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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DENNIS DETWILLER and ROBERT SPARKS

Appeal 2018-002959
Application 13/306,917¹
Technology Center 2400

Before MAHSHID D. SAADAT, JASON J. CHUNG, and
JOYCE CRAIG, *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 1–6, 9–16, 19, and 20.² We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

INVENTION

The invention is directed to rewarding users responsive to sharing digital content online. Spec. ¶ 1. Claim 1 is illustrative of the invention and is reproduced below:

1. A computer-implemented method of rewarding a user for sharing digital content, the method comprising:

¹ According to Appellants, Hothead Games Inc. is the real party in interest. App. Br. 3.

² Claims 7, 8, 17, and 18 are canceled. App. Br. 26, 29.

receiving, from a user, a request to share the digital content, the received request including an identification of the digital content to be shared;
retrieving the identified digital content;
providing a reward to the user for the request to share the digital content, the reward being provided to the user in response to sharing the retrieved digital content on the one or more destinations;
providing the user with sharing parameters;
receiving selections of the sharing parameters from the user; and
transmitting the digital content to one or more destinations, the transmission based at least in part on the selected sharing parameters.

REJECTIONS AT ISSUE

Claims 1–6, 9–16, 19, and 20 stand rejected under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter. Final Act. 4–7.

Claims 1–6, 9–16, 19, and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Wang³ and Brougher.⁴ Final Act. 7–14.

ANALYSIS

1. Rejection Under 35 U.S.C. § 101

The Examiner concludes the present claims are directed to an abstract idea of receiving and publishing data similar to the abstract idea in *Affinity Labs of Texas, LLC v. Amazon.com*, 838 F.3d 1266, 1269 (Fed. Cir. 2016), which is delivering user-selected media content to devices. Ans. 11, 14.

³ Wang, US 2011/0184791 A1, pub. July 28, 2011.

⁴ Brougher et al., US 2009/0157491 A1, pub. June 18, 2009 (“Brougher”).

The Examiner concludes the present claims also are directed to an abstract idea of a fundamental economic practice. *Id.* at 13.

The Examiner concludes the present claims are not significantly more than any abstract idea because they do not contain an inventive concept sufficient to transform the claim into patent-eligible subject matter. *Id.* at 15. In addition, the Examiner finds the present claims are directed to implementing the abstract idea using conventional or generic technology. Final Act. 6.

Appellants argue the Examiner engaged in piecemeal prosecution and presenting new grounds of rejections, which are unfair to Appellants. App. Br. 7–10; Reply Br. 3–7. Appellants argue the present claims are similar to the claims in *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327 (Fed. Cir. 2016), *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245 (Fed. Cir. 2014), and *Classen Immunotherapies, Inc. v. Biogen IDEC*, 659 F.3d 1057 (Fed. Cir. 2011) because they are necessarily rooted in computer technology, are directed to improvements in the computer related technology, and not manifestly abstract. App. Br. 10–13. In addition, Appellants argue the Examiner merely compares conclusions of cases with the present claims rather than analogizing relevant case facts with facts of the present claims that courts have found ineligible. *Id.* at 15–17; Reply Br. 7–8. Additionally, Appellants argue the Examiner fails to provide analysis pertaining to the dependent claims. App. Br. 20.

Appellants argue the Examiner provides conclusory assertions and ignores limitations in reaching the conclusion that the claims are directed to an abstract idea without significantly more. *Id.* at 13–14. Appellants argue the Examiner did not consider the combination of claim elements as a whole

in reaching the conclusion that the claims are directed to using conventional or generic technology. *Id.* at 14–15; Reply Br. 7–8. We disagree with Appellants.

A. Legal Principles

Section 101 of the Patent Act provides “[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.” 35 U.S.C. § 101. The Supreme Court has long held that this provision contains an implicit exception: “[l]aws of nature, natural phenomena, and abstract ideas are not patentable.” *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2354 (2014) (quoting *Ass’n for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576, 589–90 (2013)). The Court has set forth a two-part inquiry to determine whether this exception applies.

First, we must “determine whether the claims at issue are directed to one of those patent-ineligible concepts.” *Alice*, 134 S. Ct. at 2355. Second, if the claims are directed to one of those patent-ineligible concepts, we consider “the elements of each claim both individually and ‘as an ordered combination’ to determine whether the additional elements ‘transform the nature of the claim’ into a patent-eligible application.” *Id.* (quoting *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 77–78 (2012)). Put differently, we must search the claims for an “inventive concept,” that is, “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 (alteration in original) (quoting *Mayo*, 566 U.S. at 72–73).

B. Based Upon a Preponderance of the Evidence, and our Review of the Record, we Disagree with Appellants’ Arguments

i. Alice Step 1

As an initial matter, we note the issue of whether an Examiner raises an improper new ground of rejection (App. Br. 7–10; Reply Br. 3–7) is a petitionable matter and not an appealable matter. *See* 37 C.F.R. § 41.40(a). Appellants’ failure to file timely such a petition waives the argument. *See id.*

Furthermore, on this record, we discern no error in the Examiner’s analysis and conclusion that the present claims are directed to an abstract idea of receiving and publishing data similar to the abstract idea in *Affinity Labs of Texas*, which is delivering user-selected media content to devices. Ans. 11, 14. Moreover, we conclude the present claims are similar to the fundamental abstract idea in *In re Eberra*, 730 F. App’x 916 (Fed. Cir. 2018) (non-precedential) (affirming decision that promoting a product with an incentive is an abstract idea).

We, therefore, also disagree with Appellants’ argument that the present claims are necessarily rooted in computer technology, are directed to improvements in the computer related technology, and not manifestly abstract (App. Br. 10–13⁵) because the present claims are directed to an

⁵ Appellants incorrectly characterize *DDR* as an abstract idea issue (i.e., *Alice* step 1). App. Br. 10–13. Instead, *DDR* is an *Alice* step 2 issue. *See Synopsys, Inc. v. Mentor Graphics Corp.*, 839 F.3d 1138, 1151 (Fed. Cir. 2016) (Judge Chen, who is the same judge that authored *DDR*, characterizes *DDR* as an *Alice* step 2 issue). Nonetheless, we conclude the

abstract idea listed *supra* that use generic computing elements without significantly more.

Regarding Appellants' argument that the Examiner merely compares conclusions of cases with the present claims rather than analogizing relevant case facts with facts of the present claims that courts have found ineligible (*id.* at 15–17; Reply Br. 7–8), we note that the issues the Examiner provides conclusions about are legal issues under 35 U.S.C. § 101 rather than factual issues. We, therefore, conclude it is correct for the Examiner to compare legal holdings of relevant cases to the present claims.

We disagree with Appellants' argument that the Examiner did not provide analysis for the dependent claims (App. Br. 20) because the Examiner provides sufficient analysis to the dependent claims by analogizing the dependent claims to *Electric Power Grp, LLC v. Alstom S.A.*, 830 F.3d 1350 (Fed. Cir, 2016) and explaining why the dependent claims are abstract without significantly more. Ans. 15.

Because the present claims are directed to an abstract idea, we proceed to step (2) of the *Alice*, two-part test.

ii. Alice Step 2

On this record, we see no error in the Examiner's analysis and conclusion that the present claims are not significantly more than any abstract idea because they do not contain an inventive concept sufficient to transform the claim into patent-eligible subject matter. Ans. 15. We also see no error in the Examiner's finding that the present claims are directed to implementing the abstract idea using conventional or generic technology.

present claims are directed to an abstract idea without significantly more for the reasons stated *supra* and *infra*.

Final Act. 6. In particular, paragraphs 58 and 63 of Appellants' Specification describe using generic components. Spec. ¶¶ 58, 63.

We, therefore, disagree with Appellants' argument (App. Br. 13–15; Reply Br. 7–8) that the Examiner provides conclusory assertions, ignores limitations, and did not consider the combination of claim elements as a whole in reaching the conclusion that the claims are directed to using conventional or generic technology.

Accordingly, we sustain the Examiner's rejection of claims 1–6, 9–16, 19, and 20 under 35 U.S.C. § 101.

2. Rejection Under 35 U.S.C. § 103

The Examiner finds Brougher teaches an author can edit the public profile content and edit account permissions such as default visibility and editability, which the Examiner maps to the limitation “providing the user with sharing parameters” and “transmitting the digital content to one or more destinations, the transmission based at least in part on the selected sharing parameters” as recited in claims 1 and 20 (and similarly recited in claim 11). Ans. 17 (citing Brougher, Figs. 6A–6D, ¶ 174). Furthermore, the Examiner finds paragraph 7 of the Specification states that “sharing parameters may indicate one or more of the following: description of the digital content the user wishes to share,” which the Examiner finds, Brougher teaches in Figures 6A–6D, ¶¶ 71, 170–177. Ans. 18–19 (citing Spec. ¶¶ 7, 10, 47; Brougher Figs. 6A–6D, ¶¶ 71, 170–177).

Appellants argue paragraphs 67–76 of Brougher fails to teach the limitations “providing the user with sharing parameters” and “transmitting the digital content to one or more destinations, the transmission based at least in part on the selected sharing parameters” recited in claims 1 and 20

(and similarly recited in claim 11) because those cited portions do not teach or suggest “sharing parameters.” App. Br. 20–22; Reply Br. 8–9. We disagree with Appellants.

At the outset, Appellants do not argue the Examiner’s findings relying on Brougher’s Figures 6A–6D and paragraphs 170–177; these findings, therefore, are unrebutted. Nonetheless, the cited portions of Brougher relied upon by the Examiner teach an author can edit the public profile content and edit account permissions such as default visibility and editability, which teaches the limitation “providing the user with sharing parameters” and “transmitting the digital content to one or more destinations, the transmission based at least in part on the selected sharing parameters” as recited in claims 1 and 20 (and similarly recited in claim 11). Ans. 17 (citing Brougher, Figs. 6A–6D, ¶ 174). Furthermore, we agree with the Examiner’s finding that paragraphs 7, 10, and 47 of the Specification describe sharing parameters being one or more of a description of the digital content the user wishes to share, which Brougher teaches in Figures 6A–6D, ¶¶ 71, 170–177. Ans. 18–19 (citing Spec. ¶¶ 7, 10, 47; Brougher Figs. 6A–6D, ¶¶ 71, 170–177).

Accordingly, we sustain the Examiner’s rejection of claims 1–6, 9–16, 19, and 20 under 35 U.S.C. § 103.

We have only considered those arguments that Appellants actually raised in the Briefs. Arguments Appellants could have made, but chose not to make, in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(iv).

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DECISION

We affirm the Examiner's decision rejecting claims 1–6, 9–16, 19, and 20 under 35 U.S.C. § 101.

We affirm the Examiner's decision rejecting claims 1–6, 9–16, 19, and 20 under 35 U.S.C. § 103(a).

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