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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte LEE LINDEN and BENJAMIN LEWIS

Appeal 2018-007251
Application 13/684,089
Technology Center 3600

Before JOSEPH L. DIXON, JENNIFER L. McKEOWN, and
JOHN D. HAMANN, *Administrative Patent Judges*.

McKEOWN, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant¹ appeals under 35 U.S.C. § 134(a) from the Examiner's decision to reject claims 1, 6, 7, 11, 15, 23–26, and 29–31. Claims 2–5, 8–10, 12–14, 16–22, 27, and 28 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

¹ Facebook, Inc. (“Appellant”) is the applicant as provided in 37 C.F.R. § 1.46 and is identified as the real party in interest. App. Br. 3.

STATEMENT OF THE CASE

Appellant's disclosed and claimed invention relates to

receiving a set of communications from multiple users, the set of communications directed to a recipient through a social networking system; identifying a gift-appropriate event of the recipient based on the set of communications; determining an intent of a sender to respond to the gift-appropriate event of the recipient based on an incomplete electronic note drafted by the sender, within the social networking system, and designating the recipient; selecting a gift for the recipient in response to the determined intent of the sender; and prior to transmission of the note to the recipient, displaying a recommendation to the sender, the recommendation including a suggestion to purchase the gift for the recipient.

Abstract.

Claim 1 is illustrative of the claimed invention and reads as follows:

1. A method comprising:
 - receiving, via a social networking system, a set of communications from a set of remote client devices, the set of communications directed to a recipient;
 - identifying, by at least one processor, a gift-appropriate event of the recipient based on the set of communications from the set of remote client devices; detecting, by the at least one processor via a local application corresponding to the social networking system installed on a remote client device associated with a sender, that the sender is drafting an incomplete electronic note to the recipient using the remote client device;
 - determining, by the at least one processor via the local application corresponding to the social networking system installed on the remote client device, while the sender drafts the incomplete electronic note, an intent of the sender to respond to the previously identified gift-appropriate event of the recipient based on the incomplete electronic note being drafted by the sender by comparing a phrase of the incomplete electronic note with indicators of the previously identified gift-appropriate event and identifying a correspondence between the phrase of the

incomplete electronic note and the previously identified gift-appropriate event;

while the sender drafts the incomplete electronic note to the recipient, selecting, by the at least one processor, a gift for the recipient in response to the determined intent of the sender to respond to the previously identified gift-appropriate event of the recipient; and

while the sender drafts the incomplete electronic note and prior to completion of the incomplete electronic note, providing, via the local application corresponding to the social networking system, a recommendation to the remote client device associated with the sender for display to the sender with the incomplete electronic note, wherein the recommendation enables the sender to initiate a purchase of the selected gift for the recipient.

THE REJECTIONS

The Examiner rejected claims 1, 6, 7, 11, 15, 23–26, and 29–31 under 35 U.S.C. § 101 as directed to patent ineligible subject matter. Final Act. 3–6.

The Examiner rejected claims 1, 6, 7, 11, 15, 23–26, and 29–31² under 35 U.S.C. § 103 as unpatentable over Leydon (US 2013/0159919; published June 20, 2013), Becker (US 2012/0102064 A1; published Apr. 26, 2012), and Evans (US 2012/0284093 A1; published Nov. 8, 2012). Final Act. 6–14.

² We note that the Examiner lists claim 18, 27, and 28 as rejected as unpatentable over Leydon, Becker, and Evans, however, these claims have been cancelled. *Compare* Final Act. 6 *with* App Br. 1 (identifying pending claims).

ANALYSIS

THE § 101 REJECTION

Claims 1, 6, 7, 11, 15, 23–26, and 29–31

Based on the record before us, Appellant has not persuaded us that the Examiner erred in rejecting claims 1, 6, 7, 11, 15, 23–26, and 29–31 as directed to patent ineligible subject matter.

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. *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, 191 (1981)); “tanning, dyeing, making water-proof cloth, vulcanizing India rubber, smelting ores” (*id.* at 182 n.7 (quoting *Corning v. Burden*, 56 U.S. (15 How.) 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 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 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 (citation 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 section 101. USPTO’s 2019 Revised Patent Subject Matter Eligibility Guidance, 84 Fed. Reg. 50 (Jan. 7, 2019) (“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* MANUAL OF PATENT EXAMINING PROCEDURE (“MPEP”) § 2106.05(a)-(c), (e)-(h) (9th ed. 2018)). *See* Memorandum 52, 55–56. 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 56.

Analysis – Revised Step 2A

Under the Memorandum, in prong one of step 2A, we look to whether the claims recite a judicial exception. The claimed invention includes “receiving. . . a set of communications from a set of remote client devices, the set of communications directed to a recipient;” “identifying. . . a gift-appropriate event of the recipient based on the set of communications from the set of remote client devices;” “detecting. . . via a local application corresponding to the social networking system installed on a remote client device associated with a sender, that the sender is drafting an incomplete electronic note to the recipient using the remote client device;” “while the sender drafts the incomplete electronic note,” “determining. . . via the local application corresponding to the social networking system installed on the remote client device. . . an intent of the sender to respond to the previously identified gift appropriate event of the recipient” by “comparing a phrase of the incomplete electronic note with indicators of the previously identified gift-appropriate event and identifying a correspondence between the phrase of the incomplete electronic note and the previously identified gift-appropriate event;” “while the sender drafts the incomplete electronic note to the recipient, selecting, by the at least one processor, a gift for the recipient in response to the determined intent of the sender to respond to the previously identified gift-appropriate event of the recipient;” and “while the sender drafts the incomplete electronic note and prior to completion of the incomplete electronic note, providing, via the local application corresponding to the social networking system, a recommendation to the remote client device associated with the sender for display to the sender with

the incomplete electronic note, wherein the recommendation enables the sender to initiate a purchase of the selected gift for the recipient.”

In other words, the claimed invention identifies a gift-appropriate event of a recipient based on an incomplete note from a user, determines an intent to respond to the gift-appropriate event, provides gift recommendations for a recipient for the gift-appropriate event, and prompts the user to initiate purchase of the recommended gift. The steps of recognizing gift-appropriate events and providing gift recommendations are managing personal behavior or personal interactions and, thus, are certain methods of organizing human activity, which is an abstract idea. *See* Final Act. 5; *see also Accenture Global Services, GmbH v. Guidewire Software, Inc.*, 728 F.3d 1336 (Fed. Cir. 2013) (finding ineligible claims directed to an automated method for generating tasks including determining characteristics of received information and applying characteristics of the information to rules to determine a task to be completed). Additionally, providing a recommendation enabling the sender to initiate purchase of the gift is advertising or sales activities, which are also certain methods of organizing human activity – an abstract idea. *See* Final Act. 5; *see also OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359 (Fed. Cir. 2015) (finding ineligible claims directed to pricing a product based on collected and analyzed information). As such, the claimed invention recites an abstract idea.

Under prong two of revised step 2A, we determine whether the recited judicial exception is integrated into a practical application of that exception by: (a) identifying whether there are any additional elements recited in the claim beyond the judicial exception(s); and (b) evaluating those additional

elements individually and in combination to determine whether they integrate the exception into a practical application.

Appellant contends that the claimed invention “improve[es] social networking computer systems and reducing digital siphoning from social networking systems to remote websites.” App. Br. 14; *see also* App. Br. 19 (arguing the claimed invention “allows the social networking system to retain users without driving them to other sources to identify and purchase gifts corresponding to gift-appropriate events.”). Appellant additionally argues that the claimed invention “provide[s] a technical solution to this technical problem (App. Br. 18) and “[is] ‘necessarily rooted in computer technology to overcome a problem specifically arising in the realm of computer networks.’” App. Br. 17.

We disagree. Namely, the claimed invention does not address a technical problem or provide a technical improvement. Rather, as the Examiner points out, “[a]ny improvement is manifested only in the procedure for targeting advertisements suggestions itself.” Ans. 5 (emphasis omitted); *see also* Final Act. 4 (noting that “the claims direct themselves wholly to the commercial endeavor”). Specifically, “the claims are directed solely to the manner in which the advertisements are targeted” and, as such, “fail[s] to result in an improvement in the performance of a computer, another technology, or technical field.” Ans. 5; *see also* Ans. 14–15 (distinguishing *BASCOM Global Internet v. AT&T Mobility LLC* 827 F.3d 1341 (Fed. Cir. 2016) because *Bascom*’s unconventional arrangement of generic technical components resulted in a *technical* improvement, “not an abstract-idea-based solution.”). The claimed invention instead, merely uses

the computer as a tool to implement the abstract idea. *See Gottschalk v. Benson*, 409 U.S. 63 (1972).

We further note that the steps of receiving data, such as receiving and processing data, such as receiving and comparing data to determine if the data matches, is insignificant extra-solution activity. *See MPEP* § 2106.05(g); *OIP Techs., Inc.*, 788 F.3d at 1363; *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1354 (Fed. Cir. 2016). As such, based on the record before us, we determine that the claimed invention is not integrated into a practical application.

Analysis – Revised Step 2B

Under step 2B, we determine that the claimed invention does not add significantly more to the abstract idea. Appellant, in particular, argues that the Examiner fails to sufficiently support the finding of the additional limitations as well-understood, routine, and conventional. Reply Br. 9–10.

We find this argument unpersuasive. As the Examiner explains, the claims at issue recite conventional computing components arranged in a conventional manner leveraged only as mechanism for achieving the claimed result more efficiently. Merely using a computer to perform more efficiently what could otherwise be accomplished manually does not confer patent-eligibility. Ans. 14 (citing *BuySAFE Inc. v Google, Inc.*, 765 F.3d 1350 (Fed. Cir. 2014); Final Act. 6 (citing prior art as support). *See also Elec. Power Grp., LLC*, 830 F.3d at 1355 (finding that use of “conventional computer, network, and display technology for gathering, sending, and presenting the desired information” does not add significantly more to the claimed abstract idea); *Content Extraction & Transmission LLC v. Wells Fargo Bank, Nat’l Ass’n*, 776 F.3d 1343, 1347 (Fed. Cir. 2014) (discussing that data collection, recognition, and storage is well-known); *CyberSource Corp. v. Retail*

Decisions, Inc., 654 F.3d 1366, 1375 (Fed. Cir. 2011) (“[T]he incidental use of a computer to perform the [claimed process] does not impose a sufficiently meaningful limit on the claim’s scope.”).

Therefore, based on the record before us, we are not persuaded of error in the Examiner’s determination that the appealed claims are directed to patent ineligible subject matter. Accordingly, we affirm the Examiner’s decision to reject claims 1, 6, 7, 11, 15, 23–26, and 29–31 as directed to patent ineligible subject matter.

THE § 103 REJECTION BASED ON LEYDON, BECKER, AND EVANS

Claims 1, 6, 7, 11, 15, 23–26, and 29–31

Based on the record before us, we are not persuaded that the Examiner erred in finding that claims 1, 6, 7, 11, 15, 23–26, and 29–31 are unpatentable over Leydon, Becker, and Evans.

Appellant contends that the prior art combination fails to teach or suggest “limitations in the claims related to comparing incomplete electronic notes to gift-appropriate events to identify user intent to respond to a gift-appropriate event while a user is drafting an incomplete electronic note as recited by amended independent claims 1, 15, and 23.” App. Br. 21. In particular, Appellant argues that Evans only teaches inserting an advertisement after a text message is complete and, thus,

Evans fails to teach determining an intent of the sender while a sender drafts an incomplete electronic note, fails to teach comparing a phrase of an incomplete electronic note with indicators of a gift-appropriate event, and fails to teach identifying a correspondence between the phrase of the incomplete electronic note and the previously identified gift-appropriate event.

App. Br. 23. Next, with respect to Becker, Appellant maintains that Becker only teaches sending a reminder or advertisement regarding an event based on text communications regarding the event. *Id.* According to Appellant,

providing a reminder or advertisement regarding an event fails to teach determining an intent of the sender while a sender drafts an incomplete electronic note, fails to teach comparing a phrase of an incomplete electronic note with indicators of a gift-appropriate event, and fails to teach identifying a correspondence between the phrase of the incomplete electronic note and the previously identified gift-appropriate event.

App. Br. 24. Further, Appellant asserts that Leydon's teaching of identifying candidate emoticons for a text field similarly fails to teach the disputed limitations. *Id.*

We find Appellant's arguments unpersuasive. Appellant's arguments fail to consider the combination of the teachings of Evans, Becker, and Leydon. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *See In re Keller*, 642 F.2d 413, 426 (CCPA 1981); *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986).

Specifically, the Examiner determines that Leydon shows "inserting a recommended object into an incomplete note was taught in the art (see particularly para 0047, 0048)" and Becker teaches identifying gift-appropriate events based on communications. Ans. 20. As such,

the combination of Leydon and Becker teach identifying gift appropriate events by analyzing segments of an incomplete message, but does not specifically mention that the object provided to the user during the message and as a result of the analysis includes an advertisement. Evans teaches adding a relevant advertisement to a user in a message.

Id. In other words, it would have been obvious to a skilled artisan at the time of the invention to replace Leydon's emoticon with an advertisement, as taught by Evans, related to an identified gift-appropriate event, as taught by Becker. As such, based on the record before us, we are not persuaded that the cited combination of prior art fails to teach or suggest the disputed limitations.

Accordingly, we affirm the Examiner's decision to reject claims 1, 6, 7, 11, 15, 23–26, and 29–31 as unpatentable over Leydon, Becker, and Evans.

DECISION

We affirm the Examiner's decision to reject claims 1, 6, 7, 11, 15, 23–26, and 29–31 as directed to patent ineligible subject matter and affirm the Examiner's decision to reject claims 1, 6, 7, 11, 15, 23–26, and 29–31 as unpatentable over Leydon, Becker, and Evans.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED