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BAKER BOTTS L.L.P./FACEBOOK INC. 2001 ROSS AVENUE SUITE 900 DALLAS, TX 75201			MIRZA, ADNAN M	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DAVID EDWARD BRAGINSKY, CHAMATH PALIHAPITIYA
and MATTHEW NICHOLAS PAPAHIPOS ¹

Appeal 2018-007290
Application 13/042,375
Technology Center 2400

Before CARL W. WHITEHEAD JR., JEFFREY S. SMITH and
DAVID J. CUTITTA II, *Administrative Patent Judges*.

WHITEHEAD JR., *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant is appealing the final rejection of claims 1–20 under
35 U.S.C. § 134(a). Appeal Brief 3. We have jurisdiction under 35 U.S.C.
§ 6(b).

We reverse.

¹ We use the word Appellant to refer to “applicant” as defined in 37 C.F.R.
§ 1.42(a). Appellant identifies Facebook, Inc., as the real party in interest.
Appeal Brief 3.

Introduction

According to Appellant, the invention is a “geo-social networking service and, more particularly, [relates] to dynamically generating recommendations associated with one or more places based on a user’s current location and/or location history.” Specification ¶ 1.

Representative Claim

1. A method comprising:

by one or more computing devices, accessing a data store for location data of a first user of a social-networking system, wherein each user is represented by a node in a social graph;

by the one or more computing devices, accessing one or more location data stores for one or more places in proximity to one or more locations indicated by the location data, wherein at least one or more places is represented by a node in the social graph;

by the one or more computing devices, generating a set of recommendations for the first user based at least in part on:

the one or more places in proximity to the locations indicated by the location data;

and

past check-in activities of the user, wherein a past check-in activity comprises an action, shared to a social-networking system, by the first user or a second user of the social-networking system, the action indicating a location of the first user; and

by the one or more computing devices, sending one or more recommendations of the set of recommendations to the first user.

References

Name²	Reference	Date
Horvitz	US 2007/0005419 A1	January 4, 2007
Schiff	US 2012/0095863 A1	April 19, 2012
Curtis	US 2012/0124176 A1	May 17, 2012

Rejections on Appeal

Claims 1–7 stand rejected under 35 U.S.C. §112 (pre-AIA), second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the inventor or a joint inventor regards as the invention. Final Action 2–3.

Claims 1–4, 6–11 and 13–20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Horvitz and Schiff. Final Action 3–11.

Claims 5 and 12 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Horvitz, Schiff, and Curtis. Final Action 11–13.

ANALYSIS

Rather than reiterate the arguments of Appellant and the Examiner’s determinations, we refer to the Appeal Brief (filed January 10, 2018), the Reply Brief (filed July 9, 2018), the Final Action (mailed March 6, 2017) and the Answer (mailed May 9, 2018), for the respective details.

35 U.S.C. §112, Second Paragraph Rejection

Appellant contends:

Appellant respectfully submits that Appellant previously amended Claim 1 in its Response dated 18 November 2016 so

² All reference citations are to the first named inventor only.

that Claim 1's subsequent recitations in lines 4, 7, and 15 now recite "by *the* one or more computing devices," therefore establishing antecedent basis in the "by one or more computing devices" as recited in line 2. *See* 18 November 2016 Response to Office Action at 2. Appellant respectfully submits that this recitation has sufficient antecedent basis, and requests the Board to reverse this rejection.

Appeal Brief 5.

The Examiner determines:

It is the Examiner's position that Applicant has not yet submitted claims drawn to limitations, which define the operation and apparatus of Applicant's disclosed invention in manner, which distinguishes over the prior art.

Failure for Applicant to significantly narrow definition/scope of the claims and supply arguments commensurate in scope with the claims implies the Applicant intends broad interpretation be given to the claims. The Examiner has interpreted the claims with scope parallel to the Applicant in the response and reiterates the need for the Applicant to more clearly and distinctly define the claimed invention.

Answer 5–6.

We do not agree with the Examiner's determination and find Appellant's argument persuasive. The Examiner is free to interpret a claim broadly within reason, however the claim's broadness does not render the claim indefinite when the claim language defines the scope of the claim consistent with the Specification. *See* MPEP³ §2173.02 ("A decision on whether a claim is indefinite under 35 U.S.C. §112, second paragraph requires a determination of whether those skilled in the art would understand what is claimed when the claim is read in light of the specification. *Power-*

³ Manual of Patent Examining Procedure.

Appeal 2018-007290
Application 13/042,375

One, Inc. v. Artesyn Techs., Inc., 599 F.3d 1343, 1350 (Fed. Cir. 2010);
Orthokinetics, Inc. v. Safety Travel Chairs, Inc., 806 F.2d 1565 (Fed.
Cir.1986).”). We reverse the Examiner’s 35 U.S.C. § 112, second paragraph
rejection of claims 1–7.

35 U.S.C. § 103 Rejection

Appellant contends that:

[E]ven if the § 103 rejection based on *Horvitz* and *Schiff* were [sic] proper at this point, the cited portions of *Schiff* also do not qualify as prior art under § 102(e). The nonprovisional patent application which led to the *Schiff* publication was filed 11 October 2011^[4] [sic], which is *after* the filing date of this Application [March 7, 2011]. *Schiff* claims priority to a provisional application (U.S. App. 61/393,793) (“*Schiff* Provisional”) filed 15 October 2010, which would pre-date the filing date of this Application.

Appeal Brief 6.

Appellant further contends:

However, the *Schiff* Provisional does not disclose, teach, or suggest that the users or places correspond to nodes of a social graph, and does not support the Examiner’s statement that *Schiff* teaches “each user being a user of a social-networking system, wherein each user is represented by a node in a social graph (Schiff: paragraphs [0041] and [0053]).” *Office Action* at 5-6. The cited portions of *Schiff* are not disclosed in the provisional and are thus unavailable as a prior art reference.

Appeal Brief 6.

⁴ The actual filing date of Schiff’s non-provisional patent application is October 14, 2011.

Appellant’s arguments have persuaded us of error. Schiff’s non-provisional application does not antedate Appellant’s application without relying upon the filing data of Schiff’s provisional application. Our reviewing court has said: In *Dynamic Drinkware*, we clearly explained that for a non-provisional application to claim priority to a provisional application for prior art purposes, “the specification of the *provisional* [application] must contain a written description of the invention . . . in such full, clear, concise, and exact terms, to enable an ordinarily skilled artisan to practice the invention claimed in the *non-provisional* application.” *Amgen Inc. v. Sanofi*, 872 F.3d 1367, 1380 (Fed. Cir. 2017) (alteration in original) (quoting *Dynamic Drinkware, LLC v. National Graphics Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015)).

Accordingly, the non-provisional application can rely upon the filing date of the provisional application *only if* at least one of the claims in the non-provisional application is supported by the written description of the provisional application in compliance with pre-AIA 35 U.S.C. § 112, first paragraph. See MPEP § 2136.03 (III) (*citing Dynamic Drinkware*, 800 F.3d at 1381) (finding insufficient the combination of: (1) a comparison between the claims of the patent-in-suit and the disclosure of the prior art patent; and (2) a comparison between a claim of the patent-in-suit and the provisional application upon which the prior art patent’s priority claim is based).

Thus, regardless of whether the Examiner’s rejection relies upon the limitations of the claims in the Schiff non-provisional application, for the Examiner to rely upon the filing date of the Schiff provisional application, at least one claim of the published application (non-provisional application)

must be supported by the provisional application. Here, the Examiner has not made any findings in this regard. *See* Answer 4–6; Final Action 3–11.

Consequently, we are constrained by the record before us and find that the Examiner erred in rejecting claims 1–20 under the combination of Horvitz and Schiff because Horvitz alone fails to establish unpatentability. *See* Final Action 5. Further, Curtis was not used to reject independent claims 1, 8 or 17 and therefore fails to address Horvitz’s noted deficiency. *See* Final Action 11. We reverse the Examiner’s obviousness rejection of claims 1-20.

CONCLUSION

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1–7	112, 2 nd paragraph	Indefiniteness		1–7
1–4, 6–11, 13–20	103(a)	Horvitz, Schiff		1–4, 6–11, 13–20
5, 12	103(a)	Horvitz, Schiff, Curtis		5, 12
Overall Outcome				1–20

REVERSED