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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte SARAH HUM, ANDREW N. RASMUSSEN,
ARTURO J. ESQUIVEL, TATIANA J. GROSSMAN, URSULA A. LIM,
and ROBERT M. BALDWIN

Appeal 2019-003270
Application 14/558,680
Technology Center 2100

Before KARA L. SZPONDOWSKI, SCOTT B. HOWARD, and
STEVEN M. AMUNDSON, *Administrative Patent Judges*.

HOWARD, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant¹ appeals under 35 U.S.C. § 134(a) from the Examiner's Final Rejection of claims 1–16, which constitute all of the claims pending in this application. 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. Appellant identifies the real party in interest as Facebook, Inc. Appeal Br. 3.

THE INVENTION

The disclosed and claimed invention is “generally to social networking,” and more particularly to “messaging between users.” Spec.

¶ 1.²

Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A method comprising:

at a server system with a processor and memory storing instructions for execution by the processor:

receiving a first message from an electronic device of a first user to an electronic device of a second user;

generating a set of potential reply messages, for the second user, based on one or more reply factors, including content from one or more messages between the first user and the second user;

sending, to the electronic device of the second user, a data structure that includes a hierarchical interaction tree having a plurality of interaction nodes, wherein each interaction node of the plurality of interaction nodes corresponds to a respective one of the potential reply messages;

in accordance with a determination that a predefined time period has elapsed without the second user selecting a potential reply message, removing, from the hierarchical interaction tree, one or more of the interaction nodes corresponding to respective potential reply messages that are no longer selectable; and

receiving, from the electronic device of the second user, a first reply message that is selected from the set of potential

² We refer to the Specification filed Dec. 2, 2014 (“Spec.”); Non-Final Office Action mailed May 17, 2018 (“Non-Final Act.”); Appeal Brief filed Oct. 15, 2018 (“Appeal Br.”); Examiner’s Answer mailed Feb. 11, 2019 (“Ans.”); and the Reply Brief filed Mar. 22, 2019 (“Reply Br.”).

reply messages and corresponds to a respective interaction node of the plurality of interaction nodes in the data structure.

REFERENCES

The prior art relied upon by the Examiner as evidence in rejecting the claims on appeal is:

Bradford et al. ("Bradford")	US 2006/0247915 A1	Nov. 2, 2006
Spivack et al. ("Spivack")	US 2012/0272160 A1	Oct. 25, 2012
Senanayake et al. ("Senanayake")	US 2013/0311411 A1	Nov. 21, 2013
Bhatia	US 2014/0115078 A1	Apr. 24, 2014
Thirugnanasundaram et al. ("Thirugnanasundaram")	US 2015/0032724 A1	Jan. 29, 2015
Shih et al. ("Shih")	US 2015/0200878 A1	July 16, 2015

REJECTIONS³

Claims 1–8 and 14–16 stand provisionally rejected on the ground of nonstatutory obviousness-type double patenting as unpatentable over claims 1, 4, 12, 22, and 23 of copending Application No. 14/558,661. Non-Final Act. 2–3.

³ The Examiner also rejected claims 1, 15, and 16 under 35 U.S.C. § 112(a) as failing to comply with the written-description requirement. Non-Final Act. 4. The Examiner withdrew that rejection in the Answer. Ans. 12.

Claims 1–6, 9–13, 15, and 16 stand rejected under 35 U.S.C. § 103 as unpatentable over Bhatia, Thirugnanasundaram, and Senanayake. Non-Final Act. 5.

Claim 7 stands rejected under 35 U.S.C. § 103 as unpatentable over Bhatia, Thirugnanasundaram, Senanayake, and Bradford. Non-Final Act. 11.

Claim 8 stands rejected under 35 U.S.C. § 103 as unpatentable over Bhatia, Thirugnanasundaram, Senanayake, and Shih. Non-Final Act. 12.

Claim 14 stands rejected under 35 U.S.C. § 103 as unpatentable over Bhatia, Thirugnanasundaram, Senanayake, and Spivack. Non-Final Act. 12.

ANALYSIS

Obviousness-Type Double Patenting Rejection

The 14/558,661 application issued as Patent No. 10,587,541 on March 10, 2020. Therefore, the Examiner’s non-statutory obviousness-type double-patenting rejection, based on the ’661 application, is no longer provisional.

The Examiner finds that the present claims and those in then-copending application ’661 “are not identical,” but “they are not patentably distinct from each other.” Non-Final Act. 3. Specifically, the Examiner finds that “[c]opending application differs from the claim in that it fails to explicitly teach using a data structure including a hierarchical interaction tree to store predefined reply messages,” but it “would have been obvious to one of ordinary skill in the graphical user interface art at the time of invention to store reply messages in some form to generate a conversation between parties.” Non-Final Act. 3.

Appellant argues that the present application and the co-pending application both “relate to generating potential reply messages for electronic communication,” but that the “two applications address fundamentally different features.” Appeal Br. 11; *see also* Reply Br. 5. Specifically, Appellant argues that the co-pending application “focus[es] . . . on how the messages are selected, which includes a plurality of ‘reply-factors,’” while the present application “feature[s] . . . the removal of certain reply options.” Appeal Br. 11.

We are persuaded by Appellant’s arguments that the Examiner erred. Double patenting is determined by comparing a specific claim in the instant application to a specific claim in an issued patent or co-pending application:

Generally, an obviousness-type double patenting analysis entails two steps. First, as a matter of law, a court construes the claim in the earlier patent and the claim in the later patent and determines the differences. *Georgia-Pacific Corp. v. United States Gypsum Co.*, 195 F.3d 1322, 1326, 52 USPQ2d 1590, 1593 (Fed. Cir. 1999). Second, the court determines whether the differences in subject matter between the two claims render the claims patentably distinct. *Id.* at 1327, 52 USPQ2d at 1595. A later claim that is not patentably distinct from an earlier claim in a commonly owned patent is invalid for obvious-type double patenting. *In re Berg*, 140 F.3d 1428, 1431, 46 USPQ2d 1226, 1229 (Fed. Cir. 1998). *A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or anticipated by, the earlier claim. In re Longi*, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); *In re Berg*, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus).

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Eli Lilly & Co. v. Barr Labs., Inc., 251 F.3d 955, 968 (Fed. Cir. 2001)
(footnote omitted) (emphasis added).

The Examiner has not cited anything in the claims or Specification to support the conclusion that the present claims and the claims from then-copending application '661 are not patentably distinct or are obvious variants.

The present claim 1 recites reply messages “based on one or more reply factors, including content from one or more messages between the first user and the second user.” However, claim 1 of the issued '541 patent (from previously copending application '661) recites that the reply factors include “content from one or more messages between the first user and the second user” *as well as*:

one or more response statistics for the second user including (i) a first frequency with which the second user selects any predefined reply messages and (ii) a second frequency with which the second user sends any user-defined custom reply messages, wherein the set of predefined first-reply messages is filtered based on the first and the second frequencies.

The Examiner does not explain how the reply factors (limited to message content between users) of claim 1 of the present application are an obvious variant of the reply factors (including message content between users *and* response statistics for the user based on message frequencies) of claim 1 of the '541 patent (from previously copending application '661).

Accordingly, we do not sustain the Examiner's obviousness-type double-patenting rejection of claims 1–8 and 14–16.

Section 103 Rejection

Claim 1 recites “in accordance with a determination *that a predefined time period has elapsed without the second user selecting a potential reply message*, removing, from the hierarchical interaction tree, one or more of the interaction nodes corresponding to respective potential reply messages that are no longer selectable.”

The Examiner finds that Senanayake teaches “determining a user has not selected potential reply messages within a time period (i.e. lack of selection) and updating an interaction model for future considerations of potential contextual reply messages based on the determining.” Ans. 14 (citing Senanayake ¶¶ 89–110); *see also* Non-Final Act. 7 (citing Senanayake ¶¶ 89–110, Fig. 5).

Appellant argues that the references do not teach “removing potential reply messages after a predefined time period has elapsed.” Appeal Br. 13. Specifically, Appellant argues that “Senanayake does not include a ‘predefined time period’ in its determination of whether a ‘user-selectable representation’ is stored.” Reply Br. 5–6; *see* Appeal Br. 13 (citing Senanayake ¶ 109).

We are persuaded by Appellant’s argument as the Examiner has not identified sufficient evidence or provided sufficient explanation as to how the combination of Bhatia, Thirugnanasundaram, and Senanayake teaches that *a predefined time period has elapsed* without the second user selecting a reply message as claimed.

The cited sections of Senanayake teach “*User-selectable representations 150 that are not selected by the user* (and/or data relating thereto) may be stored in the interaction model 120 for future consideration

by the system 100 *or discarded*.” Senanayake ¶ 109 (emphasis added). The sections of Senanayake cited by the Examiner and on the record before us do *not* teach this discarding *after a predefined time period has elapsed* as claimed. Instead, as argued by Appellant, Senanayake teaches discarding selections that are not selected by the user *without* any consideration of a *predefined time period*.

Therefore, we agree with Appellant that the Examiner’s finding that the combination of Bhatia, Thirugnanasundaram, and Senanayake teaches the disputed limitation is in error because it is not supported by a preponderance of the evidence. *See In re Caveney*, 761 F.2d 671, 674 (Fed. Cir. 1985) (The Examiner’s burden of proving non-patentability is by a preponderance of the evidence.); *see also In re Warner*, 379 F.2d 1011, 1017 (CCPA 1967) (“The Patent Office has the initial duty of supplying the factual basis for its rejection. It may not, because it may doubt that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis.”).

Accordingly, we are constrained on the record before us to reverse the Examiner’s rejection of independent claim 1, along with the rejection of independent claims 15 and 16, which recite limitations commensurate in scope to the disputed limitation discussed above, and dependent claims 2–6 and 9–13.

Moreover, because the Examiner has not shown that the additional references cure the foregoing deficiency regarding the rejection of the independent claims 1, 15, and 16, we will not sustain the obviousness rejections of dependent claims 7, 8, and 14.

DECISION

We reverse the Examiner's rejections of claims 1–16.

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1–8, 14–16		Nonstatutory Obviousness-type Double Patenting		1–8, 14–16
1–6, 9–13, 15, 16	103	Bhatia, Thirugnanasundaram, Senanayake		1–6, 9–13, 15, 16
7	103	Bhatia, Thirugnanasundaram, Senanayake, Bradford		7
8	103	Bhatia, Thirugnanasundaram, Senanayake, Shih		8
14	103	Bhatia, Thirugnanasundaram, Senanayake, Spivack		14
Overall Outcome				1–16

REVERSED