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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HASBRO, INC.
Requester and Appellant

v.

GANZ
Patent Owner and Respondent

Appeal 2013-001726
Reexamination Control 95/001,422
Patent 7,618,303 B2
Technology Center 3900

Before HOWARD B. BLANKENSHIP, KEVIN F. TURNER, and
STEPHEN C. SIU *Administrative Patent Judges*.

SIU, *Administrative Patent Judge*

DECISION ON APPEAL

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Third Party Requester/Appellant Hasbro, Inc. appeals under 35 U.S.C. §§ 134(c) and 315(b) the Examiner's decision not to reject claims 1, 5, 6, 8, 10, 19, 21, 22, and 24-27. We have jurisdiction under 35 U.S.C. §§ 134(c) and 315(b).

STATEMENT OF THE CASE

This proceeding arose from a request by Hasbro, Inc. for an inter partes reexamination of U.S. Patent 7,618,30 B2, titled "System and Method for Toy Adoption Marketing," and issued to Howard Ganz on November 17, 2009 (the '303 patent).

The '303 patent describes toy adoption and marketing (col. 1, ll. 28-29).

Claim 1 reads as follows:

1. A method that provides a virtual presentation comprising:
registering a first registration code for a first product on a website;
responsive to a successful registration of said first product on the website, using a computer for displaying on said website, for viewing by a user, a virtual replica of the first product, where said virtual replica resembles said first product and does not resemble at least one other product that is registered on said website;
associating said virtual replica with a control of said user responsive to said successful registration, and controlling said virtual replica on said website based on said registration;
based on said registration, also viewing at least one other virtual replicas on said website that are not associated with said first registration code and which are associated with a friend of said user;
using said computer for providing, for access by said user, a chat function between said virtual replica and at least one said other replicas on the website responsive to the successful registration, said chat function that

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includes selecting from a displayed set, where the displayed set includes pre-scripted phrases for communicating with said friend, said friend viewing one of said other virtual replicas that are replicas of another product other than the first product, that also exists in the virtual presentation, wherein selections from the chat function are limited to containing selections from the displayed set and are prohibited from containing content entered by said user that is not in the displayed set; and

providing, for access by said user, additional content beyond said chat function, for said first product when at least a second registration code is registered on the website by said user who registered said first registration code, wherein the additional content comprises access to additional resources of the website beyond the resources provided by said registration of said first registration code.

Appellant appeals the Examiner's refusal to adopt the proposed rejections of claims 1, 21, 22, and 24-27 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 6,910,186 B2 ("Kim") and U.S. Patent No. 6,519,771 B1 ("Zenith") and claims 5, 6, 8, 10, and 19 under 35 U.S.C. § 103(a) as unpatentable over Kim, Zenith and Hattie Klotz, "Look Out, Pokemon: Neopets are Taking Over," The Ottawa Citizen, Feb. 7, 2000 ("TOC").

ISSUE

Did the Examiner err in refusing to reject claims 1, 5, 6, 8, 10, 19, 21, 22, and 24-27?

PRINCIPLES OF LAW

The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art,

(2) any differences between the claimed subject matter and the prior art, and
(3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966).

“The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.”
KSR Int’l Co. v. Teleflex, Inc., 550 U.S. 398, 416 (2007).

ANALYSIS

Claims 1 and 24

Claim 1 recites providing additional content for the first product when a second registration code is registered on the website by the user who registered the first registration code. Claim 24 recites a similar feature.

The Examiner states that the combination of Kim and Zenith fails to disclose or suggest this feature while Appellant argues that Kim discloses this feature. We disagree with Appellant that Kim discloses this feature.

As Appellant points out, Kim discloses a user entering a password corresponding to a doll (see, e.g., col. 18, ll. 21-23). The password “may be generic . . . to allow a user to use any of the various . . . avatars” (col. 18, ll. 26-27). Hence, upon entering the password, the user is provided with a “virtual replica” of the first product (i.e., the “generic” Barbie® doll). However, Appellant does not sufficiently demonstrate that Kim also discloses registering a second registration code and providing additional content for the first product responsive to the second registration code.

While Appellant states that Kim discloses a “specific password” (App. Br. 9), and the resulting display of content that is different from the content

displayed upon entering the “generic password,” Appellant does not show that the “specific password” (i.e., the “second registration code” as recited in claim 1) is also “for the first product” (i.e., the “generic” Barbie® doll). Instead, the “specific password” of Kim appears to be for a second product (i.e., a “specific BARBIE® doll, such as the WARRIORS doll” – col. 18, l. 29), which is a different product from the “first product” (the “generic” Barbie® doll).

Claims 5, 6, 25, and 26 depend from claim 1. Appellant does not argue that TOC provides the disputed claim feature (claims 5 and 6).

The Examiner did not err in refusing to reject claims 1, 5, 6, and 24-26 as obvious over the combination of Kim and Zenith

Claims 21 and 22

The Examiner states that the combination of Kim and Zenith fails to disclose or suggest “the virtual room ‘belonging to’ a virtual replica” (RAN 6). Claim 21 recites a virtual room belonging to either the first or the second virtual replica.

Appellant argues that Kim discloses an avatar representing a corporate entity (i.e., McDonald’s Corporation) in a “virtual room” that is “owned and controlled by McDonalds Corporation” (App. Br. 13; citing Kim, Fig. 6A) and, hence, discloses or suggests a virtual room belonging to either a first or second virtual replica. We agree with Appellant. Kim discloses that “the controlling organization (e.g., McDonald’s Corporation) uses its chatroom (FIG. 6A)” (col. 15, ll. 21-22). If the organization is using “its” chatroom, one of ordinary skill in the art would have understood that the chatroom, or

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“virtual room” belongs to the organization. Neither the Examiner nor the Respondent provides arguments or evidence refuting this finding.

The Examiner erred in refusing to adopt the rejection of claims 21 and 22 as obvious over the combination of Kim and Zenith.

Claim 27

The Examiner states that the combination of Kim and Zenith fails to disclose or suggest “the purpose of protecting children from inappropriate language” (RAN 6). According to the Examiner, Zenith discloses “symbol chat with preset icons” and Kim discloses “protecting children from inappropriate language” by “ ‘blacklisting’ or ‘muting’ users that misbehave by making obscene comments” (RAN 6) but “it would not have been obvious to replace the existing mechanism of Kim” (RAN 7). Patent Owner does not provide additional arguments with respect to this issue. We disagree with the Examiner for at least the reasons set forth by Appellant (App. Br. 15). For example, as Appellant states, protecting children from inappropriate language “is purely a statement of intended result” and “is entitled to no patentable weight” (App. Br. 15).

In addition, since Zenith discloses a chat message that “includes a symbol chat with preset icons” as recited in claim 27 (as the Examiner states), the utilization of a symbol chat with preset icons would have been known to one of ordinary skill in the art. One of ordinary skill in the art would also have known of the problems of inappropriate language and processes involving protecting children from such inappropriate language as the Examiner states that Kim discloses. Utilizing a known symbol chat with

present icons to manage the known issue of protecting children from inappropriate language would have entailed no more than combining known features in known ways to achieve the predictable result of protecting children from inappropriate language (which, according to the Examiner, Kim discloses).

The Examiner erred in refusing to reject claim 27.

Claims 8, 10, and 19

The Examiner states that it would have not been obvious to one of ordinary skill in the art to have combined the teachings of TOC with those of Kim and Zenith (RAN 7-8). We disagree with the Examiner for at least the reasons set forth by Appellant (App. Br. 16-17). Respondent does not provide additional arguments with respect to this issue.

As previously discussed, Kim discloses users who are represented by a “virtual representation” (i.e., avatar) while participating in a chatroom via a website while TOC also discloses a “virtual representation” of an entity on a website. Since both Kim and TOC disclose known methods of representing entities on websites by providing virtual representations corresponding to the entities, the combination of the teachings of Kim and TOC would have required no more than applying features of one known system of providing virtual representations on a website (Kim) with another known system of providing virtual representations on a website (TOC) to achieve the predictable result of providing virtual representations on a website (Kim or TOC). “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield

predictable results.” *KSR Int’l Co.*, 550 U.S. at 416. Such a combination would have been obvious to one of ordinary skill in the art, particularly given that “a person of ordinary skill is also a person of ordinary creativity, not an automaton.” *KSR Int’l Co.*, 550 U.S. at 421.

CONCLUSION

The Examiner did not err in refusing to reject claims 1, 5, 6, and 24-26, but erred in refusing to reject claims 8, 10, 19, 21, 22, and 27.

DECISION

The Examiner’s decision not to reject claims 1, 5, 6, and 24-26 under 35 U.S.C. § 103(a) as unpatentable over Kim and Zenith is affirmed. The Examiner’s refusal to adopt the proposed rejections of claims 21, 22, and 27 under 35 U.S.C. § 103(a) as unpatentable over Kim and Zenith and claims 8, 10, and 19 under 35 U.S.C. § 103(a) as unpatentable over Kim, Zenith, and TOC is reversed and denominated as a new ground of rejection pursuant to our authority under 37 C.F.R. § 41.77(b).

This decision contains new grounds of rejection pursuant to 37 C.F.R. § 41.77(b) which provides that “[a]ny decision which includes a new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.” Correspondingly, no portion of the decision is final for purposes of judicial review. A requester may also request rehearing under 37 C.F.R. § 41.79, if appropriate, however, the Board may elect to defer issuing any decision on such request for rehearing until such time that a final decision on appeal has been issued by the Board.

For further guidance on new grounds of rejection, see 37 C.F.R. § 41.77(b)-(g). The decision may become final after it has returned to the Board. 37 C.F.R. § 41.77(f).

37 C.F.R. § 41.77(b) also provides that the Patent Owner, WITHIN ONE MONTH FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* The owner may file a response requesting reopening of prosecution before the examiner. Such a response must be either an amendment of the claims so rejected or new evidence relating to the claims so rejected, or both.

(2) *Request rehearing.* The owner may request that the proceeding be reheard under § 41.79 by the Board upon the same record. ...

Any request to reopen prosecution before the examiner under 37 C.F.R. § 41.77(b)(1) shall be limited in scope to the "claims so rejected." Accordingly, a request to reopen prosecution is limited to issues raised by the new ground(s) of rejection entered by the Board. A request to reopen prosecution that includes issues other than those raised by the new ground(s) is unlikely to be granted. Furthermore, should the patent owner seek to substitute claims, there is a presumption that only one substitute claim would be needed to replace a cancelled claim.

A requester may file comments in reply to a patent owner response. 37 C.F.R. § 41.77(c). Requester comments under 37 C.F.R. § 41.77(c) shall be limited in scope to the issues raised by the Board's opinion reflecting its

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decision to reject the claims and the patent owner's response under paragraph 37 C.F.R. § 41.77(b)(1). A newly proposed rejection is not permitted as a matter of right. A newly proposed rejection may be appropriate if it is presented to address an amendment and/or new evidence properly submitted by the patent owner, and is presented with a brief explanation as to why the newly proposed rejection is now necessary and why it could not have been presented earlier.

Compliance with the page limits pursuant to 37 C.F.R. § 1.943(b), for all patent owner responses and requester comments, is required.

The examiner, after the Board's entry of a patent owner response and requester comments, will issue a determination under 37 C.F.R. § 41.77(d) as to whether the Board's rejection is maintained or has been overcome. The proceeding will then be returned to the Board together with any comments and reply submitted by the owner and/or requester under 37 C.F.R. § 41.77(e) for reconsideration and issuance of a new decision by the Board as provided by 37 C.F.R. § 41.77(f).

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

AFFIRMED-IN-PART
37 C.F.R. § 41.77(b)

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