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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* JAGADESHWAR REDDY NOMULA

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Appeal 2017-011126  
Application 13/908,992  
Technology Center 3600

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Before DENISE M. POTHIER, JUSTIN BUSCH, and  
NORMAN H. BEAMER, *Administrative Patent Judges*.

POTHIER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant<sup>1,2</sup> appeals under 35 U.S.C. § 134(a) from the Examiner’s final rejection of claims 1–4, 6–14, and 16–22.<sup>3</sup> Appeal Br. 1. Claims 5 and 15 have been canceled. Final Act. 2. The instant application for this appeal relates to U.S. Application No. 13/089,772, which has been assigned Appeal No. 2017-011325.

We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

*Invention*

Appellant’s invention relates to a method and system for presenting gift recommendations for a friend through an online social networking platform. “[I]nformation corresponding to the friend is mined from the online social networking platform” and “[r]ecommend[at]ions corresponding to gifts for the friend [are] presented based on processing . . . the mined information.” Spec. ¶ 9. The invention also relates to a similar method and system that “enable[s] sharing . . . aggregated information to applications that can leverage the information to enhance the relevance of the targeted content[, including recommended goods that can be bought as gifts,] presented to the user.” *Id.* ¶ 7; *see id.* ¶ 19.

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<sup>1</sup> Throughout this Opinion, we refer to the Final Office Action (Final Act.) mailed May 19, 2016, the Appeal Brief (Appeal Br.) filed January 19, 2017, the Examiner’s Answer (Ans.) mailed June 30, 2017, and the Reply Brief (Reply Br.) filed August 30, 2017.

<sup>2</sup> Appellant identifies the real party in interest as Jagadeshwar Reddy Nomula. Appeal Br. 2.

<sup>3</sup> Appellant states both that “[c]laims 21-38 are pending and are the subject of this appeal” and that “[c]laims 1-4, 6-14, and 16-22 stand finally rejected.” Appeal Br. 2. We presume the reference to claims 23–38 was in error because claims 1–4, 6–14, and 16–22 are pending and rejected. *See* Final Act. 1.

Independent claim 1 exemplifies the claims at issue and reads as follows:

1. A method, performed by a computer system, for recommending to a first user of targeted gifts for a second user in an online social network of the first user, the first user operating a user terminal, the online social network of the first user established through a social networking platform communicable to both the computer system and the user terminal, the computer system having access to a database storing ecommerce activity information of each of a plurality of system users, the ecommerce activity information of each user adapted to identify prior activities which the respective user has conducted on at least one ecommerce website coupled to the database, the method comprising steps of:

    sending, by the computer system, a first set of instructions to the user terminal for the user terminal to display a first user interface (UI), the first UI containing one or more UI elements allowing the first user to authenticate to the social networking platform using the first user interface as a way for the first user to sign-up with or authenticate into the computer system;

    receiving, by the computer system, social network information of the first user from the social networking platform after the first user successfully authenticates to the social network platform, the received social network information including information about the second user;

    sending, by the computer system, a second set of instructions to the user terminal for the user terminal to display a second UI, the second UI listing the second user as a selectable recipient for receiving one or more gift items from the first user;

    receiving, by the computer system, selection information from the user terminal, the selection information indicating that the second user is selected by the first user as a recipient to receive one or more gifts from the first user;

    receiving, by the computer system, social network information of the second user from the social networking platform,

determining, by the computer system, whether the database stores ecommerce activity information of the second user as one of the plurality of system users, using the received social network information of the second user;

retrieving, when ecommerce activity information of the second user is determined to be present in the database, ecommerce activity information of the second user, and deciding one or more potential gift items for the second user using at least the retrieved ecommerce activity information of the second user; and

sending, by the computer system, a third set of instructions to the user terminal for the user terminal to display a third UI, the third UI listing the decided one or more potential gift items as selectable for purchase for the second user.

Appeal Br. 29–30 (Claims App.).

The Examiner relies on the following as evidence of unpatentability:

Morgenstern	US 2008/0189188 A1	Aug. 7, 2008
Kanigsberg	US 2008/0294624 A1	Nov. 27, 2008
Ramer	US 2009/0222329 A1	Sept. 3, 2009

### *The Rejections*

Claims 1–4, 6–14, and 16–22 are rejected under 35 U.S.C. § 101.

Final Act. 7–10.

Claims 1–4, 6–9, 11–14, 16–19, 21, and 22<sup>4</sup> are rejected under 35 U.S.C. § 103(a) as unpatentable over Morgenstern and Kanigsberg. Final Act. 12–29.

Claims 10 and 20 are rejected under 35 U.S.C. § 103(a) as unpatentable over Morgenstern, Kanigsberg, and Ramer. Final Act. 30–31.

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<sup>4</sup> Although omitting claims 21 and 22 in the rejection’s heading (Final Act. 12), claims 21 and 22 are rejected in the rejection’s body (Final Act. 29).

### THE PATENT ELIGIBILITY REJECTION

The Examiner finds that the claims are directed to (1) an abstract idea of collecting, comparing, organizing, storing, and transmitting information, including using rules to identify options (Final Act. 7–9; *see also* Ans. 3) and (2) optimizing a marketing objective through collecting, storing, comparing, and displaying data (*see* Final Act. 4; *see also* Ans. 3). The Examiner states the claimed computer components, when considered as an ordered combination, “add nothing that is not already present when the steps reconsidered [sic] separately,” do not add significantly more than applying the abstract idea using a generic computer, and do not transform the abstract idea into a patent-eligible invention. Final Act. 10; Ans. 3–4. The Examiner adds the claim’s individual limitations “are some of the most basic functions of a computer” and are “well-understood, routine, conventional activities previously known to the industry.” Final Act. 10; *see also* Ans. 3.

Appellant argues that the Examiner has oversimplified the claims and has failed to identify an abstract idea when considering the claim as a whole. Appeal Br. 17–18; Reply Br. 5. Appellant asserts the claimed invention improves on the existing technological process by acquiring content targeting a specific user and making gift recommendations using the specific user’s ecommerce activity information. Appeal Br. 19. Appellant further states the additional claim limitations are not merely routine or conventional. *Id.* at 20–21.

### LEGAL FRAMEWORK

An invention is patent-eligible if it claims a “new and useful process, machine, manufacture, or composition of matter.” 35 U.S.C. § 101.

However, the Supreme Court has long interpreted 35 U.S.C. § 101 to include implicit exceptions: “[l]aws of nature, natural phenomena, and abstract ideas” are not patentable. *See Alice Corp. v. CLS Bank Int’l*, 573 U.S. 208, 216 (2014).

In determining whether a claim falls within an excluded category, we are guided by the Supreme Court’s two-step framework, described in *Mayo* and *Alice*. *Id.* at 217–18 (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 75–77 (2012)). Under that framework, we first determine what concept the claim is “directed to.” *See Alice*, 573 U.S. at 219; *see also Bilski v. Kappos*, 561 U.S. 593, 611 (2010). Concepts determined to be abstract ideas, and thus patent ineligible, include certain methods of organizing human activity, such as fundamental economic practices (*Alice*, 573 U.S. at 219–20; *Bilski*, 561 U.S. at 611); mathematical formulas (*Parker v. Flook*, 437 U.S. 584, 594–95 (1978)); and mental processes (*Gottschalk v. Benson*, 409 U.S. 63, 69 (1972)).

If the claim is “directed to” an abstract idea, we turn to the second step of the *Alice* and *Mayo* framework, where “we must examine the elements of the claim to determine whether it contains an ‘inventive concept’ sufficient to ‘transform’ the claimed abstract idea into a patent-eligible application.” *Alice*, 573 U.S. at 221 (internal quotation marks omitted). “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].’” *Id.* (quoting *Mayo*, 566 U.S. at 77). “[M]erely requir[ing] generic computer implementation[] fail[s] to transform that abstract idea into a patent-eligible invention.” *Id.*

The PTO recently published revised guidance concerning 35 U.S.C. § 101. *2019 Revised Patent Subject Matter Eligibility Guidance* (“2019 Guidance”), 84 Fed. Reg. 50 (Jan. 7, 2019). Under this guidance, we first look to whether the claim recites:

- (1) any judicial exceptions, including certain groupings of abstract ideas (i.e., mathematical concepts, certain methods of organizing human interactions such as a fundamental economic practice, or mental processes) (“Revised Step 2A, Prong One”); and
- (2) additional elements that integrate the judicial exception into a practical application (*see* MPEP § 2106.05(a)–(c), (e)–(h)) (“Revised Step 2A, Prong Two”).

*See* 2019 Guidance, 84 Fed. Reg. 50–52, 54–55.

If a claim (1) recites a judicial exception and (2) does not integrate that exception into a practical application, we further consider whether the claim:

- (3) adds a specific limitation beyond the judicial exception that is not “well-understood, routine, conventional” in the field (*see* MPEP § 2106.05(d)); or
- (4) simply appends well-understood, routine, conventional activities previously known to the industry, specified at a high level of generality, to the judicial exception.

*See* 2019 Guidance, 84 Fed. Reg. 50, 56.

## ANALYSIS

Based on the record before us, we find error.

*The Judicial Exception — Revised Step 2A, Prong 1*

Among other descriptions, the Examiner finds claim 1 recites optimizing an advertiser’s marketing objective through collecting, storing, comparing, and displaying data. *See* Final Act. 4; *see also* Ans. 3. This characterization falls into one of the three judicial exceptions in the 2019 Guidance, including a certain method of organizing human activity (e.g., commercial interaction that involves marketing and sales activities or behaviors).

Claim 1 recites “[a] method . . . for recommending to a first user of targeted gifts for a second user.” Appeal Br. 29 (Claims App.). Claim 1’s method is implemented on a computer system. The recited method uses the computer system to: (1) send instructions to list the second user as a selectable recipient for receiving a gift item from the first user, (2) receive information indicating the second user has been selected to receive a gift, (3) receive the second user’s social network information, (4) determine whether the received information includes the second user’s ecommerce activity information, (5) when such a determination has been made, retrieve the ecommerce activity information, (6) decide on potential gifts for the second user using the retrieved ecommerce activity information, and (7) send instructions to display the decided potential gifts as selectable for purchase. Appeal Br. 29–30 (Claims App.).

Deciding on or recommending gifts (e.g., an advertiser’s marketing objective as described by the Examiner (Final Act. 4)) by targeting specific user activities, including a recipient’s commerce activity is a commercial interaction (e.g., marketing or sales activity). Because claim 1 covers this commercial interaction, claim 1 is directed to subject matter that falls within

the group of certain methods of organizing human activity. *See* 2019 Guidance, 84 Fed. Reg. 50, 52 (explaining that the grouping of certain methods of organizing human activity includes “commercial or legal interactions”).

Appellant argues that the Examiner failed to identify one abstract idea for the entire claim. Appeal Br. 17–18. We are not persuaded. “Adding one abstract idea (math) to another abstract idea (encoding and decoding) does not render the claim non-abstract.” *See RecogniCorp, LLC v. Nintendo Co.*, 855 F.3d 1322, 1327 (Fed. Cir. 2017). Also, to the extent Appellant asserts the Examiner fails to identify *any* abstract idea, we disagree for the above-stated reasons.

Appellant states “the claimed subject matter is . . . to increase the relevancy of gift recommendations specifically targeting a specific user.” Appeal Br. 17. Appellant argues the claimed invention improves on the conventional art of providing online targeting information to a specific user by making the acquired content more relevant. *Id.* at 19. According to the Specification, known approaches to present targeted content in this environment do not consider the gift recipient’s preferences, including mining the recipient’s information related to the recipient’s ecommerce activities or aggregated from multiple social networking platforms. Spec. ¶¶ 5–7, 42–43. Even so, “a claim for a *new* abstract idea is still an abstract idea.” *Synopsys, Inc. v. Mentor Graphics Corp.*, 839 F.3d 1138, 1151 (Fed. Cir. 2016).

On this record, we are not persuaded that the Examiner erred in determining that claim 1 recites a judicial exception.

*Integration into a Practical Application — Revised Step 2A, Prong 2*

Claim 1 recites features in addition to the judicial exception of deciding/recommending gifts by targeting specific user activities. Namely, claim 1 performs its steps using a computer system, a database that stores information of its system users, and a user terminal to receive and send instructions in a social networking environment. In addition, the first two steps in claim 1 (i.e., “sending . . . a first set of instructions to the user terminal for the user terminal to display a first user interface (UI), the first UI containing one or more UI elements allowing the first user to authenticate to the social networking platform using the first user interface as a way for the first user to sign-up with or authenticate into the computer system” and “receiving . . . social network information of the first user from the social networking platform after the first user successfully authenticates to the social network platform, the received social network information including information about the second user”) are separate from the above-identified judicial exception. That is, these steps involve authenticating a user to a social networking platform and are further features in addition to claim 1’s judicial exception.

Appellant argues the claimed invention improves on the conventional art by providing online targeting information to a specific user by making the acquired content more relevant. Appeal Br. 19 (citing *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299 (Fed. Cir. 2016)). For the reasons stated below related to Step 2B, we do not reach whether claim 1 is integrated into a practical application. If prosecution continues, we encourage the Examiner to follow the guidance set forth in the 2019

Guidance related to Revised Step 2A, Prong 2. *See* 2019 Guidance, 84 Fed. Reg. 50, 54–55.

*The Inventive Concept —Step 2B*

Regarding the inventive concept, the Examiner finds “the individual limitations claimed are some of the most basic functions of a computer. All of these computer functions are well-understood, routine, conventional activities previously known to the industry.” Final Act. 10; *see also* Final Act. 4 (discussing obtaining, identifying, transmitting, displaying, and filtering data functions are well-understood, routine, and conventional activities); *see also* Ans. 3 (same).

Among other things, Appellant argues the first two steps in claim 1 are not routine or conventional activity in a field of recommending a gift to a specific giftee. *See* Appeal Br. 20–21. As previously stated, claim 1’s first two steps are additional elements beyond the judicial exception. Also, as noted above, claim 1 includes limitations directed to purported improvements described in the Specification.

In response to *Berkheimer v. HP Inc.*, 881 F.3d 1360 (Fed. Cir. 2018), *reh’g denied en banc*, 890 F.3d 1369 (Fed. Cir. 2018), the Office issued *Changes in Examination Procedure Pertaining to Subject Matter Eligibility, Recent Subject Matter Eligibility Decision (Berkheimer v. HP, Inc.)* (Apr. 19, 2018) (“2018 Memorandum”).<sup>5</sup> Specifically, the 2018 Memorandum states an additional element (or combination of elements) is not well-understood, routine or conventional to one skilled in the art *unless* the Examiner finds and supports the § 101 rejection with one or more of the

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<sup>5</sup> Available at <https://www.uspto.gov/sites/default/files/documents/memo-berkheimer-20180419.PDF>.

following: (1) a citation to an express statement in the Specification or to a statement made by applicants during prosecution demonstrating the well-understood, routine, and conventional nature of the additional elements, (2) a citation to one or more court decisions in MPEP § 2106.05(d)(II) as noting the well-understood, routine, and conventional nature of the additional elements, (3) a citation to a publication that demonstrates the well-understood, routine, and conventional nature of the additional elements, and (4) a statement that the Examiner is taking official notice of the well-understood, routine, and conventional nature of the additional elements. 2018 Memorandum 3–4.

Upon review of the record, the Examiner has not relied upon one or more of the above-identified manners to support the findings that the certain, additional features in claim 1 are well-understood, routine, and conventional. *See* Final Act. 4, 10; *see also* Ans. 3. Specifically, the Examiner has not relied upon the Specification, case law, or a publication to demonstrate the well-known, routine, and conventional nature of the first two steps in claim 1 (i.e., “sending . . . a first set of instructions to the user terminal for the user terminal to display a first user interface (UI), the first UI containing one or more UI elements allowing the first user to authenticate to the social networking platform using the first user interface as a way for the first user to sign-up with or authenticate into the computer system” and “receiving . . . social network information of the first user from the social networking platform after the first user successfully authenticates to the social network platform, the received social network information including information about the second user”). *See* Final Act. 4, 10; *see also* Ans. 3. Also, to the extent the Examiner relied upon Official Notice of the well-understood,

routine, and conventional nature of the additional elements, no such explicit statement has been made in the record. *See* Final Act. 4 (discussing obtaining, identifying, transmitting, displaying, and filtering data functions are well-understood, routine, and conventional activities), 10; *see also* Ans. 3. In any event, the 2018 Memorandum indicates that once applicant challenges the Examiner’s position that certain elements are not well-understood, routine, and conventional activities, as is the case here, the Examiner can no longer rely on Official Notice and must provide one of the above, outlined items (1) through (3).

For the foregoing reasons, Appellant has persuaded us of error in the rejection of (1) independent claims 1, 6, 11, and 16 and (2) dependent claims 2–4, 7–10, 12–14, and 17–22 for similar reasons.

#### THE OBVIOUSNESS REJECTION OVER MORGENSTERN AND KANIGSBURG

Regarding independent claim 1, the Examiner finds Morgenstern teaches or suggests many of its limitations. Final Act. 12–14 (citing Morgenstern ¶¶ 21–22, 28, 49, 52–57, Abstract, Figs. 1, 2, 4, 6, and 7). As for the steps of “receiving . . . social network information of the second user from the social networking platform,” “determining . . . whether the database stores ecommerce activity information of the second user . . .,” and “retrieving . . . ecommerce activity information of the second user, and deciding one or more potential gift items for the second user using at least the retrieved ecommerce activity information of the second user,” the Examiner relies on Morgenstern and Kanigsberg in combination. *Id.* at 13–14 (citing Kanigsberg ¶ 3, Abstract).

Appellant argues Morgenstern is irrelevant to gift-recommending and therefore to the “subject matter recited in independent claims 1, 6, 11, and 16.” Appeal Br. 22. Appellant contends Morgenstern does not disclose a combination (1) “relating to a first user (giftor) selecting a second user as a giftee” (*id.* at 23), (2) “of a first user (giftor) selecting a second user as a giftee using the online social network information of the first user” (*id.*), or (3) “relating to using ecommerce activity information of the second user or aggregated social network information of the second user, to determine recommended gifts for the second user” (*id.* at 24). Appellant asserts Morgenstern relates to an already purchased asset and does not disclose selecting a second user as a giftee using a first user’s online social network information. *Id.* at 23, 25. Also, Appellant argues Kanigsberg does not relate to using ecommerce activity information or aggregated social network information of a giftee to determine a recommended gift. *Id.* at 25.

Appellant argues claims 1, 6, 11, and 16 as a group. *Id.* at 21–26. Claims 1 and 11 differ in scope from claims 6 and 16. We therefore select independent claims 1 and 6 as representative. *See* 37 C.F.R. § 41.37(c)(1)(iv).

#### MAIN ISSUE

Under § 103, has the Examiner erred in rejecting claim 1 by finding Morgenstern and Kanigsberg collectively would have taught or suggested “[a] method, performed by a computer system, for recommending to a first user of targeted gifts for a second user in an online social network of the first user” and “deciding one or more potential gift items for the second user

using at least the retrieved ecommerce activity information of the second user”?

## ANALYSIS

### *Claims 1 and 11*

Based on the record before us, we find no error in the Examiner’s obviousness rejection of independent claim 1. Appellant first argues Morgenstern is irrelevant to gift-recommending. Appeal Br. 22–24. In this regard, Appellant contends the gifts in Morgenstern have already been purchased and do not involve selecting a second user as a giftee. *Id.* at 23. We are not persuaded.

Although reciting “[a] method . . . for recommending to a first user of targeted gifts for a second user” in its preamble, claim 1 does not recite an active step of *recommending* a gift in the body. *Id.* at 29–30 (Claims App.). At best, claim 1 recites “deciding [on] one or more potential gift items for the second user using at least the retrieved ecommerce activity information of the second user” and “sending . . . a third set of instructions to the user terminal for the user terminal to display a third UI, the third UI listing the decided one or more potential gift items as selectable for purchase for the second user.”<sup>6</sup> *Id.* at 30 (Claims App.). The later step only recites sending

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<sup>6</sup> These steps stem from a conditional limitation, where if the condition for performing its contingent step is not satisfied, the performance recited by the step need not be carried out in order for the claimed method to be performed. See MPEP § 2111.04(II) (9th ed. Rev. 08.2017, Jan. 2018) (citing *Ex parte Schulhauser*, Appeal No. 2013-007847 (PTAB Apr. 28, 2016) (precedential)). In claim 1, the recited “retrieving . . . ecommerce activity information of the second user” only occurs “*when* ecommerce activity information of the second user is determined to be present in the database.”

*instructions* to the user *to display* the instruction, but does not recite actively displaying the potential gift item listing. *Id.* As such, the preamble’s recitation regarding gift recommending is intended use, and claim 1’s breadth requires only the ability to recommend targeted gifts. *See Am. Med. Sys., Inc. v. Biolitec, Inc.*, 618 F.3d 1354, 1358–59 (Fed. Cir. 2010).

Nonetheless, Morgenstern discloses a method that recommends gifts to a first user. For instance, Morgenstern discloses a gift database 308 of available gifts using a social network provider, and a first user’s (e.g., 102A) gift webpage can be used to gift to a second user (e.g., 102B). Morgenstern ¶¶ 56, 66, Figs. 1 and 3, *cited in part in* Final Act. 12–13 and Ans. 5. Morgenstern further describes gifting an asset (e.g., an image) and gift module 306 “may recommend several rose images to” the first user (e.g., 102A) “for consideration,” which are based on the *recipient’s* affinity. Morgenstern ¶ 66. Morgenstern even further teaches and shows in Figure 6 a first user selecting a recipient user (e.g., a second user in window 610) and then displaying numerous “potential gift items” (e.g., in window 620) a first user can give to a second user. Morgenstern ¶¶ 77–78, Fig. 6, *cited in part in* Final Act. 13. Morgenstern thus teaches a process that can recommend gifts to a first user and “decid[e on] one or more potential gift items for the

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Appeal Br. 30 (Claims App.) (emphasis added). Also, the “deciding” and “sending” steps follow from the above “retrieving” step and only occur when the above condition occurs. Similar limitations are found in claim 6. Notably, claims 11 and 16 recite “system” claims, where the claim construction differs because the structure for performing the conditional limitations must be present in the system. *See* MPEP § 2111.04(II).

second user” based on second user’s information (e.g., recipient’s affinity) as claim 1 recites.

Additionally, Morgenstern’s process includes embodiments where a first user buys a gift for a second user in an online social network environment and the gift has *not* been purchased already. Morgenstern ¶ 28, *cited in* Ans. 5; *see also* Morgenstern ¶¶ 76–82, Figs. 5–8, *cited in part in* Final Act. 12–13. Even if some features in Morgenstern address an already purchased gift (*see* Appeal Br. 22–23 (citing Morgenstern ¶¶ 24–26)), Morgenstern teaches other features where the gift has not been purchased already, such as that shown in cited Figures 6 and 7 (*see* Final Act. 13) and Figure 8 (*see* Morgenstern, Fig. 8 (elements 810, 820)). *See also* Morgenstern ¶ 26, *cited in* Appeal Br. 22. As such, contrary to Appellant’s assertions, Morgenstern teaches using a first user’s online social network information to select a second user (e.g., element 610 in Figure 6) and the second user’s gift (e.g., element 620 in Figure 6) is selected for purchase. *See* Appeal Br. 22–23; *see also* Reply Br. 7.

Appellant further argues Morgenstern is not relevant “to any combination relating to using ecommerce activity information of the second user . . . to determine recommended gifts for the second user.” Appeal Br. 24; *see also* Reply Br. 7. As previously discussed, claim 1 recites “deciding [on] one or more potential gift items for the second user using at least the retrieved ecommerce activity information of the second user” but does not actively *recommend* gifts. However, we previously noted Morgenstern can recommend gifts to a user. Moreover, the rejection relies on Morgenstern *and* Kanigsberg to teach the recited “deciding” step. Final Act. 13–14 (citing Kanigsberg ¶ 3, Abstract). As such, Appellant cannot

show nonobviousness by attacking Morgenstern individually. *See In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986).

Regarding Kanigsberg, Appellant argues this reference does not relate to using a giftee's or second user's ecommerce activity information to determine recommended gifts for the second user. Appeal Br. 25. This argument too does not consider what both Morgenstern and Kanigsberg collectively teach or suggest to one skilled in the art and what Morgenstern already teaches or suggests, including deciding on potential gifts for the second user based on the second user's affinity as previously discussed.

Turning to the Specification, the phrase "ecommerce activity information" has not been defined. At best, the Specification provides an example of system 100 using information about a friend's purchase (e.g., an iPhone) to provide a recommended gift (e.g., iPhone accessories). Spec. ¶ 42, Fig. 1. We decline to import such an embodiment into claim 1, which is broader in scope. Claim 1 also recites the "ecommerce activity information of each user [is] *adapted to identify prior activities* which the respective user has conducted on at least one ecommerce website coupled to the database." Appeal Br. 29 (Claims App.) (emphasis added). But, this does not claim the "ecommerce activity information" *are* prior user activity information conducted on an ecommerce website. Rather, the recited information is information *indicative* of user's ecommerce activities on an ecommerce website.

Turning to the references, Morgenstern discusses retaining a gift box (e.g., 285) that may display digital assets received as gifts by the second user (e.g., electronic commerce concerning the second user). Morgenstern ¶ 57, *cited in* Final Act. 13. Morgenstern also discloses an example where the

icons represent information related to what a user already owns (e.g., an iPod) and “[t]hus, a second IPOD would probably not be an appropriate gift, while IPOD accessories and tunes might be appropriate gifts.” Morgenstern ¶ 24, *cited in* Appeal Br. 22. Morgenstern thus suggests obtaining a user’s ecommerce activity information and displaying appropriate icons based on this information.

Kanigsberg further teaches that it is known to an ordinary skilled artisan to use information in a user’s social networking profile (e.g., user’s interests), past behaviors, and all users’ product ratings to make recommendations in an ecommerce environment. Kanigsberg ¶ 3, Abstract. Although not explicitly stating such user’s information is “ecommerce activity information,” Kanigsberg discusses analyzing a user’s information (e.g., a user’s past behavior) with the other users, collecting *all user’s* product ratings, and comparing all users’ product ratings to the user’s ratings of the same products, which at least suggests each user has purchased a product online and that each user’s product rating information is collected prior to recommending a product. *Id.* ¶ 3. Thus, Kanigsberg suggests using all users’ “ecommerce activity information,” including the second user, to make recommendations. When combining this suggestion with Morgenstern, we agree the combination would have yielded no more than a predictable result to one skilled in the art of “deciding [on] one or more potential gift items for the second user using at least the retrieved ecommerce activity information of the second user” and “sending” a listing that includes “the decided one or more potential gift items” to the user terminal operated by the first user as claim 1 recites. *See* Final Act. 14.

Appellant quotes many limitations in claim 1. *See* Appeal Br. 22–24. To the extent Appellant is asserting Morgenstern (or Kanigsberg) does not teach each of these claim features of claim 1, merely reciting claim features and asserting these features are missing from Morgenstern is not considered a separate argument for patentability. *See In re Lovin*, 652 F.3d 1349, 1357 (Fed. Cir. 2011).

Appellant also argues Kanigsberg discloses prior art subject matter (i.e., collaborative filtering), which does not involve using factors personal to the giftee. Appeal Br. 25. This argument is unavailing. First, claim 1 does not preclude using collaborative filtering. Second, the Specification states “the instant [collaborative filtering] approach *does not appear* to be designed to consider the preference of the person who will be receiving the gift into consideration.” Spec. ¶ 5 (emphasis added). This does not demonstrate collaborative filtering necessarily excludes a giftee’s preferences. Third, although stating collaborative filtering is a commonly-used technique (*Id.* ¶ 5), the Specification also indicates collaborative filtering can be used to recommend gifts in the invention (*Id.* ¶¶ 39, 44). Fourth, Kanigsberg explicitly discloses statistically comparing a user’s personal ratings to the collaborative set of ratings to form recommendations, which suggests considering other particular user’s preferences or factors.

For the first time in the Reply Brief, Appellant asserts the Examiner has not presented a prima facie case of obviousness because Morgenstern does not relate to the claimed subject matter. *See* Reply Br. 6–7. We are not persuaded for the above stated reasons. To the extent Appellant is further attempting to assert the Examiner has not made a prima facie case for *all* the claim language quoted in the Appeal Brief, Appellant has not pointed out

what specific features are purportedly missing other than the “aspects (i) and (ii)” (Reply Br. 7; *see also* Appeal Br. 22–25), which we already addressed.

For the foregoing reasons, Appellant has not persuaded us of error in the rejection of independent claim 1 and claim 11, which is not separately argued.

*Claims 2–4 and 12–14*

For the dependent claims, Appellant argues the claims are allowable due to their dependencies on claims 1 and 11. Appeal Br. 26. Appellant also repeats Morgenstern and Kanigsberg are not relevant to using a second user’s retrieved ecommerce activity information to recommend a gift. *Id.* For this reason, Appellant contends the references do not teach similar limitations found in the dependent claims. *Id.* at 26–27 (underlining similar language found in the dependent claims). We are not persuaded for reasons previously stated. Accordingly, Appellant has not persuaded us of error in the rejection of claims 2–4 and 12–14.

*Claims 6 and 16*

Many of the arguments for representative claim 6 are the same as those for claim 1. *See id.* at 21–25. We are not persuaded for reasons previously stated. We further note, like claim 1, claim 6’s last step only recites sending *instructions* to the user *to display* the instruction but does not recite actively displaying the potential gift items lists. *Id.* at 31–33 (Claims App.). As such, the preamble’s recitation regarding gift recommending is intended use.

Appellant separately contends Morgenstern does not relate to determining a recommended gift for the second user using aggregated social network information and, thus, does not teach “deciding [on] one or more

potential gift items for the second user using at least the retrieved aggregated social network information of the second user” (*id.* at 33 (Claims App.)) in claim 6 to determine recommended gifts for the second user. *See id.* at 22, 24–25. We are not persuaded.

In claim 6, the “aggregated social network information” is “information of each system user aggregated from a plurality of social networking platforms.” *Id.* at 32 (Claims App.). The Examiner turns to Morgenstern and Kanigsberg to teach this feature. Final Act. 16, 18 (citing Morgenstern ¶¶ 21, 28, 49, Fig. 1 and Kanigsberg ¶ 3, Abstract). Specifically, Morgenstern discusses a user can provide information to a social network website for access to other users, the information coming from personal webpages, web logs, and other sources (e.g., a plurality of social networking platforms). Morgenstern ¶ 21. Also, as previously discussed, Morgenstern discusses making recommendations based on a recipient’s affinity (Morgenstern ¶ 66), and Kanigsberg further teaches that it is known to an ordinary skilled artisan to use user information in a user’s social networking profile to make recommendations in an ecommerce environment (Kanigsberg ¶ 3, Abstract). When combining Morgenstern’s and Kanigsberg’s teachings, we agree the combination would have yielded a predictable result to one skilled in the art of “deciding [on] one or more potential gift items for the second user using the retrieved aggregated social network information of the second user” as claim 6 recites to determine recommended gifts for the second user. *See* Final Act. 18.

For the foregoing reasons, Appellant has not persuaded us of error in the rejection of independent claim 6 and claim 16, which is not separately argued.

*Claims 7–9, 17–19, 21, and 22*

For the dependent claims, Appellant argues the claims are allowable due to their dependencies on claims 6 and 16. Appeal Br. 26. Appellant also repeats Morgenstern and Kanigsberg are not relevant to using a second user’s aggregated social network information to recommend a gift. *Id.* at 26. For this reason, Appellant contends the references do not teach similar limitations found in the dependent claims. *Id.* at 26–27 (underlining similar language found in the dependent claims). We are not persuaded for reasons previously stated. Accordingly, Appellant has not persuaded us of error in the rejection of claims 7–9, 17–19, 21 and 22.

THE OBVIOUSNESS REJECTION OVER MORGENSTERN,  
KANIGSBERG, AND RAMER

Claims 10 and 20 are rejected based on Morgenstern, Kanigsberg, and Ramer. Final Act. 30–31. The Examiner turns to Ramer in combination with Morgenstern and Kanigsberg to teach the recited features related to social feeds among other things. *See id.*

Appellant argues the claims are allowable due to their dependencies on claims 6 and 16. Appeal Br. 26. Appellant also repeats Morgenstern and Kanigsberg are not relevant to using a second user’s aggregated social network information to recommend a gift. *Id.* at 26. For this reason, Appellant contends the references do not teach similar limitations found in the dependent claims. *Id.* at 26–27 (underlining similar language found in the dependent claims). We are not persuaded for reasons previously discussed. Additionally, Appellant does not dispute the findings and

Appeal 2017-011126  
Application 13/908,992

conclusions related to Ramer, including those features underlined in claims 10 and 20. *See id.*

For the foregoing reasons, Appellant has not persuaded us of error in the rejection of claims 10 and 20.

#### DECISION

We affirm the Examiner's rejections of claims 1–4, 6–14, and 16–22 under § 103.

We reverse the Examiner's rejection of claims 1–4, 6–14, and 16–22 under § 101.

Because we have affirmed at least one ground of rejection with respect to each claim on appeal, the Examiner's decision is affirmed. *See* 37 C.F.R. § 41.50(a)(1).

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