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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte CHRISTOPHER EMERY AUSTIN-LANE

Appeal 2018-000601¹
Application 13/800,946
Technology Center 2400

Before DENISE M. POTHIER, JOYCE CRAIG, and JASON M. REPKO,
Administrative Patent Judges.

CRAIG, *Administrative Patent Judge.*

DECISION ON APPEAL

Appellant² appeals under 35 U.S.C. § 134(a) from the Examiner's Non-Final Rejection of claims 41, 43–67, and 69, which are all of the claims pending in this Application.³ We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

¹ According to Appellant, the Application at issue in this appeal is related to Application 13/800,786 (abandoned) and Application 13/616,369 (issued as US 9,736,209). App. Br. 1.

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

³ Claims 1–40, 42, and 68 have been canceled. App. Br. 17–22 (Claim App'x).

INVENTION

Appellant's invention relates to a state change alerts mechanism.

Abstract. Claim 41 is illustrative and reads as follows:

41. A method comprising:

receiving one or more user-specified alert conditions from a user;

detecting, using one or more processors, a state change at one or more remote servers that triggers the one or more user-specified alert conditions;

presenting, based on detecting the state change at the one or more remote servers, an alert to the user in accordance with one or more alert preferences, wherein the alert comprises a selectable option to edit alert preferences associated with the alert;

detecting an interaction, by the user, with the alert; and
presenting, in response to the detected interaction, information associated with the alert.

REJECTIONS⁴

Claims 41, 43, 44, 46–57, 59–67, and 69 stand rejected under pre-AIA 35 U.S.C. § 103(a) as unpatentable over the combination of Huna et al. (US 2001/0012286 A1; published Aug. 9, 2001) (“Huna”) and Bunney et al. (US 6,466,969 B1; issued Oct. 15, 2002) (“Bunney”). Non-Final Act. 3–11.

Claims 45 and 58 stand rejected under pre-AIA 35 U.S.C. § 103(a) as unpatentable over the combination of Huna, Bunney, and Tyra et al. (US 2004/0019612 A1; published Jan. 29, 2004) (“Tyra”). Non-Final Act. 11–13.

⁴ The Examiner also objected to and required correction of claims 57 and 59. Non-Final Act. 2.

ANALYSIS

We have reviewed the rejections of claims 41, 43–67, and 69 in light of Appellant’s arguments that the Examiner erred. We have considered in this Decision only those arguments Appellant actually raised in the Briefs. Any other arguments Appellant could have made, but chose not to make, in the Briefs are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(iv).

Appellant’s arguments are not persuasive of error. We agree with and adopt as our own the Examiner’s fact findings and conclusions as set forth in the Answer (Ans. 2–7) and in the Action from which this appeal was taken (Non-Final Act. 3–14). We provide the following explanation for emphasis.

With respect to Appellant’s contention that the Examiner did not meet his/her initial burden (App. Br. 8–9), we highlight that a *prima facie* case is established when the party with the burden of proof points to evidence that is sufficient, if uncontroverted, to entitle it to prevail as a matter of law. *See Saab Cars USA, Inc. v. U. S.*, 434 F.3d 1359, 1369 (Fed. Cir. 2006). In particular, regarding the Patent Examiner’s burden of production:

[A]11 that is required of the office to meet its *prima facie* burden of production is to set forth the statutory basis of the rejection and the reference or references relied upon in a sufficiently articulate and informative manner as to meet the notice requirement of [35 U.S.C.] § 132. As the statute itself instructs, the examiner must “notify the applicant,” “stating the reasons for such rejection,” “together with such information and references as may be useful in judging the propriety of continuing prosecution of his application.” 35 U.S.C. § 132. *In re Jung*, 637 F.3d 1356, 1363 (Fed. Cir. 2011). Here, the Examiner clearly set forth the statutory basis of the rejection, references relied upon, and reasons for such rejection, i.e., qualifying information useful to

Appellant in judging the propriety of continuing prosecution (*see* Non-Final Act. 3–11).

We agree with Appellant that the Examiner presented no explicit findings with regard to which portions of Huna or Bunney teach the limitation “wherein the alert comprises a selectable option to edit alert preferences associated with the alert,” as recited in claim 41. App. Br. 9; *see* Non-Final Act. 3. The Examiner, however, concluded “it would have been obvious that any disclosed user interface functionality could have been presented within the alert notifications of Huna-Bunney, and that the decision of where to locate these entities amounts to simple design choice.” Non-Final Act. 5.

The Examiner explained that the proposed modification to Huna “is merely to relocate or duplicate the button used to access the preferences menu (Huna: 606 of FIG. 6) to appear within the alert window (Huna: 1318 of FIG. 13) according to the technique disclosed in Bunney” Ans. 3 (citing Bunney 9:37–47 (“clicking on an invitation to a special event can take the user to a page where the special event is occurring.”)). The Examiner found relocating button 606 of Huna Figure 6 to alert window 1318 of Huna Figure 13 would have been a matter of design choice. *Id.* at 5–7; *see also* Non-Final Act. 4–5. The Examiner reasoned that

[r]elocating or duplicating the selectable option (606) of Huna to appear within an alert window would provide the predictable benefit of improving convenience of end users particularly in the event where an end user receives an alert of a type that he or she is no longer interested in receiving.

Ans. 4.

Appellant argues the Examiner erred because “nothing in the MPEP (nor in precedential case law) provides the Examiner with authority to reject

the claims as a ‘design choice.’ Moreover, the Examiner does not indicate a standard for applying ‘design choice’ as a test for patent eligibility.” App. Br. 13. Appellant also argues “the claimed invention does not arrange known elements in a configuration recognized as functionally equivalent to a known configuration.” *Id.* at 14 (citing *Ex parte Gunasekar*, No. 2009-008345, 2011 WL 3872007 (BPAI Aug. 29, 2011)). Appellant further argues the Examiner improperly relied on Sharfman et al. (WO 00/46686; Aug. 10, 2000) (“Sharfman”) as prior art. *Id.* at 12–13.

We are not persuaded that the Examiner erred. Design changes that do not result in a difference in function or give unexpected results are no more than obvious variations consistent with the principles known in the art of the patent at issue are obvious design choices. *See* 35 U.S.C. § 103(a). “[D]esign choice may be an acceptable rationale for an obviousness rejection when a claimed product merely arranges known elements in a configuration recognized as functionally equivalent to a known configuration.” *Gunasekar*, 2011 WL 3872007, at *5 (citing *In re Kuhle*, 526 F.2d 553, 555 (CCPA 1975)). A modification of prior art teachings may be a matter of design choice unless a proposed change results in different structure and function. *In re Gal*, 980 F.2d 717, 719–20 (Fed. Cir. 1992).

Here, Appellant argues in a conclusory manner, and without citations to the Specification, that the disputed limitation “allow[s] users to more easily and quickly modify alert preferences at the time of receiving an alert.” Reply Br. 4; *see also* App. Br. 14. Appellant then contends “the claimed invention provides a functional improvement over the prior art and is not an obvious design choice.” Reply Br. 5. But, we do not see where Appellant’s Specification describes a problem that the recited alert comprising a

selectable option to edit alert preferences associated with the alert (i.e., the disputed limitation) would solve or that its location within the alert changes the selectable option's functionality from the selectable options located elsewhere. It is well settled that mere attorney arguments and conclusory statements, which are unsupported by factual evidence, are entitled to little probative value. *In re Geisler*, 116 F.3d 1465, 1470 (Fed. Cir. 1997); *see also In re Pearson*, 494 F.2d 1399, 1405 (CCPA 1974) (indicating attorney argument is not evidence).

Similarly, Appellant has not sufficiently argued or persuaded us that moving button 606 of Huna Figure 6 to Huna Figure 13 in the manner proposed by the Examiner would result in a difference in function or give unexpected results. Appellant states only that "the claimed invention does not arrange known elements in a configuration recognized as functionally equivalent to a known configuration." App. Br. 14. This statement, which is unsupported by factual evidence, is entitled to little probative value. *Geisler*, 116 F.3d at 1470.

The Examiner articulated an adequate reason with a rational underpinning to modify or rearrange Huna's selectable option's location in the manner proposed by the Examiner. *See* Ans. 4, 7. Appellant has not persuaded us that the Examiner's proffered rationale of providing "the benefit of enhanced user convenience" is the result of impermissible hindsight. *Id.* Nor has Appellant identified, as previously discussed, any knowledge relied upon by the Examiner that was gleaned only from Appellant's disclosure and that was not otherwise within the level of ordinary skill in the art at the time of invention. *See In re McLaughlin*, 443 F.2d 1392, 1395 (CCPA 1971).

We note that the facts in the non-binding, non-precedential *Gunasekar* case are distinguishable from the present case in that the Examiner in *Gunasekar* took “Official Notice” that a claimed feature was well known in the art. *Gunasekar*, 2011 WL 3872007, at *4. No such “Official Notice” was taken in the present case; instead, the Examiner here illustrates where all of the claimed components are known in either Huna or Bunney, only adding that the rearrangement of the location of any user interface functionality was a matter of design choice. *See* Non-Final Act. 5; Ans. 6–7.

Finally, the Examiner relied on Sharfman “to provide evidence of the level of skill in the art,” not as teaching or suggesting the disputed limitation in combination with Huna and Bunney. Ans. 5; *see Ex parte Erlich*, 22 USPQ 1463 (BPAI 1992). Moreover, Sharfman is cumulative and unnecessary in view of the teachings of Huna and Bunney.

For these reasons, we are not persuaded that the Examiner erred in finding that that the combination of Huna and Bunney teaches or suggests the disputed limitations of claim 41.

Accordingly, we sustain the Examiner’s § 103(a) rejection of independent claim 41, as well as the Examiner’s § 103(a) rejection of independent claim 55, which Appellant argues is patentable for similar reasons. *See* App. Br. 15. We also sustain the Examiner’s § 103(a) rejection of dependent claims 43–54, 56–67, and 69, not argued separately with particularity. *See id.*

DECISION

We affirm the Examiner’s decision rejecting claims 41, 43–67, and 69.

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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)(iv). *See* 37 C.F.R. § 41.50(f).

AFFIRMED