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Table with 5 columns: APPLICATION NO., FILING DATE, FIRST NAMED INVENTOR, ATTORNEY DOCKET NO., CONFIRMATION NO.
12/977,027 12/22/2010 Erick Tseng 26295-17318 8537

87851 7590 12/13/2018
Facebook/Fenwick
Silicon Valley Center
801 California Street
Mountain View, CA 94041

EXAMINER

HARPER, ELIYAH STONE

ART UNIT PAPER NUMBER

2166

NOTIFICATION DATE DELIVERY MODE

12/13/2018

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ERICK TSENG and DAVID BRAGINAKY

Appeal 2018-005708
Application 12/977,027¹
Technology Center 2100

Before ST. JOHN COURTENAY III, LARRY J. HUME, and
JOYCE CRAIG, *Administrative Patent Judges*.

HUME, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) of the Non-Final Rejection of claims 1, 2, 4–14, 16, and 17, which are all claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

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

STATEMENT OF THE CASE²

The Invention

Appellants' disclosed embodiments and claimed invention relate to "providing relevant notifications for a user of a social networking system based on user location and social information." Spec. ¶ 1.

Exemplary Claim

Claim 1, reproduced below, is representative of the subject matter on appeal:

1. A method comprising:

maintaining information about a first user in a social networking system, the information comprising one or more connections established between the first user and one or more other users of the social networking system;

receiving a first location of the first user from a first mobile device at a first time point;

receiving a second location of a second user of the social networking system from a second mobile device at a second time point, the second user having a connection established with the first user in the social network system;

determining that the first user and the second user are in close proximity at a current time point by comparing the first location at the first time point with the second location at the second time point, the first time point and the second time point within a predetermined threshold of the current time point;

² Our decision relies upon Appellants' Appeal Brief ("App. Br.," filed Nov. 15, 2017); Reply Brief ("Reply Br.," filed May 17, 2018); Examiner's (Subsequent) Answer ("Ans.," mailed April 11, 2018); Non-Final Office Action ("Non-Final Act.," mailed June 15, 2017); and the original Specification ("Spec.," filed Dec. 22, 2010).

determining one or more content objects of which assigned object locations match the first location and the second location;

determining a relevance score for each of the one or more content objects to the first user, the determining comprising:

determining a location value that represents a proximity of the content object at the current time point to the first location;

determining an interest value for the content object, the interest value based on whether a category assigned to the content object is included in the one or more categories associated with the interest information for the second user;

combining the location value and the interest value to determine a combined score; and

modifying the combined score by a weighting factor to determine the relevance score, the weighting factor indicating a likelihood of the first user sharing interest in the content item with the second user;

selecting a set of content objects from the one or more content objects, each selected content object associated with a relevance score greater than a threshold;

ranking the set of content objects based at least in part on their relevance scores; and

providing the ranked set of content objects to a notification controller for transmission to the first user while the first user and the second user are determined to be in close proximity at the current time point.

Rejection on Appeal

Claims 1, 2, 4–14, 16, and 17 stand rejected under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter. Non-Final Act. 2.

ISSUE

Appellants argue (App. Br. 7–14; Reply Br. 2–9) the Examiner's rejection of claim 1 under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter is in error. These contentions present us with the following issue:

Under our governing case law concerning 35 U.S.C. § 101, did the Examiner err in concluding claim 1 is directed to a judicial exception, i.e., an abstract idea, without significantly more, and thus is patent-ineligible under § 101?

ANALYSIS

In reaching this decision, we consider all evidence presented and all arguments actually made by Appellants. To the extent Appellants have not advanced separate, substantive arguments for particular claims, or other issues, such arguments are waived. 37 C.F.R. § 41.37(c)(1)(iv).

Based upon our review of the record, we find a preponderance of the evidence supports particular arguments advanced by Appellants with respect to claims 1, 2, 4–14, 16, and 17 for the specific reasons discussed below. We highlight and address specific findings and arguments for emphasis as follows.

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. That provision "contains an important implicit exception: Laws of nature, natural phenomena, and abstract ideas are not

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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.*, 133 S. Ct. 2107, 2116 (2013)).

The Federal Circuit has described the *Alice* step one inquiry as looking at the "focus" of the claims, their "character as a whole," and the *Alice* step two inquiry as looking more precisely at what the claim elements add—whether they identify an "inventive concept" in the application of the ineligible matter to which the claim is directed. See *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016); *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335–1336 (Fed. Cir. 2016); *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1346 (Fed. Cir. 2015).

According to the Federal Circuit, "[t]he second step of the *Alice* test is satisfied when the claim limitations 'involve more than performance of 'well-understood, routine, [and] conventional activities previously known to the industry.' "' *Berkheimer v. HP Inc.*, 881 F.3d 1360, 1367 (Fed. Cir. 2018) (quoting *Content Extraction & Transmission LLC v. Wells Fargo Bank, Nat. Ass'n*, 776 F.3d 1343, 1347–1348 (Fed. Cir. 2014) and *Alice*, 134 S. Ct. at 2359).

In this case, the Examiner found:

The instantly claimed invention collects information about a user and content objects analyzes the information to produce rankings for content object and displays for display the results of the analysis of the content object. The mere collecting of information, analyzing of the information and displaying/storing certain results of the collection and analysis do not amount to significantly more than the judicial exception. All of these computer functions are *well understood routine conventional activities* previously known to the industry,

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therefore each step does no more than require a generic computer to perform generic computer functions.

Non-Final Act. 5–6 (emphasis added).

However, in the Reply Brief, Appellants argue the Examiner's analysis was deficient with respect to Step two of *Alice*:

[A] trio of recent cases issued after filing of the Brief has made clear that the step 2B inquiry for "well-understood, routine, and conventional" is a factual question. See *Berkheimer v. HP Inc.*, Case No. 2017-1437 (Fed. Cir. 2018) (reversing summary judgement of claims as ineligible because question of fact remained to determine conventionality), *Aatrix v. Green Shades Software, Inc.*, Case No. 2017-1452 (Fed. Cir. 2018) (reversing motion to dismiss and holding abuse of discretion to reject amended complaint that included factual support of unconventionality), *Exergen Corp. v. Kaz USA, Inc.*, Case Nos. 2016-2315, 2016-2341 (Fed. Cir. 2018) ("[t]here are many obscure references that nonetheless qualify as prior art . . . [t]his type of evidence . . . would not suffice to establish that something is 'well-understood, routine, and conventional activity.'")

Reply Br. 8.

In particular, Appellants point out the Examiner has not provided evidence of the well-known, routine, and conventional nature of the claimed elements:

The Answer have not provided any factual basis for the conclusion that the additional elements in the claims are well-understood, routine, or conventional. In particular, the initially-selected content items, the method of determining relevance based on location value, interest value, and weighing factor, and providing the content items for transmission "while the first user and the second user are determined to be in close proximity" have not been demonstrated by the examiner to be conventional activity. Unlike EPG, the presented claims do recite more than the generic concept of "analyzing" - instead,

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the claimed particular way of selecting and presenting content items were not demonstrated by the examiner to be conventional and the rejection thus fails to provide a sufficient factual basis.

Reply Br. 9.

We note Appellants' Appeal Brief was filed on Nov. 15, 2017, and Appellants' Reply Brief was filed on May 17, 2018. In reviewing the record, we recognize that Appellants had no opportunity to argue *Berkheimer* until after it was decided by the Federal Circuit on February 8, 2018. Thus, Appellants' first opportunity to argue *Berkheimer* as an intervening authority was in the Reply Brief. In the Reply Brief (9), Appellants also address the changes to patent examination practice that were set forth in the April 19, 2018 USPTO *Berkheimer* Memorandum ("The Examiner has not sufficiently shown a conventional application of an abstract idea 'unless the examiner finds, and expressly supports a rejection in writing' with one of a set of enumerated factual bas[e]s. *Berkheimer* Memo, p. 3.").

Accordingly, Appellants' new arguments citing *Berkheimer* (881 F.3d at 1369) and the USPTO *Berkheimer* Memorandum as intervening authorities (Reply Brief 8–9) are permitted under our procedural rule, 37 C.F.R. § 41.52(a)(2) ("Appellant may present a new argument based upon a recent relevant decision of either the Board or a Federal Court.").

Based upon our review of the record, and as guided by the mandatory changes to patent examination practice, as set forth in USPTO *Berkheimer* Memorandum, we are persuaded by and agree with Appellants' argument that the Examiner has not set forth a sufficient evidentiary basis to find the

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additional element (or combination of elements) of the independent claims is/are well-understood, routine, or conventional.

On this record, we find the Examiner provides no evidentiary support to show that any of the claimed method steps recited in independent claims 1 and 14 were well-understood, routine, and conventional. Therefore, we agree with Appellants that the Examiner's determination is not in accord with our binding case law because, as *Berkheimer* held, "[w]hether something is well-understood, routine, and conventional to a skilled artisan at the time of the patent is a factual determination." *Berkheimer*, 881 F.3d at 1369.

Here, the Examiner has not provided any of the four types of factual evidence required under the USPTO *Berkheimer* Memorandum. Accordingly, we are constrained on this record to reverse the Examiner's rejection of claims 1, 2, 4–14, 16, and 17.

CONCLUSION

The Examiner erred with respect to patent-ineligible subject matter Rejection of claims 1, 2, 4–14, 16, and 17 under 35 U.S.C. § 101, and we do not sustain the rejection.

DECISION

We reverse the Examiner's decision rejecting claims 1, 2, 4–14, 16, and 17.

REVERSED