed since *Alice* that the category of abstract ideas embraces “fundamental economic practice[s] long prevalent in our system of commerce,” including “longstanding commercial practice[s]” and “method[s] of organizing human activity.” *E.g., Intellectual Ventures I LLC v. Symantec Corp.*, 838 F.3d 1307, 1313 (Fed. Cir. 2016). Our reviewing court has explained that claims directed to “the mere formation and manipulation of economic relations” and “the performance of certain financial transactions” are properly held to be directed to abstract ideas. *Content Extraction & Transmission LLC v. Wells Fargo Bank, Nat. Ass’n*,

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<sup>2</sup> *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245 (Fed Cir. 2014)

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776 F.3d 1343, 1347 (Fed. Cir. 2014); *see also, e.g., Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 716 (Fed. Cir. 2014) (finding computer-implemented system for “using advertising as a currency [on] the Internet” to be ineligible); *buySAFE, Inc. v. Google, Inc.*, 765 F.3d 1350, 1352, 1355 (Fed. Cir. 2014) (finding computer-implemented system for guaranteeing performance of an online transaction to be ineligible.); *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1370 (Fed. Cir. 2011) (finding computer-implemented system for “verifying the validity of a credit card transaction over the Internet” to be ineligible).

Also, our reviewing court has repeatedly held that information collection and analysis, including when limited to particular content, is within the realm of abstract ideas. *See, e.g., Elec. Power Grp.*, 830 F.3d at 1353 (holding that “collecting information, analyzing it, and displaying certain results of the collection and analysis” are “a familiar class of claims ‘directed to’ a patent-ineligible concept”); *Fair Warning IP, LLC v. Iatric Sys., Inc.*, 839 F.3d 1089, 1093–94 (Fed. Cir. 2016) (claims directed to collecting information and analyzing it according to certain rules were directed to an abstract idea); *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1370 (Fed. Cir. 2011) (computer-implemented system for “verifying the validity of a credit card transaction over the Internet” was patent-ineligible).

Appellants’ argument that the claimed invention solves a business challenge unique to the Internet is not persuasive because the mere application of an abstract idea on a computer system does not make a claimed invention patentable. *See Alice Corp.*, 134 S. Ct. at 2358 (“[I]f 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.”) (citations omitted). Appellants do not argue, nor does Appellants’ Specification state, that the claimed programmed computer processor require specialized or improved technology.

Further, we find Appellants’ claims are distinguished from those claims that our reviewing court has found to be patent eligible by virtue of reciting technological improvements to a computer system. *See, e.g., DDR Holdings*,<sup>3</sup> 773 F.3d at 1249, 1257 (holding that claims reciting computer processor for serving “composite web page” were patent eligible because “the claimed solution is necessarily rooted in computer technology in order to overcome a problem specifically arising in the realm of computer networks”); *Enfish*, 822 F.3d at 1338 (holding that claims directed to a self-referential table for a computer database were patent eligible because the claims were directed to an improvement in the functioning of a computer); *Visual Memory LLC v. NVIDIA Corp.*, 867 F.3d 1253, 1259 (Fed. Cir. 2017) (holding that claims directed to “an improved computer memory system” having many benefits were patent eligible).

We agree with the Examiner’s finding that at step one of the *Alice* analysis, the claims are directed to one or more abstract ideas, we turn to the second step of the *Alice* analysis, in which we must determine whether the additional elements of the claims transform them into patent-eligible subject matter.

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<sup>3</sup> Moreover, we note the court in *DDR* did not turn on the issue of whether the claims were abstract under the first step of *Alice* analysis. *See DDR Holdings*, 773 F.3d at 1257 (“under any of these characterizations of the abstract idea, the ’399 patent’s claims satisfy Mayo/Alice step two”).

*Step Two: Whether Additional Elements Transform the Idea into Patent-Eligible Subject Matter*

Appellants' argument that the claimed invention solves an Internet-centric problem with a solution that is rooted in computer technology is not persuasive of Examiner error because, as we noted above, the mere application of an abstract idea on a computer system does not make a claimed invention patentable. *See Alice Corp.*, 134 S. Ct. at 2358 (“[I]f 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.”) (citations omitted); *See* Appeal Brief 11. Appellants do not argue, nor does Appellants’ Specification state, that the claimed method of gift recommendation requires specialized or improved technology. *See, e.g.*, Specification ¶¶ 23, 24, 91.

Appellants argue:

The claims require transmitting an updated electronic notification with a modified gift recommendation upon detecting “an update event” relating to tracked factors. While these steps are by no means exhaustive, they demonstrate that the claimed inventions do not merely recite an abstract idea of human activity, embody a field of use of a computer, or perform generic computer functions, as the Examiner asserts.

Appeal Brief 12.

Appellants further argue:

The combined steps enable at least three things necessarily rooted in computer technology allowing the electronic purchase of a recommended gift from within the social networking system, maintaining the look and feel of that system during the gift-notification and purchasing process, and updating the electronic notification based on tracked factors within the system. *See Specification*, FIGS. 3–4, 9, 13 and ¶¶ [0005], [0081], [0083],

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[0085]. When considered as an ordered combination, therefore, claims 1–20 amount to significantly more than an abstract idea.

Appeal Brief 12–13.

The Examiner finds:

Viewing the limitations as an ordered combination does not add anything further than looking at the limitations individually. **When viewed either individually, or as an ordered combination, the additional limitations do not amount to a claim as a whole that is significantly more than the abstract idea, because the claims simply instruct the practitioner to implement the abstract idea with routine, conventional activity (*Step 28: NO*).** The claim is not patent eligible.

Final Action 5–6.

We do not find Appellants’ arguments persuasive and agree with the Examiner’s findings. The claim’s additional steps—whether viewed individually or combined—employ computer technology to merely implement the human activity via conventional technology and therefore do not amount to significantly more than an abstract idea. As the Supreme Court has explained, “the mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention.” *Alice Corp.*, 134 S. Ct. at 2358. Thus, automating the claimed gift recommendation method with the use of a generic computer performing generic computer operations such as collecting and categorizing data does not transform Appellants’ claims into patent-eligible subject matter. Accordingly, we sustain the Examiner’s 35 U.S.C. §101 rejection of claims 1–20.

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DECISION

The Examiner's 35 U.S.C. §101 rejection of claims 1–20 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)(1). *See* 37 C.F.R. § 1.136(a)(1)(v).

AFFIRMED