

Commissioner's Decision No. 1494

Décision du commissaire n° 1494

TOPICS: J00 Meaning of Art
J10 Computer Programs
J40 Mental Steps
O00 Obviousness

SUJETS: J00 Signification de la technique
J10 Programmes d'ordinateur
J40 Processus psychologique
O00 Évidence

Application No. 2858424

Demande n° 2858424

IN THE CANADIAN PATENT OFFICE

DECISION OF THE COMMISSIONER OF PATENTS

Patent application number 2858424, having been rejected under subsection 30(3) of the *Patent Rules* (SOR/96-423), has consequently been reviewed in accordance with paragraph 30(6)(c) of the *Patent Rules*. The recommendation of the Patent Appeal Board and the decision of the Commissioner are to refuse the application.

Agent for the Applicant

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INTRODUCTION

- [1] This recommendation concerns the review of rejected Canadian patent application number 2858424, which is entitled “Advertisement Based on Application-Created Social Content” and is owned by Facebook Inc. (the Applicant). A review of the rejected application has been conducted by the Patent Appeal Board (the Board) pursuant to paragraph 30(6)(c) of the *Patent Rules*.
- [2] As explained in more detail below, our recommendation is that the Commissioner of Patents refuse the application.

BACKGROUND

The Application

- [3] The application, based on a previously filed Patent Cooperation Treaty application, is considered to have been filed in Canada on December 14, 2012 and was laid open to the public on June 20, 2013.
- [4] The application relates generally to targeted advertising on social media based on interactions.

Prosecution History

- [5] On August 10, 2016, a Final Action (FA) was issued pursuant to subsection 30(4) of the *Patent Rules*. The FA stated that the instant application was defective on the grounds that all of the claims on file encompassed subject matter outside the definition of invention and thus did not comply with section 2 of the *Patent Act* and that all of the claims were directed to obvious subject matter and therefore did not comply with section 28.3 of the *Patent Act*.

- [6] In a response to the FA (RFA) received on February 3, 2017, the Applicant submitted arguments in favour of the claims being allowable. The Applicant also submitted a set of 17 proposed claims (proposed claim set-1).
- [7] The Examiner considered the application to not comply with the *Patent Act* despite the arguments submitted with the RFA and proposed claim set-1. Therefore, pursuant to paragraph 30(6)(c) of the *Patent Rules*, the application was forwarded to the Board for review along with an explanation outlined in a Summary of Reasons (SOR). The SOR set out the position that the claims on file were still considered to be defective on the grounds of non-statutory subject matter and obvious subject matter. The SOR also set out the position that proposed claim set-1 did not cure the defects.
- [8] In a letter dated April 3, 2017, the Board forwarded a copy of the SOR to the Applicant. In a letter dated June 27, 2017, the Applicant indicated a continued interest in having the Board review the application.
- [9] The present panel (the Panel) was formed to review the instant application under paragraph 30(6)(c) of the *Patent Rules*. The Panel sent a Preliminary Review letter (the PR letter) to the Applicant on February 6, 2019 wherein we set out our preliminary analysis and rationale as to why, based on the record before us, the defects identified in the SOR were present. Further and in accordance with subsection 30(6.1) of the *Patent Rules*, the Panel identified two new defects and presented its preliminary view that claims 1, 16 and 17 on file were indefinite and therefore not compliant with subsection 27(4) of the *Patent Act*, and that the description contained numerous trademarked terms not identified as such and was therefore non-compliant with section 76 of the *Patent Rules*.
- [10] In correspondence received on April 9, 2019, the Applicant provided written submissions in response to the PR letter (the RPR) arguing in favour of the claims being allowable and also submitted a proposed amended set of 17 claims (proposed claim set-2) as well as a proposed amended description.

[11] On April 18, 2019, a hearing was held via conference call.

ISSUES

[12] The substantive issues to be addressed by the present review are whether claims 1-17 on file are directed to subject matter outside the definition of invention as found at section 2 of the *Patent Act* and whether claims 1-17 on file are directed to non-obvious subject matter according to section 28.3 of the *Patent Act*. As well, the issues which arose during the Preliminary Review regarding indefiniteness of claims 1, 16 and 17 on file and trademarks are considered. We also consider proposed claim set-2 and the proposed amendments to the description.

LEGAL PRINCIPLES AND OFFICE PRACTICE

Purposive construction

[13] In accordance with *Free World Trust v Électro Santé Inc*, 2000 SCC 66, essential elements are identified through a purposive construction of the claims done by considering the whole of the disclosure, including the specification and drawings (see also *Whirlpool Corp v Camco Inc*, 2000 SCC 67 at paras 49(f) and (g) and 52). In accordance with the *Manual of Patent Office Practice* (CIPO) at §13.05, revised June 2015 [*MOPOP*], the first step of purposive claim construction is to identify the person of ordinary skill in the art (the POSITA) and their relevant common general knowledge (CGK). The next step is to identify the problem addressed by the inventors and the solution put forth in the application. Essential elements can then be identified as those required to achieve the disclosed solution as claimed.

[14] As explained in *MOPOP* at §13.05.02c, not every element having a material effect on the operation of a given practical embodiment is essential to the solution; some recited elements define the context or environment of the embodiment but do not actually change the nature of the solution. Accordingly, purposive construction must consider which elements are required for the solution—proposed by the specification and underlying the claimed embodiment—to achieve its result.

Statutory subject matter

[15] The definition of invention is set out in section 2 of the *Patent Act*:

“Invention” means any new and useful art, process, machine, manufacture or composition of matter, or any new and useful improvement in any art, process, machine, manufacture or composition of matter.

[16] “*Examination Practice Respecting Computer-Implemented Inventions*”, PN 2013–03 (CIPO, March 2013) [PN 2013–03] clarifies the Patent Office’s approach to determining if a computer-related invention is statutory subject matter.

[17] As indicated in PN 2013–03, where a computer is found to be an essential element of a construed claim, the claimed subject matter will generally be statutory. Where, on the other hand, it is determined that the essential elements of a construed claim are limited to matter excluded from the definition of invention (e.g., the fine arts, mere ideas, schemes or rules), the claimed subject matter will not comply with section 2 of the *Patent Act*.

Obviousness

[18] Section 28.3 of the *Patent Act* requires claimed subject matter not to be obvious:

The subject-matter defined by a claim in an application for a patent in Canada must be subject-matter that would not have been obvious on the claim date to a person skilled in the art or science to which it pertains, having regard to

(a) information disclosed more than one year before the filing date by the applicant, or by a person who obtained knowledge, directly or indirectly, from the applicant in such a manner that the information became available to the public in Canada or elsewhere; and

(b) information disclosed before the claim date by a person not mentioned in paragraph (a) in such a manner that the information became available to the public in Canada or elsewhere.

[19] In *Apotex Inc v Sanofi-Synthelabo Canada Inc*, 2008 SCC 61 [*Sanofi*] at para 67, the Supreme Court of Canada stated that it is useful in an obviousness inquiry to follow the following four-step approach:

- (1)(a) Identify the notional “person skilled in the art”;
- (b) Identify the relevant common general knowledge of that person;
- (2) Identify the inventive concept of the claim in question or if that cannot readily be done, construe it;
- (3) Identify what, if any, differences exist between the matter cited as forming part of the “state of the art” and the inventive concept of the claim or the claim as construed;
- (4) Viewed without any knowledge of the alleged invention as claimed, do those differences constitute steps which would have been obvious to the person skilled in the art or do they require any degree of invention?

Indefiniteness

[20] Subsection 27(4) of the *Patent Act* requires that the claims define the subject matter of the invention distinctly and in explicit terms:

The specification must end with a claim or claims defining distinctly and in explicit terms the subject-matter of the invention for which an exclusive privilege or property is claimed.

Trademarks

[21] Section 76 of the *Patent Rules* requires that any trademark mentioned in the application be identified as such.

ANALYSIS

[22] In our analysis, we construe the claims first, according to a purposive construction, and identify the essential elements. We then consider the question of non-statutory subject matter. The same purposive construction is then used to consider the question of obviousness. The questions of indefiniteness and trademarks are then considered. Finally,

we consider the claims and description proposed with the letter received on April 9, 2019.

Claim Construction

The POSITA and the relevant CGK

[23] In the FA (page 2), the POSITA was defined thus:

The skilled worker or team is familiar with the programming techniques for building networked based applications. Furthermore, the skilled worker (team) is also familiar with online advertising, social media systems and data management for such applications.

[24] The Applicant did not dispute this definition in the RFA, the RPR or at the hearing, and consistent with the PR letter, we adopt it here.

[25] The FA cited the following references:

D1:	US 2011/0093336	Calabria	April 21, 2011
D2:	US 2010/0228614	Zhang et al	September 9, 2010
D3:	US 2011/0225291	Dobroth et al	September 15, 2011
D4:	US 2010/0076850	Parekh et al	March 25, 2010

[26] The Panel retrieved the following additional prior art document and in the PR letter, gave the Applicant notice of the document and its pertinence in relation to obviousness:

D5:	WO 2009/061616	Kendall et al	May 14, 2009
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[27] We make use of the description of the background art in some of these citations as well as the background of the instant application to establish the CGK. Consistent with the PR letter, in our view, the CGK of the POSITA includes the following:

- social networks may be online and present ads [D2, paras 0003-0004; D3, para 002; D4, paras 0003-0007; D5, para 0005];
- ads may be targeted at users based on their profiles [D2, para 0004; D5, para 0005];

- ad systems may combine user behavior information with social information to target ads [D4, paras 0003-0004];
- social graphs may be used to analyze the relationship of users to other users and services [instant application, page 1, lines 4-14]; and
- the implementation of social networks and servers and generation and presentation of ad content using general purpose computing systems [instant application, page 22, lines 3-4].

[28] The Applicant did not dispute this characterization of the CGK in the RPR or at the hearing.

Problem and solution

[29] Based on the CGK and the instant specification as a whole, our view remains as expressed in the PR letter that the problem addressed is how to better determine which advertising content to present to a user of a social network, the advertising content relating to applications used for interacting with one or more multimedia objects. Our view is that the solution is to use graph analysis to determine the applications and multimedia objects to advertise to a user based on the set of applications which have been used by others in the user's social graph to access particular multimedia objects.

[30] The Applicant did not dispute this characterization of the problem and solution in the RPR or at the hearing.

Essential elements

[31] We consider independent claim 1 as representative. Claim 1 reads:

A method comprising:

receiving, from a client device of a first user associated with an online social network, a request to access a page of the on line social network;

accessing, using one or more processors associated with one or more computing devices, a social graph comprising a plurality of nodes and a plurality of edges connecting the nodes, wherein each edge between two nodes represents a single degree of separation between the two nodes, the plurality of nodes comprising:

a first node corresponding to the first user;

a plurality of second nodes corresponding to a plurality of second users associated with the online social network, respectively, wherein each of the second nodes is within a threshold degree of separation from the first node; and

a plurality of third nodes corresponding to a plurality of multimedia objects, respectively;

identifying, using the one or more processors, a first set of nodes from the plurality of third nodes, wherein each node in the first set of nodes is connected to one or more of the second user nodes by one or more edges, respectively, wherein each node in the first set of nodes corresponds to a multimedia object that is associated with an application accessible by users associated with the online social network, and wherein the application was used to interact with each multimedia object;

selecting, using the one or more processors, a second set of nodes from the first set of nodes, each node in the second set of nodes being selected based at least in part on a number of edges connected to the node, wherein for each node in the second set of concept nodes, each edge connected to the node indicates that one of the second users accessed, created, or managed, with the application, the multimedia object corresponding to the concept node;

generating, using the one or more processors, an advertisement of the application for display to the first user, the advertisement comprising a reference to the application and further comprising information representing one or more multimedia objects corresponding to one or more third nodes, respectively, in the second set of nodes; and

transmitting, to the client device of the first user in response to the request, the request page of the online social network for display to the first user, wherein the page comprises at least the generated advertisement of the application.

[32] In the PR letter, we listed the following as the essential elements of claim 1 which are required to implement the solution identified above:

- providing a social graph of a social network, the social graph comprising a plurality of nodes and a plurality of edges connecting the nodes, wherein each edge between two nodes represents a

single degree of separation between the two nodes, the plurality of nodes comprising;

- a first node corresponding to a first user;
- a plurality of second nodes corresponding to a plurality of second users, wherein each of the second nodes is within a threshold degree of separation from the first node; and
- a plurality of third nodes corresponding to a plurality of multimedia objects respectively;
- identifying a first set of nodes from the plurality of third nodes, wherein each node in the first set of nodes is connected to one or more of the second user nodes by one or more edges, respectively, wherein each node in the first set of nodes corresponds to a multimedia object that is associated with an application accessible by users of the social network and wherein the application was used to interact with each multimedia object;
- selecting a second set of nodes from the first set of nodes, each node in the second set of nodes being selected based at least in part on a number of edges connected to the node, wherein for each node in the second set of nodes, each edge connected to the node indicates that one of the second users accessed, created, or managed, with the application, the multimedia object corresponding to the node; and
- presenting to the first user, an advertisement comprising a reference to the application and further comprising information representing one or more multimedia objects corresponding to one or more third nodes, respectively, in the second set of nodes.

[33] In the RPR the Applicant agreed with this list, but also stated their view that the essential elements also include:

- generating, using one or more processors, an advertisement of the third-party application for display to the first user, the advertisement comprising a reference to the third-party application and further comprising information representing one or more multimedia objects corresponding to one or more third nodes, respectively, in the second set of nodes.

[34] In the RFA, RPR and at the hearing, the Applicant contended that at least the “identifying” and “generating” statements of the claims relate to technical and computer-implemented steps and have physical existence or manifest a discernible effect. Although we don’t view the generating step as essential, as noted below, in our view, the

identifying step is indeed an essential element. A computer is not, however, essential to its implementation. In claim 1, although a processor is recited, it is part of the environment or context in which the invention operates, but is not essential to the solution to the problem of how to better choose advertising content.

[35] In our view, the generating step is not an essential element of the identified solution to the problem of how to better determine which advertising content to present to a user of a social network. As noted above, the CGK included presenting targeted ads to users of a social network. The problem did not lie in how to generate the ad (formatting, providing hyperlinks etc.) as these techniques were well-known in the art. The instant application does not provide any detail concerning how to generate the ad, which further reinforces our view that the techniques of generating ad content were well-known in the art. The essential elements are those necessary for choosing which ad content to present, not those elements concerned with how to present it. While an element which is CGK may be an essential element of a claim, the element is not essential if it is not part of the solution to the problem.

[36] In the RPR the Applicant also made reference to *Canada (Attorney General) v Amazon.com Inc*, 2011 FCA 328 [*Amazon.com*]. The Applicant noted that “a novel business method may be an essential element of a valid patent claim” (*Amazon.com* at para 63).

[37] The current Patent Office practice was developed in response to the guidance of *Amazon.com*. There is no absolute categorical prohibition on patenting business methods; however, to be statutory subject matter, a claim must contain at least one essential element which constitutes statutory subject matter.

[38] In the RPR and at the hearing, the Applicant also contended that the claimed system involves a complex array of interactions between the various nodes and edges and hardware computer components. In the RPR and at the hearing, the Applicant noted that interactions between computerized elements were considered to be statutory subject

matter in *Re Progressive Casualty Insurance Company's Patent Application 2344781* (2013), CD 1336 (Pat App Bd & Pat Commr).

- [39] We note that each case must be considered according to its own merits. In the instant case, all the computerized elements are considered to be non-essential to the claimed solution.
- [40] In the RFA, the Applicant contended that nothing in the description or the words of the claims clearly indicates that the computer or processor was not intended to be essential. Consistent with Patent Office practice as expressed in *MOPOP* at §13.05.02c, the POSITA would not consider the computer or processor essential to the solution of using social graph information to better choose advertising content.
- [41] In the RFA, the Applicant also contended that a computerized implementation is essential due to time sensitivity or urgency. In the RPR, the Applicant noted that the alleged invention involves "...weighing through vast amounts of data..." We note that the specification is silent regarding time sensitivity or urgency. Even if time sensitivity had been mentioned in the specification, the use of computers to implement social networks was part of the CGK, and computers are well-known to manipulate data quickly. Hence the problem did not lie in how to rapidly evaluate information or choose advertising content, but in what content to choose.
- [42] Independent claims 16 and 17 contain the same essential elements as claim 1. Claims 2 to 15 add additional detail concerning the social graph data or the advertised content.

Statutory Subject Matter

- [43] As construed above, the essential elements of independent claims 1, 16 and 17 correspond to a set of manipulations of data, along with the presentation of information of merely intellectual significance. A computer is not among the essential elements. Using the language of *Amazon.com* (at para 66) the essential elements are not "something with physical existence", and are not "something that manifests a discernible effect or

change”. Such matter is outside the categories of invention in section 2 of the *Patent Act*. The additional elements of dependent claims 2 to 15 constitute a set of manipulations of data or presentation of information of merely intellectual significance.

[44] Therefore, in our view, claims 1 to 17 do not define statutory subject matter and thus do not comply with section 2 of the *Patent Act*.

Obviousness

[45] We consider independent claim 1 as representative.

(1)(a) Identify the notional “person skilled in the art”

(1)(b) Identify the relevant common general knowledge of that person

[46] The POSITA has already been identified above. The above identification of the relevant CGK as of the publication date is also considered to be valid as of the claim date and thus applicable for the purpose of assessing obviousness.

(2) Identify the inventive concept of the claim in question or if that cannot readily be done, construe it

[47] For this case, we take the set of essential elements as construed above as representing the inventive concept.

(3) Identify what, if any, differences exist between the matter cited as forming part of the “state of the art” and the inventive concept of the claim or the claim as construed

[48] We consider D1 to be the closest prior art. In brief, D1 is directed to methods and systems for delivering customized advertisements based on social distance. D1 discloses the computer network infrastructure of a social network. In the PR letter, we compared each essential element of independent claim 1 to D1:

- providing a social graph of a social network, the social graph comprising a plurality of nodes and a plurality of edges connecting the nodes, wherein each edge between two nodes represents a single degree of separation between the two nodes, the plurality of nodes comprising [D1, para 0032];
- a first node corresponding to a first user [D1, para 0025];
- a plurality of second nodes corresponding to a plurality of second users, wherein each of the second nodes is within a threshold degree of separation from the first node [D1, paras 0028, 0032, 0034, 0044]; and
- a plurality of third nodes corresponding to a plurality of multimedia objects respectively [D1, para 0023];
- identifying a first set of nodes from the plurality of third nodes, wherein each node in the first set of nodes is connected to one or more of the second user nodes by one or more edges, respectively, wherein each node in the first set of nodes corresponds to a multimedia object that is associated with an application accessible by users of the social network and wherein the application was used to interact with each multimedia object [D1, para 0028];
- selecting a second set of nodes from the first set of nodes, each node in the second set of nodes being selected based at least in part on a number of edges connected to the node, wherein for each node in the second set of nodes, each edge connected to the node indicates that one of the second users accessed, created, or managed, with the application, the multimedia object corresponding to the node [not in D1];
- presenting to the first user, an advertisement comprising a reference to the application and further comprising information representing one or more multimedia objects corresponding to one or more third nodes, respectively, in the second set of nodes [D1, para 0074-0075].

[49] We consider that the only essential element not found in D1 is that of selecting a second set of nodes (a subset) from the first set of nodes based on how many of the user's social contacts (second nodes) have connected to a given third node.

[50] In the RPR, the Applicant took the position that the step of generating the advertisement was an essential feature and not disclosed by the cited references. We do not agree that the generating step is an essential element, as explained above. However, even assuming

this element were to be essential, D1 discloses this element [D1, paras 0079-0082 and Figures 11 and 12].

(4) Viewed without any knowledge of the alleged invention as claimed, do those differences constitute steps which would have been obvious to the person skilled in the art or do they require any degree of invention?

[51] D1 hints at the use of “other metrics” besides social distance to rate subjects that may be of interest to a user [D1, para 0071]. The POSITA would then be motivated to look at other criteria beyond social distance to users of an application to choose appropriate ad content. D3, in the same art, discloses using the number of friends who have downloaded a particular software application, as one criterion for choosing to present information to a user [D3, para 0006]. This provides the element not found in D1. Further, D5, in the same art, discloses indicating to a user the number of that user’s connections who have accessed a third node [D5, para 0084, para 0091], and prioritizing (selecting) based on a user’s connections’ actions [D5, para 0092]. In our view, the POSITA would consider it obvious to apply the principle of either one of D3 or D5 to the system of D1 to arrive at the matter recited in claims 1, 16 and 17.

[52] The Applicant contended in the RFA (page 8) that D3 discloses purchased applications but does not disclose multimedia objects that may be accessed by the application. We note that the term “multimedia” object does not appear in the description. It was introduced into the claims by amendment upon national entry. A multimedia object appears to mean a concept node. The description, at page 4, line 26 to page 5, line 3, defines concept nodes as corresponding to a wide variety of entities including applications. In our view, D3 reads on multimedia objects. In the alternative, if a multimedia object was to be interpreted as something distinct from an application, the term would constitute new matter.

[53] At the hearing, the Applicant acknowledged that D5 at para 84 discloses presenting a user with information as to how many of the user’s friends have liked a movie. The Applicant pointed out, however, that this is not necessarily the same as having

information that the user's friends actually watched the movie using a specific application (as opposed, for example, to clicking "like" without actually having watched the movie using an application). We note that the claims recite an application used to interact with a multimedia object. We noted above that a multimedia object is construed to broadly refer to an application. Therefore, the claims broadly construed recite that the information gathered relates to which users have used an application or have interacted with specific media content, but, not necessarily both at once. In our view, D3 or D5 read on this aspect of the claims.

[54] At the hearing, the Applicant stressed that they regard the crux of the alleged invention to be the complex interaction of software and hardware to identify the advertising content. The Applicant noted that no such combination of features existed in a social media network at the time of filing. We do not find the claims anticipated; however, we find the combination of D1 with either one of D3 or D5 renders the claims obvious.

[55] The same analysis applies to independent claims 16 and 17.

[56] Claims 2 to 15 add additional detail regarding particular threshold social separations or the structure of the ad content. The particular threshold social separations to use would merely be an optimization choice for the POSITA and not require any degree of invention. The structure of the ad content is not regarded as an essential element, as noted above in the construction of the claims. Even if this were an essential element, it is CGK and non-inventive.

[57] Therefore it is our view that all of claims 1 to 17 are directed to obvious subject matter and do not comply with section 28.3 of the *Patent Act* having regard to D1 in view of D3 or D5.

Indefiniteness

[58] In the PR letter we noted the following indefiniteness defects in claims 1, 16 and 17:

Claim 1 refers to ‘the second set of concept nodes’ at line 23. However, the antecedent is unclear as “concept nodes” was not introduced. The claim, at page 32, line 21, introduces “a second set of nodes from the first set of nodes”. These would appear to correspond to nodes belonging to the third nodes which correspond to multimedia objects, also known as concept nodes. The same defect is found in claims 16 and 17.

Further, claim 1, at page 33, line 1, refers to “the request page of the online social network”. It appears that what was intended should be “the requested page of the online social network”, as the request is a command distinct from the page presented upon receiving the request. The same wording is used in claims 16 and 17.

[59] Therefore, in our view, claims 1, 16 and 17 are unclear and do not comply with subsection 27(4) of the *Patent Act*.

[60] The Applicant did not disagree and in the RPR submitted that the proposed claim set addresses the issue.

Trademarks

[61] In our review of the specification on file, we noted numerous terms which appear to be trademarks, but are not indicated as such. In the PR letter we noted the first occurrence of such terms in the description on file:

Page 2: MICROSOFT WINDOWS, INTERNET EXPLORER,
MOZILLA FIREFOX, APPLE SAFARI, GOOGLE
CHROME, OPERA, Facebook, iPhone

Page 7: SPOTIFY

Page 10: BLACKBERRY

Page 11: GOOGLE

Page 25: WI-FI, BLUETOOTH

Page 26: HYPERTRANSPORT, INFINIBAND, SECURE DIGITAL

Page 30: YAHOO

[62] Therefore, in our view, the specification does not comply with section 76 of the *Patent Rules*.

[63] The Applicant did not disagree and in the RPR submitted that the proposed amendments to the description address the issue.

PROPOSED CLAIM SET

[64] In the RPR, the Applicant proposed claim set-2 as well as an amended description. The substantive change to the independent claims is that the application for interacting with multimedia objects is recited to be a third-party application, and it is recited that the multimedia object is interacted with while using the third-party application. Other proposed amendments to the claims address the indefiniteness defects.

[65] In our view, the proposed amendments do not overcome the non-statutory subject matter and obviousness defects above. The specification is silent as to how the social network keeps track of the usage of third-party applications. This issue was discussed at the hearing, where the Applicant acknowledged that a variety of methods exist to track such usage, such as cookies, application programming interfaces to the third party application through the social media platform, or back-office communication between the third party application provider and the social media provider. Our view is that such ability to track activity outside the social network is therefore part of the CGK. This ability was not part of the problem being addressed by the alleged invention; hence we do not construe accessing and using third-party applications as an essential element. Even if this were to be an essential element, this element is CGK and non-inventive. As the Applicant explained at the hearing, the invention is not focused on how the usage information is tracked, but on the deeper analysis of that information. Our assessment of subject matter and obviousness remain unchanged.

[66] In our view, proposed claim set-2 addresses the indefiniteness defects noted above; however, proposed claim 7 would introduce a new indefiniteness defect in that the term “the third nodes” would lack an antecedent given that the term would no longer be found

in proposed claim 1. Therefore with the exception of claim 7, we consider that proposed claim set-2 would comply with subsection 27(4) of the *Patent Act*.

[67] In our view the proposed description would address the trademark defect and would comply with section 76 of the *Patent Rules*.

CONCLUSIONS

[68] We consider that claims 1-17 are directed to non-statutory subject matter and are therefore non-compliant with section 2 of the *Patent Act*.

[69] We also consider that claims 1-17 are directed to obvious subject matter and are therefore non-compliant with section 28.3 of the *Patent Act*.

[70] We also consider that claims 1, 16 and 17 are unclear and do not comply with subsection 27(4) of the *Patent Act*.

[71] We also consider that the specification does not comply with section 76 of the *Patent Rules*.

[72] We do not consider proposed claim set-2 to constitute specific amendments necessary to comply with the *Patent Act* and *Patent Rules*.

RECOMMENDATION OF THE BOARD

[73] For the reasons set out above, we recommend that the Commissioner of Patents refuse this application as the claims on file are directed to non-statutory subject matter and are therefore non-compliant with section 2 of the *Patent Act*; the claims on file are directed to obvious subject matter and are therefore non-compliant with section 28.3 of the *Patent Act*; claims 1, 16 and 17 are indefinite and therefore do not comply with subsection 27(4) of the *Patent Act*, and the specification does not comply with section 76 of the *Patent Rules*.

Howard Sandler
Member

Mara Gravelle
Member

Leigh Matheson
Member

DECISION

[74] I concur with the conclusions and recommendation of the Board that the application be refused on the grounds that the claims on file are directed to non-statutory subject matter and are therefore non-compliant with section 2 of the *Patent Act*; the claims on file are directed to obvious subject matter and are therefore non-compliant with section 28.3 of the *Patent Act*; claims 1, 16 and 17 are indefinite and therefore non-compliant with subsection 27(4) of the *Patent Act*, and the description contains numerous trademarked terms which are not identified as such and is therefore non-compliant with section 76 of the *Patent Rules*.

[75] Therefore, in accordance with section 40 of the *Patent Act*, I refuse to grant a patent on this application. Under section 41 of the *Patent Act*, the Applicant has six months within which to appeal my decision to the Federal Court of Canada.

Johanne Bélisle
Commissioner of Patents

Dated at Gatineau, Quebec,

This 19th day of August, 2019