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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte AMANDA EARHART and LOREN ALFRED CHENG

Appeal 2017-010940
Application 13/748,222
Technology Center 3600

Before CARL W. WHITEHEAD JR., IRVIN E. BRANCH and
DAVID J. CUTITTA II, *Administrative Patent Judges*.

WHITEHEAD JR., *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants¹ are appealing the rejection of claims 5, 8, 10–12, 15, 16, and 18–30 under 35 U.S.C. § 134(a). Appeal Brief 5. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

Introduction

The invention is directed to “social networking and, more specifically, to maintaining a socially-generated listing of desired goods and/or services for a social networking system user.” Specification, paragraph 1.

¹ Appellants identify Facebook, Inc. as the real party in interest. *See* Appeal Brief 1.

Illustrative Claim

16. A computer-implemented method comprising:

storing one or more user profiles of users of a social networking system and a set of connections among the users, the one or more user profiles including a user profile of a viewing user;

retrieving a user profile of a target user connected to the viewing user, the user profile of the target user associated with a wish list identifying products associated with the target user;

selecting, by the social networking system, an additional product for the target user based on the products identified by the wish list associated with the target user;

sending, by the social networking system to a first client device associated with the viewing user over a network, an identifier of the additional product, the identifier sent for display via a first application executing on the first client device along with an inquiry of whether the viewing user would like to suggest the additional product to the target user;

receiving, by the social networking system from the first client device over the network, a request by the viewing user to suggest the additional product to the target user, the request having been initiated by the viewing user via the first application based on the inquiry;

responsive to receiving the request to suggest the additional product to the target user, sending, by the social networking system to a second client device associated with the target user over the network, a notification of the additional product, the notification sent for display via a second application executing on the second client device;

receiving, by the social networking system from the second client device over the network, a request by the target user to add the additional product to the wish list, the request having been initiated by the target user via the second application based on the display of the notification; and

responsive to receiving the request to add the additional product to the wish list, adding a description of the additional product to the wish list.

Rejection on Appeal

Claims 5, 8, 10–12, 15, 16, and 18–30 stand rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. Non-Final Action 10.

ANALYSIS

Rather than reiterate the arguments of Appellants and the Examiner, we refer to the Appeal Brief (filed January 18, 2017), the Reply Brief (filed August 15, 2017), the Answer (mailed June 15, 2017), and the Non-Final Action (mailed April 21, 2016) for the respective details.

35 U.S.C. § 101 Rejection

The Supreme Court has set forth an analytical “framework for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts.” *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 573 U.S. 208, 217 (2014) (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 71–73 (2012)). In the first step of the analysis, we determine whether the claims at issue are “directed to” a judicial exception, such as an abstract idea. *Alice*, 573 U.S. at 217. If not, the inquiry ends. *Thales Visionix Inc. v. U.S.*, 850 F.3d 1343, 1346 (Fed. Cir. 2017); *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1339 (Fed. Cir. 2016). If the claims are determined to be directed to an abstract idea, then we consider under step two whether the

claims contain an “inventive concept” sufficient to “transform the nature of the claim’ into a patent-eligible application.” *Alice*, 573 U.S. at 217 (citation omitted).

Noting that the two stages involve “overlapping scrutiny of the content of the claims,” the Federal Circuit has described “the first-stage inquiry” as “looking at the ‘focus’ of the claims, their ‘character as a whole,’” and “the second-stage inquiry (where reached)” as “looking more precisely at what the claim elements add—specifically, whether, in the Supreme Court’s terms, they identify an ‘inventive concept’ in the application of the ineligible matter to which (by assumption at stage two) the claim is directed.” *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016). In considering whether a claim is directed to an abstract idea, we acknowledge, as did the Court 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: (1) whether the claims focus on a specific means or method that improves the relevant technology, or (2) are directed to a result or effect that itself is the abstract idea, in which the claims merely invoke generic processes and machinery. *See Enfish*, 822 F.3d at 1336.

Step One: Whether the Claims Are Directed to a Patent-Ineligible Concept (Abstract Idea)

The Examiner determines the claims are directed to a patent-ineligible concept because the claims recite an abstract idea. Non-Final Action 4. The Examiner determines: “The idea of suggesting/recommending a product is ‘an idea having no particular concrete or tangible form[.]’ This is similar to

the concepts involving human activity relating to commercial practices (e.g., hedging in *Bilski*) that have been found by the courts to be abstract ideas.” Non-Final Action 4 (citing *Bilski v. Kappos*, 561 U.S. 593 (2010)). The Examiner further determines: “The limitations that narrow the idea of storing, retrieving, selecting, sending, receiving, suggesting, adding, do not make the concept less abstract. The mere recitation of a computer (*social networking system, first client device, second client device*) is not enough to transform the abstract idea into a patent-eligible invention.” Non-Final Action 4 (emphasis omitted).

Appellants contend “[t]he claims here are not directed to the result of suggesting a product, but rather the **method of producing the result of suggesting a product to a user.**” Appeal Brief 6. Appellants argue the claimed invention improves on the technology wherein, “[t]raditionally, based on the products that a user has in his/her wish list, a computer system will select an additional product to suggest to the user[, h]owever, in majority of the cases the user is not interested in the suggested product” and “[i]f the user has no interest in the additional product, the suggestion of the product may cause the user to be irritated and have a negative experience.” Appeal Brief 6.

Appellants contend:

The claimed invention improves on this technology. Similar to prior technologies, in the claimed invention a computer system/social networking system selects an additional product for a target user based on products identified by a wish list associated with the target user. However, instead of simply suggesting the selected additional product to the target user as is traditional, the social networking system takes additional steps to verify that the target user will be interested in the additional

product prior to suggesting the additional product. The additional steps include the social networking system presenting the additional product to a viewing user connected to the target user (e.g., a friend) and inquiring as to whether the viewing user believes the additional product should be suggested to the target user. The social networking system makes the inquiry by sending via a network an identifier of the additional product to a first client device associated with the viewing user and having the identifier displayed via a first application executing on the first client device.

Appeal Brief 6.

“The Supreme Court has suggested that claims ‘purport[ing] to improve the functioning of the computer itself,’ or ‘improv[ing] an existing technological process’ might not succumb to the abstract idea exception.” *Enfish*, 822 F.3d at 1335 (alterations in original) (citing *Alice*, 573 U.S. at 223–25). Thus, our reviewing court guides that the first step in the *Alice* inquiry asks whether the focus of the claims is on a specific asserted improvement in computer capabilities or an existing technological process, or, instead, on a process that qualifies as an “abstract idea” for which computers are invoked merely as a tool. *Enfish*, 822 F.3d at 1335–36. *Accord McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1314 (Fed. Cir. 2016) (“We therefore look to whether the claims in these patents 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.”).

Despite characterizing the claimed invention as using computer technology to overcome a problem specific to the operation of a computer or a computer network per se, Appellants do not present sufficient persuasive evidence or argument that the claims are directed to an improvement specific

to a computer network or the Internet *itself*. See *Elec. Power Grp.*, 830 F.3d at 1354 (“[T]he focus of the claims is not on such an improvement in computers as tools, but on certain independently abstract ideas that use computers as tools.”). We find Appellants’ claims are distinguished from those claims that our reviewing court has found to be patent eligible by virtue of reciting technological improvements to a computer system. See, e.g., *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1249, 1257 (Fed. Cir. 2014) (holding that claims reciting a computer processor for serving a “composite web page” were patent-eligible because “the claimed solution is necessarily rooted in computer technology in order to overcome a problem specifically arising in the realm of computer networks”); *Enfish*, 822 F.3d at 1338 (holding that claims directed to a self-referential table for a computer database were patent eligible because the claims were directed to an improvement in the functioning of a computer); *Visual Memory LLC v. NVIDIA Corp.*, 867 F.3d 1253, 1259 (Fed. Cir. 2017) (holding that claims directed to “an improved computer memory system” having many benefits were patent eligible).

We agree with the Examiner’s determination that at step one of the *Alice* analysis, the claims are directed to one or more abstract ideas. We turn to the second step of the *Alice* analysis, in which we must determine whether the additional elements of the claims transform them into patent-eligible subject matter.

Step Two: Whether Additional Elements Transform the Idea into Patent-Eligible Subject Matter

Appellants contend “[t]he claimed invention is similar to *BASCOM v. AT&T* in that it is the ordered combination of the claim limitations that

makes the claims patent eligible.” Appeal Brief 8 (citing *Bascom Global Internet Services, Inc. v. AT&T Mobility LLC*, 827 F.3d 1341 (Fed. Cir. 2016)). Appellants produce a chart comparing a claim from *Bascom* that was found to be patent eligible under the second step of the *Alice* test and claim 16 from the instant application. See Appeal Brief 9–10. The chart is not reproduced here. The Federal Court stated in *Bascom*:

We have found software-related patents eligible under both steps of the test *Alice* sets out. We found a patent to a particular improvement to a database system patent-eligible under step one in *Enfish LLC v. Microsoft Corp.*, 822 F.3d 1327, 1339–40, 2016 WL 2756255, at *8 (Fed. Cir. May 12, 2016). There, we found claim language reciting the invention's specific improvements to help our determination in step one of the *Alice* framework that the invention was directed to those specific improvements in computer technology. But we also recognized that, “in other cases involving computer-related claims, there may be close calls about how to characterize what the claims are directed to.” *Id.* “In such cases,” we noted, “an analysis of whether there are arguably concrete improvements in the recited computer technology could take place under step two.” *Id.* That is, some inventions' basic thrust might more easily be understood as directed to an abstract idea, but under step two of the *Alice* analysis, it might become clear that the specific improvements in the recited computer technology go beyond “well-understood, routine, conventional activit[ies]” and render the invention patent-eligible. See *Alice*, [573 U.S. at 225]. We took this step-two path in *DDR*, 773 F.3d at 1259 (“When the limitations of the . . . claims are taken together as an ordered combination, the claims recite an invention that is not merely the routine or conventional use of the Internet.”).

Bascom, 827 F.3d at 1348.

Therefore, “the relevant question is whether the claims here do more than simply instruct the practitioner to implement the abstract idea . . . on a generic computer.” *Alice*, 573 U.S. at 225. They do not.

Taking the claim elements separately, the function performed by the computer at each step of the process is purely conventional. Using a computer to receive, analyze, modify, and generate data, amounts to electronic data query and retrieval—one of the most basic functions of a computer. All of these computer functions are well-understood, routine, and conventional activities previously known to the industry. *See Elec. Power Grp., supra*. *See also In re Katz Interactive Call Processing Patent Litig.*, 639 F.3d 1303, 1316 (Fed. Cir. 2011) (“Absent a possible narrower construction of the terms ‘processing,’ ‘receiving,’ and ‘storing,’ . . . those functions can be achieved by any general purpose computer without special programming.”). In short, each step does no more than require a generic computer to perform generic computer functions. As to the data operated upon, “even if a process of collecting and analyzing information is ‘limited to particular content’ or a particular ‘source,’ that limitation does not make the collection and analysis other than abstract.” *SAP Am. Inc. v. InvestPic LLC*, 898 F.3d 1161, 1168 (Fed. Cir. 2018) (citation omitted).

Accordingly, we are not persuaded the Examiner erred and sustain the Examiner’s 35 U.S.C. § 101 rejection of claims 5, 8, 10–12, 15, 16, and 18–30.

DECISION

The Examiner’s 35 U.S.C. § 101 rejection of claims 5, 8, 10–12, 15, 16, and 18–30 is affirmed.

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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). *See* 37 C.F.R. § 1.136(a)(1)(v).

AFFIRMED