



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/545,257	07/10/2012	Shawn P. Firminger	SE1-1141-US	5120
80118	7590	03/28/2018	EXAMINER	
Constellation Law Group, PLLC P.O. Box 580 Tracyton, WA 98393			TRAN, MAI T	
			ART UNIT	PAPER NUMBER
			2124	
			NOTIFICATION DATE	DELIVERY MODE
			03/28/2018	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

admin@constellationlaw.com
Tyler@constellationlaw.com
ISFDocketInbox@intven.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte SHAWN P. FIRMINER, JASON GARMS,
EDWARD K. Y. JUNG, CHRIS D. KARKANIAS,
ERIC C. LEUTHARDT, ROYCE A. LEVIEN, ROBERT W. LORD,
MARK A. MALAMUD, JOHN D. RINALDO JR.,
CLARENCE T. TEGREENE, KRISTIN M. TOLLE,
and LOWELL L. WOOD JR.

Appeal 2017-006987
Application 13/545,257
Technology Center 2100

Before JOHN A. JEFFERY, DENISE M. POTHIER, and
JOHN D. HAMANN, *Administrative Patent Judges*.

JEFFERY, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants¹ appeal under 35 U.S.C. § 134(a) from the Examiner's decision to reject claims 191 and 200–209. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

STATEMENT OF THE CASE

Appellants' invention enables selecting a hypothesis identifying at least a relationship between different event types, and presents advisories

¹ "The real party in interest in this appeal is Searete LLC." Br. 5.

related to the hypothesis. *See generally* Abstract; Spec. ¶¶ 9-0014–31.²

Claim 191 is illustrative:

A computationally-implemented method, comprising:
selecting, by one or more processors, at least one hypothesis from a plurality of hypotheses relevant to a user, the selection of the at least one hypothesis being based, at least in part, on at least one reported event associated with the user that was reported via one or more social networking entries; and
presenting one or more advisories related to the hypothesis.

THE REJECTIONS

The Examiner rejected claims 191 and 200–209 under 35 U.S.C. § 101 as directed to patent ineligible subject matter. Ans. 3–6.³

The Examiner rejected claims 191 and 200 on the ground of nonstatutory double patenting as unpatentable over claim 1 of U.S. Patent No. 8,224,956 (“’956 patent”).⁴ Ans. 7–8, 10–11.

The Examiner rejected claim 191 on the ground of nonstatutory double patenting as unpatentable over claim 42 of the ’956 patent. Ans. 8–10.

The Examiner rejected claim 202 on the ground of nonstatutory double patenting as unpatentable over claim 3 of the ’956 patent. Ans. 8, 11.

² Throughout this opinion, we refer to the Substitute Specification filed September 27, 2012.

³ Throughout this opinion, we refer to the Appeal Brief filed May 31, 2016 (“Br.”) and the Examiner’s Answer mailed October 28, 2016 (“Ans.”).

⁴ Although the Examiner rejects claims 191 and 200 separately over claim 1 of the ’956 patent, we nonetheless consolidate those rejections here for brevity.

The Examiner rejected claim 203 on the ground of nonstatutory double patenting as unpatentable over claim 39 of the '956 patent. Ans. 9, 11–12.

The Examiner rejected claim 208 on the ground of nonstatutory double patenting as unpatentable over claim 35 of U.S. Patent No. 8,180,830. Ans. 9, 12.

The Examiner rejected claim 209 on the ground of nonstatutory double patenting as unpatentable over claim 36 of U.S. Patent No. 8,244,858. Ans. 9, 12.

The Examiner rejected claims 191 and 200–209 under 35 U.S.C. § 103 as unpatentable over Shoemaker (US 7,885,902 B1, issued Feb. 8, 2011) and Bal (US 2010/0010866 A1, published Jan. 14, 2010). Ans. 13–19.

THE DOUBLE PATENTING REJECTIONS

Because Appellants do not contest the Examiner's double patenting rejections of claims 191, 200, 202, 203, 208, and 209 (Ans. 7–12), we summarily sustain these rejections. *See* MANUAL OF PATENT EXAMINING PROCEDURE (MPEP) § 1205.02 (9th ed. Rev. 08.2017, Jan. 2018) (“If a ground of rejection stated by the examiner is not addressed in the appellant’s brief, appellant has waived any challenge to that ground of rejection and the Board may summarily sustain it, unless the examiner subsequently withdrew the rejection in the examiner’s answer.”).

THE PATENT ELIGIBILITY REJECTION

The Examiner finds that the claims are directed to the abstract idea of selecting hypotheses, and that the additional elements reciting presenting related advisories do not add significantly more to the abstract idea. Ans. 4–6. According to the Examiner, the recited advisories are insignificant extra-solution activity that is routine and conventional in the field. Ans. 6. The Examiner adds that the claims merely recite basic computing functionality to implement steps that are otherwise performed mentally. *Id.*

Appellants contend that not only are the Examiner’s ineligibility assertions conclusory and unsupported, the Examiner disregards the recited hypothesis selection as based at least partly on an event associated with the user that was reported via one or more social networking entries as claimed. Br. 7–10. According to Appellants, the independent claims, when viewed as a whole, are directed to an abstract idea, and include features that would lead one of ordinary skill in the art to conclude that the claims are directed to ineligible subject matter. Br. 9–10.

ISSUE

Has the Examiner erred in rejecting claims 191 and 200–209 by concluding that they are directed to ineligible subject matter under § 101? This issue turns on whether the claimed invention is directed to a patent-ineligible abstract idea and, if so, whether the claim’s elements—considered individually and as an ordered combination—transform the nature of the claim into a patent-eligible application of that abstract idea.

ANALYSIS

To determine whether claims are patent eligible under § 101, we apply the Supreme Court’s two-step test articulated in *Alice Corp. Proprietary Ltd. v. CLS Bank International*, 134 S. Ct. 2347 (2014). First, we determine whether the claims are directed to a patent-ineligible concept: laws of nature, natural phenomena, and abstract ideas. *Id.* at 2354–55. If so, we then proceed to the second step and examine the claim’s elements—both individually and as an ordered combination—to determine whether the claim contains an “inventive concept” sufficient to transform the claimed abstract idea into a patent-eligible application. *Id.* at 2357.

Alice Step One

Applying *Alice* step one, we are not persuaded of error in the Examiner’s finding that the claimed invention is directed to an abstract idea, namely selecting hypotheses (Ans. 6)—an abstract idea that Appellants apparently acknowledge. *See* Br. 9–10 (acknowledging that the independent claims, when viewed as a whole, are *not only directed to an abstract idea*, but also include features that would not lead one to conclude that the claims are directed to ineligible subject matter).

Our emphasis underscores Appellants’ apparent acknowledgement that the independent claims are directed to an abstract idea, and disagreement with the Examiner’s finding that the additional recited elements do not add significantly more to the abstract idea. *See* Br. 8–10. In other words, Appellants apparently do not contest the Examiner’s findings with respect to *Alice* step one, but rather contest *Alice* step two. *See id.*

But even if Appellants somehow dispute the Examiner’s findings regarding *Alice* step one (which they do not), namely that the claimed invention is directed to the abstract idea of selecting hypotheses, we are still unpersuaded of error in those findings. Independent claim 191 recites two steps: (1) selecting, by at least one processor, at least one hypothesis from plural hypotheses relevant to a user, where the selection is based at least partly on an event associated with user that was reported via one or more social networking entries, and (2) presenting one or more advisories related to the hypothesis.

According to Appellants’ Specification, a “hypothesis” may define one or more relationships or links between different types of events including, for example, (1) a first event type that may reflect a user’s subjective state (e.g., “happy”), and (2) a second event type when, for example, a favorite sports team wins a game. Spec. ¶ 9-0014. As the Specification explains, these relationships between different event types can be spatial or temporal, and the associated hypothesis may indicate the strength or weakness of the link between these event types. *Id.* ¶¶ 9-0014–16.

A hypothesis may assist a user in various ways, for example, by (1) modifying behavior, (2) alerting the user that a pattern of events occurs repeatedly, (3) assisting advertisers in developing targeted marketing schemes, and (4) treating ailments. *Id.* ¶ 9-0017. In one aspect, the user associated with the hypothesis can be a microblogger or social networking user, and the hypothesis can determine a pattern of repeated events regarding that user. *Id.* ¶¶ 9-0017–9-0020. For example, if a microblogger reports repeatedly that he or she has an upset stomach after visiting a particular

restaurant, a hypothesis can be created suggesting that the user's stomach will be upset after visiting that restaurant. *Id.* ¶ 9-0018. The hypothesis, however, can be weakened if the user later reports that the user's stomach was not upset after eating at that restaurant. *Id.*

After a particular hypothesis is selected, one or more advisories are presented that may include (1) presenting the selected hypothesis, (2) an alert regarding past events related to the hypothesis, (3) a recommendation for future action based on the hypothesis, (4) a prediction of a future event based on the hypothesis, or (5) other types of advisories. *Id.* ¶ 9-0031.

Given this functionality, we see no error in the Examiner's finding that the recited limitations are directed to the abstract idea of selecting hypotheses—a finding that is undisputed as noted previously. Not only is a hypothesis an idea of itself, but the fact that such an idea is *selected* based on events reported via social networking entries is likewise abstract.

Although the Examiner finds that claim 1's last clause reciting presenting advisories related to the hypothesis is insignificant extra-solution activity (Ans. 6), this presentation step along with the selecting step collectively constitutes an abstract idea that is not limited to selecting hypotheses, but also includes the abstract idea of advising based on selected hypotheses. That the recited advisory need only *merely present the selected hypothesis* as noted in paragraph 9-0031 of the Specification only further bolsters the Examiner's finding that the claim is directed to an abstract idea.

Furthermore, it well settled that collecting information is within the realm of abstract ideas—even when the information is limited to particular content. *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016). It is also well settled that analyzing information by steps people

go through in their minds, or by mathematical algorithms, without more, are essentially mental processes within the abstract idea category. *Id.* at 1354. And merely presenting the results of abstract processes of collecting and analyzing information, without more (such as identifying a particular tool for presentation), is abstract as an ancillary part of such collection and analysis. *Id.*

Similar to the claims at issue in *Electric Power*, the claimed invention here gathers, manipulates, analyzes, and presents information of a specified content, but does not use any particular inventive technology for performing those functions.

We, therefore, agree with the Examiner that claim 191 is directed to an abstract idea.

Alice Step Two

Nor do the recited elements—considered individually and as an ordered combination—transform the nature of claim 191 into a patent-eligible application of the abstract idea to ensure that the claim amounts to significantly more than that idea. *See Alice*, 134 S. Ct. at 2357.

That (1) the recited method is “computationally-implemented,” (2) the recited selection is performed by one or more processors (unlike the presenting step), and (3) the selection is based on events reported via one or more social networking entries, does not change our conclusion. As the Examiner indicates (Ans. 6), the claimed invention merely uses generic computing components to do that which can be performed mentally or with a pen and paper—exclusive mental functions ineligible for patent protection

under § 101. *See Cybersource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1372 (Fed. Cir. 2011).

Even assuming, without deciding, that the recited components add efficiency, any speed increase comes from the capabilities of the generic computer components—not the recited process itself. *See FairWarning IP, LLC v. Iatric Systems, Inc.*, 839 F.3d 1089, 1095 (Fed. Cir. 2016) (citing *Bancorp Services, LLC v. Sun Life Assurance Co.*, 687 F.3d 1266, 1278 (Fed. Cir. 2012) (“[T]he fact that the required calculations could be performed more efficiently via a computer does not materially alter the patent eligibility of the claimed subject matter.”)). Like the claims in *FairWarning*, the focus of claim 191 is not on an improvement in computer processors as tools, but on certain independently abstract ideas that use generic computing components as tools. *See FairWarning*, 839 F.3d at 1095.

In short, merely reciting these generic computing components cannot transform a patent-ineligible abstract idea into a patent-eligible invention. *Id.* at 2358. In other words, merely reciting an abstract idea while adding the words “apply it with a computer” does not render an abstract idea non-abstract: there must be more. *See Alice*, 134 S. Ct. at 2359. Nor does the claimed invention improve the computer processor device’s functionality or efficiency, or otherwise change the way that device functions. *Cf. Enfish LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335 (Fed. Cir. 2016).

That the recited hypothesis is selected based on events reported via social networking entries is merely information that is gathered and used as a basis for this selection. Such data gathering steps, however, are insignificant extra-solution activity that is insufficient to render the claim

patent-eligible. *See In re Bilski*, 545 F.3d 943, 963 (Fed. Cir. 2008) (en banc), *aff'd on other grounds*, 561 U.S. 593 (2010) (characterizing data gathering steps as insignificant extra-solution activity).

We reach a similar conclusion regarding the recited advisory presentation for, here again, such a presentation is insignificant extra-solution activity as the Examiner indicates. Ans. 6. Leaving aside the fact that the recited presentation need not use a processor under the terms of claim 191—unlike the recited hypothesis selection—this presentation is merely insignificant post-solution activity that does not add significantly more to the abstract idea to render the claimed invention patent-eligible. *See Bilski*, 545 F.3d at 957; *see also Parker v. Flook*, 437 U.S. 584, 590 (1978) (insignificant post-solution activity found to be insufficient to impart patentability). *Accord Apple, Inc. v. Ameranth, Inc.*, 842 F.3d 1229, 1242 (Fed. Cir. 2016). And, as noted previously, merely presenting the results of abstract processes of collecting and analyzing information, without more (such as identifying a particular tool for presentation), is abstract as an ancillary part of such collection and analysis. *Elec. Power*, 830 F.3d at 1354.

That the recited advisory need only *merely present the selected hypothesis* as noted in paragraph 9-0031 of the Specification only further bolsters the Examiner's findings in this regard.

For the foregoing reasons, the recited elements—considered both individually and as an ordered combination—do not contain an “inventive concept” sufficient to transform the claimed abstract idea into a patent-eligible application. Therefore, we are not persuaded that the Examiner

erred in rejecting claim 191, and claims and 200–209, not argued separately with particularity.

THE OBVIOUSNESS REJECTION

Regarding claim 191, the Examiner finds that Shoemaker’s system selects at least one hypothesis from plural hypotheses relevant to a user, where the selection is based on at least one reported event associated with the user—an event that is said to correspond to past interaction and/or input sample user profile data. Ans. 14, 21. The Examiner also finds that Shoemaker presents hypothesis-related advisories by providing recommendations based on a set of hypotheses. Ans. 15. Although the Examiner acknowledges that Shoemaker’s events are not reported via one or more social networking entries, the Examiner nevertheless cites Bal for teaching this feature in concluding that the claim would have been obvious. Ans. 14–15.

Appellants argue that the Examiner does not establish a prima facie case of unpatentability of the pending claims. Br. 10–40. According to Appellants, the recited features are not disclosed by the cited portions of the prior art, nor is there a broadest reasonable interpretation of record that would account for several recited limitations. Br. 40–49. Specifically, Appellants contend that the Examiner failed to provide objectively verifiable evidence that supports the alleged conclusory statement that the cited prior art discloses the recited hypothesis selection. *Id.*

ISSUE

Under § 103, has the Examiner erred in rejecting claim 191 by finding that Shoemaker and Bal collectively would have taught or suggested selecting, by at least one processor, at least one hypothesis from plural hypotheses relevant to a user, where the selection is based at least partly on an event associated with user that was reported via one or more social networking entries (the “selection limitation”)?

ANALYSIS

On this record, we see no error in the Examiner’s obviousness rejection of independent claim 191. Despite Appellants’ arguments to the contrary (Br. 42–49), Appellants do not squarely address—let alone persuasively rebut—the Examiner’s mapping the recited “reported event” to the past interactions or input sample user profile data that are used to generate Shoemaker’s hypotheses 120 as shown in Figure 1. *See* Ans. 20–21 (citing Shoemaker, col. 2, ll. 58–66); *see also* Shoemaker, col. 7, ll. 4–56).

Notably, these hypotheses are employed to correlate features of a date seeker with those of possible match candidates to provide associated recommendations—recommendations that reasonably correspond to the presented hypothesis-related advisories in claim 191. *See* Ans. 15; *see also* Shoemaker, col. 8, ll. 10–49; col. 9, ll. 32–34. That Shoemaker’s system uses these hypotheses as a basis for providing associated recommendations at least suggests that at least one hypothesis is at least selected to achieve that end. *See* Shoemaker, col. 8, ll. 10–49; col. 9, ll. 32–34.

Although Shoemaker does not indicate explicitly that the relied-upon “reported events” were reported from social networking entries as the Examiner acknowledges (Ans. 15), we nevertheless see no error in the Examiner’s reliance on Bal for teaching that obtaining data from social networking sources is known in the art by tracking interactions on social networking sites in paragraph 16, and that reporting such data in Shoemaker would have been at least an obvious variation. Such an enhancement uses prior art elements predictably according to their established functions—an obvious improvement. *See KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 417 (2007).

Therefore, we are not persuaded that the Examiner erred in rejecting claim 191, and claims 200–209 not argued separately with particularity.

CONCLUSION

The Examiner did not err in rejecting claims 191, 200, 202, 203, 208, and 209 under the ground of obviousness-type double patenting. Nor did the Examiner err in rejecting claims 191 and 200–209 under §§ 101 and 103.

DECISION

We affirm the Examiner’s decision to reject claims 191 and 200–209.

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