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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte CHIRAG K. BARHATE and MAHESH S. PARADKAR

Appeal 2017-004263
Application 13/425,608
Technology Center 3600

Before ERIC S. FRAHM, JOHN P. PINKERTON, and BETH Z. SHAW,
Administrative Patent Judges.

FRAHM, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants¹ appeal under 35 U.S.C. § 134(a) from a rejection of claims 10–29. Claims 1–9 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b).

¹ According to Appellants, the real party in interest is International Business Machines, Inc. Appeal Br. 3. This case is related to the appeal in US Patent Application No. 13/483,132 (Appeal No. 2017-004249), which has an identical inventive entity and real party in interest as the instant case.

We affirm the rejections of claims 10–29 under 35 U.S.C. §§ 112, second paragraph, 101, 102(e), and 103(a).

Appellants’ application relates to “the field of data handling and, more particularly, to using the inheritance of professional-social network information to facilitate organizational position changes.” Spec. ¶ 1; *see also* Title (“Using The Inheritance of Professional-Social Network Information to Facilitate Organizational Position Changes”). Appellants claim a computer implemented system for maintaining professional-social networks including a professional-social network tool for automatically creating and maintaining a professional-social network for members using automatically captured “tacit information” (*see claims* 10, 15, 26), and for transferring “tacit knowledge” in an organization (*see claim* 26). Appellants describe “tacit information” and “tacit knowledge” in the following manner:

- (1) “Tacit information are those subtle data nuggets that members learn over time like who is the best supplier to order from or what font your supervisor prefers for document.” Spec. ¶ 2.
- (2) Tacit information is “information about a performance of the plurality of job functions of the member’s organizational position.” Appeal Br. 8 citing Spec. ¶¶ 28, 73–78.
- (3) Tacit information can include electronic communications, and “can represent items, including, but not limited to, email messages, instant messages, social network postings, text messages, shared application messages and/or data, electronic documents, Web forms, and the like.” Spec. ¶ 27.

Claim 10 recites that “tacit information” is information “about a performance of the plurality of job functions of the member’s organizational position;” claim 15 recites that “tacit knowledge comprises information regarding job functions regarding job functions associated with the first organizational position” and “tacit information” is information about “performing job functions of the second organizational position” that a member is being moved into; and, claim 26 recites “the tacit knowledge comprises information regarding job functions associated with the first organizational position.”

Claim 10 is representative of the subject matter on appeal, and is reproduced below, with emphases added to disputed portions of the claim:

10. A computer implemented system for maintaining professional-social networks comprising:
one or more processors;
one or more memories storing program instructions executable on at least one of the one or more processors;
a plurality of organizational data defining a plurality of data items for a plurality of members of an organization;
an organizational model defining a plurality of uniquely-identified organizational positions held by the plurality of members of the organization, wherein each uniquely-identified organizational position has a plurality of job functions;
a plurality of contacts representing at least one of a person, a group of people, and another organization with whom a member interacts with to perform at least one job function defined for their organizational position, wherein a contact is at least one of a member of the organization and a non-member of the organization;
an electronic communications system, comprising at least one of the one or more processors and comprising at least one of the one or more memories, configured to convey a plurality

of electronic communications between the plurality of members and the plurality of contacts; and

[A] *a professional-social network tool, comprising at least one of the one or more processors and comprising at least one of the one or more memories, configured to automatically create and maintain a professional-social network for each member based upon an automatic analysis of the plurality of electronic communications in which the member is included, wherein a professional-social network is comprised of nodes representing the member's contacts that are connected to the member by relationships that express an interaction context, [B] wherein tacit information about a performance of the plurality of job functions of the member's organizational position is automatically captured within the professional-social network.*

REJECTIONS

The Examiner made the following rejections:

(1) The Examiner rejected claims 14 and 15 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Appellants regard as the invention.² Final Act. 2–3; Ans. 2.

(2) The Examiner rejected claims 10–29 under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter, because claims 10, 15, and 26 are drawn to (a) a fundamental economic activity (e.g. maintaining social

² Because the Examiner's Answer (Ans. 2) continues to reject claims 14 and 15 under 35 U.S.C. § 112, second paragraph, as being indefinite as per the rejection made in the Final Rejection, the indefiniteness rejection of claims 14 and 15 is before us on appeal. Appellants do not contest this rejection. See Appeal Br. 12. Because Appellants do not contest the merits of the indefiniteness rejection of claims 14 and 15, no issue is presented by Appellants as to this rejection. Therefore, we sustain the indefiniteness rejection of claims 14 and 15 *pro forma*. See 37 C.F.R. § 41.37(c)(1)(iv).

networks), which is an abstract idea, and can be performed by a human using pen and paper; and (b) managing interpersonal activities, which can be considered methods of organizing human activity (Ans. 35–49).

(3) The Examiner rejected claims 10–13 under 35 U.S.C. § 102(e) as being anticipated by Skarin (US 2011/0072052 A1; published March 24, 2011). Final Act. 6–10; Ans. 3–7.

(4) The Examiner rejected claim 14 under 35 U.S.C. § 103(a) as being unpatentable over Skarin, Henderson (US 2011/0282944 A1; published Nov. 17, 2011), and Homsy (US 7,065,493 B1; issued June 20, 2006). Final Act. 10–12; Ans. 7–9.

(5) The Examiner rejected claims 15–29 under 35 U.S.C. § 103(a) as being unpatentable over either (a) the base combination of Skarin, Dunn (US 2012/0102114 A1; published April 26, 2012), and Burritt (US 2012/0110083 A1; published May 3, 2012), or (b) the base combination in view of various other references. Final Act. 12–35; Ans. 9–32.

Principal Issues on Appeal

Based on Appellants' arguments in the Appeal Brief (Appeal Br. 12–27) and the Reply Brief (Reply Br. 2–4), the following principal issues are presented on appeal:

(1) Did the Examiner err in rejecting claims 10–29 under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter, because representative claim 10, taken as a whole in light of the Specification, is directed to an abstract idea or combination of abstract ideas implemented on generic computer equipment without reciting an element or combination of elements that is (are) significantly more than the abstract idea(s) itself(themselves)?

(2) Did the Examiner err in rejecting claims 10–13 under 35 U.S.C. § 102(e) as being anticipated by Skarin; and/or claim 14 under 35 U.S.C. § 103(a) as being unpatentable over Skarin, Henderson, and Homs, because Skarin fails to disclose (a) “automatically creat[ing] and maintain[ing] a professional-social network for each member based upon an automatic analysis of the plurality of electronic communications in which the member is included” (limitation [A]); and (b) “tacit information about a performance of the plurality of job functions of the member’s organizational position” (limitation [B]), as recited in representative claim 10?

(3) Did the Examiner err in rejecting claim 14 under 35 U.S.C. § 103(a) over Skarin, Henderson, and Homs because the references are non-analogous to Appellants’ invention recited in claim 14?

(4) Did the Examiner err in rejecting claims 15–29 under 35 U.S.C. § 103(a) over the base combination of Skarin, Burritt, and Dunn because (a) Skarin fails to disclose automatically creating a professional-social network and tacit knowledge as recited in claims 15 and 26; and/or (b) the references are from different fields of endeavor and are therefore non-analogous to Appellants’ invention recited in claims 15 and 26?

ANALYSIS

Issue (1): Patent-Ineligible Subject Matter

In *Alice*, the Supreme Court reiterated the two-step framework set forth in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 132 S. Ct. 1289 (2012), for determining whether claimed subject matter is judicially-excepted from patent eligibility under § 101. *Alice Corp. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2355 (2014). Assuming that a claim nominally

falls within one of the statutory categories of machine, manufacture, process, or composition of matter, the first step in the analysis is to determine if the claim is directed to a law of nature, a natural phenomenon, or an abstract idea (judicial exceptions). *Alice*, 134 S. Ct. at 2355. For example, abstract ideas 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 claim is directed to a judicial exception, such as an abstract idea, the second step is to determine whether additional elements in the claim “transform the nature of the claim’ into a patent-eligible application.” *Id.* at 2355 (quoting *Mayo*, 132 S. Ct. at 1297). This second step is described as “a search for an “inventive concept””—*i.e.*, an element or combination of elements that is ‘. . . significantly more than . . . the [ineligible concept] itself.’” *Id.* at 2355 (alteration in original) (quoting *Mayo*, 132 S. Ct. at 1294).

“The first step in the *Alice* inquiry . . . asks whether the focus of the claims is on the 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, 1335–36 (Fed. Cir. 2016). “The abstract idea exception prevents patenting a result where ‘it matters not by what process or machinery the result is accomplished.’” *McRO, Inc. v. Bandai Namco Games America Inc.*, 837 F.3d 1299, 1312 (Fed. Cir. 2016) (quoting *O’Reilly v. Morse*, 56 U.S. (15 How.) 62, 113 (1854)). “We therefore look to whether the claims . . . focus on a specific means or method that improves the relevant technology or are instead directed to a result or effect that itself

is the abstract idea and merely invoke generic processes and machinery.”
McRO, 837 F.3d at 1314.

Further, as our reviewing court noted in *McRO*, it is important to determine “whether the claims . . . focus on a specific means or method that improves the relevant technology or are instead directed to a result or effect that itself is the abstract idea and merely invoke generic processes and machinery.” 837 F.3d at 1314. In other words, a claim that defines the way by which a computer-related result is achieved is distinguishable from a patent-ineligible claim that simply describes a result.

The second step in the *Alice* analysis requires a search for an “inventive concept” that “must be significantly more than the abstract idea itself, and cannot simply be an instruction to implement or apply the abstract idea on a computer.” *Bascom Global Internet Servs., Inc. v. AT&T Mobility LLC*, 827 F.3d 1341, 1349 (2016). There must be more than “computer functions [that] are ‘well-understood, routine, conventional activit[ies]’ previously known to the industry.” *Alice*, 134 S. Ct. at 2359 (second alteration in original) (quoting *Mayo*, 132 S. Ct. at 1294).

Step One of *Alice*

Regarding step one of *Alice*, *Enfish* held that the “directed to” inquiry asks not whether “the claims *involve* a patent-ineligible concept,” but instead whether, “considered in light of the specification, . . . ‘their character as a whole is directed to excluded subject matter.’” *Enfish*, 822 F.3d at 1335. Regarding improvements to computer-related technology, the Court in *Enfish* held as follows:

We do not read *Alice* to broadly hold that all improvements in computer-related technology are inherently abstract and, therefore, must be considered at step two. Indeed, some

improvements in computer-related technology when appropriately claimed are undoubtedly not abstract, such as a chip architecture, an LED display, and the like. Nor do we think that claims directed to software, as opposed to hardware, are inherently abstract and therefore only properly analyzed at the second step of the *Alice* analysis. Software can make non-abstract improvements to computer technology just as hardware improvements can, and sometimes the improvements can be accomplished through either route. We thus see no reason to conclude that all claims directed to improvements in computer-related technology, including those directed to software, are abstract and necessarily analyzed at the second step of *Alice*, nor do we believe that *Alice* so directs. Therefore, we find it relevant to ask whether the claims are directed to an improvement to computer functionality versus being directed to an abstract idea, even at the first step of the *Alice* analysis.

Enfish, 822 F.3d at 1335. Thus, we determine whether the claims “focus on a specific means or method that improves the relevant technology” or are “directed to a result or effect that itself is the abstract idea and merely invoke generic processes and machinery.” *McRO*, 837 F.3d at 1314.

We agree with the Examiner (Ans. 35–50) that claim 10 is drawn to a fundamental economic activity (e.g., maintaining professional-social networks) and a method of organizing human activity (e.g., managing interpersonal activities, capturing and recording a person or persons’ tacit knowledge, and disassociating members from the professional-social network), which is an abstract idea.

Claims 10, 15, and 26 recite a “computer implemented system” (claims 10 and 26) and “computer program product” (claim 15) having a “professional-social network tool” (claims 10 and 26) or “computer usable program code” (claim 15) “configured to” perform the functional results of “automatically creat[ing] and maintain[ing] a professional-social network for

each member based upon an automatic analysis of the plurality of electronic communications,” and “automatically captur[ing]” “tacit information”, but do not sufficiently describe how to achieve these results in a non-abstract way (*see e.g.*, claim 10). *Affinity Labs of Tex., LLC v. DIRECTV, LLC*, 838 F.3d 1253, 1258 (Fed. Cir. 2016) (holding that claims were directed to an abstract idea where they claimed “the function of wirelessly communicating regional broadcast content to an out-of-region recipient, not a particular way of performing that function”).

For example, independent claim 10 merely recites a “computer implemented system for maintaining professional-social networks” (claim 10) that is performed by generic computer elements (“one or more processors” and “one or more memories,” “an electronic communications system,” and “a professional-social network tool” comprising one or more of the memories and processors) for their basic functions and thus do not transform the claimed abstract idea into eligible subject matter under *Alice*. *See Content Extraction & Transmission LLC v. Wells Fargo Bank, Nat’l Ass’n*, 776 F.3d 1343, 1348 (Fed. Cir. 2014) (finding that there is no inventive concept in using a generic computer “to perform well-understood, routine, and conventional activities commonly used in industry”).

Thus, we conclude claim 10 is simply automating the abstract idea of maintaining a professional-social network by performing the operations set forth in claim 10, which we conclude is a fundamental economic practice and method of organizing human activities and, therefore, constitutes patent-ineligible subject matter. *See Alice*, 134 S. Ct. at 2357; *Bilski v. Kappos*, 561 U.S. 593, 611 (2010); *Enfish*, 822 F.3d at 1335 (“fundamental economic and

conventional business practices are often found to be abstract ideas, even if performed on a computer”).

Appellants do not rebut (*see generally* Reply Br. 2–4) the Examiner’s conclusion that the claims are directed to a fundamental activity that is an abstract idea for commercial purposes—and that such an abstract idea or ideas is/are similar to other concepts found to be abstract. *See* Ans. 41 citing *Cyberfone Systems, LLC v. CNN Interactive Group, Inc.* (Fed. Cir. 2014) (concluding collecting information, then separating and transmitting that information according to its classification is an abstract idea); *SmartGene, Inc. v. Advanced Biological Labs., SA*, 555 F. App’x 950 (Fed. Cir. 2014) (invalidating a claim to computerized application of a mental process for treating medical patients that “doctors do routinely”). Appellants’ Reply Brief neither discusses nor disputes the Examiner’s comparison of the instant claims on appeal to those found ineligible in *Cyberfone* and/or *SmartGene*.

Further, we note that examining earlier cases can have a role in deciding whether a concept that claims are found to be directed to is an abstract idea. *See Amdocs (Israel) Ltd. v. Openet Telecom, Inc.*, 841 F.3d 1288, 1294 (Fed. Cir. 2016) (“Instead of a definition [for what an ‘abstract idea’ encompasses], then, the decisional mechanism courts now apply is to examine earlier cases in which a similar or parallel descriptive nature can be seen—what prior cases were about, and which way they were decided.”).

We note the similarity of claim 10 to the concept found ineligible in *Electric Power Group, LLC v. Alstom S.A.*, 830 F.3d 1350, 1351–53 (collecting information, analyzing it, and displaying results is an abstract idea). In this regard, the claims of the instant application are similar to the

claims in *Electric Power*, which did “not go beyond requiring the collection, analysis, and display of available information in a particular field, stating those functions in general terms, without limiting them to technical means for performing the functions that are arguably an advance over conventional computer and network technology.” 830 F.3d at 1351. Specifically, our reviewing Court held that “collecting information, including when limited to particular content (which does not change its character as information), as within the realm of abstract ideas” and that “analyzing information by steps people go through in their minds, or by mathematical algorithms, without more, as essentially mental processes within the abstract-idea category.” *Id.* at 1353–54 (citations omitted).

Our conclusion that claims 10, 15, and 26 are directed to an abstract idea is supported by analogy to the Federal Circuit’s decision in *Electric Power Group*, where the court concluded claims that focused on “gathering and analyzing information of a specified content, then displaying the results,” to be directed to an abstract idea. 830 F.3d at 1354.

Here too, Appellants’ claims 10, 15, and 26 recite no more than a generic processor and storage to implement the claimed functions.

Having concluded the claims are directed to an abstract idea that is patent-ineligible, we turn to step two of the *Alice* test.

Step Two of *Alice*

Regarding step two of *Alice*, Appellants’ contentions that (i) the Examiner has not considered claim 10 as a whole, and “read out limitations that weigh against a finding in ineligibility;” and (ii) “[o]ne claim limitation missing from the rejection’s consideration is ‘creating a professional-social network tool based upon an automatic analysis of the plurality of electronic

communications in which the member is included” (see Reply Br. 2), are unpersuasive. Notably, the term “creating a professional-social network tool” does not appear in any of claims 10, 15, and/or 26. Claims 10, 15, and 26 merely recite generic computer components, such as “one or more processors” and “one or more memories” (claims 10 and 26), “a data store” and “a computer-implemented system” (claim 10 and 26), and a “computer program product” having a “storage medium” with “computer usable program code” (claim 15). And, although paragraph 28 of Appellants’ Specification describes using a professional-social network tool such as a software tool, the software tool is merely generic and performs generic functions (collecting, categorizing, acting on data). The same can be said of Appellants’ Figure 2 (see Spec. ¶¶ 11, 38–65 (describing Figure 2)), showing client devices 210 and 220 and data store 280 in “a system 200 that utilizes a professional-social network tool 245” (Spec. ¶ 38). See Appeal Br. 8, Summary of Claimed Subject Matter (supporting the “one or more processors and one or more memories” of claim 10 as elements 210 and 220 shown in Figure 2); see also Spec. ¶ 49 (describing client devices 210 and 220 as “a variety of computing devices capable of supporting operation of the communication user interface 215 and communicating with the corresponding communications application 240 over the network 295”). Paragraphs 16 through 22 of the Specification also support our understanding that the computer implemented system and data store recited in claims 10, 15, and 26 on appeal are nothing more than standard, generic computer components.

Appellants’ argument that “[n]o evidence is given that these elements are conventional and well known” (Reply Br. 3), referring to the analysis

and separation of non-professional communications from professional communications, is also unpersuasive. Appellants' drawings, in particular Figure 2, support *ignoring* electronic communications when they are not work-related (Fig. 2, step 415; Spec. ¶ 73). The Specification does not provide detailed explanation as to how the communications are separated, and simply states that “[i]t can be determined if an electronic communication is work-related in step 410,” wherein it can ensured that “social communications are not included in a member’s professional-social network” (Spec. ¶ 72).

Considering the claimed elements individually and as an ordered combination, the claims do no more than simply instruct the practitioner to implement the abstract idea on a generic computer or processor. *Alice*, 134 S. Ct. at 2359; *Dealertrack, Inc. v. Huber*, 674 F.3d 1315, 1333–34 (Fed. Cir. 2012) (“Simply adding a ‘computer aided’ limitation to a claim covering an abstract concept, without more, is insufficient to render [a] claim patent eligible.”). And, merely making the practice of an abstract idea more effective by implementing the idea on a computer does not suffice to meet the inventive concept requirement of *Alice*. See *OIP Technologies*, 788 F.3d at 1363 (“[R]elying on a computer to perform routine tasks more quickly or more accurately is insufficient to render a claim patent eligible.”).

In sum, Appellants have not demonstrated their claims provide a “solution . . . necessarily rooted in computer technology in order to overcome a problem specifically arising in the realm of computer networks,” as explained by the Federal Circuit in *DDR Holdings, LLC v. Hotels.com, LP*, 773 F.3d 1245, 1257 (Fed. Cir. 2014), or provide an “unconventional technological solution . . . to a technological problem” that “improve[s] the

performance of the system itself,” as explained in *Amdocs (Israel) Ltd. v. Openet Telecom, Inc.*, 841 F.3d 1288, 1300, 1302 (Fed. Cir. 2016).

With regard to claims 12, 20, and 27, Appellants’ contention that these claims “recite in further detail regarding analysis of the electronic communication and how the network is modified” (Reply Br. 3) is unpersuasive. Although claims 12, 20, and 27 recite automatically analyzing communications (claim 12); “determin[ing] a nature of an electronic communication,” “identify[ing] members and non-members of the organization, and “compar[ing] the identified nodes³” (claim 20); and “analysis of communications exchanged between the members and the contacts” (claim 27), these claims do not specify, or provide further detail as to, how the network is modified. Thus, these steps are nothing more than the organization of human activity to accomplish a fundamental economic activity (e.g., maintaining a social network), which is an abstract idea.

We are, therefore, not persuaded the Examiner erred by rejecting as patent-ineligible independent claims 10, 15, and 26, as well as claims 11–14, 16–25, and 27–29 depending respectively therefrom.

Issue (2): Anticipation of Claims 10–13

We have reviewed the Examiner’s anticipation rejection (Final Act. 6–10; Ans. 3–7) in light of Appellants’ arguments in the Appeal Brief (Appeal Br. 13–23) that the Examiner has erred. Appellants’ contentions in the Appeal Brief are unpersuasive of Examiner error. Because Appellants

³ According to claim 20, “each identified member and non-member is considered as a node for potential inclusion within the members’ professional-social networks.”

primarily present arguments as to claim 10, and rely on those arguments for the patentability of claims 11–13, which depend therefrom, we select claim 10 as representative of claims 10–13 rejected for anticipation. For the reasons discussed below, with regard to claim 10, we adopt as our own (1) the findings and reasons set forth by the Examiner in the Final Office Action from which this appeal is taken (Final Act. 6–9; *see also* Ans. 3–6), and (2) the reasons set forth by the Examiner in the Examiner’s Answer (Ans. 51–69) in response to Appellants’ Appeal Brief. We concur with the conclusions reached by the Examiner, and add the following for emphasis.

In formulating the anticipation rejection, the Examiner relies upon Skarin (Final Act. 9; Ans. 6, 51–69 citing Skarin Abstract; ¶¶ 13, 19, 20, 41, 53–55, 60) as disclosing limitations [A] (a tool for “automatically creat[ing] and maintain[ing] a professional-social network tacit knowledge”) and [B] (“tacit knowledge”), as recited in claim 10.

Limitation [A] of claim 10 recites, “a professional-social network tool . . . , *configured to automatically create and maintain a professional-social network* for each member based upon an automatic analysis of the plurality of electronic communications in which the member is included” (emphasis added). The Examiner finds, and we agree, that Skarin (¶¶ 19, 20, 41) discloses automatically creating and maintaining a professional-social network as recited in limitation [A] of claim 10 (Final Act. 8; Ans. 5, 67–69), and as similarly recited in claims 11–13 depending from claim 10.

Limitation [B] of claim 10 recites “tacit information about a performance of the plurality of job functions of the member’s organizational position.” The Examiner finds, and we agree, that Skarin discloses tacit

knowledge as recited in limitation [B] of claim 10 (Final Act. 9; Ans. 6, 51–67), and as similarly recited in claims 11–13 depending from claim 10.

Furthermore, Appellants neither address in the Appeal Brief, nor respond in the Reply Brief, to the Examiner’s findings relying on multiple portions of Skarin (*see generally* Ans. 51–69 citing Skarin ¶¶ 123, 125, 128, 129, 131–134).

As to Appellants’ argument that paragraph 99 of Skarin “actually teaches away from the claimed invention” (Appeal Br. 14), we do not find this line of reasoning persuasive or pertinent to our conclusion that the Examiner’s did not err in rejecting claim 10 for *anticipation*. Although a teaching away argument would be relevant to an obviousness analysis, “whether a reference ‘teaches away’ from [an] invention is inapplicable to an anticipation analysis.” *Celeritas Techs., Ltd. v. Rockwell Int’l Corp.*, 150 F.3d 1354, 1361 (Fed. Cir. 1998) (citation omitted); *see also Leggett & Platt, Inc. v. VUTEk, Inc.*, 537 F.3d 1349, 1356 (Fed. Cir. 2008) (citation omitted) (“[T]eaching away’ is irrelevant to anticipation.”).

In view of the foregoing, we sustain the Examiner’s anticipation rejection of representative claim 10, as well as claims 11–13 grouped therewith.

Issue (3): Obviousness of Claim 14 over Skarin, Henderson, and Homs

We have reviewed the Examiner’s obviousness rejection of claim 14 (Final Act. 10–12; Ans. 7–9) in light of Appellants’ arguments in the Appeal Brief (Appeal Br. 23–24) that the Examiner has erred. Appellants’ contentions in the Appeal Brief are unpersuasive of Examiner error, and notably, Appellants do not respond in the Reply Brief to the Examiner’s

response to Appellants' Appeal Brief arguments regarding the obviousness of claim 14. For the reasons discussed below, with regard to claim 14, we adopt as our own (1) the findings and reasons set forth by the Examiner in the Final Office Action from which this appeal is taken (Final Act. 10–12; *see also* Ans. 7–9), and (2) the reasons set forth by the Examiner in the Examiner's Answer (Ans. 71) in response to Appellants' Appeal Brief. We concur with the conclusions reached by the Examiner, and add the following for emphasis.

We agree with the Examiner's findings as to the individual references, and do not think it unpredictable that one of ordinary skill in the art would desire to pass along tacit information about job functions associated with a position through a professional-social network, and dissociate members from a professional-social network, in determining what professional communication/information should be passed on as tacit knowledge, as claimed.

We agree with the Examiner's findings (Ans. 71) that (i) "Skarin and Henderson are drawn to enterprise social networks and are thus in the same field of endeavor [as claim 14];" (ii) "Skarin and Homsis are drawn to operating an enterprise, and are thus in the same field of endeavor [as claim 14];" and (iii) "Homsis is particularly relevant to the problem faced by the inventor of the instant Application which is to assign a particular member of the organization to a role other than [sic] what is defined in the organization hierarchy." In light of the claimed invention's and applied art's noted similarities (*see* Ans. 9, 71), the presented evidence in the instant case on appeal establishes that the claimed invention and applied art are directed to analogous arts.

Although “the diverse Patent Office classification of the references [are] *some* evidence of ‘non-analogy’ . . . we consider the similarities and differences in structure and function of the inventions disclosed in the references to carry far greater weight.” *In re Ellis*, 476 F.2d 1370, 1372 (CCPA 1973); *In re Naren Chaganti* (Fed. Cir. 2014) (a reference need not disclose every limitation of the claimed invention to fall within the same field of endeavor as the claimed invention). And, even assuming *arguendo* the claimed invention and the applied reference in question are correctly directed to different U.S.P.T.O. search classifications, that is not persuasive evidence of non-analogous art. *See In re Mlot-Fijalkowski*, 676 F.2d 666, 670, fn. 5 (CCPA 1982) (“Such evidence is inherently weak also, because considerations in forming a classification system differ from those relating to a person of ordinary skill seeking solution for a particular problem.”). Furthermore, although search classifications are evidence of non/analogous arts, similarities of function and structure carry greater weight; *In re Deminski*, 796 F.2d at 442, fn. 3 (Fed. Cir. 1986) (“[C]ross reference in official search notes is some evidence of analogy, although the similarities and differences in structure and function of the inventions disclosed in the references . . . carry far greater weight[.]” (citation and quotation marks omitted)).

In view of the foregoing, Appellants’ contentions (Appeal Br. 23–24) that (i) Skarin, Henderson, and Homsy are from different fields of endeavor from each other because each have different U.S.P.T.O. search classifications;⁴ and (ii) Henderson and Homsy fail to solve the same

⁴ We note that Appellants’ argument as to claim 14 misapplies the standard for analogous art, as Appellants compare the classifications of the references

problem as the subject matter of claim 14, are unpersuasive. As a result, we sustain the Examiner's obviousness rejection of claim 14.

Issue (4): Obviousness of Claims 15–29 Over the Base Combination of Skarin, Dunn, and Burritt

We have reviewed the Examiner's obviousness rejections of claims 15–29 (Final Act. 12–22; Ans. 9–20) in light of Appellants' arguments in the Appeal Brief (Appeal Br. 24–27) that the Examiner has erred. Appellants' contentions are unpersuasive of Examiner error, and notably, Appellants do not respond in the Reply Brief to the Examiner's response to Appellants' Appeal Brief arguments regarding the obviousness of claims 15 and 26. For the reasons discussed below, with regard to claims 15 and 26, we adopt as our own (1) the findings and reasons set forth by the Examiner in the Final Office Action from which this appeal is taken (Final Act. 12–22; *see also* Ans. 9–19), and (2) the reasons set forth by the Examiner in the Examiner's Answer (Ans. 72–76) in response to Appellants' Appeal Brief. We concur with the conclusions reached by the Examiner, and add the following for emphasis.

We agree with the Examiner's findings as to the individual references, and do not think it unpredictable that one of ordinary skill in the art would desire to pass along tacit information about job functions associated with a position through a professional-social network, and dissociate members from

with each other. The proper comparison would be of the classification of the subject matter of claim 14 with the classifications of each of the applied references. However, even if we consider Appellants to argue under the proper standard, the argument is not persuasive as it pertains to classifications which are inherently weak evidence of non-analogy.

a professional-social network, in determining what professional communication/information should be passed on as tacit knowledge, as claimed.

We agree with the Examiner’s findings (Ans. 72) that (i) “both Skarin and Dunn are drawn to professional social networks and are thus in the same field of endeavor [as claims 15 and 26];” (ii) “both Skarin and Burritt are drawn to enterprise social networks and are thus in the same field of endeavor [as claims 15 and 26].” In light of the claimed invention’s and applied art’s noted similarities (*see* Ans. 13, 14, 72), the presented evidence in the instant case on appeal establishes that the claimed invention and applied art are directed to analogous arts.

In view of the foregoing, Appellants’ contentions (Appeal Br. 24–25) (i.e., that Dunn and Burritt have different U.S.P.T.O. search classifications from Skarin and are thus from different fields of endeavor⁵) are unpersuasive. *See In re Mlot-Fijalkowski*, 676 F.2d at 670; *In re Deminski*, 796 F.2d at 442, fn. 3.

Appellants contend (Appeal Br. 25–27) claims 15 and 26, from which claims 16–25 and 27–29 respectively depend, are not obvious over the base combination of Skarin, Dunn, and Burritt for the same reasons presented as to claim 10 rejected as anticipated by Skarin, namely that Skarin fails to

⁵ We note that Appellants’ argument as to claims 15 and 26 misapplies the standard for analogous art, as Appellants compare the classifications of the references with each other. The proper comparison would be of the classification of the subject matter of claims 15 and 26 with the classifications of each of the applied references. However, even if we consider Appellants to argue under the proper standard, the argument is not persuasive as it pertains to classifications, which are inherently weak evidence of non-analogy.

disclose the recited “tacit information” and/or “tacit knowledge.” We find these contentions as to the obviousness rejections of claims 15–29 unpersuasive for the same reasons already discussed with respect to the anticipation rejection of claim 10 over Skarin.

As a result, we sustain the Examiner’s obviousness rejections of claim 15–29, which all rely on the base combination of Skarin, Dunn, and Burritt.

CONCLUSIONS

(1) Appellants have not shown the Examiner erred in rejecting claims 14 and 15 under 35 U.S.C. § 112, second paragraph, as being indefinite.

(2) The Examiner did not err in rejecting claims 10–29 under 35 U.S.C. § 101 as being directed toward patent-ineligible subject matter.

(3) The Examiner did not err in rejecting claims 10–13 under 35 U.S.C. § 102(e) as being anticipated by Skarin.

(4) The Examiner did not err in rejecting claims 14–29 under 35 U.S.C. § 103(a) over the base combination of Skarin in view of various other references.

DECISION

We affirm the Examiner’s decision to reject:

(1) claims 14 and 15 under 35 U.S.C. § 112, second paragraph, as being indefinite;

(2) claims 10–29 under 35 U.S.C. § 101 as being drawn to patent ineligible subject matter;

(3) claims 10–13 under 35 U.S.C. § 102(e) as being anticipated by Skarin; and

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(4) claims 14–29 under 35 U.S.C. § 103(a) as being obvious over the base combination of Skarin in view of various other references.

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. § 41.50(f).

AFFIRMED