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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* SEAN MICHAEL BRUICH and FREDERICK ROSS LEACH

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Appeal 2017-003773  
Application 13/398,714  
Technology Center 3600

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Before ST. JOHN COURTENAY III, JOHN P. PINKERTON, and  
JASON M. REPKO, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants<sup>1</sup> appeal under 35 U.S.C. § 134(a) from a final rejection of claims 1, 2, 8, 12–15, 18–20, and 24–42, which are all the claims pending in this application. Claims 3–7, 9–11, 16, 17, and 21–23 are cancelled. We have jurisdiction over the pending claims under 35 U.S.C. § 6(b).

We Affirm.

STATEMENT OF THE CASE

*Introduction*

Appellants' invention "relates to distributing electronic offers using a social networking system, and in particular to selecting a whisper code to

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<sup>1</sup> According to Appellants, the real party in interest is Facebook, Inc., of Menlo Park, California. App. Br. 1.

include with an offer when delivering the offer to users of the social networking system” (Spec. ¶ 1).

*Exemplary Claim*

1. A method comprising:

receiving from an advertiser at a social networking system an offer for redemption at a merchant establishment associated with the advertiser;

receiving a set of rules for selecting a whisper code from a plurality of whisper codes to be presented with the offer, the rules determining the whisper code to be presented based on a source of the offer to a viewing user;

receiving, from a plurality of users of the social networking system, a plurality of actions with digital content that includes the offer;

determining, based on the actions, a content item for display to a viewing user of the social networking system, the content item containing the offer;

determining a source of the content item that contains the offer, the source determined from the action on which the content item is based;

*selecting, by a computer processor, a first whisper code from the plurality of whisper codes, the selecting based on applying the set of rules to the determined source of the content item;*

generating a page of content including the content item that contains the offer and the selected whisper code in connection with the content item; and

sending the page of content for display to the viewing user.

App. Br. 18 (emphasis added to contested limitation).

*Rejections*

- A. Claims 1, 2, 8, 12–15, 18–20, and 24–42 are rejected under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter. Final Act. 5.
- B. Claims 1, 2, 8, 12–15, 18–20, and 24–42 are rejected under pre-AIA 35 U.S.C. § 103(a) as being obvious over the combined teachings and suggestions of Higgins et al. (US 8,280,766 B2, issued Oct. 2, 2012) (hereinafter “Higgins”) in view of Fordyce, III et al. (US 2011/0035278 A1, pub. Feb. 10, 2011) (hereinafter “Fordyce”).

*Grouping of Claims*

Based on Appellants’ arguments, we decide the appeal of rejection A of claims 1, 2, 8, 12–15, 18–20, and 24–42 on the basis of representative claim 1. We address the § 103 rejection B, *infra*. See 37 C.F.R. § 41.37(c)(1)(iv) (2012).

*Issues on Appeal*

Did the Examiner err in rejecting claims 1, 2, 8, 12–15, 18–20, and 24–42 under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter?

Did the Examiner err in rejecting claims 1, 2, 8, 12–15, 18–20, and 24–42 under pre-AIA 35 U.S.C. § 103(a) as being obvious over the cited combination of references?

ANALYSIS

We have considered all of Appellants’ arguments and any evidence presented. To the extent Appellants have not advanced separate, substantive arguments for particular claims, or other issues, such arguments are waived.

See 37 C.F.R. § 41.37(c)(1)(iv). We highlight and address specific findings and arguments for emphasis in our analysis below.

*Mayo/Alice Analysis under 35 U.S.C. § 101*

Under 35 U.S.C. § 101, a patent may be obtained for “any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof.” The Supreme Court has “long held that this provision contains an important implicit exception: Laws of nature, natural phenomena, and abstract ideas are not patentable.” *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2354 (2014) (quoting *Ass’n for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576, 589 (2013)). The Supreme Court in *Alice* reiterated the two-step framework previously set forth in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 566 U.S. 66, 82–84 (2012), “for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts.” *Alice*, 134 S. Ct. at 2355.

The first step in that analysis is to determine whether the claims at issue are directed to one of those patent-ineligible concepts, such as an *abstract idea*. 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. *Id.* at 2355–57.

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).

Otherwise, the inquiry proceeds to the second step in which the elements of the claims are considered “individually and ‘as an ordered combination’ to determine whether the additional elements ‘transform the

nature of the claim’ into a patent-eligible application.” *Alice*, 134 S. Ct. at 2355 (quoting *Mayo*, 566 U.S. at 79, 78). We consider the question of whether the claims are directed to a *specific improvement* in the capabilities of the computing devices, or, instead, “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, 1336 (Fed. Cir. 2016).

We, therefore, decide under step two whether the claims: (a) set forth an *inventive concept* that provides a specific means or method that *improves* the relevant technology, or (b) 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.

*The Examiner’s Rejection A under 35 U.S.C. § 101*

Regarding the first step of the *Alice/Mayo* analysis, the Examiner concludes claims 1, 2, 8, 12–15, 18–20, and 24–42 are directed to an abstract idea:<sup>2</sup>

Independent claims 1, 14, and 30 are directed to the abstract idea of tracking distribution of offers with codes, which is a *fundamental economic activity* commonly used in the industry for increasing sales and/or accounting purposes, wherein distribution takes place between several different entities, which is *a method of organizing human activities*.

Final Act. 4 (emphasis added).

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<sup>2</sup> “Patent eligibility under § 101 presents an issue of law . . . .” *Accenture Glob. Servs., GmbH v. Guidewire Software, Inc.*, 728 F.3d 1336, 1340 (Fed. Cir. 2013).

Regarding the second step of the *Mayo/Alice* analysis, the Examiner finds the claims do not include additional elements that are sufficient to amount to significantly more than the judicial exception:

Here, the additional element(s) or combination of elements in the claims other than the abstract idea per se amount to no more than: (i) mere instructions to implement the idea on a computer, and (ii) recitation of generic computer structure that serves to perform generic computer functions that are *well-understood, routine, and conventional activities* previously known to the pertinent industry.<sup>[3]</sup> Viewed as a whole, these additional claim element(s) do not provide meaningful limitation(s) to transform the abstract idea into a patent eligible application of the abstract idea such that the claim(s) amounts to significantly more than the abstract idea itself.

Final Act. 4–5 (emphasis added).

For the aforementioned reasons, the Examiner concludes that all claims 1, 2, 8, 12–15, 18–20, and 24–42 on appeal are not patent-eligible under 35 U.S.C. § 101.

#### *Mayo/Alice Analysis — Step 1*

Regarding *Alice* Step 1, Appellants argue the Examiner’s assertion that the claims are directed to “a fundamental economic practice and a method of organizing human activities is a rather generic view of the claims that ignores whole aspects of the claimed invention.” App. Br. 7.

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<sup>3</sup> The patent eligibility inquiry may contain underlying issues of fact. *Mortg. Grader, Inc. v. First Choice Loan Servs. Inc.*, 811 F.3d 1314, 1325 (Fed. Cir. 2016). In particular, “[t]he question of whether a claim element or combination of elements is well-understood, routine and conventional to a skilled artisan in the relevant field is a question of fact.” *Berkheimer v. HP Inc.*, 881 F.3d 1360, 1368 (Fed. Cir. 2018).

In support, Appellants contend, *inter alia*:

The claims as a whole are drawn to *a specific way to select a whisper code included in a content item containing an offer when the content item is presented*. For example, claim 1 receives “a set of rules for selecting a whisper code from a plurality of whisper codes to be presented with the offer, the rules determining the whisper code to be presented based on a source of the offer to a viewing user,” receives “from a plurality of users of the social networking system, a plurality of actions with digital content that includes the offer, determines “based on the actions, a content item for display to a viewing user of the social networking system, the content item containing the offer,” and selects “by a computer processor, a first whisper code from the plurality of whisper codes, the selecting based on applying the set of rules to the determined source of the content item.” Accordingly, claim 1 *does not merely track distribution of offers with codes, but uses specific information*, “a source of the content item that contains the offer” that is “determined from the action on which the content item is based” and “a set of rules for selecting a whisper code from a plurality of whisper codes” based on the “source of the offer” to select a whisper code that is included in a content item including the offer.

App. Br. 7 (emphasis added).

Appellants urge that “[t]he Final Office Action thus errs by failing to explain why the [E]xaminer’s proposed abstract idea is directed to an exception.” App. Br. 8.

Our reviewing court guides that “collecting information, including when limited to particular content (which does not change its character as information), [is] within the realm of abstract ideas” and that “analyzing information by steps people go through in their minds, or by mathematical algorithms, without more, [is] essentially [a] mental process[] within the abstract-idea category.” *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353–54 (Fed. Cir. 2016); *see also Synopsys, Inc. v. Mentor Graphics*

*Corp.*, 839 F.3d 1138, 1146 (Fed. Cir. 2016) (holding that “analyzing information by steps people go through in their minds, or by mathematical algorithms, without more, [are] mental processes within the abstract-idea category” (citation omitted)). As in *Electric Power*, the combination of various abstract ideas relating to data collection and analysis is itself an abstract idea.

Applying this guidance to the claims on appeal, we conclude at least the recited step of “receiving, from a plurality of users of the social networking system, a plurality of actions with digital content that includes the offer,” is merely a *method of collecting information* to determine, “based on the actions, a content item for display to a viewing user of the social networking system, the content item containing the offer.” Claim 1.

Turning to the Specification for *context*, we note paragraph 25 expressly describes: “Offer objects 106 may further include whisper codes 124, and targeting characteristics 108 specifying a set of rules to apply a context in which the social networking system selects whisper code 124 to present with the offer to the viewing user.” Thus, we conclude the claim language interpreted in a manner consistent with the Specification is directed to data collection and analysis.

Because the offer can be redeemed at a merchant (e.g., *see* Spec. ¶¶ 5, 21) and the offers may be, for example, *coupons* (Spec. ¶25), we agree with the Examiner that “[i]ndependent claims 1, 14, and 30 are directed to the abstract idea of tracking distribution of offers with codes, which is a *fundamental economic activity* commonly used in the industry for *increasing sales and/or accounting purposes*.” Final Act. 4 (emphasis added).

Therefore, on this record, we find Appellants' contentions regarding *Alice* Step 1 are not persuasive.

*Mayo/Alice Analysis – Step 2*

Because we conclude the claims are directed to an abstract idea for essentially the same reasons articulated by the Examiner (Final Act. 4–5; Ans. 5), we turn to the second part of the *Alice/Mayo* analysis. We analyze the claims to determine if there are additional limitations that individually, or as an ordered combination, ensure the claims amount to “significantly more” than the abstract idea. *Alice*, 134 S. Ct. at 2357.

Regarding *Alice* Step 2, Appellants address the purported *inventive concept* of the claims:

The claimed features, which are not found in any of the previously cited references, enable the social networking system to measure performance of a presented offer in different dimensions. Hence, the claims provide *an inventive concept that improves on, and does not preempt*, the alleged abstract idea of “tracking distribution of offers with codes” where “distribution takes place between several different entities.”

App. Br. 11 (emphasis added).

We find unavailing Appellants' contention that “[t]he claimed features, *which are not found in any of the previously cited references*, enable the social networking system to measure performance of a presented offer in different dimensions.” *Id.* (emphasis added).

Regarding the argued purported point of novelty (*id.*), the Supreme Court emphasizes that “[t]he ‘novelty’ of any element or steps in a process, or even of the process itself, is of *no relevance* in determining whether the subject matter of a claim falls within the § 101 categories of possibly patentable subject matter.” *Diamond v. Diehr*, 450 U.S. 175, 188–89 (1981)

(emphasis added). Our reviewing court further guides that “[e]ligibility and novelty are separate inquiries.” *Two-Way Media Ltd. v. Comcast Cable Commc’ns, LLC*, 874 F.3d 1329, 1340 (Fed. Cir. 2017); *see also Affinity Labs of Tex., LLC v. DIRECTV, LLC*, 838 F.3d 1253, 1263 (Fed. Cir. 2016) (holding that “[e]ven assuming” that a particular claimed feature was novel does not “avoid the problem of abstractness”).

Similarly, we find unpersuasive Appellants’ contention that the claims “provide *an inventive concept that improves on, and does not preempt*, the alleged abstract idea of ‘tracking distribution of offers with codes’ where ‘distribution takes place between several different entities.’” App. Br. 11 (emphasis added). Our reviewing court provides applicable guidance: “[w]hile preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility.” *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015). Therefore, we are not persuaded by Appellants’ argument regarding the absence of complete preemption.

Appellants’ arguments in the Appeal Brief essentially enumerate the claim limitations without any persuasive explanation of how the limitations either individually, or as an ordered combination, amount to an *inventive concept that converts the abstract idea* into patent-eligible subject matter.

We note each independent claim 1, 14, and 30 recites “selecting, by a *computer processor*” (emphasis added). We find none of Appellants’ claims on appeal is directed to an *improvement* in a processor, database, or other computer/network component. Our reviewing court has “repeatedly held that such invocations of computers and networks that are not even arguably inventive are ‘insufficient to pass the test of an inventive concept in the

application’ of an abstract idea.” *Elec. Power*, 830 F.3d at 1355 (citation omitted); *see also Intellectual Ventures I LLC v. Capital One Fin. Corp.*, 850 F.3d 1332, 1341 (Fed. Cir. 2017) (“Rather, the claims recite both a generic computer element—a processor—and a series of generic computer ‘components’ that merely restate their individual functions . . . . That is to say, they merely describe the functions of the abstract idea itself . . . .”).

And the Supreme Court provides further guidance in *Bilski v. Kappos*, 561 U.S. 593 (2010), that a “prohibition against patenting abstract ideas ‘cannot be circumvented by attempting to limit the use of the formula to a particular technological environment.’” *Id.* at 610 (citation omitted).

Therefore, we find none of the claim limitations, viewed “both individually and ‘as an ordered combination,’” amounts to significantly more than the judicial exception in order to sufficiently transform the nature of the claims into patent-eligible subject matter. *Alice*, 134 S. Ct. at 2355 (quoting *Mayo*, 566 U.S. at 79).

Applying the aforementioned guidance from our reviewing courts to the claims before us on appeal, we conclude, in our *Mayo/Alice* analysis, that each of Appellants’ claims 1, 2, 8, 12–15, 18–20, and 24–42, considered as a whole, is directed to (under *step one*), a *patent-ineligible abstract idea*, and under *step two*, does not recite something “*significantly more*” to transform the nature of the claim into a patent-eligible application.

Accordingly, for at least the reasons discussed above, we sustain the Examiner’s rejection under 35 U.S.C. § 101 of claims 1, 2, 8, 12–15, 18–20,

and 24–42, as being directed to patent-ineligible subject matter in light of *Alice* and its progeny.<sup>4</sup>

*Rejection B of Independent Claim 1 under § 103(a)*

**Issues:** Under pre-AIA 35 U.S.C. § 103(a), did the Examiner err by finding that Higgins and Fordyce would have *collectively* taught or suggested the contested limitation: *selecting, by a computer processor, a first whisper code from the plurality of whisper codes, the selecting based on applying the set of rules to the determined source of the content item[,] within the meaning of representative independent claim 1?*<sup>5</sup> Emphasis added.

As an initial matter of claim construction, we turn to Appellants’ Specification for *context* regarding the intended meaning and broadest reasonable interpretation of the claim 1 term “whisper code.” We particularly note the non-limiting, exemplary description for a “whisper code” found at paragraph 26 of the Specification:

Whisper code 124 may be a unique code associated with an offer that when presented to merchant 110 enables user 104 to redeem the offer. Whisper code 124 may be a term, phrase, one or more letters, numbers, characters, or symbols suitable to uniquely identify offer 122. The social networking system selects whisper code 124 for each viewing user by applying a set of rules to a context in which social networking system 100 presents the offer to user 104. Whisper code 124 may be

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<sup>4</sup> To the extent Appellants have not advanced separate, substantive arguments for particular claims, or other issues, such arguments are waived. *See* 37 C.F.R. § 41.37(c)(1)(iv).

<sup>5</sup> We give the contested claim limitations the broadest reasonable interpretation (BRI) consistent with the Specification. *See In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997).

presented to merchant 110 visually or audibly. Whisper code 124 may be provided to social networking system 100 by advertiser 102 or merchant 110. Alternatively or additionally, whisper code 124 may be generated by social networking system 100, or a third party (e.g., marketing analytics service).

In reviewing the record, we note the Examiner has not indicated any particular claim interpretation for the claim term “whisper code” as recited in each independent claim on appeal. *See* claims 1, 14, 30.

However, our reviewing court guides that “[b]oth anticipation under § 102 and obviousness under § 103 are two-step inquiries. The first step in both analyses is a proper construction of the claims . . . . The second step in the analyses requires a comparison of the properly construed claim to the prior art.” *Medichem, S.A. v. Rolabo, S.L.*, 353 F.3d 928, 933 (Fed. Cir. 2003) (citations omitted).

Here, the Examiner has overlooked the first critical step of the obviousness inquiry: *claim construction of the contested claim term(s)*. We additionally note the Examiner relies on Fordyce ¶¶ 36–40, 104, 105, 110, 111, and 257, in combination with Higgins, for teaching or suggesting the contested “selecting” limitation of representative claim 1. Final Act. 8.

Appellants contend the “selecting” limitation (recited in independent claims 1, 14, 30) is not taught or suggested by Higgins and Fordyce for at least the following reasons:

    Fordyce correlates online transaction activity with offline activity related to the same transaction. *See* Fordyce, Abstract. As disclosed by Fordyce, an offer presented to a customer includes an identifier (e.g., a “coupon code”) that is stored in association with an account of the customer. *See* Fordyce, ¶ [0037]. Via online tracking, the identifier of the offer is also associated with online activity of a user, “such as viewing an

advertisement, performing online searches, browsing web pages, or any other kind of online activities.” *See* Fordyce, ¶ [0037]. Hence, Fordyce associates an offer identifier with information about a customer to whom an offer corresponding to the offer identifier was presented. However, the steps disclosed by Fordyce relate to associating an offer identifier of an offer with a customer to whom the offer was presented, and are silent regarding selection the offer from multiple offers. In contrast, the claimed invention selects “a first whisper code from the plurality of whisper codes” by “applying the set of rules to the determined source of the content item.” The selected whisper code is subsequently included in a page of content that is sent for display. No such application of rules to select the offer that is presented to a customer and subsequently stored in associated with the customer is disclosed or suggested by Fordyce.

App. Br. 14.

Based upon our review of the record, we find a preponderance of the evidence supports Appellants’ arguments regarding rejection B under § 103(a). *See Id.*

At best, we find the multiple portions of Fordyce (¶¶ 36–40, 104, 105, 110, 111, and 257) cited by the Examiner (Final Act. 8) only teach associating “an offer identifier with information about a customer to whom an offer corresponding to the offer identifier was presented,” as argued by Appellants. App. Br. 14. Appellants also contend that Fordyce is *silent* regarding selection of the offer from *multiple offers*, and there is no application of *rules* in Fordyce to select the offer that is presented to a customer.” *Id.* However, we note that selection of an “offer” is not the same as selecting a “whisper code” (as claimed), because these claim terms have different meanings.

In response, the Examiner further explains the basis for the rejection:

[W]ithout selecting an identifier out of plurality of identifiers associated with numerous activities as described in para. [0037] of Fordyce, one would not be able to determine which online activity should be given the credit for resulting in an offline transaction, note the entire Abstract of Fordyce. Thus, Fordyce's identifier selection rules associate the selected identifier with corresponding online activity of a user to determine the source or activity that resulted in selection of the offer.

Ans. 10.

Even if the Examiner is correct that there is a teaching or suggestion of selection of an identifier (i.e., whisper code) from a plurality of identifiers in Fordyce, we find the Examiner has not fully developed the record to establish Fordyce teaches or suggests "the selecting [is] based on applying the *set of rules* to the determined source of the content item" (claim 1), as also recited using commensurate language in each of the remaining independent claims 14 and 30. Emphasis added.

In particular, we find no clear teaching or suggestion of specific rules in paragraph 37 of Fordyce. Therefore, we find the Examiner has not clearly mapped the contested claimed *rules* to the corresponding *specific* feature found in Fordyce.<sup>6</sup>

Appellants further respond in the Reply Brief:

Fordyce's disclosure discusses how an identifier may be used in conjunction with an offer, but is silent regarding selection of the identifier that is used in conjunction with the offer. Rather,

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<sup>6</sup> See 37 C.F.R. § 1.104(c)(2) ("When a reference is complex or shows or describes inventions other than that claimed by the applicant, *the particular part relied on must be designated as nearly as practicable*. The pertinence of each reference, if not apparent, *must be clearly explained* and each rejected claim specified." (emphasis added)).

Fordyce merely provides that “the offer includes an identifier,” with no disclosure or suggestion of how the identifier is included in the offer. Fordyce, ¶ [0037]. In contrast, the claimed invention specifically recites that a first whisper code for distribution with an offer is selected from a plurality of whisper codes “based on applying the set of rules to the determined source of the content item.”

The Answer references “Fordyce’s identifier selection rules associate the selected identifier with corresponding online activity of a user to determine the source or activity that resulted in selection of the offer.” Answer, p. 10. However, nowhere does Fordyce disclose or suggest “identifier selection rules.” While Fordyce provides that an IP address used by a user to make a transaction is correlated with IP addresses associated with consumer accounts to identify the consumer account of the user who made the online transaction, such a correlation does not select an identifier. See Fordyce, [¶¶] [0104], [0105], [0257]. Fordyce’s matching of IP addresses identifies users who performed a transaction from IP address information, but does not apply a set of rules to a determined source of a content item to select a first whisper code that is included in a page of content sent to a user. Rather, Fordyce uses IP address information to identify a consumer account that made a transaction. This does not select a whisper code from a plurality of whisper codes by applying “the set of rules to the determined source of the content item,” as claimed, but instead to select “a first whisper code from the plurality of whisper codes” that is included in a page of content sent to a user, as claimed.

Reply Br. 13.

To the extent the Examiner has mapped the claimed set of rules to Higgins (Final Act. 6), we find it is unclear how the selecting of identifiers (i.e., “whisper codes”) in Fordyce is *based on* the purported rules found in Higgins. We note the Examiner (*id.*) cites to multiple portions of columns 11–15 in Higgins without providing any clear explanation of the mapping of

the contested claim language to a *specific* set of rules found in Higgins. *See supra* note 6.

The Examiner paints with a broad brush, and invites the panel to perform *de novo* examination, searching through the many cited portions of Higgins. We find the Examiner provides insufficient explanations regarding the reading of particular contested claim terms on the *specific corresponding features* found in Higgins. We decline the Examiner's invitation to perform *de novo* examination.

We note that the Board is a reviewing body that does not perform initial examination. To show obviousness (or anticipation), the Examiner should provide a clear mapping of each claim limitation to the *corresponding specific feature* found in the reference, which the Examiner must identify with particularity. *See* 37 C.F.R. § 1.104(c)(2).

The *prima facie* burden has not been met and the rejection does not adhere to the minimal requirements of 35 U.S.C. § 132(a) “when a rejection is so uninformative that it prevents the applicant from recognizing and seeking to counter the grounds for rejection.” *Chester v. Miller*, 906 F.2d 1574, 1578 (Fed. Cir. 1990).

Therefore, given the absence of clear mappings by the Examiner, we find some degree of speculation would be required to affirm the Examiner on this record. We decline to engage in speculation. “A rejection . . . must rest on a factual basis . . . .” *In re Warner*, 379 F.2d 1011, 1017 (CCPA 1967). “The Patent Office has the initial duty of supplying the factual basis for its rejection. It may not . . . resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis.” *Id.*

Accordingly, we are constrained on this record to reverse the Examiner's § 103(a) rejection B of independent claim 1, and for the same reasons, we also reverse rejection B of the remaining independent claims 14 and 30, which also recite the contested "selecting" limitation using similar language having commensurate scope. Because we have reversed rejection B of all independent claims, for the same reasons, we reverse the Examiner's § 103(a) rejection B of all dependent claims on appeal.

#### *Conclusions*

The Examiner did not err in rejecting claims 1, 2, 8, 12–15, 18–20, and 24–42, under 35 U.S.C. § 101, as being directed to patent-ineligible subject matter.

The Examiner erred in rejecting claims 1, 2, 8, 12–15, 18–20, and 24–42, under pre-AIA 35 U.S.C. § 103(a), as being obvious over the combined teachings and suggestions of the cited references.

DECISION

We affirm the Examiner's decision rejecting claims 1, 2, 8, 12–15, 18–20, and 24–42, under 35 U.S.C. § 101.

We reverse the Examiner's decision rejecting claims 1, 2, 8, 12–15, 18–20, and 24–42, under pre-AIA 35 U.S.C. § 103(a).

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

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