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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* SANJAY SURESHCHANDRA DUBEY  
and JOSEPH PAUL BETZ

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Appeal 2018-003747  
Application 13/689,296<sup>1</sup>  
Technology Center 3600

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Before JENNIFER L. McKEOWN, JASON J. CHUNG, and  
MATTHEW J. McNEILL, *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  
Examiner's Final Rejection of claims 1–23. We have jurisdiction under 35  
U.S.C. § 6(b).

We affirm.

INVENTION

The invention is directed to combining sponsored and unsponsored  
content in a social network. Spec. ¶ 1. Claim 1 is illustrative of the  
invention and is reproduced below:

1. A memory device, the memory device  
communicatively coupled to a processor and comprising

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<sup>1</sup> According to Appellants, LinkedIn, Corporation is the real party in interest.  
App. Br. 2.

instructions which, when performed on the processor, cause the processor to perform operations comprising:

obtain an unsponsored content group from each of a plurality of unsponsored content group sources, each unsponsored content group comprising at least two unsponsored content elements, wherein the unsponsored content groups are obtained based on a relevance of at least two unsponsored content elements of at least two unsponsored content groups to a user profile characteristic of a user;

generate a master content group based on the unsponsored content groups and a sponsored content group, the sponsored content group comprising at least one sponsored content element and an associated bid, wherein the master content group is generated based on the relevance of the at least two unsponsored content elements and a relevance of the sponsored content element to the user profile characteristic of the user and the associated bid;

reformat the content items of the master content group according to a uniform grammatical format by individually populating a plurality of fields, arranged in a predetermined grammatical relationship with respect to one another, from words included in the respective content items; and

transmit the master content group as reformatted to a user device associated with the user.

#### REJECTIONS AT ISSUE

Claims 1–23 stand rejected under 35 U.S.C. § 101 as being patent ineligible. Final Act. 2–4.

Claims 1, 6–8, 11, 16–18, and 23 stand rejected under 35 U.S.C. § 103 as being unpatentable over the combination of Bratsos (US 6,766,315 B1; issued July 20, 2004), Lymberopoulos (US 2012/0323876 A1; filed June 16, 2011), Tarantino (US 2010/0125507 A1; published May 20, 2010), Zamir

(US 7,693,827 B2; issued Apr. 6, 2010), and O’Neil (US 2013/0073280 A1; filed Sept. 21, 2011). Final Act. 4–9.

Claims 2 and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Bratsos, Lymberopoulos, Tarantino, Zamir, O’Neil, and Modzelewski (US 2009/0144243 A1; published June 4, 2009). Final Act. 10–11.

Claims 3–5, 9, 10, 13–15, 19, and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Bratsos, Lymberopoulos, Tarantino, Zamir, O’Neil, and Huang (US 2012/0284114 A1; filed May 6, 2011). Final Act. 11–14.

Claims 21 and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Bratsos, Lymberopoulos, Tarantino, Zamir, O’Neil, and Knittel (US 2007/0260627 A1; filed Nov. 8, 2007). Final Act. 14.

## ANALYSIS

### *I. Claims 1–23 Rejected Under 35 U.S.C. § 101*

#### *A. The Examiner’s Conclusions and Appellants’ Arguments*

The Examiner concludes the present claims are analogous to *TLI Communications LLC Patent Litigation v. AV Automotive, L.L.C.* 823 F.3d 607 (Fed. Cir. 2016), which recites claims directed to certain methods of organizing human activity. Final Act. 2–3. The Examiner also determines the present claims do not amount to significantly more than an abstract idea because the Examiner finds the abstract idea is implemented on a computer using generic components that are well-understood, routine, and conventional activities previously known to the industry. *Id.* at 3–4.

Appellants argue the present claims recite specific operations that do

not preempt distributing sponsored content alongside unsponsored content, in a specific format. App. Br. 14, 16. Additionally, Appellants argue, similar to the claims at issue in *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327 (Fed. Cir. 2016), the present claims focus on an improvement to computer functionality (e.g., the reformatted master content group provides an efficient, consistent, and easy to process graphical display). App. Br. 15–16.

Appellants argue the present claims subject matter is related to problems that are necessarily rooted in computer technology and specifically arise from the realm of online social networking. App. Br. 16–17. Furthermore, Appellants argue the Examiner provides no basis for asserting that such elements are conventionally and generically arranged in online social networking systems. App. Br. 17. We agree with Appellants’ last argument.

#### *B. Legal Principles*

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: “[I]aws of nature, natural phenomena, and abstract ideas” are not patentable. *E.g.*, *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)). In accordance with that framework, we first determine what concept the claim is “directed to.” *See Alice*, 573

U.S. at 219 (“On their face, the claims before us are drawn to the concept of intermediated settlement, i.e., the use of a third party to mitigate settlement risk.”); *see also Bilski v. Kappos*, 561 U.S. 593, 611 (2010) (“Claims 1 and 4 in petitioners’ application explain the basic concept of hedging, or protecting against risk.”).

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)). Concepts determined to be patent eligible include physical and chemical processes, such as “molding rubber products” (*Diamond v. Diehr*, 450 U.S. 175, 192 (1981)); “tanning, dyeing, making waterproof cloth, vulcanizing India rubber, smelting ores” (*id.* at 184 n.7 (quoting *Corning v. Burden*, 56 U.S. 252, 267–68 (1854))); and manufacturing flour (*Benson*, 409 U.S. at 69 (citing *Cochrane v. Deener*, 94 U.S. 780, 785 (1876))).

In *Diehr*, the claim at issue recited a mathematical formula, but the Supreme Court held that “[a] claim drawn to subject matter otherwise statutory does not become nonstatutory simply because it uses a mathematical formula.” *Diehr*, 450 U.S. at 176; *see also id.* at 192 (“We view respondents’ claims as nothing more than a process for molding rubber products and not as an attempt to patent a mathematical formula.”). Having said that, the Supreme Court also indicated that a claim “seeking patent protection for that formula in the abstract . . . is not accorded the protection of our patent laws, . . . and this principle cannot be circumvented by attempting to limit the use of the formula to a particular technological

environment.” *Id.* (citing *Benson* and *Flook*); *see, e.g., id.* at 187 (“It is now commonplace that an *application* of a law of nature or mathematical formula to a known structure or process may well be deserving of patent protection.”).

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 (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 on the application of § 101. USPTO’s January 7, 2019 Memorandum, *2019 Revised Patent Subject Matter Eligibility Guidance* (“Memorandum”). Under that 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 activity such as a fundamental economic practice, or mental processes); and
- (2) additional elements that integrate the judicial exception into a practical application (*see* MPEP § 2106.05(a)–(c), (e)–(h)).

Only if a claim (1) recites a judicial exception and (2) does not integrate that exception into a practical application, do we then look to whether the claim:

- (3) adds a specific limitation beyond the judicial exception that are 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* Memorandum.

*C. Discussion*

*1. Step 2A, Prong 1 (Alice Step 1)*

We consider claim 1 (with emphasis), reproduced below.

1. A memory device, the memory device communicatively coupled to a processor and comprising instructions which, when performed on the processor, cause the processor to perform operations comprising:
- obtain an unsponsored content group from each of a plurality of unsponsored content group sources, each unsponsored content group comprising at least two unsponsored content elements, wherein the unsponsored content groups are obtained based on a relevance of at least two unsponsored content elements of at least two unsponsored content groups to a user profile characteristic of a user;*
  - generate a master content group based on the unsponsored content groups and a sponsored content group, the sponsored content group comprising at least one sponsored content element and an associated bid, wherein the master content group is generated based on the relevance of the at least two unsponsored content elements and a relevance of the sponsored content element to the user profile characteristic of the user and the associated bid;*
  - reformat the content items of the master content group according to a uniform grammatical format by individually populating a plurality of fields, arranged in a*

*predetermined grammatical relationship with respect to one another, from words included in the respective content items; and*  
*transmit the master content group as reformatted to a user device associated with the user.*

We conclude the emphasized text above is directed to the generation of a master content group based on a relevance of at least two unsponsored content elements and a relevance of a sponsored content element to a user profile characteristic and reformatting of the content items of the master content group according to a uniform grammatical format. That is, the emphasized text is akin to targeting advertising to a user profile, which is a commercial interactions (including advertising). These commercial interactions (including advertising) are certain methods of organizing human activity. *See* Memorandum. These certain methods of organizing human activity are an abstract idea. *See id.*

Because the present claims recite an abstract idea, we proceed to prong 2.

2. *Step 2A, Prong 2 (Alice Step 1)*

The present claims do not integrate the abstract idea into a practical application because it does not impose any meaningful limits on practicing the abstract idea. In particular, the present claims do not recite improvements to the functioning of a computer or to any other technology or technical field.

Unlike the claims of *Enfish*, the present claims are not directed to “a specific improvement to the way computers operate, embodied in the self-referential table.” *Enfish*, 822 F.3d at 1336. Instead, the present claims focus on abstract ideas that merely use computers as tools.

Specifically, Appellants’ argument about a specific improvement in computer capabilities because the reformatted master content group provides an efficient, consistent, and easy to process graphical display (App. Br. 15–16) is unpersuasive because the present claims are focused on improving the relevance of data being fed to and processed by the computer, not improving the computer itself. And “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). “[U]nder the *Mayo/Alice* framework, a claim directed to a newly discovered law of nature (or natural phenomenon or abstract idea) cannot rely on the novelty of that discovery for the inventive concept necessary for patent eligibility.” *Genetic Techs. Ltd. v. Merial L.L.C.*, 818 F.3d 1369, 1376 (Fed. Cir. 2016) (citation omitted). Contrary to Appellants’ arguments, the present claims are directed to an abstract idea—not an improvement to computer functionality, as Appellants assert. App. Br. 15–16.

Additionally, we disagree with Appellants’ argument that the present claims are patent eligible because they do not preempt any abstract idea (App. Br. 14, 16); while preemption may denote patent ineligibility, its absence does not demonstrate patent eligibility. *See FairWarning IP, LLC v. Iatric Systems, Inc.*, 839 F.3d 1089, 1098 (Fed. Cir. 2016). For claims covering a patent-ineligible concept, preemption concerns “are fully addressed and made moot” by an analysis under the *Mayo/Alice* framework. *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015).

Appellants do not make any other arguments pertaining to step 2A, prong 2. Because the present claims are directed to an abstract idea, we proceed to Step 2B.

3. *Step 2B (Alice Step 2)*

Appellants' argument that the present claims' subject matter is related to problems that are necessarily rooted in computer technology and specifically arise from the realm of online social networking (App. Br. 10–13; Reply Br. 3–4), is unpersuasive for at least the reasons discussed *supra* in § C.2. That is, the present claims focus on abstract ideas that merely use computers as tools. And “a claim for a *new* abstract idea is still an abstract idea.” *Synopsys, Inc.*, 839 F.3d at 1151.

Turning to whether Appellants' argument that the Examiner provides no basis for asserting that such elements are conventionally and generically arranged in online social networking systems (App. Br. 17), we agree the Examiner has not established, on this record, that these elements, considered individually and as an ordered combination, are well-understood, routine, and conventional. Regarding a determination that “additional” claim elements are merely routine and conventional, the Federal Circuit has explained that:

Whether something is well-understood, routine, and conventional to a skilled artisan at the time of the patent is a factual determination. Whether a particular technology is well-understood, routine, and conventional goes beyond what was simply known in the prior art. The mere fact that something is disclosed in a piece of prior art, for example, does not mean it was well-understood, routine, and conventional.

*Berkheimer v. HP Inc.*, 881 F.3d 1360, 1369 (Fed. Cir. 2018).

To find an element to be well understood, routine, or conventional, the Examiner must support the rejection with one of the following:

1. A citation to an express statement in the specification or to a statement made by an applicant during prosecution that

demonstrates the well-understood, routine, conventional nature of the additional element(s).

2. A citation to one or more of the court decisions discussed in MPEP § 2106.05(d)(II) as noting the well-understood, routine, conventional nature of the additional element(s).
3. A citation to a publication that demonstrates the well-understood, routine, conventional nature of the additional element(s).
4. A statement that the examiner is taking official notice of the well-understood, routine, conventional nature of the additional element(s).

*Berkheimer* Memo.<sup>2</sup>

The Examiner does not support the rejection with one of these statements or citations. For these reasons, we find the rejection insufficiently supported on the record before us. Accordingly, we do not sustain the rejection of: (1) independent claims 1, 11, and 23; and (2) dependent claims 2–10 and 12–22 under 35 U.S.C. § 101.

*II. Claims 1–23 Rejected Under 35 U.S.C. § 103*

*A. Claims 1, 6–8, 11, 16–18, and 23*

*1. The Combination of Bratsos and Lymberopoulos*

The Examiner finds Bratsos teaches unsponsored content group sources (Final Act. 4–5) and that it would have been obvious to a person having ordinary skill in the art at the time of the invention (“PHOSITA”) to combine Bratsos and Lymberopoulos’ obtaining an ordered set of search

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<sup>2</sup> Memorandum on *Changes in Examination Procedure Pertaining to Subject Matter Eligibility, Recent Subject Matter Eligibility Decision (Berkheimer v. HP, Inc.)* (Apr. 19, 2018) available at: <https://www.uspto.gov/sites/default/files/documents/memo-berkheimer-20180419.PDF>

results to provide a more personalized search experience. Final Act. 5 (citing Lymberopoulos, claim 1, ¶ 1).

Appellants argue that combining Bratsos with Lymberopoulos is based on improper<sup>3</sup> hindsight because Bratsos does not teach a user profile characteristic of a user who enters a search term, so there is no basis for saying that a PHOSITA would make the leap to combine Lymberopoulos. Appellants argue Lymberopoulos teaches an *ordered* set of search results rather than content “*obtained* based on a relevance.” App. Br. 24–25. We disagree with Appellants.

As an initial matter, the Examiner finds Lymberopoulos’s claim 1 teaches obtaining an ordered search result, which teaches the limitation “obtained based on a relevance” recited in claim 1. Final Act. 5 (citing Lymberopoulos, claim 1, ¶ 1); Ans. 6.

Regarding Appellants’ hindsight argument, we are cognizant that our reviewing courts have not established a bright-line test for hindsight. In *KSR International Co. v. Teleflex, Inc.*, 550 U.S. 398 (2007), the Supreme Court guides that “[a] factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of argument reliant upon *ex post* reasoning.” *KSR*, 550 U.S. at 421 (citing *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 36 (1966)). Nevertheless, the Supreme Court qualified the issue of hindsight by stating, “[r]igid preventative rules that deny factfinders recourse to common sense, however, are neither necessary under our case law nor consistent with it.” *Id.*

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<sup>3</sup> Throughout the Appeal Brief and Reply Brief, Appellants appear to argue only “hindsight” rather than “improper hindsight.” We construe Appellants’ arguments as Appellants meaning to argue “improper hindsight.”

In reviewing the record here, we find Appellants have not identified any knowledge relied upon by the Examiner that was gleaned only from Appellants' disclosure and that was not otherwise within the level of ordinary skill in the art at the time of application filing. *See In re McLaughlin*, 443 F.2d 1392, 1395 (CCPA 1971). In this case, the Examiner relies on paragraph 1 of Lymberopoulos for their finding that a PHOSITA would have combined Bratsos and Lymberopoulos. Final Act. 5 (citing Lymberopoulos, claim 1, ¶ 1). Therefore, the Examiner's knowledge was not gleaned *only* from Appellants' disclosure.

Moreover, Appellants have not provided persuasive evidence that combining the respective teachings of the references (as proffered by the Examiner – Final Act. 5) would have been “uniquely challenging or difficult for one of ordinary skill in the art,” or that such a combination would have “represented an unobvious step over the prior art.” *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007). Nor have Appellants provided any objective evidence of secondary considerations, which, as our reviewing court explains, “operate[] as a beneficial check on hindsight.” *Cheese Systems, Inc. v. Tetra Pak Cheese and Powder Systems, Inc.*, 725 F.3d 1341, 1352 (Fed. Cir. 2013).

Accordingly, we are not persuaded of error in the Examiner's finding that Lymberopoulos teaches the limitation “obtained based on a relevance” and the Examiner's finding that a PHOSITA would have combined Bratsos and Lymberopoulos.

## 2. *The Combination of Bratsos and Zamir*

The Examiner finds that it would have been obvious to a PHOSITA to combine Bratsos and Zamir to combine unsponsored and sponsored content

so as to provide advertisers an opportunity to present content that interests a user. Final Act. 5 (citing Zamir, 2:56–58).

Appellants argue that combining Bratsos and Zamir is based on improper hindsight because there is no basis in Bratsos for assuming that the teaching of Bratsos is improved by incorporating sponsored advertising. App. Br. 25–26. We disagree with Appellants.

We agree with the Examiner’s finding that it would have been obvious to a PHOSITA to combine Bratsos with Zamir to combine unsponsored and sponsored content so as to provide advertisers an opportunity to present content that interests a user. Final Act. 5 (citing Zamir, 2:56–58). Furthermore, Appellants’ argument that there is no basis to combine Bratsos and Zamir is based on improper hindsight is conclusory.

Appellants have not identified any knowledge relied upon by the Examiner that was gleaned only from Appellants’ disclosure and that was not otherwise within the level of ordinary skill in the art at the time of application filing. *See In re McLaughlin*, 443 F.2d at 1395.

Furthermore, Appellants have not provided persuasive evidence that combining the respective teachings of the references (as proffered by the Examiner — Final Act. 5) would have been “uniquely challenging or difficult for one of ordinary skill in the art,” or that such a combination would have “represented an unobvious step over the prior art.” *Leapfrog*, 485 F.3d at 1162. Nor have Appellants provided any objective evidence of secondary considerations, which, as our reviewing court explains, “operate[] as a beneficial check on hindsight.” *Cheese Systems, Inc.*, 725 F.3d at 1352.

Accordingly, we are not persuaded of error in the Examiner’s finding that a PHOSITA would have combined Bratsos and Zamir.

3. *The Combination of Bratsos and Tarantino*

The Examiner finds that it would have been obvious to a PHOSITA to combine Bratsos and Tarantino's presenting content similar to a user's viewing history to recommend similar content to a user's interest. Final Act. 6 (citing Tarantino ¶¶ 4, 38, and 39).

Appellants argue the combination of Bratsos and Tarantino is based on improper hindsight. App. Br. 26. Appellants argue combining Bratsos and Tarantino requires changing the function of Tarantino because Tarantino pertains to relevance to a target content item previously presented to a user, whereas claim 1 requires relevance to a user profile characteristic. *Id.* at 26–27. We disagree with Appellants.

At the outset, the Examiner finds, and we agree, Tarantino's presenting content similar to a user's viewing history to recommend similar content to a user's interest teaches or suggests the limitation “relevance . . . to a user profile characteristic” recited in claim 1. Ans. 6–7; Final Act. 6 (citing Tarantino ¶¶ 4, 38, 39). Thus, we disagree with Appellants that combining Bratsos and Tarantino requires changing the function of Tarantino (App. Br. 26–27).

As for Appellants' hindsight argument (App. Br. 26), this argument is unpersuasive because it is conclusory. In addition, when reviewing the record here, we find Appellants have not identified any knowledge relied upon by the Examiner that was gleaned only from Appellants' disclosure and that was not otherwise within the level of ordinary skill in the art at the time of application filing. *See In re McLaughlin*, 443 F.2d at 1395.

Additionally, Appellants have not provided persuasive evidence that combining the respective teachings of the references (as proffered by the

Examiner — Final Act. 6) would have been “uniquely challenging or difficult for one of ordinary skill in the art,” or that such a combination would have “represented an unobvious step over the prior art.” *Leapfrog*, 485 F.3d at 1162. Nor have Appellants provided any objective evidence of secondary considerations, which, as our reviewing court explains, “operate[] as a beneficial check on hindsight.” *Cheese Systems, Inc.*, 725 F.3d at 1352.

Accordingly, we are not persuaded of error in the Examiner’s finding that a PHOSITA would have combined Bratsos and Tarantino.

#### 4. *The Combination of Bratsos and O’Neil*

The Examiner finds that it would have been obvious to a PHOSITA to combine Bratsos and O’Neil to generate sentences using objects and actions thereby allowing user experiences with external systems to be integrated in a social networking system. Final Act. 7 (citing O’Neil ¶¶ 7, 65–67).

Appellants argue the combination of Bratsos and O’Neil is based on improper hindsight because Bratsos pertains to intelligent internet searching dealing with hidden databases and bears no relationship to social networking. App. Br. 27–28. We disagree with Appellants.

Appellants have not identified any knowledge relied upon by the Examiner that was gleaned only from Appellants’ disclosure and that was not otherwise within the level of ordinary skill in the art at the time of application filing. *See In re McLaughlin*, 443 F.2d at 1395. In this case, the Examiner relies on paragraphs 7, 65, and 66 of O’Neil for their finding that a PHOSITA would have combined Bratsos and O’Neil. Final Act. 7 (citing O’Neil ¶¶ 7, 65, 67). Therefore, the Examiner’s knowledge was not gleaned *only* from Appellants’ disclosure.

Additionally, Appellants have not provided persuasive evidence that combining the respective teachings of the references (as proffered by the Examiner — Final Act. 7) would have been “uniquely challenging or difficult for one of ordinary skill in the art,” or that such a combination would have “represented an unobvious step over the prior art.” *Leapfrog*, 485 F.3d at 1162. Nor have Appellants provided any objective evidence of secondary considerations, which, as our reviewing court explains, “operate[] as a beneficial check on hindsight.” *Cheese Systems, Inc.*, 725 F.3d at 1352.

Accordingly, we are not persuaded of error in the Examiner’s finding that a PHOSITA would have combined Bratsos and O’Neil. In addition, we sustain the Examiner’s rejection of: (1) independent claims 1, 11, and 23; and (2) dependent claims 6–8 and 16–18 under 35 U.S.C. § 103.

*B. Claims 2 and 12*

The Examiner finds that it would have been obvious to a PHOSITA to combine the base combination and Modzelewski to remove duplicate data that results in an improved system that diversifies content viewed by users as well as preventing spam. Final Act. 10 (citing Modzelewski ¶ 163).

Appellants argue that the combination of the base combination and Modzelewski is based on improper hindsight because Bratsos does not appear to hint at the existence of duplication. App. Br. 29–30. We disagree with Appellants.

Appellants have not identified any knowledge relied upon by the Examiner that was gleaned only from Appellants’ disclosure and that was not otherwise within the level of ordinary skill in the art at the time of application filing. *See In re McLaughlin*, 443 F.2d at 1395. In this case, the Examiner relies on paragraph 163 of Modzelewski for their finding that a

PHOSITA would have combined the references from independent claim 1's rejection and Modzelewski. Final Act. 10 (citing Modzelewski ¶ 163).

Therefore, the Examiner's knowledge was not gleaned *only* from Appellants' disclosure.

Additionally, Appellants have not provided persuasive evidence that combining the respective teachings of the references (as proffered by the Examiner — Final Act. 10) would have been “uniquely challenging or difficult for one of ordinary skill in the art,” or that such a combination would have “represented an unobvious step over the prior art.” *Leapfrog*, 485 F.3d at 1162. Nor have Appellants provided any objective evidence of secondary considerations, which, as our reviewing court explains, “operate[] as a beneficial check on hindsight.” *Cheese Systems, Inc.*, 725 F.3d at 1352.

Accordingly, we sustain the Examiner's rejection of claims 2 and 12 under 35 U.S.C. § 103.

*C. Claims 3–5, 9, 10, 13–15, 19, and 20<sup>4</sup>*

The Examiner finds that it would have been obvious to a PHOSITA to combine the base combination and Huang to show the highest relevance first that relate to search results. Final Act. 11–12.

Appellants argue that the combination of the base combination and Huang is based on improper hindsight because the Examiner mischaracterizes the term “relevance” by relating it to “relevance of a search term” instead of “relevance to a user profile characteristic of a user.” We

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<sup>4</sup> Although Appellants label this as claims 21 and 22 in their heading (App. Br. 31), we interpret this as Appellants arguing claims 3–5, 9, 10, 13–15, 19, and 20 because the arguments in the text pertain to claims 3–5, 9, 10, 13–15, 19, and 20.

disagree with Appellants.

In this case, the base combination includes the Tarantino reference, which, as stated *supra* in § II.A.3, teaches showing relevant content to the search results of a user's viewing history (i.e., user's profile). The Examiner relies on Huang to teach *highest* relevance. And we agree with the Examiner's finding that it would have been obvious to a PHOSITA to combine the base combination and Huang to show the highest relevance first that relate to search results of a user's viewing history (i.e., user's profile). Final Act. 11–12.

Accordingly, we sustain the Examiner's rejection of claims 3–5, 9, 10, 13–15, 19, and 20 under 35 U.S.C. § 103.

*D. Claims 21 and 22*

The Examiner finds that it would have been obvious to a PHOSITA to combine the base combination and Knittel to obtain end-user characteristics from an end-user profile storage component thereby allowing presentation of personalized content to users. Final Act. 14 (citing Knittel ¶ 6).

Appellants argue that the combination of the base combination and Knittel is based on improper hindsight because first relies on Bratsos, which does not teach a user profile characteristic, then relies on Lymberopoulos to teach a user profile characteristic, but does not disclose a user profile characteristic including user profile data, then relies on Knittel to teach user profile data. We disagree with Appellants.

Appellants have not identified any knowledge relied upon by the Examiner that was gleaned only from Appellants' disclosure and that was not otherwise within the level of ordinary skill in the art at the time of application filing. *See In re McLaughlin*, 443 F.2d at 1395. In this case, the

Examiner relies on paragraph 6 of Knittel for their finding that a PHOSITA would have combined the references from independent claim 1's rejection and Knittel. Final Act. 14 (citing Knittel ¶ 6).

Additionally, Appellants have not provided persuasive evidence that combining the respective teachings of the references (as proffered by the Examiner — Final Act. 10) would have been “uniquely challenging or difficult for one of ordinary skill in the art,” or that such a combination would have “represented an unobvious step over the prior art.” *Leapfrog*, 485 F.3d at 1162. Nor have Appellants provided any objective evidence of secondary considerations, which, as our reviewing court explains, “operate[] as a beneficial check on hindsight.” *Cheese Systems, Inc.*, 725 F.3d at 1352.

Accordingly, we sustain the Examiner's rejection of claims 21 and 22 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).

#### DECISION

We reverse the Examiner's decision rejecting claims 1–23 under 35 U.S.C. § 101.

We affirm the Examiner's decision rejecting claims 1–23 under 35 U.S.C. § 103.

Because we affirm on at least one ground of rejection with respect to each claim on appeal, we affirm the Examiner's decision to reject claims 1–23. *See* 37 C.F.R. § 41.50(a)(1).

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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).

AFFIRMED