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BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte EZRA CALLAHAN, LEAH PEARLMAN, JONATHAN PINES,
JUSTIN ROSENSTEIN, KENT SCHOEN, MARTIN SMITH, and
JONATHAN WARMAN

Appeal 2018-007829
Application 12/200,892
Technology Center 3600

Before HUBERT C. LORIN, NINA L. MEDLOCK, and
BRUCE T. WIEDER, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Ezra Callahan, et al. (Appellant)¹ seeks our review under 35 U.S.C. § 134(a) of the Final Rejection of claims 1–5, 8–14, and 17–30, which constitute all the claims pending in this application. Claims 6, 7, 15, and 16 have been cancelled. We have jurisdiction under 35 U.S.C. § 6(b).

¹ The pages of the Appellant’s Appeal Brief are not numbered; we refer to the title page as page 1 and treat the pages that follow as though consecutively numbered. The Appellant identifies Facebook, Inc. as the real party in interest. App. Br. 2.

SUMMARY OF DECISION

We AFFIRM.

THE INVENTION

Claim 1, reproduced below, is illustrative of the subject matter on appeal.

1. A computer-implemented method comprising:

storing a member profile for each of a plurality of members of a social network, wherein each member is a person and each member profile contains information related to the corresponding member;

storing an organization profile for each of a plurality of organizations in the social network, wherein each organization profile contains information related to the corresponding organization, the plurality of organization profiles comprising a first organization profile describing a first organization;

receiving requests from one or more of the member profiles to establish a connection in the social network to one of the organization profiles;

creating connections in the social network between the member profiles and the organization profile in response to requests therefor;

maintaining in the social network, the member profiles, the organization profiles, and the connections among the member and organization profiles;

receiving messages posted by members via the social networking system, the messages including one or more terms describing the first organization profile;

sending newsfeed stories describing the first organization profile to member profiles indirectly connected to the first organization profile via another member profile;

receiving a request for statistical information describing viral promotion of the first organization due to presence of the first organization on the social networking system;

collecting, by a computing system, statistical information associated with a plurality of actions taken by a plurality of member profiles to which the first organization profile is connected, the statistical information comprising:

a number of newsfeed stories provided by the social networking system describing the first organization profile to member profiles indirectly connected to the first organization profile via another member profile;

aggregating the collected statistical information based on interactions related to the first organizational profile, the aggregated statistical information containing demographic information from the plurality of member profiles associated with the collected statistical information; and

sending the aggregated statistical information as the requested information describing viral promotion of the first organization due to presence of the first organization on the social networking system.

THE REJECTIONS

The following rejections are before us for review:

Claims 1–5, 8–14, and 17–30 are rejected under 35 U.S.C. § 101 as claiming patent-ineligible subject matter.

Claims 1, 12, 19, 25–27, 29, and 30 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Buyukkokten et al. (US 7,680,770 B1, iss. Mar. 16, 2010) (“Buyukkokten”), Holberg (US 8,028,905 B2, iss. Oct. 4, 2011), Mann (US 2008/0189274 A1, pub. Aug. 7, 2008), and

Kaushansky et al. (US 2008/0215607 A1, pub. Sept. 4, 2008)
("Kaushansky").

Claims 2, 3, 8, and 13 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Buyukkokten, Holberg, Mann, Kaushansky, and Abhyanker (US 2008/0270158 A1, pub. Oct. 30, 2008).

Claims 4, 5, 11, 14, 18, 20, 21, 24, and 28 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Buyukkokten, Holberg, Mann, Kaushansky, and Eager et al. (US 2008/0172344 A1, pub. July 17, 2008) ("Eager").

Claims 9, 17, and 22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Buyukkokten, Holberg, Mann, Kaushansky, and DiRienzo et al. (US 6,076,066, iss. June 13, 2000) ("DiRienzo").

Claims 10 and 23 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Buyukkokten, Holberg, Mann, Kaushansky, DiRienzo, and Cohn (US 7,266,512 B2, iss. Sept. 4, 2007).

ISSUES

Did the Examiner err in rejecting claims 1–5, 8–14, and 17–30 under 35 U.S.C. §101 as claiming patent-ineligible subject matter; claims 1, 12, 19, 25–27, 29, and 30 under 35 U.S.C. § 103(a) as being unpatentable over Buyukkokten, Holberg, Mann, and Kaushansky; claims 2, 3, 8, and 13 under 35 U.S.C. § 103(a) as being unpatentable over Buyukkokten, Holberg, Mann, Kaushansky, and Abhyanker; claims 4, 5, 11, 14, 18, 20, 21, 24, and 28 under 35 U.S.C. § 103(a) as being unpatentable over Buyukkokten, Holberg, Mann, Kaushansky, and Eager; claims 9, 17, and 22 under 35 U.S.C. § 103(a) as being unpatentable over Buyukkokten, Holberg,

Mann, Kaushansky, and DiRienzo; and claims 10 and 23 under 35 U.S.C. § 103(a) as being unpatentable over Buyukkokten, Holberg, Mann, Kaushansky, DiRienzo, and Cohn?

ANALYSIS

The rejection of claims 1–5, 8–14, and 17–30 under 35 U.S.C. §101 as claiming patent-ineligible subject matter.

The Appellant argued these claims as a group. *See* App. Br. 6–21; Reply Br. 2–8. We select claim 1 (*supra*) as the representative claim for this group, and the remaining claims 2–5, 8–14, and 17–30 stand or fall with claim 1. 37 C.F.R. § 41.37(c)(1)(iv).

Preliminary comment

In the briefs, the Appellant refers to prior USPTO guidance. *See e.g.*, App. Br. 6 (“2014 Interim Guidance on Patent Subject Matter Eligibility [2014 Interim Guidance on Patent Subject Matter Eligibility, 79 Fed. Reg. 74619–633 (Dec. 16, 2014)]”). Said guidance has been superseded by the *2019 Revised Patent Subject Matter Eligibility Guidance*, 84 Fed. Reg. 50 (Jan. 7, 2019) (hereinafter “2019 Revised 101 Guidance”). 2019 Revised 101 Guidance, 84 Fed. Reg. at 51 (“Eligibility–related guidance issued prior to the Ninth Edition, R–08.2017, of the MPEP (published Jan. 2018) should not be relied upon.”).

Accordingly, our analysis will not address the sufficiency of the Examiner’s rejection against the cited prior guidance. Rather, our analysis will comport with the 2019 Revised 101 Guidance.

Introduction

35 U.S.C. § 101 provides that “[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.”

In that regard, claim 1 covers a “process” and is, thus, statutory subject matter for which a patent may be obtained.² This is not in dispute.

However, the § 101 provision “contains an important implicit exception: Laws of nature, natural phenomena, and abstract ideas are not patentable.” *Alice Corp. v. CLS Bank Int’l*, 573 U.S. 208, 216 (2014) (quoting *Ass’n for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576, 589 (2013)).

In that regard, notwithstanding claim 1 covers statutory subject matter, the Examiner has raised a question of patent-eligibility on the ground that claim 1 is directed to an abstract idea.

Alice identifies a two-step framework for determining whether claimed subject matter is directed to an abstract idea. *Alice*, 573 U.S. at 217.

Alice step one – the “directed to” inquiry

According to *Alice* step one, “[w]e must first determine whether the claims at issue are *directed to* a patent-ineligible concept.” *Id.* at 218 (emphasis added).

² This corresponds to Step 1 of the 2019 Revised 101 Guidance which requires determining whether a “claim is to a statutory category.” 2019 Revised 101 Guidance 53; *see also id.* at 53–54 (“[C]onsider[] whether the claimed subject matter falls within the four statutory categories of patentable subject matter identified by 35 U.S.C. [§] 101 . . .”).

The Examiner determined that claim 1 recites steps “similar to the abstract idea of [u]sing categories to organize, store and transmit information (Cyberfone) and data recognition and storage (Content Extraction).” Final Act. 2 (citing *Cyberfone Systems, LLC v. CNN Interactive Group, Inc.*, 558 F. App’x 988 (Fed. Cir. 2014) and *Content Extraction and Transmission LLC v. Wells Fargo Bank, Nat. Ass’n*, 776 F.3d 1343 (Fed. Cir. 2014)). The Examiner also determined that the claims are similar to “[c]ollecting information, analyzing it, and displaying certain results of the collection and analysis (*Electric Power Group*).” *Id.* (citing *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1356 (Fed. Cir. 2016)). The Examiner further determined that

[t]he limitations of *collecting statistical information associated with actions taken by members; comprising a number of newsfeed stories describing the first organizational profile to member profiles indirectly connected to organization; aggregating the collected statistical information* are similar to abstract idea of mathematical calculations such as organizing information through mathematical correlations (*Digitech*).

Id. at 2–3. *See also* Ans. 4 (citing *Classen Immunotherapies, Inc. v. Biogen IDEC*, 659 F.3d 1057 (Fed. Cir. 2011) and *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366 (Fed. Cir. 2011)).

The Appellant contends that “claim 1 is directed to a specific, non-abstract method of determining statistical information specifically about the social networking specific newsfeed stories in order to infer viral promotion of an organization represent[ed] using an organizational profile data structure.” App. Br. 17.

Accordingly, there is a dispute over what claim 1 is directed to. Is it directed to “[u]sing categories to organize, store and transmit” (Final Act. 2) or “a specific, non-abstract method of determining statistical information” (App. Br. 17)?

*Claim Construction*³

We consider the claim as a whole⁴ giving it the broadest reasonable construction⁵ as one of ordinary skill in the art would have interpreted it in light of the Specification⁶ at the time of filing.

³ “[T]he important inquiry for a § 101 analysis is to look to the claim.” *Accenture Glob. Servs., GmbH v. Guidewire Software, Inc.*, 728 F.3d 1336, 1345 (Fed. Cir. 2013). “In *Bancorp Servs., L.L.C. v. Sun Life Assurance Co. of Can.*, 687 F.3d 1266, 1273 (Fed. Cir. 2012), the court observed that ‘claim construction is not an inviolable prerequisite to a validity determination under § 101.’ However, the threshold of § 101 must be crossed; an event often dependent on the scope and meaning of the claims.” *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1347–48 (Fed. Cir. 2015).

⁴ “In determining the eligibility of respondents’ claimed process for patent protection under § 101, their claims must be considered as a whole.” *Diamond v. Diehr*, 450 U.S. 175, 188 (1981).

⁵ 2019 Revised 101 Guidance, 84 Fed. Reg. at 53 n.14 (If a claim, “under its *broadest reasonable interpretation* . . .” (emphasis added)).

⁶ “First, it is always important to look at the actual language of the claims Second, in considering the roles played by individual limitations, it is important to read the claims ‘in light of the specification.’” *Smart Sys. Innovations, LLC v. Chicago Transit Authority*, 873 F.3d 1364, 1378 (Fed. Cir. 2017) (J. Linn, dissenting in part and concurring in part), citing *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335 (Fed. Cir. 2016), among others.

Claim 1 sets forth “[a] computer-implemented method” comprising eleven steps with the objective of providing information describing a viral promotion of an organization on a social networking system. The method for accomplishing this objective does not specify any particular computer that performs ten of the eleven steps. The method calls for “a computing system” to perform one of the eleven steps, namely “collecting, by a computing system, statistical information.” The eleven steps are:

1. “storing” Information A;
2. “storing” Information B;
3. “receiving” Information C;
4. “creating” Information D “in response to requests therefor”;
5. “maintaining in the social network” Information E;
6. “receiving” Information F;
7. “sending” Information G;
8. “receiving” Information H;
9. “collecting, by a computing system,” Information I;
10. “aggregating” Information I based on Information J, Information K containing Information L; and
11. “sending” Information K as Information M.

Where:

Information A is “a member profile for each of a plurality of members of a social network, wherein each member is a person and each member profile contains information related to the corresponding member;”

Information B is “an organization profile for each of a plurality of organizations in the social network, wherein each organization profile contains information related to the corresponding organization, the

plurality of organization profiles comprising a first organization profile describing a first organization;”

Information C is “requests from one or more of the member profiles to establish a connection in the social network to one of the organization profiles;”

Information D is “connections . . . between the member profiles and the organization profile;”

Information E is “the member profiles, the organization profiles, and the connections among the member and organization profiles;”

Information F is “messages posted by members via the social networking system, the messages including one or more terms describing the first organization profile;”

Information G is “newsfeed stories describing the first organization profile to member profiles indirectly connected to the first organization profile via another member profile;”

Information H is “a request for statistical information describing viral promotion of the first organization due to presence of the first organization on the social networking system;”

Information I is “statistical information associated with a plurality of actions taken by a plurality of member profiles to which the first organization profile is connected, the statistical information comprising: a number of newsfeed stories provided by the social networking system describing the first organization profile to member profiles indirectly connected to the first organization profile via another member profile;”

Information J is “interactions related to the first organizational profile;”

Information K is “the aggregated statistical information;”

Information L is “demographic information from the plurality of member profiles associated with the collected statistical information;”
and,

Information M is “the requested information describing viral promotion of the first organization due to presence of the first organization on the social networking system.”

The claim provides no structural details⁷ that would distinguish the “computing system” from generic computer systems that were well-known at the time the application was filed. We note that claim 1 also recites a “social networking system,” but claim 1 does not call on the social networking system to perform any of the recited method steps.

Functionally, claim 1 calls on the “computing system” to collect the specified statistical information. This is a common function that generic computers are known to perform. The difference between the claimed “computing system” and other well-known computer systems in performing said common function is that the claimed “computing system” performs said functions on certain types of information. But, that difference alone is not patentably consequential. This is so because “[c]laim limitations directed to the content of information and lacking a requisite functional relationship are not entitled to patentable weight because such information is not patent eligible subject matter under 35 U.S.C. § 101.” *Praxair Distrib., Inc. v. Mallinckrodt Hosp. Prods. IP Ltd.*, 890 F.3d 1024, 1032 (Fed. Cir. 2018).

Based on the record before us, the claim steps of “storing,” “storing,” “receiving,” “creating,” “maintaining,” “receiving,” “sending,” “receiving,” “collecting,” “aggregating,” and “sending” various types of information do not ask any computer to go beyond a generic computer system’s common information-processing functions. Although computer-based instructions

⁷ *Cf. Move, Inc. v. Real Estate Alliance Ltd.*, 721 F. App’x 950 (Fed. Cir. 2018) (Nonprecedential) (“Claim 1 is aspirational in nature and devoid of any implementation details or technical description that would permit us to conclude that the claim as a whole is directed to something other than the abstract idea identified by the district court.”).

can be patentably significant (*see Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327 (Fed. Cir. 2016) and *Ancora Technologies, Inc. v. HTC America, Inc.*, 908 F.3d 1343 (Fed. Cir. 2018)), here the instant record does not sufficiently support the view that said steps have any non-conventional effect on the generic computer or “computing system” implementing the method. To the contrary, the record supports viewing the phrase “computer-implemented” and the recitation of “collecting, by a computing system” as amounting to a mere instruction to implement the recited information-processing scheme on a generic computer. *Cf. Alice*, 573 U.S. at 225–26 (“Instead, the claims at issue amount to ‘nothing significantly more’ than an instruction to apply the abstract idea of intermediated settlement using some unspecified, generic computer.”).

Looking at the steps themselves, their combination describes information-gathering in support of evaluating a viral promotion scheme; that is, by “storing,” “storing,” “receiving,” “creating,” “maintaining,” “receiving,” “sending,” “receiving,” “collecting,” “aggregating,” and “sending” information as claimed, an organization can be provided with information describing viral promotion of the organization due to presence of the organization on the social networking system.

Accordingly, we reasonably broadly construe claim 1 as being directed to gathering information describing viral promotion of an organization implemented on a generic computer system.

*The Abstract Idea*⁸

Above, where we reproduce claim 1, we identify in italics the limitations we believe recite an abstract idea.⁹ This is consistent with the Examiner’s view. *See* Final Act. at 2–4. Based on our claim construction analysis (above), we determine that the identified limitations describe a process of gathering information describing viral promotion of an organization due to the presence of the organization on a social networking system. Gathering information describing viral promotion of an organization due to the presence of the organization on a social networking system is a type of marketing activity as well as a method of “managing personal behavior or relationships or interactions between people,” and as such is a method of organizing human activity.¹⁰ *See* 2019 Revised 101

⁸ This corresponds to Step 2A of the 2019 Revised 101 Guidance. Step 2A determines “whether a claim is ‘directed to’ a judicial exception,” such as an abstract idea. 2019 Revised 101 Guidance, 84 Fed. Reg. at 53. Step 2A is two prong inquiry.

⁹ This corresponds to Prong One (a) of Step 2A of the 2019 Revised 101 Guidance. “To determine whether a claim recites an abstract idea in Prong One, examiners are now to: (a) Identify the specific limitation(s) in the claim under examination (individually or in combination) that the Examiner believes recites an abstract idea” 2019 Revised 101 Guidance, 84 Fed. Reg. at 54.

¹⁰ Because we determine that claim 1 recites a method of organizing human activity, we need not address the Examiner’s determination that the claims also involve “mathematical calculations” (Final Act. 3) or the Appellant’s corresponding arguments that the claims are not directed to mathematical algorithms (App. Br. 14).

Guidance, 84 Fed. Reg. at 52. Accordingly, it is an abstract idea.¹¹ *Cf.* *Morsa v. Facebook, Inc.*, 77 F.Supp.3d 1007 (CD. Cal. 2014), *aff'd*, 622 F. App'x (Mem) (Fed. Cir. 2015) (“claims here are drawn to two abstract ideas: targeting advertisements to certain consumers, and using a bidding system to determine when and how advertisements will be displayed”). Claim 1 involves gathering specific types of information (e.g., statistical information) but “collecting information, including when limited to particular content (which does not change its character as information), [is] within the realm of abstract ideas.” *Elec. Power Grp., LLC*, 830 F.3d at 1353; *see also Content Extraction*, 776 F.3d at 1347. The remaining (i.e., not italicized) limitations do no more than call upon a generic computer system (i.e., “a computing system”) to be used as a tool to perform this abstract idea.

¹¹ This corresponds to Prong One (“Evaluate Whether the Claim Recites a Judicial Exception”) (b) of Step 2A of the 2019 Revised 101 Guidance. “To determine whether a claim recites an abstract idea in Prong One, examiners are now to: . . . (b) determine whether the identified limitation(s) falls within the subject matter groupings of abstract ideas enumerated in Section I of the [2019 Revised 101 Guidance].” 2019 Revised 101 Guidance, 84 Fed. Reg. at 54. This case implicates subject matter grouping “(b)”: “(b) Certain methods of organizing human activity—fundamental economic principles or practices (including hedging, insurance, mitigating risk); commercial or legal interactions (including agreements in the form of contracts; legal obligations; advertising, marketing or sales activities or behaviors; business relations); managing personal behavior or relationships or interactions between people (including social activities, teaching, and following rules or instructions).” *Id.* at 52 (emphasis omitted).

*Improvement to Technology/Technical Field*¹² (Appellant's Argument)

The Appellant contends that “[t]he claims are not directed to an abstract idea because the abstract ideas in *Cyberfone*, *Content Extraction*, *FairWarning*, *Classen*, [and] *Electric Power Group*, . . . as cited by the Office Action do not properly compare to the claims of the current application.” App. Br. 7. The Appellant argues that each of these five cases is distinguishable from the claims before us. For example, the Appellant argues that the claims are not similar to the claims in *Cyberfone* because the claims here are

tightly coupled with the background social networking technology described in the claims” and recite a “very specifically claimed process, which describes exactly what type of data is to be collected, allows organizations to understand the impact their organizational profile has in the social network on an individual user basis, something that would not have been possible in a traditional analogue (e.g., a billboard ad in which people who view the billboard are completely anonymous).

¹² This corresponds to Prong Two (“If the Claim Recites a Judicial Exception, Evaluate Whether the Judicial Exception Is Integrated Into a Practical Application”) of Step 2A of the 2019 Revised 101 Guidance. 2019 Revised 101 Guidance, 84 Fed. Reg. at 54. “A claim that integrates a judicial exception into a practical application will apply, rely on, or use the judicial exception in a manner that imposes a meaningful limit on the judicial exception, such that the claim is more than a drafting effort designed to monopolize the judicial exception.” *Id.* One consideration, implicated here, that is “indicative that an additional element (or combination of elements)[] may have integrated the exception into a practical application” (*id.* at 55) is if “[a]n additional element reflects an improvement in the functioning of a computer, or an improvement to other technology or technical field” (*id.*).

Id. at 8. *See also id.* at 10 (arguing that the claims “recite very **specific** processes for how to train an optimizer for use in a user model, among other specific limitations in the claims”); *id.* at 11 (arguing that the claims in this case “recite to specific member and organizational profile data structures, and recite to a specific usage and application of the ‘newsfeed stories’ data structure (i.e., aggregating the collected statistical information regarding ‘a number of newsfeed stories provided by the social networking system describing the first organizational profile to member profiles ...’)”); *id.* at 12 (arguing that the claims in this case “recite specific and tangible (i.e., clear and definite) application of particular type of data structure (newsfeed stories) in a social networking system”); *id.* at 14 (arguing that “claim 1 recites in detail exactly what type of data is to be aggregated, and further recites specific data structures which would only exist in a social networking system and have no human analogue” and that the claims in this case “recite specific data that is sent in response to a request”).

The features argued by the Appellant simply narrow the abstract idea to particular information. For example, collecting information in “newsfeed stores” further limits the type of information collected, but only as to content.¹³ It does not, however, render the abstract idea any less abstract. *Cf. SAP Am., Inc. v. InvestPic, LLC*, 898 F.3d 1161, 1167 (Fed. Cir. 2018)

¹³ We note that the Specification indicates that newsfeed stories themselves are messages containing a particular type of information. *See Spec.* para. 45 (“The newsfeed generator 670 generates messages for each member about information that may be relevant to the member, based on actions stored in the action log 275. These messages are called ‘stories’; each story is an [sic] message comprising one or a few lines of information based on one more actions in the action log that are relevant to the particular member.”).

(“Contrary to InvestPic’s suggestion, it does not matter to this conclusion whether the information here is information about real investments. As many cases make clear, even if a process of collecting and analyzing information is “limited to particular content” or a particular “source,” that limitation does not make the collection and analysis other than abstract.”) (quoting *Elec. Power Grp.*, 830 F.3d at 1355 (citing cases)). The Appellant refers to specific “data structures,” but the Appellant does not point to any improved data structure in the claims or in the Specification. For example, the Appellant does not assert that the claimed “member profile,” “organizational profile,” or “newsfeed stories” are stored in any unconventional data structure that improves the functioning of any computer. *Cf. Enfish*, 822 F.3d at 1339 (“the self-referential table recited in the claims on appeal is a specific type of data structure designed to improve the way a computer stores and retrieves data in memory.”)

We also cannot agree with the Appellant’s contention that the claims before us are similar to the claims held eligible in *McRO, Inc. v. Bandai Namco Games America, Inc.*, 837 F.3d 1299 (Fed. Cir. 2016). *See* App. Br. 16–17; Reply Br. 6–7. The claims in *McRO* were directed to an improvement to computer technology – namely, the display of “lip synchronization and facial expressions” of animated characters. *McRO*, 837 F.3d at 1313. The claimed improvement was to how the computer operated to produce better quality synchronized images. Here, the claimed improvement relates to collecting and analyzing information in support of identifying information describing a viral promotion of an organization due to presence of the organization on a social networking system, and not any improved way of storing or collecting information.

We have reviewed the record but have been unable to find any discussion of an improvement in a technical field or technology. The Specification states that a problem addressed by the invention is that “existing social networks do not allow organizations to interact with members of the social network, where those organizations can have connections with members of the social network.” Spec. para. 4. The Specification then discloses that “[e]mbodiments of the invention enable an organization to exist in a social network and act in the social network in a manner that is tailored to the specialized needs of an organization.” *Id.* para. 5. Thereafter the Specification discloses maintaining various information related to a social network. *Id.* paras. 6–8. And, the Specification discloses that “incorporating organizations into the social network increases the likelihood that a member’s friends in the social network will be exposed to the organization and will create a connection with the organization” which “may contribute to viral growth of the connections between the organization and members of the social network.” *Id.* para. 9. But, there is no discussion that said maintaining of information is an *improvement* in information storage or retrieval. Nowhere does the Specification provide any details of any improved data structure for storing said information. Instead, the Specification merely lists various attributes that may be stored in generic data structures. For example, in the case where an organization is a restaurant, the Specification discloses that “the attributes used to describe a restaurant includ[e] cuisine, and take-out, etc.” *Id.* para. 34. *See also, id.* para. 49 (“the member profile store 640 contains data structures with fields suitable for describing a person’s profile and the

organization profile store 645 contains data structures with fields suitable for describing an organization's profile.”).

As to the argument that the claims recite “how to train an optimizer for use in a user model” (App. Br. 10), we do not see any “optimizer” or “training” limitation in claim 1, and the Appellant’s argument in that regard is unpersuasive at least because it is not commensurate with what is claimed.

Specific asserted improvements over prior technology, when claimed, can render claimed subject matter not directed to an abstract idea. *Cf. McRO*, 837 F.3d at 1316 (“When looked at as a whole, claim 1 is directed to a patentable, technological improvement over the existing, manual 3–D animation techniques.”). *See also* MPEP § 2106.05(a) (“Improvements to the Functioning of a Computer or To Any Other Technology or Technical Field.”) and *Alice*, 573 U.S. at 225. (“The method claims do not, for example, purport to improve the functioning of the computer itself. *See ibid.* (‘There is no specific or limiting recitation of . . . improved computer technology . . .’); Brief for United States as *Amicus Curiae* 28–30. Nor do they effect an improvement in any other technology or technical field. *See, e.g., Diehr*, 450 U.S., at 177–78.”). However, there is insufficient evidence in the record before us that the claimed subject matter reflects an asserted improvement over prior technology.

“The ‘abstract idea’ step of the inquiry calls upon us to look at the ‘focus of the claimed advance over the prior art’ to determine if the claim’s ‘character as a whole’ is directed to excluded subject matter.” *Affinity Labs of Texas v. DIRECTV, LLC*, 838 F.3d 1253, 1257 (Fed. Cir. 2016) (quoting *Elec. Power Grp.*, 830 F.3d at 1353); *see also Enfish*, 822 F.3d at 1335; *see also Ancora*, 908 F.3d at 1347:

We examine the patent’s “‘claimed advance’ to determine whether the claims are directed to an abstract idea.” *Finjan, Inc. v. Blue Coat Sys., Inc.*, 879 F.3d 1299, 1303 (Fed. Cir. 2018).” “In cases involving software innovations, this inquiry often turns on whether the claims focus on ‘the specific asserted improvement in computer capabilities . . . or, instead, on a process that qualifies as an “abstract idea” for which computers are invoked merely as a tool.’” *Id.* (quoting *Enfish*, 822 F.3d at 1335–36); see *BSG Tech LLC v. Buyseasons, Inc.*, 899 F.3d 1281, 1285–86 (Fed. Cir. 2018). Computers are improved not only through changes in hardware; “[s]oftware can make non-abstract improvements to computer technology” *Enfish*, 822 F.3d at 1335. See *Finjan*, 879 F.3d at 1304. We have several times held claims to pass muster under *Alice* step one when sufficiently focused on such improvements.

As we pointed out above in our Claim Construction analysis, the claimed invention lies in gathering information, not the “computing system” which, as the Specification shows, is merely generic. It is the particular information collected which appears to be the advance. *Cf. Intellectual Ventures I LLC v. Erie Indemnity Co.*, 850 F.3d 1315, 1328 (Fed. Cir. 2017) (“[T]he heart of the claimed invention lies in creating and using an index to search for and retrieve data . . . an abstract concept . . .”).

On pages 4–6 of the Reply Brief, in response to the Examiner’s citation of *Synopsys, Inc. v. Mentor Graphics Corp.*, 839 F.3d 1138, 1151 (Fed. Cir. 2016) (Ans. 6), the Appellant argues that claim 1 is distinguishable from that case because “claim 1 recites multiple computer and physical device limitations, such as ‘storing’ of data, including the member profiles, receiving messages via the social networking system (i.e., over a network), collecting ‘by a computing system’ statistical information, and so on.” Reply Br. 5. Yet, claim 1 does not specify any physical device that performs the “storing” functions. Nor does claim 1 recite any network.

As such, the Appellant’s arguments are unpersuasive at least because they are not commensurate with the scope of the claim. Moreover, Appellant has not adequately explained how storing data member profiles on an unspecified storage device, receiving messages via some unspecified communications medium, and collecting statistical information by a generic “computing system” amounts to an improvement to computers. *See buySAFE, Inc. v. Google, Inc.*, 765 F.3d 1350, 1355 (Fed. Cir. 2014) (“That a computer receives and sends the information over a network—with no further specification—is not even arguably inventive.”).

We have carefully reviewed the Specification but can find no disclosure of an improvement over prior technology. Rather than being directed to any specific asserted improvement over prior technology, the record supports the view that the claimed subject matter is directed to gathering and analyzing information in support of identifying information describing a viral promotion of an organization due to presence of the organization on a social networking system.¹⁴

We have considered all the Appellant’s arguments challenging the Examiner’s determination under step one of the *Alice* framework and find them unpersuasive. For the foregoing reasons, the record supports the Examiner’s determination that claim 1 is directed to an abstract idea.

¹⁴ *See* the 2019 Revised 101 Guidance, 84 Fed. Reg. at 55 (“The courts have also identified examples in which a judicial exception has not been integrated into a practical application: An additional element merely recites the words ‘apply it’ (or an equivalent) with the judicial exception, or merely includes instructions to implement an abstract idea on a computer, or merely uses a computer as a tool to perform an abstract idea.”).

*Alice step two – Does the Claim Provide an Inventive Concept?*¹⁵

Step two is “a search for an ‘inventive concept’—*i.e.*, an element or combination of elements that is ‘sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself.’” *Alice*, 573 U.S. at 217–218 (quoting *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 73 (2012)).

In that regard, the Examiner determined the following:

The claim(s) does/do not include additional elements that are sufficient to amount to significantly more than the judicial exception because the additional elements or combination of elements in the independent claims are recitation of generic computer structure (*i.e.* a processor to execute instructions to perform the method), which serves to perform generic computer functions that are well-understood, routine, and conventional activities previously known to the pertinent industry, and do not add a meaningful limitation to the abstract idea because they would be routine in any computer implementation. The limitations of storing a member profile; storing an organizational profile; sending information are well-known, routine and conventional practices that require no more than a generic computer to perform generic computer functions. Generic processors/computing systems routinely provide data access by displaying the data. These are well-known, routine and conventional practices that require no more than a generic computer to perform generic computer functions.

Furthermore, claims 1–5, 8–14, 17–30 have been fully analyzed to determine whether there are additional limitations

¹⁵ This corresponds to Step 2B of the 2019 Revised 101 Guidance, 84 Fed. Reg. at 56 (“[I]f a claim has been determined to be directed to a judicial exception under revised Step 2A, examiners should then evaluate the additional elements individually and in combination under Step 2B to determine whether they provide an inventive concept (*i.e.*, whether the additional elements amount to significantly more than the exception itself).”).

recited that amount to significantly more than the abstract idea. *The claims recite additional limitations of “a social network; storing, by the computer (Claim 19); collecting, by a computing system (claim 1, 19); receiving messages posted by members via the social networking system”* However, the additional limitations are simply generic computer (i.e. processor, social network system, network) functionality, claimed to perform the basic computer functions of: obtaining data, processing data, and transmitting data - through the program that enables the steps of the claimed invention (Specification [0040]). Taking the additional claimed elements individually and in combination, the computer components at each step of the process perform purely generic computer functions. Viewed as a whole, the claims do not purport to improve the functioning of the computer itself, or to improve any other technology or technical field. Use of an unspecified, generic computer does not transform an abstract idea into a patent-eligible invention. Thus, the claim does not amount to significantly more than the abstract idea itself. Further, claims to a system and computer-readable storage medium are held ineligible for the same reason, e.g., the generically-recited computers add nothing of substance to the underlying abstract idea.

Final Act. 3–4.

We agree with the Examiner’s analysis and determination.

The Appellant cites *BASCOM Glob. Internet Servs., Inc. v. AT&T Mobility LLC*, 827 F.3d 1341 (Fed. Cir. 2016) (App. Br. 18–20) as matching this case. We disagree. Unlike in *BASCOM*, here no improvement in computer functionality has been shown. *See BASCOM*, 827 F.3d at 1351 (“[T]he claims may be read to ‘improve[] an existing technological process.’”). Emphasis added.

The Appellant argues that “under the analysis in *BASCOM*, even if the elements in claims of the current application were deemed to be known and/or conventional, the non-conventional and non-generic **arrangement** of

the elements in the claims of the current application signifies that the claims provide an inventive concept.” App. Br. 18.

The difficulty with this argument is that we can find no basis for it in the claim or the Specification. Claim 1 does not specify any arrangement of the claimed “computing system.” “Many of appellant’s arguments fail from the outset because, . . . they are not based on limitations appearing in the claims” *In re Self*, 671 F.2d 1344, 1348 (CCPA 1982). Nowhere in the record is there any suggestion that the arrangement of the claimed “computing system” is non-conventional and non-generic as the Appellant argues. The argument is not commensurate in scope with what is claimed and, because the record does not reflect it, amounts to mere attorney argument. Attorney argument, however, cannot take the place of record evidence. *See In re Geisler*, 116 F.3d 1465, 1470 (Fed. Cir. 1997); *Johnston v. IVAC Corp.*, 885 F.2d 1574, 1581 (Fed. Cir. 1989).

The Appellant further argues that the allegedly inventive concept is supplied by “aggregating specifically enumerated information about transmitted data (e.g., newsfeed stories) in order to determine for an organization an impact, or response, for that organization by having its profile within the social networking system.” App. Br. 20. According to the Appellant, “[t]he improvement allows organizations to submit an organizational profile within a social networking system and subsequently determine, based on numbers of newsfeed stories provided to members indirectly connected to the organization’s profile, the viral promotion of the organization’s profile.” *Id.*

As to the claimed recitation of “specifically enumerated information,” we have explained above that claim limitations that merely specify a

particular type or content of information do not render the claim any less abstract. *See SAP Am.*, 898 F.3d at 1167. And, although allowing an organization to determine “the viral promotion of the organization’s profile” on a social network may amount to a business or marketing improvement, it is not an improvement to any computing system.

We have reviewed the Specification and, as explained above, we can find no suggestion of any improvements to a computing system as a result of performing the recited steps. The Specification conveys that the Appellant’s invention is focused on gathering information, not on the “computing system,” individually or in the combination as claimed. Rather than focusing on the “computing system,” the Specification focuses on the content of information collected, the “computing system” being merely a conduit for performing said information collection. *Cf. In re TLI Commc’ns LLC Patent Litig.*, 823 F.3d 607, 612 (Fed. Cir. 2016) (“Put differently, the telephone unit itself is merely a conduit for the abstract idea of classifying an image and storing the image based on its classification. Indeed, the [S]pecification notes that it ‘is known’ that ‘cellular telephones may be utilized for image transmission,’ *id.* at col. 1 ll. 31–34, and existing telephone systems could transmit pictures, audio, and motion pictures and also had ‘graphical annotation capability,’ *id.* at col. 1 ll. 52–59.”).

As discussed above, the Specification evidences the conventionality of the claimed “computing system,” structurally and functionally, individually and in combination. *See, e.g.*, Spec. para. 41 (“social networking website 200 comprises a computing system that allows members to communicate or otherwise interact with each other and access content as described herein.”); *id.* para. 84 (“Embodiments of the invention may also

relate to an apparatus for performing the operations herein. This apparatus may be specially constructed for the required purposes, and/or it may comprise a general-purpose computing device selectively activated or reconfigured by a computer program stored in the computer.”). Much like the “data storage unit” and “computer, coupled to said storage unit” in the claims of *Alice* (US Patent 7,149,720, claim 1), “the claims here do [not do] more than simply instruct the practitioner to implement the abstract idea [. . .] on a generic computer.” *Alice*, 573 U.S. at 225. For the reasons discussed above, we are unpersuaded that the record supports interpreting the steps recited in the claim as yielding any improvement in technology as the Appellant has argued.

The Appellant further argues that the method of claim 1 “does not have a human analogue.” App. Br. 20. But that alone does not confer patentability. *Cf. FairWarning IP, LLC v. Iatric Systems, Inc.*, 839 F.3d 1089, 1098 (Fed. Cir. 2016) (“the inability for the human mind to perform each claim step does not alone confer patentability. As we have explained, ‘the fact that the required calculations could be performed more efficiently via a computer does not materially alter the patent eligibility of the claimed subject matter.’” (citation omitted)).

The Appellant further argues that the method of claim 1 “has not been performed before in prior art.” App. Br. 20.

Claim limitations found to be novel and/or nonobvious can affect a patent-eligibility determination. *Cf. Ariosa Diagnostics, Inc., v. Sequenom, Inc.*, 788 F.3d 1371 (Fed. Cir. 2015) (“For process claims that encompass natural phenomenon, the process steps are the additional features that must be new and useful.”). Thus, novelty is a factor to be considered when

determining “whether the claims contain an ‘inventive concept’ to ‘transform’ the claimed abstract idea into patent-eligible subject matter.”

Ultramercial, Inc. v. Hulu, LLC, 772 F.3d 709, 715 (Fed. Cir. 2014).

“[N]ovelty in implementation of the idea is a factor to be considered only in the second step of the *Alice* analysis.” *Id.*

However, a finding of novelty or nonobviousness does not necessarily lead to the conclusion that subject matter is patentable eligible.

“Groundbreaking, innovative, or even brilliant discovery does not by itself satisfy the § 101 inquiry.” *Ass’n for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576, 591 (2013).

Indeed, “[t]he ‘novelty’ of any element or steps in a process, or even of the process itself, is of *no relevance* in determining whether the subject matter of a claim falls within the § 101 categories of possibly patentable subject matter.” *Diamond v. Diehr*, 450 U.S. 175, 188–89 (1981) (emphasis added); *see also Mayo*, 132 S. Ct. at 1303–04 (rejecting “the Government’s invitation to substitute §§ 102, 103, and 112 inquiries for the better established inquiry under § 101”). Here, the jury’s general finding that Symantec did not prove by clear and convincing evidence that three particular prior art references do not disclose all the limitations of or render obvious the asserted claims does not resolve the question of whether the claims embody an inventive concept at the second step of *Mayo/Alice*.

Intellectual Ventures I LLC v. Symantec Corp., 838 F.3d 1307, 1315 (Fed. Cir. 2016).

Nor does a finding of obviousness necessarily lead to the conclusion that subject matter is patentable ineligible. *See also Rapid Litig. Mgmt. Ltd. v. CellzDirect, Inc.*, 827 F.3d 1042, 1050 (Fed. Cir. 2016) (“That each of the claims’ individual steps (freezing, thawing, and separating) were known independently in the art does not make the claim unpatentable.”) “[P]atent-

eligibility does not turn on ease of execution or obviousness of application. Those are questions that are examined under separate provisions of the Patent Act.” *Id.* at 1052 (citing *Mayo*, 566 U.S. at 90).

Notwithstanding that “‘the § 101 patent-eligibility inquiry and, say, the § 102 novelty inquiry might sometimes overlap,’ [] a claim for a new abstract idea is still an abstract idea.” *Synopsys*, 839 F.3d at 1151 (quoting *Mayo*, 566 U.S. at 90). The question in step two of the *Alice* framework is not whether an additional feature is novel but whether the implementation of the abstract idea involves “more than the performance of ‘well-understood, routine, [and] conventional activities previously known to the industry.’” *Content Extraction*, 776 F.3d at 1347–48 (quoting *Alice*, 573 U.S. at 225).

In that regard, the Appellant has not shown novel features that transform the abstract idea into patent-eligible subject matter. The Appellant does not persuasively explain what features in the claim would render the subject matter significantly more than the information-gathering in support of evaluating a viral promotion scheme we have determined the claim to be directed to. At most, the claimed scheme uses “a computing system” but, as we have discussed, that alone adds little to transform the abstract idea into an inventive concept. Accordingly, this argument is unpersuasive.

The Appellant further argues that “the Examiner has simply provided conclusory statements” and that the Appellant “cannot properly respond and is unable to determine what actions, if any, need to be taken.” App. Br. 21. We disagree. The rejection is four pages long written with extensive detail to fully inform the Appellant of the Examiner’s position. The Appellant responded with 16 pages of rebuttal reflecting an understanding of the Examiner’s position. The record shows that the rejection did not fail to

comply with the notice requirement of 35 U.S.C. § 132 — the standard by which the sufficiency of the Examiner’s rejection is properly assessed. *See In re Jung*, 637 F.3d 1356, 1362 (Fed. Cir. 2011) (holding that the USPTO carries its procedural burden of establishing a prima facie case when its rejection satisfies the requirements of 35 U.S.C. § 132); *Chester v. Miller*, 906 F.2d 1574, 1578 (Fed. Cir. 1990) (“Section 132 is violated when a rejection is so uninformative that it prevents the applicant from recognizing and seeking to counter the grounds for rejection.”).

Citing *Berkheimer v. HP Inc.*, 881 F.3d 1360 (Fed. Cir. 2018), the Appellant further argues that “the Examiner has also erred by stating that no factual inquiry is required in the formation of a rejection under § 101.” App. Br. 21.

We cited the Specification in our discussion as intrinsic evidence that the claimed element “computing system” is conventional. In doing so, we have followed “Changes in Examination Procedure Pertaining to Subject Matter Eligibility, Recent Subject Matter Eligibility Decision (*Berkheimer v. HP Inc.*,” USPTO Memorandum, Robert W. Bahr, Deputy Commissioner For Patent Examination Policy, April 19, 2018 (the “Berkheimer Memo”). The court in *Berkheimer* held that “[t]he patent eligibility inquiry may contain underlying issues of fact.” *Berkheimer*, 881 F.3d at 1365 (quoting *Mortg. Grader, Inc. v. First Choice Loan Servs. Inc.*, 811 F.3d 1314, 1325 (Fed. Cir. 2016) (“The § 101 inquiry ‘*may* contain underlying factual issues.”)). But, the court also held that “[w]hen there is *no genuine issue of material fact* regarding whether the claim element or claimed combination is well-understood, routine, [and] conventional to a skilled artisan in the relevant field, this issue can be decided on summary judgment as a matter of

law.” *Id.* at 1368 (emphasis added). This qualification has been subsequently reiterated.

If there is a genuine dispute of material fact, Rule 56 requires that summary judgment be denied. In *Berkheimer*, there was such a genuine dispute for claims 4–7, but not for claims 1–3 and 9 [I]n accordance with *Alice*, we have repeatedly recognized the absence of a genuine dispute as to eligibility for the many claims that have been defended as involving an inventive concept based merely on the idea of using existing computers or the Internet to carry out conventional processes, with no alteration of computer functionality.

Berkheimer v. HP Inc., 890 F.3d 1369, 1371–74 (Fed. Cir. 2018) (Moore, J., concurring in denial of petition for rehearing en banc). Here, the Appellant has not specifically disputed any particular finding by the Examiner that any particular limitation is “well-understood, routine, and conventional.” And, as discussed above, the Specification indisputably shows the claimed “computing system” covers a generic computer system that was conventional at the time of filing. Accordingly, no genuine issue of material fact exists as to the well-understood, routine, or conventional nature of the claimed “computing system,” individually or in the combination as claimed.

No other persuasive arguments having been presented, we conclude that no error has been committed in the determination under *Alice* step two that claim 1 does not include an element or combination of elements circumscribing the patent-ineligible concept it is directed to so as to transform the concept into an inventive application.

We have considered all of the Appellant’s remaining arguments and find them unpersuasive. Accordingly, because we are not persuaded as to error in the determinations that representative claim 1, and claims 2–5, 8–14, and 17–30, which fall with claim 1, are directed to an abstract idea and do

not present an “inventive concept,” we sustain the Examiner’s rejection as being judicially-expected from 35 U.S.C. § 101. *Cf. LendingTree, LLC v. Zillow, Inc.*, 656 F. App’x 991, 997 (Fed. Cir. 2016) (“We have considered all of LendingTree’s remaining arguments and have found them unpersuasive. Accordingly, because the asserted claims of the patents in suit are directed to an abstract idea and do not present an ‘inventive concept,’ we hold that they are directed to ineligible subject matter under 35 U.S.C. § 101.”); *see, e.g., OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1364 (Fed. Cir. 2015); *FairWarning*, 839 F.3d at 1098.

The rejection of claims 1, 12, 19, 25–27, 29, and 30 under 35 U.S.C. § 103(a) as being unpatentable over Buyukkokten, Holberg, Mann, and Kaushansky.

The Appellant argues these claims as a group. *See App. Br. 22–27.* We select claim 1 as the representative claim for this group, and the remaining claims 12, 19, 25–27, 29, and 30 stand or fall with claim 1. 37 C.F.R. § 41.37(c)(1)(iv).

The Appellant argues that:

While paragraphs 53–54 of Mann disclose that “Users can track the number of times a specific brand, product or competitor (brand and/or product) is mentioned in **user community posts**” (emphasis added), Mann does not disclose collecting of “a number of newsfeed stories provided by the social networking system describing the first organization profile to member profiles indirectly connected to the first organization profile via another member profile . . .” as recited in currently amended claim 1. Thus, Mann does not teach this limitation of claim 1.

Note that the distinction between “user community posts” and “newsfeed stories” is not simply a matter of a different type of data. The “user community posts” of Mann are posted by users, as plainly stated. However, the “newsfeed stories” of the

currently amended claims are provided by the social networking system instead (“sending newsfeed stories . . .”). Furthermore, these newsfeed stories are presented to the user in the user’s newsfeed, rather than being searchable in a discussion group as described in Mann, and are limited to users that are connected to the organization. Thus, the effect of such newsfeed stories, and thus their measurement, produces very different results. Newsfeed stories about an organization, in contrast to user community posts, are only shown to users connected to the organization and are selected by the social networking system based on rules rather than randomly posted by users. Thus, the provisioning of the newsfeed stories may be significantly more consistent than randomly posted user community posts, and the collecting the number of newsfeed stories may measure the virality or influence of the organization in the social network much more accurately. Thus, the newsfeed stories are better indicators of virality and are not simply swappable for the user posts described in Mann.

App. Br. 23–24.

As we understand it, the argument is that the claimed statistical information is distinguished from that of Mann in that the “newsfeed stories” of claim 1 are provided by the social networking system (instead of being posted by users) and presented to the user in the user’s newsfeed (rather than being searchable in a discussion group).

However, there is insufficient evidence showing that the claim 1 step of “collecting, by a computing system, statistical information . . . the statistical information comprising: a number of newsfeed stories . . .” is functionally affected by the newsfeed stories being “provided by the social networking system describing the first organization profile to member profiles indirectly connected to the first organization profile via another

member profile” (claim 1), rather than being posted by users as the Appellant concedes Mann already discloses.

As for the Appellant’s argument that “the newsfeed stories are better indicators of virality,” we note that claim 1 does not require determining virality, and thus the argument is unpersuasive at least because it is not commensurate with the scope of the claim.

Claim 1 calls for “statistical information comprising” a specified content, namely “a number of newsfeed stories” Based on this, we do not see any patentable distinction between statistical information comprising a number of newsfeed stories and Mann’s statistical information comprising a number of user community posts, except that the claimed content of the “statistical information” comprises “a number of newsfeed stories” (claim 1). However, there is insufficient evidence that the specified content functionally affects the method; that is, gathering information via a generic computer system.

Given said lack of sufficient evidence, it is thus reasonable to characterize said claimed content of said “statistical information” as nonfunctional descriptive material; that is, akin to printed matter. Just as printed matter is not given patentable weight, similarly the content of the “statistical information” (claim 1) claim limitations, as a distinction over Mann’s statistical information, is not patentably consequential. “[N]on-functional descriptive material, being useful and intelligible only to the human mind, is given no patentable weight.” *Ex parte Graf*, Appeal 2012-003941, 2013 WL 3873066, at *4 (PTAB July 23, 2013) (non-precedential), *aff’d*, *In re Graf*, 585 F. App’x 1012 (Fed. Cir. 2014) (non-precedential); *cf.*

In re DiStefano, 808 F.3d 845 (Fed. Cir. 2015); as explained in *In re Xiao*, 462 F. App'x 947, 950–52 (Fed. Cir. 2011) (non-precedential):

[T]he Board did not create a new “mental distinctions” rule in denying patentable weight On the contrary, the Board simply expressed the above-described functional relationship standard in an alternative formulation—consistent with our precedents—when it concluded that any given position label’s function . . . is a distinction “discernable only to the human mind.” Board Decision at 6; *see In re Lowry*, 32 F.3d 1579, 1583 (Fed. Cir. 1994) (describing printed matter as “useful and intelligible only to the human mind.”) (quoting *In re Bernhart*, 417 F.2d 1395, 1399 (CCPA 1969)).

“The rationale behind this line of cases is preventing the indefinite patenting of known products by the simple inclusion of novel, yet functionally unrelated limitations.” *King Pharms., Inc. v. Eon Labs, Inc.*, 616 F.3d 1267, 1279 (Fed. Cir. 2010).

Accordingly, the argument that the claimed statistical information distinguishes from that of Mann in that it comprises “a number of newsfeed stories” (claim 1) is unpersuasive as to error in the rejection.

To the extent that the Appellant argues that Mann does not disclose the claimed “collecting,” we note that the Examiner finds the claimed “collecting” in Buyukkokten, not in Mann. *See* Final Act. 9 (“Buyukkokten teaches collecting, by a computing system, statistical information . . .”); *see also id.* at 11. And, to the extent that the Appellant argues that Mann does not disclose “sending newsfeed stories,” we note that the Examiner finds the claimed “sending newsfeed stories” in Holberg, not in Mann. *Id.* at 8.

The Appellant further argues that “Mann is directed to a completely different goal and thus not only teaches away from the current claims, but also the combination proposed in the Office Action renders Mann

unsatisfactory for its intended purpose.” App. Br. 26. According to the Appellant, “[t]he goal of the system disclosed in Mann is to connect ‘users with relevant information about products or services . . .’” whereas “the claimed invention concerns ‘information describing viral promotion of the first organization due to the presence of the first organization on the social networking system.’” *Id.* The Appellant contends that the claimed “newsfeed stories represent content generated by the social networking system” and that “[t]his is distinct from the system disclosed in Mann that concerns content generated by the users.” *Id.*

A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant. The degree of teaching away will of course depend on the particular facts; in general, a reference will teach away if it suggests that the line of development flowing from the reference’s disclosure is unlikely to be productive of the result sought by the applicant.

In re Gurley, 27 F.3d 551, 553 (Fed. Cir. 1994).

Here, rather than discouraging measuring content generated by a social networking system, Mann is simply disclosing measuring content generated by users. Accordingly, Mann does not lead one of ordinary skill in the art away from collecting or sending “information describing viral promotion” as the Appellant argues. *Cf. In re Gurley*, 27 F.3d at 553 (“A known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use.”). *See also In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004) (“The prior art’s mere disclosure of more than one alternative does not

constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed in the . . . application.”)

The Appellant contends that “user generated conversations would not provide a measure of viral promotion of an organization by the social networking systems” because “[u]ser conversations may be generated in response to advertisements that the organization is paying for.” App. Br. 26. Therefore, according to the Appellant, “the combination would render Mann unsatisfactory for its intended purpose or goal.” *Id.*

As a preliminary matter, we see nothing in claim 1 that excludes conversations generated in response to advertisements from the scope of “information describing viral promotion,” and the Appellant’s argument in that regard is unpersuasive at least because it is not commensurate with the scope of the claim. Moreover, the Appellant does not cite any evidence that the proposed combination would render Mann unsatisfactory for its intended purpose, would require substantial redesign of Mann, or would change Mann’s basic operating principle. *Cf. In re Ratti*, 270 F.2d 810, 981 (CCPA 1959) (reversing rejection where proposed combination “would require substantial reconstruction and redesign of the elements shown in Chinnery et al. [the primary prior art reference] as well as a change in the basic principles under which the Chinnery et al. construction was designed to operate”). The Appellant’s unsupported attorney argument cannot take the place of record evidence. *See In re Geisler*, 116 F.3d at 1470.

The Appellant’s arguments having been fully considered and found, for the foregoing reasons, unpersuasive as to error in the rejection, the

rejection as to claim 1 is sustained. For the same reasons, the rejection of claims 12, 19, 25–27, 29, and 30, which fall with claim 1, is also sustained.

The rejection of claims 2, 3, 8, and 13 under 35 U.S.C. § 103(a) as being unpatentable over Buyukkorten, Holberg, Mann, Kaushansky, and Abhyanker.

The rejection of claims 4, 5, 11, 14, 18, 20, 21, 24, and 28 under 35 U.S.C. § 103(a) as being unpatentable over Buyukkorten, Holberg, Mann, Kaushansky, and Eager.

The rejection of claims 9, 17, and 22 under 35 U.S.C. § 103(a) as being unpatentable over Buyukkorten, Holberg, Mann, Kaushansky, and DiRienzo.

The rejection of claims 10 and 23 under 35 U.S.C. § 103(a) as being unpatentable over Buyukkorten, Holberg, Mann, Kaushansky, DiRienzo, and Cohn.

The Appellant does not separately argue the rejection of dependent claims 2–5, 8–11, 13, 14, 17, 18, 20–24, and 28 apart from the arguments presented for independent claim 1. *See* App. Br. 27. Therefore, we sustain the rejection of claims 2–5, 8–11, 13, 14, 17, 18, 20–24, and 28 for the reasons discussed above regarding independent claim 1.

CONCLUSION

In summary:

Claims Rejected	Basis	Affirmed	Reversed
1–5, 8–14, 17–30	§ 101	1–5, 8–14, 17–30	
1–5, 8–14, 17–30	§ 103(a)	1–5, 8–14, 17–30	

Claims Rejected	Basis	Affirmed	Reversed
Overall Outcome		1-5, 8-14, 17-30	

DECISION

The decision of the Examiner to reject claims 1-5, 8-14, and 17-30 is affirmed.

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