



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

Table with 5 columns: APPLICATION NO., FILING DATE, FIRST NAMED INVENTOR, ATTORNEY DOCKET NO., CONFIRMATION NO. Includes application details for Wayne Kao and examiner information for Stanley, Jeremy L.

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

judy.wan@bakerbotts.com
ptomail1@bakerbotts.com
ptomail2@bakerbotts.com

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

*Ex parte* WAYNE KAO

---

Appeal 2019-001778  
Application 14/551,179  
Technology Center 2100

---

Before ST. JOHN COURTENAY III, LARRY J. HUME, and  
PHILLIP A. BENNETT, *Administrative Patent Judges*.

HUME, *Administrative Patent Judge*.

DECISION ON APPEAL

Pursuant to 35 U.S.C. § 134(a), Appellant,<sup>1</sup> Wayne Kao, appeals from the Examiner's decision rejecting claims 1–20. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

---

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

STATEMENT OF THE CASE<sup>2</sup>

*The Invention*

The claims are directed to “location-based services” (Spec. ¶ 1) and “Check-in Additions.” Title.

*Exemplary Claim*

Claim 1, reproduced below, is representative of the subject matter on appeal (formatting and *emphases* added to contested prior-art limitations):

1. A method comprising:

by a computing device, generating a notification for a first user, the notification comprising a description of a check-in by a second user, the check-in comprising an identification that the second user is, was, or will be at a place, the first and second users being users of a social networking system comprising a plurality of nodes and a plurality of edges connecting the nodes, at least one node corresponding to the first user, at least one node corresponding to the second user;

by a computing device, *determining whether to generate in association with the notification **an interactive element that when activated associates the first user with the check-in;***

by the computing device, *when the interactive element is not to be generated, providing the notification for display to the first user;* and

by a computing device, when the interactive element is to be generated, generating the interactive element and providing the interactive element for display to the first user in association with the notification.

---

<sup>2</sup> Our decision relies upon Appellant’s Appeal Brief (“Appeal Br.,” filed July 12, 2018); Reply Brief (“Reply Br.,” filed Dec. 31, 2018); Examiner’s Answer (“Ans.,” mailed Oct. 30, 2018); Final Office Action (“Final Act.,” mailed Nov. 13, 2017); and the original Specification (“Spec.,” filed Nov. 24, 2014).

*Prior Art*

The Examiner relies upon the following prior art as evidence in rejecting the claims on appeal:

Curtis et al. (“Curtis”)	US 2012/0124176 A1	May 17, 2012
Liu et al. (“Liu”)	US 2013/0332525 A1	Dec. 12, 2013
Akutagawa et al. (“Akutagawa”)	US 2015/0248651 A1	Sept. 3, 2015
Fasen et al. (“Fasen”)	US 2015/0347979 A1	Dec. 3, 2015
Chan et al. (“Chan”)	US 2017/0286556 A1	Oct. 5, 2017

*Rejections on Appeal<sup>3</sup>*

R1. Claims 1–7, 10, 11, 14–17, 19, and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Liu, Fasen, and Chan. Final Act. 14.

R2. Claims 8, 9, 12, and 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Liu, Fasen, Chan, and Curtis. Final Act. 31.

R3. Claim 18 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Liu, Fasen, Chan, and Akutagawa. Final Act. 39.

**CLAIM GROUPING**

Based on Appellant’s arguments (Appeal Br. 8–11) and our discretion under 37 C.F.R. § 41.37(c)(1)(iv), we decide the appeal of obviousness Rejection R1 of claims 1–7, 10, 11, 14–17, 19, and 20 on the basis of

---

<sup>3</sup> The Examiner has withdrawn his rejection under 35 U.S.C. § 101. Ans. 3–4.

representative claim 1. Appellant argues independent claims 1, 19, and 20 together (Appeal Br. 8) and does not separately argue any of the dependent claims. Therefore, we group these independent claims 19 and 20, and also dependent claims 2-7, 10, 11, and 14-17, together with claim 1. We address remaining dependent claims 8, 9, 12, 13, and 18 rejected under obviousness Rejections R2 and R3, not-separately argued, *infra*.<sup>4</sup>

### ISSUES AND ANALYSIS

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

We disagree with Appellant's arguments with respect to claim 1 and, unless otherwise noted, we incorporate by reference herein and adopt as our own: (1) the findings and reasons set forth by the Examiner in the action from which this appeal is taken, and (2) the reasons and rebuttals set forth in the Examiner's Answer in response to Appellant's arguments. We highlight and address specific findings and arguments regarding claim 1 for emphasis as follows.

---

<sup>4</sup> "Notwithstanding any other provision of this paragraph, the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately." 37 C.F.R. § 41.37(c)(1)(iv). In addition, when Appellant does not separately argue the patentability of dependent claims, the claims stand or fall with the claims from which they depend. *In re King*, 801 F.2d 1324, 1325 (Fed. Cir. 1986).

1. § 103(a) Rejection R1 of Claims 1-7, 10, 11, 14-17, 19, and 20

Issue 1

Appellant argues (Appeal Br. 8–13; Reply Br. 1–9) the Examiner’s rejection of claim 1 under 35 U.S.C. § 103(a) as being obvious over the combination of Liu, Fasen, and Chan is in error. These contentions present us with the following issues (emphasis added):

(a) Did the Examiner err in finding the cited prior art combination teaches or suggests “*determining whether to generate in association with the notification an interactive element that when activated associates the first user with the check-in,*” as recited in claim 1?

(b) Did the Examiner err in finding the cited prior art combination teaches or suggests “[w]hen the interactive element is not to be generated, providing the notification for display to the first user,” as recited in claim 1?

(c) Did the Examiner err in combining Liu, Fasen, and Chan in the manner suggested because, allegedly, the Examiner did not provide an articulated reason or proper motivation to combine the references?

Analysis

*Issue (a): “generate . . . an interactive element” is taught or suggested*

The Examiner finds Liu teaches or suggests an interactive element that, when activated, associates the first user with the second user and the event. Final Act. 16–17 (citing Liu, Fig. 5, steps 508–510, 512, 518 ¶¶ 50–51). Liu discloses:

For example, if the first user responds to the user suggestion by accepting the suggestion (e.g., clicking on an “invite” button provided with the user suggestion), then the suggested user may

receive a message from the social networking system indicating to the suggested user that the first user has invited the suggested user to the event and prompting whether the suggested user would like to accept the invitation.

Liu ¶ 50.

In another aspect, after step 512, the user suggestion may be first communicated to the suggested user (518). The user suggestion communicated to the suggested user may also identify the first user and the event. For example, the suggested user may receive a message indicating that the first user is planning on attending the event, and prompting the suggested user whether the suggested user would like to ask the first user if the suggested user may attend the event with the first user. . . . If the suggested user accepts the user suggestion, the user suggestion is also communicated to the first user (520). For example, the first user receives a message indicating that the second user would like to attend the event together with the first user and prompting whether the first user would also like to attend the event with the suggested user.

Liu ¶ 51.

The Examiner finds Liu’s “first user” and “suggested user” teach or at least suggest the “first user” and “second user” as recited in claim 1. Final Act. 15; Fig. 5, Liu ¶ 51. Liu’s first user attending the event teaches or at least suggests “a check-in by a second user” as recited in claim 1. *Id.*, Liu ¶ 51.

Appellant argues the Examiner does not identify what in Chan can be considered to be a “check-in by the second user.” Appeal Br. 11. Appellant further argues “the Examiner does not explain how Chan’s action item 240 can be considered to be ‘an interactive element that when activated associates the first user with the [second user’s] check-in,’ as the independent claims require.” *Id.*

We are not persuaded by Appellant’s arguments because Appellant is arguing the references separately. The Examiner cites Liu, not Chan, for teaching the disputed limitations “check-in by the second user” and “an interactive element that when activated associates the first user with the [second user’s] check-in.” Final Act. 15–20; Ans. 9.

Moreover, the Examiner finds Liu’s “invite” and “accept” buttons providing the user with suggested event attendance teaches the recited “interactive element.” Final Act. 16–17. In contrast, the Examiner only cites Chan for teaching or suggesting a particular claim limitation, i.e., “when the interactive element is not to be generated, providing the notification for display to the first user,” and is not relied on for “a check-in by the second user.” Ans. 12.

The Examiner also cites Fasen for teaching or suggesting an “interactive element” that, when activated, associates the first user with the check-in. Final Act. 18–19; Ans. 10. Specifically, the Examiner finds Fasen’s user adding an event to a calendar by clicking on a link associated with the event teaches or at least suggests the “interactive element” limitation. *Id.*

We are not persuaded of error in the Examiner’s findings and legal conclusion because Appellant is arguing the references separately. As the rejection is for obviousness, we rely upon what the teachings of the cited references considered in *combination would have suggested* to a person of ordinary skill in the art. “[O]ne cannot show non-obviousness by attacking references individually where . . . the rejections are based on combinations of references.” *In re Keller*, 642 F.2d 413, 426 (CCPA 1981). Nor is the

test for obviousness whether a secondary reference's features can be bodily incorporated into the structure of the primary reference. *See Keller*, 642 F.2d at 425.

*Issue (b): Conditional “providing the notification for display” limitation is taught or suggested*

Appellant also argues:

[T]he Examiner does not identify any reference that discloses the features of “when the interactive element is not to be generated, providing the notification for display to the first user.” The Examiner does not identify any reference that discloses determining the claimed interactive element should not be generated and providing the claimed notification in response.

Appeal Br. 11–12. We disagree with Appellant's allegation.

We disagree because the Examiner cites Chan for teaching or suggesting this disputed limitation:

Chan is . . . cited in the Office Action as teaching . . . “when the interactive element is not to be generated, providing the notification for display to the first user,” and is not relied on specifically for “a check-in by the second user,” “an interactive element that which activated associates the first user with the second user's check-in” as these limitations are already cited as being taught by Liu and Fasen.

Ans. 12 (citing Final Act. 12).

As a matter of claim construction, Appellant's Specification describes that a notification of a check-in may be performed in an open-ended variety of possible methods and manners of notifications. Ans. 7–8, citing Spec. ¶¶ 39, 52, 74, and 76.

We are not persuaded by Appellant’s arguments because Chan’s user *not* checking in to a flight-event at a particular airport/terminal, and the resulting displayed notification, teaches or at least suggests the disputed limitation “when the interactive element is not to be generated, providing the notification for display to the first user.” Ans. 14. In agreement with the Examiner, we find Chan’s determination of whether *or not* to generate an interactive element, and Chan’s providing the notification for display to the first user teaches or at least suggests this disputed limitation. Ans. 15, citing Chan, Figs. 2A and 2B, ¶¶ 67–68.

As found by the Examiner, we find the combination of Liu’s and Fasen’s interactive elements and notifications to the users, together with Chan’s teaching of when to not generate an interactive element (i.e., when a traveler has not checked in), would not have been “uniquely challenging or difficult for one of ordinary skill in the art.” *See Leapfrog Ent. Inc. v. Fisher-Price Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007).

Accordingly, we find the prior art combination teaches or suggests the disputed limitations of claim 1.

*Issue (c): The Examiner provided proper motivation to combine*

Appellant further argues the Examiner has not provided proper reasoning for combining Liu, Fasen, and Chan:

Rather than explaining how the cited portions of the references would actually be combined together to achieve all the claimed features, and the motivation for making that specific combination, the Examiner merely asserts that one would “incorporate” the teachings with each other because of benefits each reference attributes to its separate teaching. That is not sufficient to make a *prima facie* case of obviousness.

Appeal Br. 12–13.

We are not persuaded by Appellant’s argument because the Examiner has articulated a lengthy and detailed reasoning for combining the cited references in the manner suggested, quoted below for completeness:

[I]t would have been obvious to one of ordinary skill in the art at the time the invention was filed having the teachings of Liu, Fasen, and Chan in front of him to have modified the teachings of Liu (directed to a social network-based system and method for providing suggested users, based on predefined criteria, for attending an event together with a first user who has indicated that he or she is attending an event and communicating the suggestion to the users), to incorporate the teachings of Fasen (directed to social calendar event sharing) to include the capability, when a user selects an interactive element provided with a check-in (such as an indication that a different user is attending, or will attend, an event associated with the different user’s calendar), to store the user selection and user’s identity as feedback data (e.g. acceptance or other indication that the user will attend the event, has subscribed to the event, or has viewed the event details) associated with the check-in, and to further incorporate the teachings of Chan (directed to determining display prominence and attributes of search results including data records specific to a user, such as a pending flight and associated check-in button, based on triggering rules), to include the capability to determine whether to display the check-in information (e.g. an association with a specific airline, or air plane with a flight event having a specific time and place) with a user-selectable button for checking in to the flight event, or without the button, based on triggering rules, such as a time threshold. One of ordinary skill would have been motivated to perform such a modification in order to provide a system which can help an event organizer with event preparation and provide feedback regarding whether events are promoted/marketed appropriately as described in Fasen (e.g. paragraph 0047), in order to address known difficulties in the art associated with sharing and disseminating information about

an event while maintaining control over the event as described in Fasen (e.g. paragraph 0002; difficulty obtaining feedback when an event is disseminated via a one-way channel, limitations to specific people when using a two-way channel, difficulty obtaining feedback/maintaining control over event invitations sent via email), by providing systems and techniques that maintain a connection between those who view an event and the organizer event regardless of calendar service (e.g. paragraph 0004), and provide platform-independent feedback (e.g. paragraph 0005), in order to determine a user's intent and provide user-specific search results to the user as described in Chan (e.g. paragraph 0008), and in order to sub.

Final Act. 21–22.

Thus, based on this detailed explanation, we conclude the Examiner has, in fact, provided an articulated reasoning with a rational underpinning for combining the cited references as required.<sup>5</sup>

Therefore, based upon the findings above, on this record, we are not persuaded of error in the Examiner's reliance on the combined teachings and suggestions of the cited prior art combination to teach or suggest the disputed limitations of claim 1, nor do we find error in the Examiner's resulting legal conclusion of obviousness.

Accordingly, we sustain the Examiner's obviousness rejection of independent claim 1, and grouped claims 1–7, 10, 11, 14–17, 19, and 20, which fall therewith. *See Claim Grouping, supra.*

---

<sup>5</sup> The relevant inquiry is whether the Examiner has set forth “some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (cited with approval in *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 418 (2007)).

3. § 103 Rejections R2 and R3 of Claims 8, 9, 12, 13, and 18

In view of the lack of *any* substantive or separate arguments directed to obviousness Rejection R2 of claims 8, 9, 12, 13, and Rejection R3 of claim 18 under § 103, we sustain the Examiner's rejections of these claims. Arguments not made are waived.

REPLY BRIEF

To the extent Appellant *may* advance new arguments in the Reply Brief (Reply Br. 1–10) not in response to a shift in the Examiner's position in the Answer, arguments raised in a Reply Brief that were not raised in the Appeal Brief or are not responsive to arguments raised in the Examiner's Answer will not be considered except for good cause (*see* 37 C.F.R. § 41.41(b)(2)), which Appellant has not shown.

CONCLUSION

The Examiner did not err with respect to obviousness Rejections R1 through R3 of claims 1–20 under 35 U.S.C. § 103(a) over the cited prior art combinations of record, and we sustain the rejections.

DECISION SUMMARY

<b>Claims Rejected</b>	<b>35 U.S.C. §</b>	<b>Basis / References</b>	<b>Affirmed</b>	<b>Reversed</b>
1-7, 10, 11, 14-17, 19, 20	103	Obviousness Liu, Fasen, Chan	1-7, 10, 11, 14-17, 19, 20	
8, 9, 12, 13	103	Obviousness Liu, Fasen, Chan, Curtis	8, 9, 12, 13	
18	103	Obviousness Liu, Fasen, Chan, Akutagawa	18	
<b>Overall Outcome</b>			1-20	

FINALITY AND RESPONSE

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv). *See* 37 C.F.R. § 41.50(f).

AFFIRMED