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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte CHRIS CHEAH

Appeal 2017-002384
Application 12/258,295
Technology Center 2100

Before ERIC S. FRAHM, KRISTEN L. DROESCH, and
JOHN D. HAMANN, *Administrative Patent Judges*.

FRAHM, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE¹

Introduction

Appellant appeals under 35 U.S.C. § 134(a) from a Final Rejection of claims 1–20 and 24–42. Claims 21–23 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b). We AFFIRM.

¹ We note that the instant application on appeal is related to twelve other applications also on appeal, all having the same inventive entity (Chris Cheah) and assignee (Facebook, Inc.). The related applications are as follows: U.S. Patent Application No. 12/258,299 and Appeal No. 2016-006539 decided Feb. 23, 2017 (affirmed-in-part); U.S. Patent Application No. 13/609,041 and Appeal No. 2017-002678 decided August 17, 2017 (affirmed-in-part); U.S. Patent Application No. 14/599,216 and Appeal No. 2017-002157 decided January 16, 2018 (affirmed); U.S. Patent Application

Disclosed Field of Invention

Appellant discloses a method and system for controlled distribution of information, such as electronic business cards or contact information, over a network. Title; Spec. ¶¶ 3–5; *see generally* Figs. 1–4. More specifically, Appellant discloses a method for automatically updating and distributing contact information such as profiles or electronic business cards, as well as allowing attachment of various additional information (e.g., business website information or Universal Resource Locator, hyperlinks, audio/video objects, etc.). Spec. ¶¶ 10–12. A first or requesting user requests access to a user profile of a second user, and a display of an authorization request is provided to the second user before any relationships are established between the first and second users. Spec. ¶¶ 23, 28, 100; claim 1; *see* Fig. 18G; *see also* App. Br. 5, Summary of Claimed Subject Matter. After an authorization response is received from the second user, the first and second users are permitted to access each other’s user profiles. Spec. ¶¶ 15–18, 27, 29, 100; claim 1; *see also* App. Br. 5, Summary of Claimed Subject Matter. Then, at least the user profile of the second user is displayed, including textual profile information as well as at least one data object (i.e., an icon) representing

No. 12/268,981 and Appeal No. 2017-008051 decided January 29, 2018 (affirmed); U.S. Patent Application No. 13/615,062 and Appeal No. 2017-002512; U.S. Patent Application No. 13/618,881 and Appeal No. 2017-002456; U.S. Patent Application No. 13/612,619 and Appeal No. 2017-002455; U.S. Patent Application No. 13/612,606 and Appeal No. 2017-002088; U.S. Patent Application No. 12/258,302 and Appeal No. 2017-002070; U.S. Patent Application No. 11/840,968 and Appeal No. 2017-009638; U.S. Patent Application No. 13/610,560 and Appeal No. 2017-008097; and U.S. Patent Application No. 13/612,584 and Appeal No. 2017-008113.

additional content accessible through the second user's profile. Spec. ¶¶ 15–18, 124–128; claim 1; *see* Figs. 19A, 19A1; *see also* App. Br. 5, Summary of Claimed Subject Matter.

Exemplary Claims

Exemplary claims 1 and 5, with bracketed lettering (indicating disputed limitations A, B, and C) and emphases added to disputed portions of the claims, read as follows below:

1. A method comprising:

by a computer system, receiving an access request from a requesting user, the access request comprising a request to access a user profile of a second user, the user profile of the second user being associated with profile information provided by the second user and maintained in a data repository of a plurality of user profiles of a plurality of users;

[A] by the computer system, before any relationships are established between the requesting user and the second user, providing for display to the second user an authorization request responsive to the access request from the requesting user;

by the computer system, receiving an authorization response from the second user via a network responsive to the authorization request, the authorization response being generated at least in part by the second user interacting with one or more selectable options displayed with the authorization request;

[B] by the computer system, in response to receiving the authorization response from the second user:

permitting the requesting user to access the user profile of the second user; and

permitting the second user to access a user profile of the requesting user; and

by the computer system, causing the display of the user profile of at least the second user, the displayed user profile comprising textual profile information associated with the second user and at least one data object, the at least one data

object comprising a representation of additional content accessible through the user profile of the second user, wherein the additional content comprises one or more data types selected by the second user from a plurality of different available data types.

5. The method of claim 1, [C] *wherein at least one data object is packaged within a HTML wrapper.*

The Examiner's Rejections

(1) The Examiner rejected claims 1–4, 6–17, 19, 20, 24, 27–36, and 38–42 under 35 U.S.C. § 103(a) as being obvious over the combination of Robertson (US 6,269,369 B1; issued July 31, 2001) and Tang (US 5,793,365; issued Aug. 11, 1998). Final Act. 4–20; Ans. 3–7.

(2) The Examiner rejected claims 18 and 37 under 35 U.S.C. § 103(a) as being obvious over the combination of Robertson, Tang, and Kukkal (US 5,774,117; issued June 30, 1998). Final Act. 20–21.

(3) The Examiner rejected claim 5 under 35 U.S.C. § 103(a) as being obvious over the combination of Robertson, Tang, and Dasan (US 5,761,662; issued June 2, 1998). Final Act. 21–22; Ans. 7–8.

(4) The Examiner rejected claims 25 and 26 under 35 U.S.C. § 103(a) as being obvious over the combination of Robertson, Tang, and Appelman (US 7,539,942 B1; issued May 26, 2009). Final Act. 22–23.

Issues on Appeal

Based on Appellant's arguments in the Briefs (App. Br. 11–20; Reply Br. 2–10), the following principal issues are presented on Appeal:²

² With regard to the rejection over Robertson and Tang, Appellant does not present separate arguments regarding the patentability of claims 2–4, 6–17, 19, 20, 24, 27–36, and 38–42, and instead relies on the arguments presented

(1) Did the Examiner err in rejecting claims 1–4, 6–17, 19, 20, 24, 27–36, and 38–42 under 35 U.S.C. § 103(a) as being obvious over the combination of Robertson and Tang because the combination fails to teach or suggest limitations [A] and/or [B], as recited in representative independent claim 1 *supra*, and as similarly recited in remaining independent claims 16, 19, and 24?

(2) Did the Examiner err in rejecting claim 5 under 35 U.S.C. § 103(a) as being obvious over the combination of Robertson, Tang, and Dasan because the combination, and specifically Dasan, fails to teach or suggest limitation [C] *supra*, as recited in dependent claim 5?

ANALYSIS

We have reviewed Appellant’s arguments in the Briefs (App. Br. 11–20; Reply Br. 2–10), the Examiner’s rejection (Final Act. 4–23), and the Examiner’s response (Ans. 3–8) to Appellant’s arguments.

as to claim 1 (*see generally* App. Br. 11–17; Reply Br. 2–7). Independent claims 16 (method), 19 (method), and 24 (system) recite similar subject matter as recited in claim 1, including “providing for display to the second user an authorization request” and permitting access to user profiles “in response to receiving the authorization response from the second user” as recited in limitations [A] and [B] of claim 1. Therefore, we select independent claim 1 as representative of the group of claims consisting of claims 2–4, 6–17, 19, 20, 24, 27–36, and 38–42 rejected as being obvious over Robertson and Tang. Because Appellant does not present separate arguments as to the obviousness rejections of: (i) claims 18 and 37 over Robertson, Tang, and Kukkal; and (ii) claims 25 and 26 over Robertson, Tang, and Appelman, the outcome of these rejections will fall with the outcome for representative claim 1. Accordingly, our analysis only addresses representative claim 1, and dependent claim 5 separately argued (*see* App. Br. 17–19; Reply Br. 8–9).

Obviousness Rejection of Claims 1–4, 6–17, 19, 20, 24, 27–36, and 38–42

With regard to representative claim 1, we adopt as our own: (1) the findings and reasons set forth by the Examiner in the action from which this appeal is taken (Final Act. 4–7); and (2) the reasons set forth by the Examiner in the Examiner’s Answer in response to Appellant’s Appeal Brief (*see* Ans. 3–7). We concur with the conclusions reached by the Examiner with regard to the obviousness of claim 1 over Robertson and Tang. We are not persuaded by Appellant’s contentions (App. Br. 11–17; Reply Br. 2–7) that the Examiner erred in rejecting claim 1, and we find the combination of Robertson and Tang teaches or suggests limitations [A] and [B] as recited in claim 1. We provide the following for emphasis.

With regard to limitation [A], we agree with the Examiner’s comparison of Appellant’s screen illustration in Figure 18E (showing “linked users” who have made requests) with Robertson’s Figure 8 (showing specifying a user 580-10 desired to link with using box 580-14 and submit button 580-16) and Figure 9 (showing a GUI 600 being displayed after linking first and second users by granting permission to link) as described in Robertson’s column 8, lines 11–20 (*see* Ans. 3–5). Specifically, we agree with the Examiner (Ans. 4 citing Robertson col. 8, ll. 11–29; Figs. 8, 9) that Robertson’s disclosure of a first user sending a request before a second user decides whether to establish a relationship teaches is the same as Appellant’s process implemented in Figure 18E showing linked users who have made requests. We also agree with the Examiner (Ans. 4–5; *see also* Final Act. 4–5) that no relationship is established between the requesting user and responding user until *after* the second user authorizes the requesting user’s request to establish a link/relationship, because the second or responding

user must set data field permissions for the first or requesting user as shown in Figure 9 and the accompanying description in column 8, lines 11–29. The relationship begins when the responding user grants permission to the requesting user’s request; and that way user profile information can then be shared.

In this light, Appellant’s arguments (App. Br. 11–13; Reply Br. 2–5) that Robertson, including the disclosure at column 8, lines 11–29, fails to disclose, teach, or suggest limitation [A], including providing an authorization request for display to a second user before any user relationships are established, are unpersuasive.

With regard to limitation [B], we agree with the Examiner (Final Act. 5–6; Ans. 6) that Robertson (*see* Robertson Fig. 9; col. 9, ll. 10–26) discloses permitting access to user profiles “in response to receiving the authorization response from the second user” as recited in limitation [B] of claim 1, which constitutes a visual indicator. We agree with the Examiner’s finding that “upon member B granting permission to member A, address book profile access will appear in both member A and member B’s address book” (Ans. 6), as supported by column 9, lines 10–26. And, Robertson discloses user profiles being personal information 600-8 and/or work information 600-10 (col. 8, ll. 50–51; Fig. 9).

In this light, Appellant’s contention (Reply Br. 6) that Robertson’s column 9, lines 10–26 merely “disclose[s] adding information to address books” and thus does not disclose, teach, or suggest limitation [B] is not persuasive.

Motivation and Reasonable Expectation of Success

A rationale to support a conclusion that a claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art would have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded nothing more than predictable results to one of ordinary skill in the art. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 538, 416 (2007). Such understandings about reasons to combine or countervailing reasons not to combine could come from the knowledge, skill, and creativity of the ordinarily skilled artisan. *KSR*, 550 U.S. at 418.

In the instant case, the Examiner determines that it would have been obvious “to combine Robertson with Tang so that users can display a means[,] i.e., an object as a means[,] of communicating with them [Tang figure 1b]” (Final Act. 6). The Examiner also determines that it would have been obvious to modify Robertson with the display properties of Tang “to display profile information in a different format or in a different means that is preferable to others” (Ans. 7). We agree.

In this light, Appellant’s contention (App. Br. 15–16) that “the Examiner has failed to provide a clear articulation of the reasons why the proposed *Robertson-Tang* combination would have been obvious to one of ordinary skill in the art” is not persuasive. And, notably, Appellant does not respond with any evidence supporting a finding of a lack of motivation. We agree with the Examiner (Final Act. 6; Ans. 7) that one of ordinary skill in the art, looking at the combined teachings and suggestions of Robertson (*see e.g.*, Figs. 5, 8, 9 showing user profiles and access request and permission forms) and Tang (Fig. 1b, business card object 29, stick-up text button 34,

email button 36, video conference button 38), would have found it predictable to successfully perform the method of claim 1, including “providing for display to the second user an authorization request” and permitting access to user profiles “in response to receiving the authorization response from the second user” as recited in limitations [A] and [B], as well as displaying a user profile along with a data object as recited in claim 1.

Where there is a reason to modify or combine the prior art to achieve the claimed invention, the claims may be rejected as *prima facie* obvious provided there is also a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091 (Fed. Cir. 1986); *Amgen Inc. v. F. Hoffman-LA Roche Ltd.*, 580 F.3d 1340, 1362 (Fed. Cir. 2009) (“An obviousness determination requires that a skilled artisan would have perceived a reasonable expectation of success in making the invention in light of the prior art.”).

The “reasonable expectation of success” requirement refers to the likelihood of success in combining references to meet the limitations of the claimed invention, and does not look to whether one would reasonably expect the prior art references to operate as those references intended once combined. Instead, there must be a motivation to combine accompanied by a reasonable expectation of achieving what is claimed. The teachings of the prior art can provide a sufficient basis for a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091 (Fed. Cir. 2009). In the case before us, the Examiner has met this burden in making findings about the teachings of the individual references as they relate to the claimed subject matter.

In addition, evidence showing there was *no* reasonable expectation of success may support a conclusion of nonobviousness. *In re Rinehart*, 531

F.2d 1048 (CCPA 1976). In the instant case, Appellant has not provided any evidence or reasoning showing there was no reasonable expectation of success. Appellant's contentions (*see* App. Br. 15–17; Reply Br. 6–7) do not persuade us that the Examiner erred. Specifically, Appellant merely avers (App. Br. 16–17) that there is no reasonable expectation of success without providing any reasoning, and such a naked assertion, without any evidence, is not persuasive. It is well settled that mere attorney arguments and conclusory statements, which are unsupported by factual evidence, are entitled to little probative value. *In re Geisler*, 116 F.3d 1465, 1470 (Fed. Cir. 1997); *see also In re Pearson*, 494 F.2d 1399, 1405 (CCPA 1974) (attorney argument is not evidence).

Moreover, the Examiner makes specific findings as to why a person of ordinary skill in the art would have a reasonable expectation of success, based on the teachings of the references (*see* Final Act. 4–7). Final Act. 6 (finding Robertson and Tang are in the analogous art of user profiles); Ans. 7 (“Robertson and Tang are analogous art of user profiles displayed on a user interface.”).

In view of the foregoing, we sustain the Examiner's rejection of claim 1, as well as claims 2–4, 6–17, 19, 20, 24, 27–36, and 38–42 grouped therewith.

Obviousness Rejection of Claim 5

With regard to dependent claim 5 rejected over Robertson, Tang, and Dasan, Appellant argues (App. Br. 17–19; Reply Br. 8–9) that the combination fails to disclose, teach, or suggest limitation [C] because, although Dasan's Figure 2 may disclose using HTML (Hypertext Markup Language) and HTTP (Hypertext Transfer Protocol) to present an object,

this is not the same as “wrapping” or “packaging” a data object “within a HTML wrapper” as recited in claim 5.³

Appellant’s Specification discloses pages, such as registration page (*see* Spec. ¶ 40), a registration download application page (Spec. ¶ 44), and a profile page, as being HTML pages (*see* Fig. 18A; Spec. ¶ 41). We note that the profile page shown in Appellant’s Figure 18A is similar to Dasan’s user profile displayable/retrievable in HTML.

We note an equivalent teaching in Dasan is not required to support a legal conclusion of obviousness. Rather, “the question under [35 U.S.C. § 103] is not merely what the references expressly teach but what they would have **suggested** to one of ordinary skill in the art at the time the invention was made.” *Merck & Co. v. Biocraft Laboratories, Inc.*, 874 F.2d 804, 807 (Fed. Cir. 1989) (emphasis added) (quoting *In re Lamberti*, 545 F.2d 747, 750 (Fed. Cir. 1976); *see also* MPEP § 2123).

In this light, Dasan’s disclosure in columns 3–4, describing the operation of server 150’s HTML functionality in Figure 2, teaches or suggests packaging at least one data object (e.g., a user profile) within a HTML wrapper as claimed (*see e.g.*, col. 4, ll. 8–13, 26–50). Server 150 provides HTML functionality 210 by displaying and retrieving certain textual and other data based upon Hypertext views (col. 4, ll. 29–32), and “[t]he server’s application program, the personal newspaper generator,

³ Mere attorney arguments and conclusory statements (such as Appellant’s contention that Dasan’s presentation of an object HTML is not the same as “packaging” a data object “within a HTML wrapper” as recited in claim 5), which are unsupported by factual evidence, are entitled to little probative value. *In re Geisler*, 116 F.3d at 1470; *see also In re Pearson*, 494 F.2d at 1405 (attorney argument is not evidence).

maintains a record of the state of each user's profile, and thus, provides state functionality from session to session" (col. 4, ll. 36–40). One of ordinary skill in the art would have understood that data objects are wrapped in HTML packages for display and retrieval by a user of a browser 200 on a client side 100 via server 150 implementing HTML functionality 210 (*see* Fig. 2).

The Examiner has made a prima facie case for the obviousness of claim 5, including packaging an object within a HTML wrapper, and Appellant has not sufficiently rebutted the Examiner's findings and conclusion with respect to *Dasan*.

Furthermore, Appellant's arguments that (i) "Claim 5 does not simply require presenting something 'in HTML' as alleged by the Examiner" (Reply Br. 8) and (ii) "no portion of *Dasan* discloses '**wherein at least one data object is packaged within a HTML wrapper,**' as recited in Claim 5" (*id.*), are not supported by any evidence or industry-recognized definition, and are therefore unpersuasive.

In view of the foregoing, we sustain the Examiner's obviousness rejection of claim 5 over Robertson, Tang, and *Dasan*.

Obviousness Rejections of Claims 18, 25, 26, and 37

Based on Appellant's failure to address the Examiner's prima facie case of obviousness as to (i) claims 18 and 37 over the combination of Robertson, Tang, and Kukkal; and (ii) claims 25 and 26 over the combination of Robertson, Tang, and Appelman, Appellant has failed to show that the Examiner erred in determining that the combination of Robertson, Tang, and either of Kukkal or Appelman teaches or suggests the subject matter recited in these claims. Accordingly, we summarily sustain

the Examiner's obviousness rejections of claims 18, 25, 26, and 37. *See* 37 C.F.R. § 41.37(c)(1)(iv) (requiring a statement in the briefs as to each ground of rejection presented by Appellant for review and stating that arguments not presented in the briefs will be refused consideration).

CONCLUSIONS

(1) The Examiner did not err in rejecting claims 1–4, 6–17, 19, 20, 24, 27–36, and 38–42 under 35 U.S.C. § 103(a) as being obvious over the combination of Robertson and Tang, because (a) the combination teaches or suggests limitations [A] and [B] recited in representative claim 1; and (b) there is sufficient motivation to combine as well as a reasonable expectation of success in achieving the claimed subject matter.

(2) The Examiner did not err in rejecting claim 5 under 35 U.S.C. § 103(a) as being obvious over the combination of Robertson, Tang, and Dasan, because Appellant has not sufficiently rebutted the Examiner's prima facie case that Dasan discloses limitation [C] as recited in claim 5.

(3) Appellant has not adequately shown the Examiner erred in rejecting (a) claims 18 and 37 over Robertson, Tang, and Kukkal; and (b) claims 25 and 26 over Robertson, Tang, and Appelman.

DECISION

The Examiner's obviousness rejections of claims 1–20 and 24–42 are affirmed.

Appeal 2017-002384
Application 12/258,295

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