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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/770,471	04/29/2010	Drake Sutton-Shearer	113096.001US1	9793

79804 7590 02/28/2017

Duncan Galloway Egan Greenwald, PLLC
9750 Ormsby Station Road, Suite 210
Louisville, KY 40223

EXAMINER
OFORI-AWUAH, MAAME

ART UNIT	PAPER NUMBER
3629	

NOTIFICATION DATE	DELIVERY MODE
02/28/2017	ELECTRONIC

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):

kduncan@dgeglaw.com
carnold@dgeglaw.com
jlindner@dgeglaw.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DRAKE SUTTON-SHEARER

Appeal 2015-003977
Application 12/770,471[1]
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

Drake Sutton-Shearer (Appellant) seeks our review under 35 U.S.C. § 134 of the final rejection of claims 1- 19. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We REVERSE.

---

[1] The Appellant identifies Bimodall LLC as the real party in interest. Appeal Br. 2.

THE INVENTION

Claim 8, reproduced below, is illustrative of the subject matter on appeal.

> 8. A computer-implemented method of hosting a social network, wherein the method is implemented in a server configured to host webpages that define views of the social network, and to transmit the webpages to client computing platforms that request the webpages over a network, the server comprising one or more processors configured to execute one or more computer program modules, the method comprising:
>
> executing, on the one or more processors of the server, one or more computer program modules configured to assemble webpages defining views of a wall associated with a first entity;
>
> executing, on the one or more processors of the server, one or more computer program modules configured to maintain associations between entities that use the social network;
>
> executing, on the one or more processors of the server, one or more computer program modules configured to transmit a certificate from a second entity to the first entity;
>
> executing, on the one or more processors of the server, one or more computer program modules configured to make, responsive to the certificate being a private certificate, the certificate viewable on the wall of the first entity by other entities that are associated with the second entity and to make the certificate hidden on the wall of the receiving entity from other entities that are not associated with the second entity; and
>
> executing, on the one or more processors of the server, one or more computer program modules configured to make, responsive to the certificate being a public certificate, the certificate viewable by other entities on the wall of the first entity without regard for associations with the second entity.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Morgenstern	US 2008/0189188 A1	Aug. 7, 2008
Fuste Vilella	US 2010/0208662 A1	Aug. 19, 2010

Calderon, Sara Ines, "How to Protect Your Privacy with Facebook's New Privacy Settings in 17 Easy Steps." Jan. 2010. http://www.insidefacebook.com/2010/01 /19/how-to-protect-your-privacy-withfacebook%E2%80%99s-new-privacy-settings-in-17-easy-steps/ [Calderon].

The following rejections are before us for review:

1. Claims 1–19 are rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter.
2. Claims 1–4, 6–11, 13–17, and 19 are rejected under 35 U.S.C. §103(a) as being unpatentable over Morgenstern and Calderon.
3. Claims 5, 12 and 18 are rejected under 35 U.S.C. §103(a) as being unpatentable over Morgenstern, Calderon, and Fuste Vilella.

ISSUES

Did the Examiner err in rejecting claims 1–19 under 35 U.S.C. §101 as being directed to non-statutory subject matter?

Did the Examiner err in rejecting claims 1–4, 6–11, 13–17, and 19 under 35 U.S.C. §103(a) as being unpatentable over Morgenstern and Calderon?

Did the Examiner err in rejecting claims 5, 12 and 18 under 35 U.S.C. §103(a) as being unpatentable over Morgenstern, Calderon and Fuste Vilella?

ANALYSIS

The rejection of claims 1-19 under 35 U.S.C. §101 as being directed to non-statutory subject matter.

All the claims on appeal are rejected. But no claim with all its limitations is specifically analyzed. Rather, the claims are treated as a group and generally found to be "directed to . . . managing the privacy of content posted on a social network . . . [and thus] drawn to an abstract idea [and] do not recite limitations that are 'significantly more' than the abstract idea." Ans. 8. We agree with the Appellant that "[t]he present invention describes a much more detailed system than is suggested by the Examiner's … shorthand description and analysis." Reply Br. 4. A plain reading of the claims bears this out.

Alice Corp. Pty. Ltd. v. CLS Bank Int'l, 134 S. Ct. 2347 (2014) identifies a two-step framework for determining whether claimed subject matter is judicially-excepted from patent eligibility under § 101.

According to *Alice* step one, "[w]e must first determine whether the claims at issue are *directed to* a patent-ineligible concept," such as an abstract idea. *Alice*, 134 S. Ct. at 2355. Emphasis added.

> The "directed to" inquiry [ ] cannot simply ask whether the claims *involve* a patent-ineligible concept, because essentially every routinely patent-eligible claim involving physical products and actions *involves* a law of nature and/or natural phenomenon—after all, they take place in the physical world. *See Mayo*, 132 S. Ct. at 1293 ("For all inventions at some level embody, use, reflect, rest upon, or apply laws of nature, natural phenomena, or abstract ideas.") Rather, the "directed to" inquiry applies a stage-one filter to claims, considered in light of the specification, based on whether "their character as a whole is directed to excluded subject matter." *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1346 (Fed. Cir. 2015); *see Genetic Techs. Ltd. v. Merial L.L.C.*, 2016 WL 1393573, at *5 (Fed.

> Cir. 2016) (inquiring into "the focus of the claimed advance over the prior art").

Enfish, LLC v. Microsoft Corp., 822 F.3d 1327, 1335 (Fed. Cir. 2016).

> In addressing the first step of the section 101 inquiry, as applied to a computer-implemented invention, it is often helpful to ask whether the claims are directed to "an improvement in the functioning of a computer," or merely "adding conventional computer components to well-known business practices." *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1338 (Fed. Cir. 2016).

Affinity Labs of Tex., LLC v. DIRECTV, LLC, 838 F.3d 1253, 1257 (Fed. Cir. 2016). The Specification supports viewing the claims as being directed more toward the former category than the latter.

The Specification (para. 1) explains:

> The invention relates to a system and method for hosting a social network that recognizes associations other than social relationships separately from social relationships for purposes of information privacy management, and that provides control over the privacy of individual pieces of information released over the social network to facilitate use of the social network by entities like corporations or companies, schools, charitable organizations, government departments, and/or other entities.

According to the Specification, the invention is directed to social networks and seeks to solve a problem of information privacy management with respect to them. The inventor has solved this problem by including a mechanism to control privacy. "One aspect of the invention relates to a system and method for hosting a social network that enables entities to particularly manage the privacy level of content posted on the social network." Spec. para. 4. Specifically, all the claims call for, *inter alia*, "modules configured to make, responsive to [a] certificate being a private certificate, the certificate viewable on [a] wall of [a] first entity by other

entities that are associated with [a] second entity and to make the certificate hidden on the wall of the receiving entity from other entities that are not associated with the second entity." Independent claim 8 (the other independent claims 1 and 15 include similar limitations).

The record supports finding the focus of the invention – that is, when reading the claims as a whole in light of the Specification – to be solving a problem with the way social networks handle private information, not privacy per se. The problem with controlling private information in social networks is not itself necessarily patent-ineligible. And the advance over the prior art is not simply "managing the privacy of content posted on a social network" (Ans. 8) but in an improvement in the mechanism by which social networks manage information privacy. For these reasons, we do not find the record to adequately support a determination that "the claims at issue are directed to one of those patent-ineligible concepts," such as an abstract idea (*Alice*, 134 S. Ct. at 2355) as the Examiner found.

Having made this threshold determination under step one of the *Alice* framework, we need not move to the second step.

For the foregoing reasons, the record does not support the determination that the claimed subject matter is judicially-excepted from patent eligibility under § 101. Accordingly, the rejection is not sustained.

The rejection of claims 1-4, 6-11, 13-17 and 19 under 35 U.S.C. §103(a) as being unpatentable over Morgenstern and Calderon.

All the claims require "modules configured to make, responsive to [a] certificate being a private certificate, the certificate viewable on [a] wall of [a] first entity by other entities that are associated with [a] second entity and

to make the certificate hidden on the wall of the receiving entity from other entities that are not associated with the second entity." Independent claim 8 (the other independent claims 1 and 15 include similar limitations).

According to the Examiner, said claim limitations are disclosed in Calderon.

> Calderon teaches privacy settings of the Facebook website, where a user can select "friend of friends" to view posts by friends on the receiving user's wall (see page 3). Therefore, when a friend posts (the gift" on the user's wall, the friend of the posting friend can view the "gift" on the receiving user's wall.

Final Rej. 4.

We have reviewed Calderon but do not find there disclosure of said claim limitations. Calderon discloses a privacy setting ranging from "Everyone" to more restrictive groups like "Only Friends" or "Friends of Friends." The setting can be customized. But this simply restricts the people viewing content posted on a wall.

The claims, however, describe a privacy management mechanism whereby certificates are transmitted by a first entity to a wall of a second receiving entity. When the certificate is private, the entities associated with the second receiving entity can view it on the wall but entities not associated with the second receiving entity cannot. Nothing in Calderon would lead one to this; that is, to control privacy on a receiving entity's wall by way of a transmitting entity's private certificate, as claimed.

For the foregoing reasons, a prima facie case of obviousness for the claimed subject matter has not been made out in the first instance by a preponderance of the evidence. Accordingly, the rejection is not sustained.

The rejection of claims 5, 12 and 18 under 35 U.S.C. §103(a) as being unpatentable over Morgenstern, Calderon and Fuste Vilella.

The claims here rejected depend from claims whose rejection has not been sustained as discussed above. The rejection of these claims is also not sustained for the same reasons.

CONCLUSIONS

Claims 1-19 are rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter is not sustained.

The rejection of claims 1–4, 6–11, 13–17, and 19 under 35 U.S.C. §103(a) as being unpatentable over Morgenstern and Calderon is not sustained.

The rejection of claims 5, 12 and 18 under 35 U.S.C. §103(a) as being unpatentable over Morgenstern, Calderon, and Fuste Vilella is not sustained.

DECISION

The decision of the Examiner to reject claims 1–19 is reversed.

REVERSED