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Table with 5 columns: APPLICATION NO., FILING DATE, FIRST NAMED INVENTOR, ATTORNEY DOCKET NO., CONFIRMATION NO.
12/272,225 11/17/2008 TSZ S. CHENG CHA920080011US1\_8134-0118 5895

73109 7590 06/04/2018
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EXAMINER

BURKE, JEFF A

ART UNIT PAPER NUMBER

2159

NOTIFICATION DATE DELIVERY MODE

06/04/2018

ELECTRONIC

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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* TSZ S. CHENG  
and  
GREGORY P. FITZPATRICK

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Appeal 2017-010541  
Application 12/272,225  
Technology Center 2100

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Before CARLA M. KRIVAK, JASON V. MORGAN, and  
SHARON FENICK, *Administrative Patent Judges*.

KRIVAK, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants<sup>1</sup> appeal under 35 U.S.C. § 134(a) from a final rejection of claims 24–41. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

STATEMENT OF THE CASE

Appellants' invention is directed to social networking, "particularly, to obtaining trusted recommendations through discovery of common contacts in contact lists" (Spec. ¶ 1).

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<sup>1</sup> Appellants identify IBM Corporation as the real party in interest (App. Br. 1).

Independent claim 24, reproduced below, is exemplary of the subject matter on appeal.

24. A computer-implemented method, comprising:
- receiving, from a user, a query for a recommendation including a search criteria;
  - receiving, from a plurality of different users, one or more different contact lists respectively associated with each of the plurality of different users;
  - generating, from the received plurality of different contact lists, a shared contact list;
  - generating, from the shared contact list and using the search criteria, a recommendation result; and
  - forwarding, to the user, the recommendation result.

#### REFERENCES and REJECTIONS

The Examiner rejected claims 24–41 as patent ineligible under 35 U.S.C. § 101 as directed to an abstract idea.

The Examiner rejected claims 24–41 as obvious under 35 U.S.C. § 103(a) based upon the teachings of Manolescu (US 2010/0057772 A1; publ. Mar. 4, 2010) and Jagadish (US 2009/0271370 A1; publ. Oct. 29, 2009).

#### ANALYSIS

##### *Rejection under 35 U.S.C. § 101*

The Supreme Court in *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 134 S. Ct. 2347, 2354–55 (2014) reaffirmed the framework set forth previously in *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 71–72 (2012) “for distinguishing patents that claim laws of nature, natural

phenomena, and abstract ideas from those that claim patent-eligible applications of these concepts.” *Alice*, 134 S. Ct. at 2355.

The first step in the analysis is to “determine whether the claims at issue are directed to one of those patent-ineligible concepts.” *Alice*, 134 S. Ct. at 2355. If the claims are directed to a patent-ineligible concept, then the second step in the analysis is to consider the elements of the claims “individually and ‘as an ordered combination’” to determine whether there are additional elements that “‘transform the nature of the claim’ into a patent-eligible application.” *Id.* (quoting *Mayo*, 566 U.S. at 79, 78). That is, the second step is to “search for an ‘inventive concept’—*i.e.*, an element or combination of elements that is ‘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 (brackets in original) (quoting *Mayo*, 566 U.S. at 72–73). “A claim that recites an abstract idea must include ‘additional features’ to ensure ‘that the [claim] is more than a drafting effort designed to monopolize the [abstract idea].’” *Alice*, 134 S. Ct. at 2357 (brackets in original) (quoting *Mayo*, 566 U.S. at 77–78). The prohibition against patenting an abstract idea “cannot be circumvented by attempting to limit the use of the formula to a particular technological environment or adding ‘insignificant post[-]solution activity.’” *Bilski v. Kappos*, 561 U.S. 593, 610–11 (2010) (internal citation omitted). The Court in *Alice* noted that “[s]imply appending conventional steps, specified at a high level of generality,’ was not ‘*enough*’ [in *Mayo*] to supply . . . [the] ‘inventive concept.’” *Alice*, 134 S. Ct. at 2357 (quoting *Mayo*, 566 U.S. at 82, 77, 72).

*Step one: Are the claims at issue directed to a patent-ineligible concept?*

The Examiner finds Appellants' claims are directed to the "abstract idea of collecting contacts from other people and generating a recommendation based on the collection" without additional elements "sufficient to amount to significantly more than the judicial exception" (Final Act. 3; Ans. 3).

Appellants contend their "claims . . . do more than 'simply instruct' one to implement 'collecting contacts from other people and generating a recommendation based on the collection' on a generic computer" (App. Br. 9–10). Thus, they "are not 'directed to'" an abstract idea (App. Br. 10). Specifically, Appellants contend the Examiner ignores the claim language "'a query . . . including a search criteria,' 'a shared contact list,' and using the search criteria and the shared contact list to generate the recommendation result" (*id.*). Appellants then assert the Examiner's identifying the claims as referring to "using categories to organize, store, and transmit information" is "pulled directly from page 5 of the 2015 Guidelines update and refers [to] Cyberfone Systems, LLC v. CNN Interactive Group, Inc., 558 F. App'x 988, 993 (Fed. Cir. 2014)," a case Appellants note is nonprecedential (App. Br. 12).

However, as the Examiner finds, and we agree, the claim limitations are similar to those in *Electric Power Group, LLC v. Alstom S.A.*, 830 F.3d 1350 (Fed. Cir. 2016)<sup>2</sup> ("collecting information, analyzing it, and displaying

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<sup>2</sup> "Information as such is an intangible. *See Microsoft Corp. v. AT&T Corp.*, 550 U.S. 437, 451 n.12, 127 S. Ct. 1746, 167 L.Ed.2d 737 (2007); *Bayer AG v. Housey Pharm., Inc.*, 340 F.3d 1367, 1372 (Fed. Cir. 2003). Accordingly, we have treated collecting information, including when limited to particular content (which does not change its character as information), as within the

certain results of the collection and analysis”) (Ans. 3–5). Appellants’ claims “without more, (such as identifying a particular tool for presentation),” are “abstract as an ancillary part of such collection and analysis” (*Electric Power Group*, 830 F.3d at 1353).

We are also unpersuaded by Appellants’ assertion that the “Examiner’s reliance upon Cyber[S]ource is also misplaced” (App. Br. 15) and that a “process employed by a person would not correspond to the claimed process” is factually unsupported (Reply Br. 4). The Examiner’s Answer sets forth what a person would do to obtain recommendations for a good or service (Ans. 4). Further, “relying on a computer to perform routine tasks more quickly or more accurately is insufficient to render a claim patent eligible.” *OIP Techs.*, 788 F.3d at 1363; *see also Intellectual Ventures I LLC v. Capital One Bank (USA)*, 792 F.3d 1363, 1370 (Fed. Cir. 2015)

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realm of abstract ideas. *See, e.g., Internet Patents*, 790 F.3d at 1349; *OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1363 (Fed. Cir. 2015); *Content Extraction & Transmission LLC v. Wells Fargo Bank, Nat’l Ass’n*, 776 F.3d 1343, 1347 (Fed. Cir. 2014); *Digitech Image Techs., LLC v. Elecs. for Imaging, Inc.*, 758 F.3d 1344, 1351 (Fed. Cir. 2014); *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1370 (Fed. Cir. 2011) (*Electric Power Group*, 830 F.3d at 1353). In a similar vein, we have treated 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. *See, e.g., TLI Commc’ns*, 823 F.3d at 613; *Digitech*, 758 F.3d at 1351; *SmartGene, Inc. v. Advanced Biological Labs., SA*, 555 Fed.Appx. 950, 955 (Fed. Cir. 2014).”

*Electric Power Group*, 830 F.3d at 1353–54 (some citations omitted).

“[M]erely 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. *See, e.g., Content Extraction*, 776 F.3d at 1347; *Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 715 (Fed. Cir. 2014)” (*id.* at 1354).

("[O]ur precedent is clear that merely adding computer functionality to increase the speed or efficiency of the process does not confer patent eligibility on an otherwise abstract idea"); *CLS Bank Int'l v. Alice Corp. Pty. Ltd.*, 717 F.3d 1269, 1286 (Fed. Cir. 2013).

Appellants' arguments that the claims go beyond requiring collection, analysis, and display of information in a particular field (Reply Br. 2) and the Examiner "has not established that the claimed invention involves that the alleged analyzing steps are essentially 'mental processes'" (Reply Br. 3) are also unconvincing. Appellants have made assertions without evidence to support those assertions. The Examiner explains, and we agree, Appellants' claims are directed to an abstract idea (Ans. 3–5) and are similar to a mental process (Ans. 4).

Therefore, we agree the claims are directed to an abstract idea.

*Step two: Is there something else in the claims that ensures they are directed to significantly more than a patent-ineligible concept?*

Appellants assert the Examiner has not identified "additional elements beyond 'additional computer elements'" and "has not explained why the additional elements do not add significantly more to the alleged exception" (App. Br. 17–18).

Contrary to these assertions, the Examiner finds, "in the current claims, no new source or type of information is required, nor is there explicitly claimed a new technique for analyzing it" (Ans. 6). The Examiner further finds the claims require nothing more than a generic computer having conventional computing components, "which does not transform the claim into patent eligible subject matter" (Ans. 6) (*see also* Spec. ¶¶ 8–11, specifically ¶ 11, "[t]hese computer program instructions may be provided to

a processor of a *general purpose computer*” (emphasis added)). Appellants’ Reply Brief assertions are also unpersuasive (Reply Br. 4).

Therefore, we concur with the Examiner that claim 24 and claims 25–41, argued therewith, are patent ineligible.

*35 U.S.C. § 103(a)*

The Examiner finds Manolescu teaches all the limitations of claim 24 except for “generating, from the received plurality of different contact lists, a shared contact list” and “generating, from the shared contact list and using the search criteria, a recommendation result” and relies on Jagadish for teaching these limitations (Final Act. 9).

Appellants contend the “Examiner has not established that the ‘list of candidate friends’ described in paragraphs [0051]-[00052] of Jagadish is a shared contact list” (App. Br. 20–21). Appellants state Jagadish does not teach a “‘recommendation’ separate from the shared contact list,” therefore, “Jagadish cannot be used to teach that the shared contact list is used to create a separate recommendation”—thus, the “Examiner is relying upon the same teaching for two different limitations, which is impermissible” (App. Br. 23). Appellants also assert the Examiner does not address these arguments (Reply Br. 6–7). We do not agree.

The Examiner does not rely on the same teachings in Jagadish to teach two different limitations, as Appellants contend (Ans. 7). As the Examiner states, and we agree, the Examiner relies on the combination of the references; whereas Appellants are arguing the references separately and not as a combination (*id.*). The Examiner’s arguments on pages 7 and 8 of the Answer are reasonable and persuasive in addressing Appellants’ contention.

The Examiner also finds, in the Final Office Action, and we agree, Jagadish’s paragraph 21 states, “[a]s used herein, the term ‘contact list’ refers to any source of information about members in a person's list of contacts. As such a contact list includes email address books, buddy lists, text messaging address lists, and the like” (*see* Final Act. 9). Additionally, Jagadish’s paragraphs 51 and 52 state a user may create a list from other’s contact lists (Final Act. 9; Ans. 6). The Examiner also finds there is “no specific definition of the term ‘shared contact list’” in Appellants’ Specification (Ans. 6). Therefore, the Examiner reasonably interprets this term to mean the shared contact list is “composed of contacts that share a relationship with the user requesting the contact list” (*id.*). We agree. Appellants’ Reply Brief merely states the “‘shared contact list’ is a list of ‘shared contacts’—not a ‘contact list’ that is shared” (Reply Br. 5), which is consistent with the Examiner’s interpretation. Thus, we find no error in the Examiner’s findings with respect to independent claim 24 and independent claims 30 and 36, argued together, along with their respective dependent claims 25, 27, and 29–41 (App. Br. 19).

Appellants separately argue claim 26’s limitation “wherein each of the [at] least one name is respectively associated with a confidence rating” is not taught or suggested by Jagadish’s paragraph 74 (App. Br. 25–26). Paragraph 74 states “CFF [(client friend finder)] **246** may further order and/or group the resulting candidate friends *using any of a variety of ranking or ordering mechanisms*, including, but not limited to a most common friends of friends” (emphasis added). Thus, the Examiner finds, “[t]hese ordering or rankings represent the confidence, of the system, that the candidate friend will provide the best contact list recommendation” (Ans. 8).

We agree Jagadish suggests a ranking system based on confidence can be used so that each of the at least one name is associated with a confidence rating as claimed.

Appellants separately argue claim 28's limitation "wherein the confidence rating for the associated name is based upon degrees of separation between contacts[sic] lists in which the associated name was found" is not taught or suggested by Jagadish's paragraph 73 (App. Br. 26). Paragraph 73 of Jagadish states the CFF may "iteratively search each available contact list, starting with those of at least the subset of friends, and continuing over the *identified degrees of separation*" (emphasis added).

Appellants' contend Jagadish's teaching that "the user may provide a degree over which to conduct a search" does not teach the degree of separation is assigned to the search (App. Br. 26). The Examiner in the Answer, however, further asserts the rejection is also with respect to Jagadish's paragraph 74 ("Jagadish discloses that the CFF generates a list of candidate friends based on the iterative search ([0074]). Jagadish discloses that the CFF may further group or order the candidate friends using a variety or ranking or ordering mechanisms, including most common friends of friends, diffusion and/or a weighted graph approach"), thus teaching and suggesting the ranking or ordering in Jagadish is based on degrees of separation provided by the user (Ans. 8-9; Jagadish ¶ 74). We agree with the Examiner's findings with respect to the teachings of Jagadish. Appellants' statement in the Reply Brief that "[n]othing within the Examiner's cited passage refers to degrees of separation between contact lists" (Reply Br. 9) does not persuade us the Examiner erred in light of Jagadish's teachings and suggestions (Ans. 8-9).

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Thus, we sustain the Examiner's rejection of dependent claims 26 and 28.

#### DECISION

The Examiner's decision rejecting claims 24–41 as patent ineligible under 35 U.S.C. § 101 is affirmed.

The Examiner's decision rejecting claims 24–41 as obvious under 35 U.S.C. § 103(a) is affirmed.

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