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.
13/827,553	03/14/2013	Lara Mehanna	19487.206.1.2	5658

107193   7590   09/30/2019

Keller Jolley Preece/Facebook
1010 North 500 East
Suite 210
North Salt Lake, UT 84054

EXAMINER
FILIPCZYK, MARCIN R

ART UNIT	PAPER NUMBER
2158	

NOTIFICATION DATE	DELIVERY MODE
09/30/2019	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):

docketing@kjpip.com
gjolley@kjpip.com
ljohnson@kjpip.com

UNITED STATES PATENT AND TRADEMARK OFFICE
_____

BEFORE THE PATENT TRIAL AND APPEAL BOARD
_____

Ex parte LARA MEHANNA
_____

Appeal 2017-010639
Application 13/827,553[1]
Technology Center 2100
_____

Before MICHAEL J. STRAUSS, JASON J. CHUNG, and
JOSEPH P. LENTIVECH, *Administrative Patent Judges*.

CHUNG, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) of the Final
Rejection of claims 21–40. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse and enter a new ground of rejection.

INVENTION

The invention relates to "content retrieval and presentation." Spec.
1:16. Claim 21 is illustrative of the invention and is reproduced below with
emphases added and discussed in the Analysis section *infra*:

> 21. A method comprising:
> receiving a query from a user;

_____

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

presenting, to the user, a first plurality of results based on the query;

monitoring, using at least one processor, *the user's interactions with the first plurality of results*;

identifying, *based on monitoring the user's interactions*, a plurality of user selected results that the user selects from the first plurality of results based on the query;

modifying the query based on the plurality of user selected results;

performing an updated search using the query modified based on the plurality of user selected results from the query; and

providing, to the user, a second plurality of results in response to the updated search using the query modified based on the plurality of user selected results.

REJECTION AT ISSUE

Claims 21–40 stand rejected under 35 U.S.C. § 103 as being unpatentable over the combination of Milic-Frayling (US 6,968,332 B1; filed May 25, 2000) (hereinafter "Milic") and Biebesheimer (US 6,853,998 B2; issued Feb. 8, 2005). Non-Final Act. 3–16.

ANALYSIS

I. *Claims 21–40 Rejected Under 35 U.S.C. § 103*

A. *The Examiner's Findings and Appellant's Argument*

The Examiner finds Milic teaches a user selects documents from a list of uniform resource locators presented from a search, subsequently, highlighting facility 210 ranks the documents and the user can perform a search over the documents, which the Examiner maps to the disputed limitation "identifying, based on monitoring the user's interactions, a plurality of user selected results" recited in claim 21 (and similarly recited in claims 30 and 36). Non-Final Act. 4 (citing Milic Figs. 2A, 2B, 4, 9:50–

10:10, 10:16–27); Ans. 2–3 (citing Milic Figs. 2A, 2B, 4, 9:50–10:10, 10:16–27).

Appellant argues Milic fails to teach the limitation "identifying, based on monitoring the user's interactions, a plurality of user selected results [with a first plurality of results]" because the Examiner mischaracterizes the cited portions of Milic. According to Appellant, rather than based on user interaction, the cited portions of Milic teach creating augmented search terms based on a query such that the augmented search terms are created using syntactic analysis and semantic expansion of the query. App. Br. 9–10 (citing Milic, 10:31–47, 13:16–27); Reply Br. 2–4. We agree with Appellant. To resolve this issue, we first construe the disputed limitation.

B. Claim Construction of Claims 21, 30, and 36

Claim construction is an issue of law that is left for a court or a tribunal. "[W]hen the district court reviews only evidence intrinsic to the patent (the patent claims and specifications, along with the patent's prosecution history), the judge's determination will amount solely to a determination of law." *Teva Pharms. USA, Inc. v. Sandoz, Inc.*, 135 S. Ct. 831, 841 (2015). "[T]he ultimate issue of the proper construction of a claim should be treated as a question of law." *Id.* at 838.

We construe claim terms according to their broadest reasonable construction in light of the specification of the patent or application in which they appear. *In re Bigio*, 381 F.3d 1320, 1324 (Fed. Cir. 2004). Consistent with the broadest reasonable construction, claim terms are generally given their ordinary and customary meaning, as understood by a person of ordinary skill in the art, in the context of the entire specification. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). Furthermore,

a term may be defined in the specification with reasonable clarity,
deliberateness, and precision. *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir.
1994). However, we must be careful not to read a particular embodiment
appearing in the written description into the claim if the claim language is
broader than the embodiment. *See In re Van Geuns*, 988 F.2d 1181, 1184
(Fed. Cir. 1993) ("[L]imitations are not to be read into the claims from the
specification.").

Claim 21 recites "monitoring, using at least one processor, *the user's
interactions with the first plurality of results*; identifying, *based on
monitoring the user's interactions*, a plurality of user selected results"
(emphases added). Claims 30 and 36 recite similar features. In particular,
the phrase "the user's interactions" has antecedent basis to "the user's
interactions with the first plurality of results."

Therefore, we interpret claim 21 (and similarly recited in claims 30
and 36) as effectively reciting "based on monitoring the user's interactions
[with the first plurality of results]."

C.   *Discussion*

Column 9, line 50 through column 10, line 10 of Milic teaches
information highlighting facility 210 processes documents in view of the
model of the user's interest such as by marking terminology in text, scrolling
to relevant passages in the documents, summarizing the documents, and
ranking documents. Milic, 9:50–10:10 (cited at Non-Final Act. 4; Ans. 2–
3). In addition, column 10, lines 16 through 27 of Milic teaches a user using
a search query for documents that are ranked in order of relevance and sent
back to the user. Milic, 10:16–27 (cited at Non-Final Act. 4; Ans. 2–3).
Although the cited text of Milic teaches "monitoring the user's interactions,"

the cited text fails to teach the limitation "identifying, based on monitoring the user's interactions *[with the first plurality of results]*, a plurality of user selected results" (emphasis added) recited in claim 21 (and similarly recited in claims 30 and 36).

Moreover, the Examiner fails to explain persuasively how Figures 2A, 2B, and 4 of Milic teach the limitation "identifying, based on monitoring the user's interactions *[with the first plurality of results]*, a plurality of user selected results" (emphasis added) recited in claim 21 (and similarly recited in claims 30 and 36). Milic Figs. 2A, 2B, 4 (cited at Non-Final Act. 4; Ans. 2–3). Instead, the Examiner appears to reiterate the same rationale in the Answer and the Non-Final Rejection. *Compare* Non-Final Act. 4 *with* Ans. 2–3.

Accordingly, we do not sustain the Examiner's rejections for:
(1) independent claims 21, 30, and 36; and (2) dependent claims 22–29, 31–35, and 37–40 under 35 U.S.C. § 103.

<div align="center">

II.   *News Ground of Rejection*

A.   *Claims 21, 30, and 36 Rejected Under 35 U.S.C. § 102*

</div>

Within our authority under 37 C.F.R. § 41.50(b), we enter a new ground of rejection for claims 21, 30, and 36 under 35 U.S.C. §§ 102(a) and 102(e).

Regarding claim 21, Biebesheimer discloses a user inputting a search query into graphical user interface 12 (Biebesheimer, 4:43–55, 9:62–64, 11:41–43, Figs. 2, 4), which discloses the limitation "receiving a query from a user" recited in claim 21.

Biebesheimer discloses the user views the response set from the search query in Results Display Workspace 33 and may return to the

<div align="center">

5

</div>

previous step to further refine the search (i.e., further refining the set from the search query discloses the limitation "user's interactions with the first plurality of results") to narrow the response set and re-execute the search (i.e., re-executing the search discloses the limitation "monitoring" because Biebesheimer's system is waiting for the user's next re-execution) (*id.* at 14:42–57, Figs. 2, 4, 5), which discloses the limitation "monitoring, using at least one processor, the user's interactions with the first plurality of results" recited in claim 21.

Biebesheimer discloses the user views the response set from the search query in Results Display Workspace 33 and may return to the previous step to further refine the search to narrow the response set and re-execute the search (Biebesheimer, 14:42–57, Figs. 2, 4, 5), which discloses the limitation "identifying, based on monitoring the user's interactions [with the first plurality of results], a plurality of user selected results that the user selects from the first plurality of results based on the query" recited in claim 21. Under the broadest reasonable construction, we construe claim 21's "selected results" to include an entire response set; that is, Biebesheimer's entire response set from the user's search query discloses the limitation "selected results" (Biebesheimer, 14:42–57, Figs. 2, 4, 5) recited in claim 21 because claim 21 does not require a subset of a response set to be the "selected results."

Biebesheimer discloses the user views the response set from the search query in Results Display Workspace 33 and may return to the previous step to further refine (i.e., the user selects the entire response set from the search query to further refine the entire response set) the search to narrow the response set and re-execute the search (Biebesheimer, 14:42–57,

Figs. 2, 4, 5), which discloses the limitation "modifying the query based on the plurality of user selected results" recited in claim 21.

Biebesheimer discloses the user views the response set from the search query in Results Display Workspace 33 and may return to the previous step to further refine the search to narrow the response set and re-execute the search (Biebesheimer, 14:42–57, Figs. 2, 4, 5), which discloses the limitation "performing an updated search using the query modified based on the plurality of user selected results from the query" recited in claim 21.

Biebesheimer discloses the user views the response set from the search query in Results Display Workspace 33 and may return to the previous step to further refine the search to narrow the response set, re-execute the search, and display a second response set from the refined query (Biebesheimer, 14:42–57, Figs. 2, 4, 5), which teaches the limitation "providing, to the user, a second plurality of results in response to the updated search using the query modified based on the plurality of user selected results" recited in claim 21.

We apply the same reasoning explained *supra* to independent claims 30 and 36, which recite similar features as independent claim 21.

We, therefore, disagree with Appellant's argument (App. Br. 11–13) that Biebesheimer's content filters using pre-set parameters is fundamentally different than "monitoring the user's interactions [with a first plurality of results]" for at least the reasons stated *supra*. Moreover, we note that Appellant does not have a specific definition of monitoring in their Specification; rather, Appellant describes "monitoring" using non-limiting language. *See* Spec. 7:21–8:6, 3:14–15 (discussing monitoring using non-limiting language such as "[i]n one implementation," "[f]or example," etc.).

B. *Claims 21, 30, and 36 Rejected Under 35 U.S.C. § 103*

Within our authority under 37 C.F.R. § 41.50(b), we enter a new ground of rejection for claims 21, 30, and 36 under 35 U.S.C. § 103.

Regarding claim 21, Milic teaches a user sends search queries 215 to a search engine that is communicated to information highlighting facility 210 (Milic, 7:4–14, Fig. 2A), which teaches the limitation "receiving a query from a user" recited in claim 21. Milic teaches user A requested that the accessed documents (i.e., accessed documents teach the limitation "the first plurality of results" because those documents are accessed in response to the search query) be analyzed for company names and person names (i.e., user A requesting analysis teaches the limitation "the user's interactions"), information highlighting facility can perform this analysis and store the analysis results (Milic, 9:17–20, Fig. 2A), which teaches the limitation "monitoring, using at least one processor, the user's interactions with the first plurality of results" recited in claim 21.

Milic teaches user A requested that the accessed documents be analyzed for company names and person names (i.e., the analyzed company names and person names teaches the limitation "a plurality of user selected results"), information highlighting facility can perform this analysis and store the analysis results (Milic, 9:17–20, Fig. 2A), which teaches the limitation "identifying, based on monitoring the user's interactions [with the first plurality of results], a plurality of user selected results that the user selects from the first plurality of results based on the query" recited in claim 21.

Milic teaches user A requested that the accessed documents be analyzed for company names and person names (Milic, 9:17–20, Fig. 2A),

which teaches the limitation "modifying the query based on the plurality of user selected results" recited in claim 21.

Milic teaches information highlighting facility can perform analysis of company names and person names and store the analysis results for user B (Milic, 9:17–23, Fig. 2A), which teaches the limitation "performing an updated search using the query modified based on the plurality of user selected results from the query" recited in claim 21.

Milic teaches information highlighting facility can perform analysis of company names and person names and store the analysis results for user B (Milic, 9:17–23, Fig. 2A), which teaches the limitation "providing, to [a] user, a second plurality of results in response to the updated search using the query modified based on the plurality of user selected results" recited in claim 21. Milic is silent as to "providing, to *the* user, a second plurality of results in response to the updated search using the query modified based on the plurality of user selected results" (emphasis added).

In analogous art of searching, Biebesheimer teaches a user views the response set from their search query in Results Display Workspace 33 and may return to the previous step to further refine the search to narrow the response set and re-execute the search (Biebesheimer, 14:42–57, 4:43–59, 9:62–64, Figs. 2, 4, 5), which teaches the limitation "providing, to the user, a second plurality of results in response to the updated search using the query modified based on the plurality of user selected results" recited in claim 21. It would have been obvious to a person having ordinary skill in the art at the time of the invention to combine Milic's system with Biebesheimer's search revision/modification in a current context to improve the efficiency of resource dispersion in searching (Biebesheimer, 2:39–62).

We apply the same reasoning explained *supra* to independent claims 30 and 36, which recite similar features as independent claim 21.

We, therefore, disagree with Appellant's argument (App. Br. 8–11) pertaining to Milic. Additionally, we note that we rely on a different portion of Milic (e.g., Milic, 9:17–23) than the Examiner relied upon so Appellant's argument does not apply to our newly cited portion of Milic.

We also disagree with Appellant's argument (App. Br. 13–14) pertaining to the combination of Milic and Biebesheimer for at least the reasons stated *supra*. Furthermore, we note that we articulate a different rationale to combine than expressed by the Examiner so Appellant's argument does not apply to our rationale directly.

The Patent Trial and Appeal Board is a review body rather than a place of initial examination. While we have made a new rejection regarding independent claims 21, 30, and 36 under 37 C.F.R. § 41.50(b), we have not reviewed the remaining claims 22–29, 31–35, and 37–40 to the extent necessary to determine whether these claims are anticipated by Biebesheimer, are unpatentable over Milic and Biebesheimer, or in combination with other prior art. We leave it to the Examiner to determine the appropriateness of any further rejections based on Milic and Biebesheimer or other references. Our decision not to enter a new ground of rejection for all claims should not be considered as an indication regarding the appropriateness of further rejection or allowance of the non-rejected claims.

DECISION

We reverse the Examiner's decision rejecting claims 21–40 under 35 U.S.C. § 103.

We enter a new ground of rejection for claims 21, 30, and 36 under 35 U.S.C. § 102 as explained *supra*.

We enter a new ground of rejection for claims 21, 30, and 36 under 35 U.S.C. § 103 as explained *supra*.

TIME PERIOD

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review." 37 C.F.R. § 41.50(b) also provides that Appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

> (1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

> (2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record . . . .

<u>REVERSED</u>
<u>37 C.F.R. § 41.50(b)</u>

11