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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte LEE LINDEN and BENJAMIN LEWIS

Appeal 2017-008460
Application 13/615,321¹
Technology Center 3600

Before MARC S. HOFF, JASON J. CHUNG, and JOYCE CRAIG,
Administrative Patent Judges.

CRAIG, *Administrative Patent Judge.*

DECISION ON APPEAL

Appellants² appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1–20, which are all of the claims pending in this application. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

¹ According to Appellants, this application is related to copending Application No. 13/615,289; copending Application No. 13/615,307; and copending Application No. 13/615,328, all currently on appeal. App. Br. 1.

² According to Appellants, the real party in interest is Facebook, Inc. App. Br. 1.

INVENTION

Appellants' invention relates to a method for enabling a gift transaction. Spec. 1. Claim 1 is illustrative and reads as follows:

1. A method comprising:

receiving a gift request from a sender, the gift request corresponding to an event and specifying a recipient;

identifying, by at least one processor, a nature of the event based on communications on an online social network;

identifying a time window based upon the nature of the event;

accessing a time-specific list of previous gifts comprising gifts previously selected for the recipient by other senders within the identified time window based upon the nature of the event;

generating, by the at least one processor, a list of suggested gifts utilizing the time-specific list of previous gifts selected for the recipient by other senders within the identified time window;

providing to the sender the generated list of suggested gifts based on the time-specific list of previous gifts selected for the recipient by other senders within the identified time window;

receiving, from the sender, a selection of a gift item for the recipient from the list of suggested gifts;

requesting approval, by the at least one processor via the online social network, of the gift item from the recipient;

posting, by the at least one processor in response to approval of the gift item by the recipient but prior to purchase of the modified gift item³ by the sender for the recipient, a notification of the modified gift item and the event corresponding to the gift request to the online social network, the notification accessible to the recipient, the sender, and one or more other third

³ In the event of further prosecution, we leave it for the Examiner to determine whether there is proper antecedent basis for the limitation "the modified gift item," as recited in independent claims 1 and 13.

party users of the online social network and identifying the sender, the recipient, and the modified gift;

sending a message to the sender of the modified gift item indicating that the notification of the modified gift item and the event corresponding to the gift request has been posted to the online social network; and

completing, by the at least one processor, a purchase of the gift item by the sender.

REJECTIONS

Claims 1–20 stand rejected under 35 U.S.C. § 101 because the claimed invention is directed to a judicial exception, without significantly more. Final Act 2–4.

Claims 1–3, 6–15, and 17–20 stand rejected under pre-AIA 35 U.S.C. § 103(a) as unpatentable over the combination of O’Sullivan et al. (US 2010/0280879 A1; published Nov. 4, 2010) (“O’Sullivan”), Morgenstern (US 2008/0189188 A1; published Aug. 7, 2008), and Jacobi et al. (US 2008/0154632 A1; published June 26, 2008) (“Jacobi”). Final Act. 4–9.

Claims 4, 5, and 16 stand rejected under pre-AIA 35 U.S.C. § 103(a) as unpatentable over the combination of O’Sullivan, Morgenstern, Jacobi, and Lee et al. (US 2009/0171804 A1; published July 2, 2009) (“Lee”). Final Act. 9–11.

Claim 1 stands provisionally rejected on the ground of nonstatutory double patenting as unpatentable over claim 1 of copending Application No. 13/615,289, claim 1 of copending Application No. 13/615,321, and claim 1 of copending Application No. 13/615,307. Final Act. 11–12.

ANALYSIS

We have reviewed the rejections of claims 1–20 in light of Appellants’ arguments that the Examiner erred. We have considered in this

decision only those arguments Appellants actually raised in the Briefs. Any other arguments Appellants could have made, but chose not to make, in the Briefs are waived. *See* 37 C.F.R. § 41.37(c)(1)(iv).

Appellants' arguments are not persuasive of error. We agree with and adopt as our own the Examiner's findings of facts and conclusions as set forth in the Answer (Ans. 4–13) and in the Action (Final Act. 2–13) from which this appeal was taken. We provide the following explanation for emphasis.

Rejection of Claims 1–20 under 35 U.S.C. § 101

Under 35 U.S.C. § 101, an invention is patent-eligible if it claims a “new and useful process, machine, manufacture, or composition of matter.” 35 U.S.C. § 101. The Supreme Court, however, has long interpreted § 101 to include an implicit exception: “[l]aws of nature, natural phenomena, and abstract ideas” are not patentable. *See, e.g., Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 134 S. Ct. 2347, 2354 (2014). In determining whether a claim falls within the excluded category of abstract ideas, we are guided in our analysis by the Supreme Court's two-step framework, described in *Mayo* and *Alice*. *Alice*, 134 S. Ct. at 2355 (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 76–77 (2012)).

In accordance with that framework, we first determine whether the claim is “directed to” a patent-ineligible abstract idea. *See id.* at 2356. If the claim is “directed to” a patent-ineligible abstract idea, we then consider the elements of the claim—both individually and as an ordered combination—to assess whether the additional elements transform the nature of the claim into a patent-eligible application of the abstract idea. *Id.* at 2355. This is a search for an “inventive concept”—an element or

combination of elements sufficient to ensure that the claim amounts to “significantly more” than the abstract idea itself. *Id.* (internal quotations and citation omitted). The Court acknowledged in *Mayo* that “all inventions at some level embody, use, reflect, rest upon, or apply laws of nature, natural phenomena, or abstract ideas.” *Mayo*, 566 U.S. at 71. We, therefore, look to 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. *See Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1336 (Fed. Cir. 2016).

In rejecting independent claims 1 and 13, and dependent claims 2–12 and 14–20, under 35 U.S.C. § 101, the Examiner determined the claims are directed to an abstract idea of “gift shopping,” i.e., a “fundamental economic practice.” Final Act. 3. The Examiner also determined the claims as a whole do not amount to significantly more than the abstract idea itself. *Id.* at 3–4.

Alice Step 1: Abstract Idea

As to the first step of the *Alice* inquiry, Appellants contend the Examiner erred by inventing an abstract idea and not citing case authority for the conclusion that “gift shopping” is an abstract idea akin to a fundamental economic practice and a method of organizing human activity. App. Br. 13.

We are not persuaded of error. To determine whether the claims at issue are directed to an abstract idea, we need only look to other decisions where similar concepts were previously found abstract by the courts. *See Amdocs (Israel) Limited 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 agree with the Examiner that the claimed invention resembles the claims at issue in *Alice*. See Final Act. 2–3; see also Ans. 5. Claim 1 is directed to gift shopping, whereby a list of suggested gifts is generated for a sender from a list of gifts previously selected for the recipient by other senders within a time window, a request for approval of a selected gift is sent to the recipient, a notification of the gift is posted on an online social network, and payment is initiated for the gift item. Gift shopping is a fundamental economic practice, long prevalent in our system of commerce, like the risk hedging in *Bilski* (see *Bilski v. Kappos*, 561 U.S. 593 (2010)) and the intermediated settlement in *Alice* (see *Alice*, 134 S. Ct. at 2356–57). Thus, gift shopping, like the fundamental economic practices above, is an “abstract idea” beyond the scope of § 101. See *Alice*, 134 S. Ct. at 2356.

Accordingly, we see no error in the Examiner’s conclusion that the claims are directed to a fundamental economic practice. See Final Act. 2–3; see also Ans. 5–10.

Appellants next argue that the Examiner’s analysis overly generalizes the claims because “the actual claims contain numerous steps that are not involved in the concept of ‘gift shopping.’” App. Br. 16. Appellants assert that the Examiner merely copied and pasted the claim language and concluded, without further analysis, that all of the elements are ““directed to the abstract idea.”” *Id.* at 15.

We are not persuaded of error. Appellants’ argument does not address the Examiner’s determinations as to which claim elements are part of the

abstract idea and which are additional elements. *See* Ans. 6. For example, the Examiner determined that the generating and posting steps being performed “by the at least one processor,” and the social network being “online” are additional elements that are not part of the abstract idea. *Id.* Additional elements are addressed in step 2 of the *Alice* analysis, which endeavors to identify additional elements “sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself.” *Alice*, 134 S. Ct. at 2355 (quoting *Mayo*, 566 U.S. at 73).

Appellants also argue the claims are directed to concrete, patent-eligible concepts, not mere “gift shopping.” App. Br. 17. In Appellants’ view, the claims are directed to

systems and methods for generating suggested gifts utilizing a time-specific list of previous gifts selected for a recipient by other senders within a time window selected based on the nature of an event identified from communications in an online social network and utilizing the online social network to provide digital notifications and messages to a sender of a gift item (and recipients and other third party users of the social networking system) prior to the sender purchasing a gift.

Id. (citing *Enfish*).

We are not persuaded. In *Enfish*, “the plain focus of the claims is on an improvement to [the] computer functionality itself.” *Enfish*, 822 F.3d at 1336. In contrast, we do not find a claimed focus on an improvement to the computer functionality here. Appellants point to the Specification, but none of the cited paragraphs explains how using a social networking system to provide digital notifications and messages prior to a sender purchasing a gift improves any computer functionality. *See* App. Br. 18 (citing Spec. ¶¶ 18, 50, 55, 56). We agree with the Examiner that the claims are directed to

solving a business or commercial problem, not a technical problem. *See* Ans. 7.

For these reasons, we are not persuaded of error in the Examiner’s determination that the claims are directed to “gift shopping,” which is a fundamental economic practice and an “abstract idea.”

Alice Step 2: Inventive Concept

As to the second step of the *Alice* inquiry, Appellants argue “the actual elements of the claims go far beyond the general idea of ‘gift shopping.’” App. Br. 19. As in step 1 of the *Alice* analysis, Appellants again identify claim elements that Appellants do not consider part of the abstract idea of “gift shopping.” *Id.* Appellants argue that the Examiner failed to analyze any additional elements in step 2 because the Examiner determined that all of the claim elements are directed to the abstract idea of “gift shopping” in step 1. *See id.*

Appellants’ arguments are not persuasive. The question in step 2 of the *Alice* analysis is not whether there are additional elements in the claims, but whether the additional elements add anything “significantly more” to transform the abstract concept into patentable eligible subject matter. *Alice*, 134 S. Ct. at 2355. The Examiner identified the recited generating and posting “by at least one processor” and the recited social network being “online” as additional elements. Ans. 6, 8. The Examiner determined that the additional limitations are nothing more than instructions to perform the abstract idea on a generic computer. *Id.* at 8. Appellants have not challenged the Examiner’s determinations with regard to the additional elements identified by the Examiner. Nor have Appellants argued that any

additional element adds something “significantly more” such that the claims are patent-eligible. *See* App. Br. 17–21.

For example, Appellants do not argue that any of the elements of claims 1 and 13 are individually inventive. *See* App. Br. 18–19. Instead, in the Reply Brief (Reply Br. 7–8), Appellants rely on *DDR Holdings, LLC v. Hotels.com L.P.*, 773 F.3d 1245 (Fed. Cir. 2014), in which the Federal Circuit found claims were “necessarily rooted in computer technology in order to overcome a problem specifically arising in the realm of computer networks” because they addressed a technical issue unique to Internet website problems. 773 F.3d at 1257.

Here, unlike in *DDR Holdings*, the claims merely use technology to address issues of communication between gift senders, gift recipients, and others, without solving any underlying technological issues. As recognized by the Supreme Court, “the mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention.” *See Alice*, 134 S. Ct. at 2358–59 (concluding claims “simply instruct[ing] the practitioner to implement the abstract idea of intermediated settlement on a generic computer” not patent-eligible); *see also Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 715–16 (Fed. Cir. 2014) (Claims merely reciting abstract idea of using advertising as currency as applied to particular technological environment of the Internet not patent-eligible.); *Accenture Global Servs., GmbH v. Guidewire Software, Inc.*, 728 F.3d 1336, 1344–45 (Fed. Cir. 2013) (Claims reciting “generalized software components arranged to implement an abstract concept [of generating insurance-policy-related tasks based on rules to be completed upon the occurrence of an event] on a computer” not patent-eligible.); *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.”).

We are also not persuaded by Appellants’ argument that the claimed limitations as an ordered combination include an inventive concept because “they provide an inventive concept that provides a technical solution to a technical problem.” App. Br. 20 (citing *Bascom Global Internet Servs., Inc. v. AT&T Mobility LLC*, 827 F.3d 1341 (Fed. Cir. 2016)). Appellants argue “the ordered combination of limitations in the claims provide an inventive concept that goes beyond mere recitation of ‘gift shopping.’” *Id.* at 21. In particular, Appellants argue the claims

include the inventive concept of generating suggested gifts utilizing a time-specific list of previous gifts selected for a recipient by other senders within a time window selected based on the nature of an event identified from communications in an online social network and utilizing the online social network to provide digital notifications and messages to a sender of a gift item (and recipients and other third party users of the social networking system) prior to the sender purchasing a gift.

Id. Appellants further argue the claimed invention “serves to provide a digital solution that can remove concerns regarding the absence of a brick-and-mortar store”; “can further reduce concerns by identifying suggested gifts that correspond to a contemporary event in the life of a recipient and do not overlap or conflate with gifts already selected for the event”; and “serves to remove the hurdle of entering payment or delivery information prior to selecting a gift.” App. Br. 22.

The claims here are distinguishable from those in *Bascom*. In *Bascom*, the system claims were directed to a “content filtering system for filtering content retrieved from an Internet computer network,” which the

court held were directed to an abstract idea. *Bascom*, 827 F.3d at 1348–49. The court further held the claims included an inventive concept in the ordered combination of system components, including a local client computer and a remote ISP server connected to the client computer and Internet computer network providing for “the installation of a filtering tool at a specific location, remote from the end-users, with customizable filtering features specific to each end user.” *Id.* at 1350. The claims at issue here do not involve a similar or analogous arrangement or “ordered combination” of components. We agree with the Examiner that the additional limitations are not improvements to the functioning of a computer or some other technology (*see* Ans. 9), and that any problems being solved are commercial, not technological. Indeed, we find nothing in Appellants’ claims that adds anything “significantly more” to transform the abstract concept of gift shopping.

Because Appellants’ claims 1–20 are directed to a patent-ineligible abstract concept and do not recite something “significantly more” under the second prong of the *Alice* analysis, we sustain the Examiner’s rejection of these claims under 35 U.S.C. § 101.

Rejection of Claims 1–20 under 35 U.S.C. § 103(a)

In rejecting independent claims 1 and 17 for obviousness, the Examiner found the combination of O’Sullivan, Morgenstern, and Jacobi teaches all of the recited limitations. Final Act. 4–9.

Appellants contend the Examiner erred because the cited references fail to teach or suggest the limitation “generating, by the at least one processor, a list of suggested gifts utilizing the time-specific list of previous gifts selected for the recipient by other senders within the identified time

window,” as recited in independent claim 1, and as similarly recited in independent claim 13. App. Br. 26. In particular, Appellants argue that one of ordinary skill in the art “would not read *Jacobi* and generate a list of suggested gifts utilizing a time-specific list of previous gifts selected for the recipient by other senders within an identified time window.” *Id.* at 28. Appellants argue that, because *Jacobi* teaches analyzing a time period to determine an upcoming event and then generating gift recommendations based on a recipient’s wish list or purchase history, *Jacobi* takes the opposite approach of the claimed invention. *Id.* at 27.

We are not persuaded by Appellants’ arguments because Appellants argue the references separately. Nonobviousness cannot be established by attacking the references individually when the rejection is predicated upon a combination of prior art disclosures. *See In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). The test for obviousness is not whether the claimed invention is suggested expressly in any one or all of the references, but whether the claimed subject matter would have been obvious to those of ordinary skill in the art in light of the combined teachings of those references. *See In re Keller*, 642 F.2d 413, 425 (CCPA 1981).

Here, the Examiner relied on O’Sullivan as teaching the claim limitation “identify a nature of the event based on communications on an online social network.” Ans. 10 (citing O’Sullivan ¶¶ 34–35). The Examiner relied on *Jacobi* as teaching generating the list of suggested items based on the time window. Ans. 11. Appellants do not address whether the disputed limitation would have been obvious to those of ordinary skill in the art in light of the combined teachings of those references.

Appellants also contend that the Examiner erred because the combination of O’Sullivan, Morgenstern, and Jacobi do not teach or suggest the limitation

posting, by the at least one processor in response to approval of the gift item by the recipient but prior to purchase of the modified gift item by the sender for the recipient, a notification of the modified gift item and the event corresponding to the gift request to the online social network, the notification accessible to the recipient, the sender, and one or more other third party users of the online social network and identifying the sender, the recipient, and the modified gift, as recited by independent claim 1, and as similarly recited by independent claim 13. App. Br. 28. In particular, Appellants argue one of ordinary skill would not have read O’Sullivan and Morgenstern as teaching posting a notification for viewing by the sender and friends of the sender *prior to* the sender purchasing the gift item. *Id.* at 29.

We are not persuaded that the Examiner erred. The Examiner found that O’Sullivan teaches a notification that is sent prior to purchasing the item. Final Act. 5; Ans. 11 (citing O’Sullivan Fig. 3C, ¶ 48). We agree. O’Sullivan, in describing Figure 3C, explicitly teaches “the transaction manager module **208** or purchase process manager module **204** may notify the gift recipient of the gift giver’s final gift selection prior to actual purchase of the gift by the gift giver (block **332**).” O’Sullivan ¶ 48. Moreover, the Examiner found Morgenstern teaches a method of sending gifts through an online social network, including by the known technique of posting a notification that is accessible to the recipient, the sender, and one or more other third party users of the on line social network. Final Act. 5–6

(citing Morgenstern Figs. 7, 12, and 15, ¶¶ 80, 97, 98). Appellants have not rebutted the Examiner’s findings persuasively.

For these reasons, we are not persuaded that the Examiner erred in finding the combination of O’Sullivan, Morgenstern, and Jacobi teaches or suggests the disputed limitations recited in claims 1 and 13.

Appellants next contend that the disputed subject matter would not have been obvious because O’Sullivan teaches away from the Examiner’s proposed combination. App. Br. 30; Reply Br. 14. In particular, Appellants argue that O’Sullivan teaches away from the disputed “posting” limitation because “*O’Sullivan* warns that sharing direct information about ‘selections, specifications, or rejections’ may undermine the relationship between the sender and the recipient.” *Id.* (citing O’Sullivan ¶ 9).

Appellants further argue that “*O’Sullivan* explains that information should be maintained in ‘an anonymous manner’ to avoid violating ‘social norms.’” *Id.* (citing O’Sullivan ¶ 70). Appellants also argue that “*O’Sullivan* teaches that ‘explicitness’ would ‘devalue the gift and/or the entire gift giving process.’” *Id.* (citing O’Sullivan ¶ 6). Appellants argue that the recited “sending” step “is directly contrary to maintaining selections in an anonymous manner, as O’Sullivan teaches. *Id.* at 31.

Appellants’ “teaching away” argument fails because Appellants have not identified where O’Sullivan actually criticizes, discredits, or otherwise discourages the “posting” or “sending” limitations. *See In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004); *DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 567 F.3d 1314, 1327 (Fed. Cir. 2009) (“A reference does not teach away, however, if it merely expresses a general preference for an

alternative invention but does not ‘criticize, discredit, or otherwise discourage’ investigation into the invention claimed”) (citing *Fulton*).

The paragraphs in O’Sullivan cited by Appellants do not actually criticize, discredit, or otherwise discourage the disputed limitation. Paragraph 6 of O’Sullivan explains, for example, that “having the gift recipient specify a gift to eliminate uncertainty in gift selection removes the element of surprise and may also obligate the gift giver to an uncomfortable price point or type of gift.” O’Sullivan ¶ 6. Paragraph 9 describes a “gift incentive engine [that] combines an interactive distributed environment for gathering anonymous (and opaque) gift selection advice from relevant parties” O’Sullivan ¶ 9. Paragraph 70 describes that “knowledge held by one party that would be beneficial to another party is obtained in an anonymous manner (anonymous from the point of view of the non-input providing parties).” O’Sullivan ¶ 70. As the Examiner points out, “O’Sullivan teaches both anonymous and public notifications and therefore cannot be said to be teaching away from a public notification.” Ans. 12 (citing O’Sullivan ¶ 38).

Appellants also argue that the Examiner “fails to provide any cogent reason that one of ordinary skill in the art would read *Morgenstern’s* teaching (to post a notification of a purchased gift item) with *O’Sullivan’s* teaching (to provide a gift suggestion) in combination as teaching” the disputed “posting” limitation. App. Br. 30.

We disagree. The Examiner provided “articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006); *see* Final Act. 6. Thus, we are not persuaded of error in the Examiner’s ultimate conclusion that claims

1 and 13 are obvious over the combined teachings of O’Sullivan, Morgenstern, and Jacobi.

Accordingly, we sustain the Examiner’s § 103(a) rejection of independent claims 1 and 13. We also sustain the Examiner’s § 103(a) rejection of dependent claims 2–12 and 14–20, not argued separately with particularity. App. Br. 32–33.

Non-Statutory Double Patenting Rejection of Claim 1

Claim 1 stands provisionally rejected on the ground of nonstatutory double patenting as unpatentable over claim 1 of copending Application No. 13/615,289, claim 1 of copending Application No. 13/615,321, and claim 1 of copending Application No. 13/615,307. Final Act. 12.

Because Appellants make no arguments related to this rejection, we, therefore, summarily sustain the rejection *pro forma*. Arguments not made are waived.

DECISION

We affirm the Examiner’s decision rejecting claims 1–20.

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