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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte OLUDARE OBASANJO, ALEXANDER S. FORD, and
SEUNG-HAE PARK

Appeal 2018-004156
Application 12/721,589
Technology Center 2100

Before BRYAN F. MOORE, JASON J. CHUNG, and
BETH Z. SHAW, *Administrative Patent Judges*.

CHUNG, *Administrative Patent Judge*.

DECISION ON APPEAL

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals the Final Rejection of claims 1–5, 7, 21–25, 27–31, 33, and 34.² We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

INVENTION

The invention relates to a social network activity reporting system. Spec. ¶ 4. Claim 1 is illustrative of the invention and is reproduced below:

¹ We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. According to Appellant, Microsoft Technology Licensing, LLC is the real party in interest. Appeal Br. 2.

² Claims 6, 8–20, 26, and 32 are cancelled. Appeal Br. 26, 27, and 29.

1. A computer-readable storage medium that comprises computer-executable instructions that, based on execution by a client computing device of a user, configure the client computing device to perform actions comprising:

retrieving, by the client computing device from one or more services, *a plurality of activity items published* by the one or more services, where the client computing device is separate from the one or more services;

forming, by the client computing device *from the plurality of retrieved activity items based on relationships, a set of activity items where, for each activity in the set, the relationships include one or more of a relationship between the user and a subject of the each activity and a relationship between the user and a publisher of the each activity;*

calculating, by the client computing device *according to a relevance formula, relevance scores for each of the activity items in the formed set;*

ordering, by the client computing device, *the set of activity items in a presentation order that is based on the calculated relevance scores; and*

presenting, by the client computing device, *the set of activity items according to the presentation order.*

Appeal Br. 25 (Claims Appendix) (emphases added).

REJECTIONS³

Claims 1–5, 7, 21–25, 27–31, 33, and 34 stand rejected under 35 U.S.C. § 101 as being directed to patent ineligible subject matter. Final Act. 2–4.

³ Claims 1–5 and 7 recite “computer-readable storage medium,” but do not recite “non-transitory.” In the event of further prosecution, the Examiner should evaluate claims 1–5 and 7 in light of *Subject Matter Eligibility of Computer Readable Media*, 1351 Off. Gaz. Pat. Office 212 (Feb. 23, 2010) and the Decision in *Ex parte Mewherter*, 107 USPQ2d 1857 (PTAB 2013) (precedential).

Claims 1–5, 7, 21–25, 27–31, 33, and 34 stand rejected under 35 U.S.C. § 103 as being unpatentable over the combination of Mawhinney (US 2008/0209320 A1; published Aug. 28, 2008) and Surukkai (US 8,412,698 B1; filed Apr. 7, 2005). Final Act. 5–10.

ANALYSIS

I. Claims 1–5, 7, 21–25, 27–31, 33, and 34 Rejected Under 35 U.S.C. § 101

A. Principles of Law

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 U.S. 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. *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 Court’s two-part 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, 67 (1972)). Concepts determined to be patent eligible include physical and chemical processes, such as “molding rubber products” (*Diamond v. Diehr*, 450 U.S. 175, 191 (1981)); “tanning, dyeing, making waterproof cloth, vulcanizing India rubber, smelting ores” (*id.* at 182 n.7 (quoting *Corning v. Burden*, 56 U.S. 252, 267–68 (1853))); 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 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 187; *see also id.* at 191 (“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 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.* (citation omitted) (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.* (alterations in original) (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.*

B. USPTO Section 101 Guidance

In January 2019, the U.S. Patent and Trademark Office (USPTO) published revised guidance on the application of § 101. 2019 Revised Patent Subject Matter Eligibility Guidance, 84 Fed. Reg. 50 (Jan. 7, 2019) (“2019 Revised Guidance”).⁴ “All USPTO personnel are, as a matter of internal agency management, expected to follow the guidance.” *Id.* at 51; *see also* October 2019 Update at 1.

Under the 2019 Revised Guidance and the October 2019 Update, 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) (“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) (9th ed.

⁴ In response to received public comments, the Office issued further guidance on October 17, 2019, clarifying the 2019 Revised Guidance. USPTO, *October 2019 Update: Subject Matter Eligibility* (the “October 2019 Update”) (available at https://www.uspto.gov/sites/default/files/documents/peg_oct_2019_update.pdf).

Rev. 08.2017, Jan. 2018)) (“Step 2A, Prong Two”).⁵
2019 Revised Guidance, 84 Fed. Reg. at 52–55.

Only if a claim (1) recites a judicial exception and (2) does not integrate that exception into a practical application, do we then look, under Step 2B, to 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.

2019 Revised Guidance, 84 Fed. Reg. at 52–56.

C. The Examiner’s Conclusions and Appellant’s Arguments

The Examiner concludes the present claims recite mental processes. Final Act. 3; Ans. 3 (citing *Electric Power Group, LLC v. Alstom S.A.*, 830 F.3d 1350 (Fed. Cir. 2016)). The Examiner also determines the present claims do not amount to significantly more than an abstract idea itself because the abstract idea is implemented on additional elements that are well-understood, routine, and conventional. Final Act. 2, 4; Ans. 3–4.

Appellant argues the present claims recite an improvement in computer-related technology because the present claims recite delivering

⁵ This evaluation is performed by (a) identifying whether there are any additional elements recited in the claim beyond the judicial exception, and (b) evaluating those additional elements individually and in combination to determine whether the claim as a whole integrates the exception into a practical application. *See* 2019 Revised Guidance - Section III(A)(2), 84 Fed. Reg. 54–55.

social networking content based on how interesting the content is to the user. Appeal Br. 10–14 (citing Spec. ¶¶ 3–5; *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327 (Fed. Cir. 2016); *Thales Visionix Inc. v. United States*, 850 F.3d 1343 (Fed. Cir. 2017)); Reply Br. 11–12. Appellant further argues the present claims are necessarily rooted in computer technology to solve problems specifically arising in that realm. Appeal Br. 12 (citing *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245 (Fed. Cir. 2014)). Appellant argues the present claims do not preempt any abstract idea. Appeal Br. 15. Appellant argues the present claims recite a non-conventional and non-generic arrangement of known, conventional elements, which results in an inventive concept. *Id.* at 14–16 (citing *BASCOM Global Internet Services, Inc. v. AT&T Mobility LLC*, 827 F.3d 1341 (Fed. Cir. 2016)). We are not persuaded by Appellant’s arguments for the following reasons.

D. Discussion

1. Step 2A, Prong 1

Patent eligibility under 35 U.S.C. § 101 is a question of law that is reviewable *de novo*. See *Dealertrack, Inc. v. Huber*, 674 F.3d 1315, 1333 (Fed. Cir. 2012). We do not rely on all of Examiner’s bases for the rejection but we reach the same conclusion as the Examiner. We, therefore, conclude the emphasized portions of claim 1,⁶ reproduced above (*see supra* at 1–2),

⁶ Claim 1, reproduced above with emphases, recites similar features as independent claims 21 and 28. Appellant does not argue 1–5, 7, 21–25, 27–31, 33, and 34 separately, but asserts the § 101 rejection of those claims should be withdrawn for at least the same reasons as argued for independent claim 1. Appeal Br. 5–16. We, therefore, group these claims together and refer to those claims as the “present claims.”

recite concepts performed in the human mind (including an observation, evaluation, judgement, opinion) because claim 1 requires “retrieving,” “forming,” “calculating,” “ordering,” and “presenting.” These features can be performed by using pen and paper and using the human mind. According to the Memorandum, concepts performed in the human mind (including an observation, evaluation, judgement, opinion) fall into the category of mental processes. *See* Memorandum. Moreover, those mental processes are a type of an abstract idea. *See id.*

We also agree with the Examiner’s conclusion that the present claims are analogous to the claims in *Electric Power Group, LLC v. Alstom S.A.*, 830 F.3d 1350 (Fed. Cir. 2016). *Ans. 3.* In *Electric Power*, the court held that the claims were drawn to “collecting information, analyzing it, and displaying certain results of the collection and analysis,” which is a mental process (i.e., an abstract idea). *Id.* at 1355–1356. The present claims at issue here are similar because they recite “retrieving” (i.e., this is analogous to “collecting information” in *Electric Power*), “forming,” “calculating,” and “ordering” (i.e., these steps are analogous to “analyzing it” in *Electric Power*), and “presenting” (i.e., this is analogous to displaying certain results of the collection and analysis in *Electric Power*).

Because the present claims recite concepts performed in the human mind (including an observation, evaluation, judgement, opinion), they fall into the category of mental processes (i.e., an abstract idea), and we proceed to prong 2.

2. Step 2A, Prong 2

The present claims do not integrate the abstract idea into a practical application because they do not impose any meaningful limits on practicing

the abstract idea. In particular, we disagree with Appellant’s argument that the present claims recite an improvement in computer-related technology by reciting social networking content delivery based on how interesting the content is to the user. Appeal Br. 10–14 (citing Spec. ¶¶ 3–5; *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327 (Fed. Cir. 2016); *Thales Visionix Inc. v. United States*, 850 F.3d 1343 (Fed. Cir. 2017)); Reply Br. 11–12.

Appellant does not identify persuasively how the Specification sets forth an improvement in technology. The USPTO October 2019 Patent Eligibility Guidance Update (“Update”) addresses how we consider evidence of improvement that is presented to us. The Update states:

[d]uring examination, the examiner should analyze the “improvements” consideration by evaluating the specification and the claims to ensure that a technical explanation of the asserted improvement is present in the specification, and that the claim reflects the asserted improvement. Generally, examiners are not expected to make a qualitative judgment on the merits of the asserted improvement. *If the examiner concludes the disclosed invention does not improve technology, the burden shifts to applicant to provide persuasive arguments supported by any necessary evidence to demonstrate that one of ordinary skill in the art would understand that the disclosed invention improves technology.* Any such evidence submitted under 37 C.F.R. § 1.132 must establish what the specification would convey to one of ordinary skill in the art and cannot be used to supplement the specification. For example, in response to a rejection under 35 U.S.C. § 101, an applicant could submit a declaration under § 1.132 providing testimony on how one of ordinary skill in the art would interpret the disclosed invention as improving technology and the underlying factual basis for that conclusion.

Update, 13 (emphasis added).

In this case, the Examiner concludes the present claims do not recite an improvement to technology. Final Act. 3–4; Ans. 3–4. Consequently, we

focus on any evidence Appellant cites as discussed in the Update. Here, although Appellant identifies paragraphs 3–5 of the Specification, those paragraphs merely describe publishing relevant social networking content that may be more interesting to a user (i.e., this can be done using pen and paper, which, therefore, is a mental process), which fall within the category of an abstract idea as discussed *supra*, not an improvement to technology. Appeal Br. 10–14 (citing Spec. ¶¶ 3–5; *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327 (Fed. Cir. 2016); *Thales Visionix Inc. v. United States*, 850 F.3d 1343 (Fed. Cir. 2017)); Reply Br. 11–12. In addition, paragraphs 3–5 of the Specification are unlike the technological improvements in *Enfish*.

In *Enfish*, the Federal Circuit considered how the invention in *Enfish* was superior to the technology in the prior art. That is, the court considered “the specification’s emphasis that ‘the present invention comprises a flexible, self-referential table that stores data,’” “[t]he specification also teaches that the self-referential table functions differently than conventional database structures,” and “traditional databases, such as ‘those that follow the relational model and those that follow the object oriented model’ are inferior to the claimed invention.” *Enfish, LLC v. Microsoft Corp.*, 822 F.3d at 1337 (interior citations omitted). Moreover, in *Enfish* “[t]he structural requirements of current databases require a programmer to predefine a structure and subsequent [data] entry must conform to that structure,’ [and] the ‘database of the present invention does not require a programmer to preconfigure a structure to which a user must adapt data entry.’” *Id.* Based on the foregoing, the court determined the claims “achieve[d] other benefits over conventional databases, such as increased flexibility, faster search times, and smaller memory requirements.” *Id.* Unlike the claims of *Enfish*,

the present claims do not recite “a specific improvement to the way computers operate, embodied in the self-referential table.” *Id.* at 1336.

Like the *Enfish* argument, Appellant’s *Thales* argument is unpersuasive. In particular, does not identify any paragraphs in the Specification or any other evidence to support the argument that the present claims recite an improvement in technology through the use of (non-abstract) electronic components in an uncommon way. The subject matter the *Thales* court considered was a method that eliminates many complications in previous solutions for determining position and orientation of an object on a moving platform. *Thales*, 850 F.3d at 1348. The *Thales* court reasoned that because the motion of a moving platform like a plane is more dynamic and unpredictable than the earth’s rotation, a traditional system that measured inertial data with respect to the earth had difficulty accurately calculating inertial data of an object on a moving platform. *Id.* The *Thales* court concluded the subject claims did not recite an abstract idea because the claims were directed to systems and methods that use inertial sensors in a new way to reduce errors in measuring the relative position and orientation of a moving object on a moving reference frame. *Id.* at 1348–49. Unlike the claims of *Thales*, the present claims do not recite using sensors to more efficiently track an object on a moving platform.

Instead, the present claims recite an abstract idea as discussed *supra*, in § I.D.1. or at best, improving an abstract idea—not a technological improvement. The Specification indicates the additional elements (i.e., “client computing device,” “one or more services,” “activity item

collector,”⁷ and “relevance calculator”⁸) recited in the present claims are merely generic computer components used to implement the abstract idea. Spec. ¶¶ 21–23, 38. Further, the generic computer components, individually or in combination, do not integrate the judicial exception into a practical application.

Additionally, “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) (emphasis added). “[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) (citations omitted).

We further disagree with Appellant’s argument that the present claims are necessarily rooted in computer technology to solve problems specifically arising in that realm. Appeal Br. 12 (citing *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245 (Fed. Cir. 2014)). The subject claim considered by the *DDR* court pertained to a visitor of a host’s website clicking on an advertisement for a third-party product displayed on the host’s website, the visitor is no longer being transported to the third party’s website. *DDR Holdings*, 773 F.3d at 1257. In *DDR*, instead of losing visitors to the third-party’s website, the host website can send its visitors to a web page on an outsource provider’s server that (1) incorporates “look and feel” elements from the host website and (2) provides visitors with the opportunity to purchase products from the third-party merchant without

⁷ This feature is recited in claim 28, but not recited in claims 1 and 21.

⁸ This feature is recited in claim 28, but not recited in claims 1 and 21.

actually entering that merchant’s website. *Id.* at 1257–58. In contrast to the claims of *DDR*, the present claims do not recite incorporating “look and feel elements” from a host website and providing visitors with the opportunity to purchase products from a third-party merchant without actually entering the merchant’s website.

Appellant’s argument that the present claims do not preempt any abstract idea does not persuade us that the claims are eligible. Appeal Br. 15. Although preemption may denote patent ineligibility, its absence does not demonstrate patent eligibility. *See FairWarning, IP, LLC v. Iatric Sys., Inc.*, 839 F.3d at 1098. 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).

Appellant does not make any other arguments pertaining to step 2A, prong 2. Because the present claims recite an abstract idea that is not integrated into a practical application, we proceed to Step 2B.

3. *Step 2B*

We agree with the Examiner’s determination that the additional elements implementing the abstract idea are well-understood, routine, and conventional. Final Act. 2, 4; Ans. 3–4. The Specification supports the Examiner’s determination in this regard because it explains that “client computing device,” “one or more services,” “activity item collector,” and “relevance calculator” are generic components. Spec. ¶¶ 21–23, 38. Appellant’s Specification indicates these additional elements were well-understood, routine, and conventional components because it describes them at a high level of generality and in a manner that indicates that they were

sufficiently well-known. *Id.* Moreover, the additional elements recited in the present claims, analyzed individually or in combination, does not result in the claim, as a whole, amounting to significantly more than the judicial exception.

An inventive concept “cannot be furnished by the unpatentable law of nature (or natural phenomenon or abstract idea) itself.” *Genetic Techs. Ltd. v. Merial L.L.C.*, 818 F.3d 1369, 1376 (Fed. Cir. 2016); *see also* 84 Fed. Reg. at 56; *Alice*, 573 U.S. at 217 (explaining that, after determining a claim is directed to a judicial exception, “we then ask, ‘[w]hat else is there in the claims before us?’” (emphasis added, brackets in original) (quoting *Mayo*, 566 U.S. at 78)). Instead, an “inventive concept” is furnished by an element or combination of elements that is recited in the claim in addition to the judicial exception and sufficient to ensure the claim as a whole amounts to significantly more than the judicial exception itself. *Alice*, 573 U.S. at 218-19 (citing *Mayo*, 566 U.S. at 72–73); *see BSG Tech LLC v. BuySeasons, Inc.*, 899 F.3d 1281, 1290 (Fed. Cir. 2018) (explaining that the Supreme Court in *Alice* “only assessed whether the claim limitations other than the invention's use of the ineligible concept to which it was directed were well-understood, routine and conventional,” (emphasis added)).

We also disagree with Appellant’s argument that the present claims recite a non-conventional and non-generic arrangement of known, conventional elements, which results in an inventive concept. Appeal Br. 14–16 (citing *BASCOM Global Internet Services, Inc. v. AT&T Mobility LLC*, 827 F.3d 1341 (Fed. Cir. 2016)). Appellant’s arguments fail to identify any additional element or particular combination of elements that allegedly are unconventional, non-routine, or not well-understood. *See*

Appeal Br. 14–16.

Additionally, in *BASCOM*, the claims were directed to “a filter implementation versatile enough that it could be adapted to many different users’ preferences while also installed remotely in a single location.” *BASCOM*, 827 F.3d at 1348–51. The inventive concept was “the installation of a filtering tool at a specific location, remote from the end-users, with customizable filtering features specific to each end user” that “gives the filtering tool both the benefits of a filter on a local computer and the benefits of a filter on the ISP server.” *Id.* at 1350. Thus, when considered as an ordered combination, the court concluded the claims provided “an inventive concept can be found in the non-conventional and non-generic arrangement of known, conventional pieces.” *Id.* Here, the present claims recite an abstract idea using additional elements that are generic computer components as discussed *supra*, in §§ I.D.1. and I.D.2. or at best, improving an abstract idea—not an inventive concept for the reasons discussed in § I.D.2. Accordingly, Appellant’s assertion fails to identify error in the Examiner’s conclusions and findings.

Appellant does not argue claims 2–5, 7, 21–25, 27–31, 33, and 34 separately, but asserts the § 101 rejection of those claims should be withdrawn for at least the same reasons as argued for independent claim 1. Appeal Br. 5–16. Accordingly, we sustain the Examiner’s rejection of: (1) independent claims 1, 21, and 28; and (2) dependent claims 2–5, 7, 22–25, 27, 29–31, 33, and 34 under 35 U.S.C. § 101.

We have only considered those arguments that Appellant actually raised in the Briefs. Arguments Appellant 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).

II. Claims 1–5, 7, 21–25, 27–31, 33, and 34 Rejected Under 35 U.S.C. § 103

The Examiner finds Mawhinney’s predefined or preselected weights and Sarukkai’s filter records teach the limitation “calculating, by the client computing device according to a relevance formula, relevance scores for each of the activity items in the formed set” recited in claim 21. Final Act. 6–7, 9 (citing Mawhinney ¶ 122; Sarukkai 7:7–19, 8:59–67, 12:52–67); Ans. 7–8. The Examiner concludes Appellant is attacking references individually. Ans. 7–8.

Appellant argues Mawhinney teaches initially weighting memes, but argues: (1) Mawhinney’s memes are not activity items; (2) Mawhinney’s initial weighting is for new memes that have yet to operate on any activity items; and (3) Sarukkai’s filter records do not cure this deficiency. Appeal Br. 22–23 (citing Mawhinney ¶ 120); Reply Br. 8–10 (citing Mawhinney ¶ 120). We agree with Appellant.

As an initial matter, we agree with Appellant that Mawhinney’s memes are not activity items. Appeal Br. 22–23; Reply Br. 8–10. In fact, the Examiner’s finding comports with Appellant’s argument; that is, Mawhinney’s⁹ “memes” operate as filters for explicit user preferences (Final Act. 5–6 (citing Mawhinney ¶¶ 43, 122)).

We also note that claim 21 recites “calculating, by the client computing device according to a relevance formula, relevance scores for each of the activity items in the formed set” (emphasis added). Because the

⁹ Our references to Mawhinney are to the portions of Mawhinney cited by the Examiner.

set is already formed before the calculation occurs, Mawhinney's initial weighting cannot teach calculating relevance scores for each activity item in the formed set because Mawhinney's initial weighting is for new memes that have yet to operate on any activity items.

Sarukkai's¹⁰ filter records fail to cure Mawhinney's deficiency because the Examiner merely relies on Sarukkai's filter records to teach "relevance formula." Final Act. 9 (citing Sarukkai 7:7–19, 8:59–67, 12:52–67); Ans. 7–8. However, even if Sarukkai's filter records teach relevance scores, Sarukkai's filter records still fail to teach the feature that Mawhinney is missing; that is, performing a calculation in an already formed set. Appeal Br. 22–23; Reply Br. 8–10.

Accordingly, we do not sustain the Examiner's rejection of: (1) independent claim 21 (and claims 1 and 28, which recite similar features); and (2) dependent claims 2–5, 7, 22–25, 27, 29–31, 33, and 34 under 35 U.S.C. § 103.

¹⁰ When we refer to Sarukkai, we refer to the portions of Sarukkai cited by the Examiner.

CONCLUSION

Claim(s) Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1-5, 7, 21- 25, 27-31, 33, 34	101	Eligibility	1-5, 7, 21- 25, 27-31, 33, 34	
1-5, 7, 21- 25, 27-31, 33, 34	103	Mawhinney, Surukkai		1-5, 7, 21- 25, 27-31, 33, 34
Overall Outcome			1-5, 7, 21- 25, 27-31, 33, 34	

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. § 1.136(a)(1)(iv).

AFFIRMED