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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte CHRISTOPHER JAMES DAWSON,
RICK ALLEN HAMILTON II, CLIFFORD ALAN PICKOVER and
ANNE R. SAND

Appeal 2012-005995
Application 11/924,743¹
Technology Center 3700

Before STEFAN STAICOVICI, MICHAEL L. HOELTER
and THOMAS F. SMEGAL, *Administrative Patent Judges*.

SMEGAL, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Christopher James Dawson et al. (Appellants) seek our review under 35 U.S.C. § 134 of the Examiner's Final Rejection of claims 1–3, 5–16, 18, and 20. Claims 4, 17, and 19 have been canceled. Appeal Br. 1. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ According to Appellants, the real party in interest is International Business Machines Corporation. Appeal Br. 1.

CLAIMED SUBJECT MATTER

Claims 1, 16, and 18 are independent. An understanding of the invention can be derived from a reading of independent claim 1, which is reproduced below, with emphasis on the disputed claim limitations.

1. A method for customizing a wait state experience for a user represented by an avatar in a virtual universe, the method comprising:

during a default context of a virtual universe, detecting by a server computer that the avatar is entering a wait state for an event, *the default context representing one or more contexts selected from the group consisting of a business-to-business meeting, a presentation, a customer service session, an education session, and a training session;*

determining by the server computer one or more wait state context preferences for the user using artificial intelligence to infer the wait state context preferences;

selecting by the server computer at least one wait state content object according to the one or more wait state context preferences;

creating by the server computer a wait state context in the virtual universe containing the at least one wait state content object;

transporting by the server computer the avatar to the wait state context in the virtual universe thereby allowing the user to interact with the at least one wait state content object in the wait state context until the event starts or occurs; and

returning by the server computer the avatar to the default context responsive to the event starting or occurring.

Appeal Br. 16, Claims App.

REJECTIONS ON APPEAL

The following Examiner's rejections are before us for review:

1. Claim 16 is rejected under 35 U.S.C. §101 as directed to non-statutory subject matter;
2. Claims 1–3, 10, 11, 16, and 18 are rejected under 35 U.S.C. § 103(a) as unpatentable over Lektion (US 6,271,843 B1, iss. Aug. 7, 2001) and Gerace (US 5,848,396, iss. Dec. 8, 1998);
3. Claims 5–7 and 20 are rejected under 35 U.S.C. §103(a) over Lektion, Gerace and Lee (US 2001/10029506 A1, publ. Oct. 11, 2001); and
4. Claims 8, 9, and 12–15 as rejected under 35 U.S.C. §103(a) over Lektion, Gerace and Hayashi (US 5,718,632, iss. Feb. 17, 1998).

ANALYSIS

Non-statutory Subject Matter

The Examiner interprets claim 16 as being drawn to a computer readable medium, i.e., “computer readable, tangible storage devices” that “typically covers forms of non-transitory tangible media and transitory propagating signals *per se* in view of the ordinary and customary meaning of computer readable media, particularly when the [S]pecification is silent. See MPEP 2111.01.” Final Act. 2. The Examiner also points out that “[w]hen the broadest reasonable interpretation of a claim covers a signal *per se*, the claim must be rejected under 35 U.S.C. § 101 as covering non-statutory subject matter. *See In re Nuijten*, 500 F.3d 1346, 1356-57 (Fed. Cir. 2007) (transitory embodiments are not directed to statutory subject matter).” *Id.*

Applicants first contend that “the Examiner has erred by considering the claim term ‘one or more computer readable, tangible storage devices’ to read upon a transitory, propagating signal.” Appeal Br. 7. Appellants also argue that “it is illogical and unreasonable to consider a signal to be either ‘tangible’ or a ‘device’.” *Id.* (citing to “The Free Dictionary by Farlex” to define the terms “signal,” “storage device,” and “tangible”).

Rather than follow the Examiner’s invitation to amend the claim to cover only statutory embodiments (*see id.*), Appellants’ argue that the rejection of claim 16 under 35 U.S.C. §101 is improper because claim 16 is directed to “[a] computer program product comprising one or more computer readable, tangible storage devices, [which] unlike a ‘computer readable medium’ per se, does not [] have a broadest reasonable interpretation that could include a transitory propagating signal per se.” Appeal Br. 8.

Although Appellants’ Specification describes various forms of machine-readable devices, such as floppy disks, CDs, flash drives, and memory modules (see paras. 54–58 and fig. 4a), nonetheless, the Specification also describes “another embodiment option (405) of the present invention” which incorporates “wireless . . . electro-optical, and optical signaling systems” (see Spec. ¶¶ 59–63 and Fig. 4b). Thus, the Specification discusses employing non-statutory subject matter such as signals. Including the terms “tangible” and “device” in claim 16 does not remedy this issue. *Ex parte Mewherter*, 107 USPQ2d 1857 (PTAB 2013) (precedential). Merely because Appellants have used different terminology, and the fact that the Specification does not explicitly exclude a “computer-readable signal” (*see Spec. ¶ 59*), we find that the phrase “computer-

readable, tangible storage devices” does not exclude non-statutory subject matter, such as, transitory signals.

We thus affirm the Examiner’s rejection of claim 16 under 35 U.S.C. §101 as covering both non-statutory and statutory subject matter.

Obviousness of claims 1–3, 10, 11, 16, and 18 over Lektion and Gerace

Appellants do not present separate arguments for the patentability of claims 1–3, 10, 11, 16, and 18 apart from their reliance on claim 1. *See* Appeal Br. 8–14, Reply Br. 5–7. Therefore, we select claim 1 as the representative claim to decide the appeal of the rejection, with claims 2, 3, 10, 11, 16, and 18 standing or falling with claim 1. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2011) .

We have considered Appellants’ arguments and do not find them persuasive of error in the Examiner’s rejection of claim 1 as being obvious over Lektion and Gerace. Appellants contend that a user’s virtual taxi ride, as disclosed by Lektion, does not equate to a default context selected from a Markush group “consisting of a business-to-business meeting, a presentation, a customer service session, an education session, and a training session,” as recited by claim 1. *See* Appeal Br. 8–10. Appellants argue, *inter alia*, that because “the supposed default context [in Lektion of] [is] a user’s avatar arriving on a sidewalk at a taxi sign, and clicking the sign to summon a taxi,” the sign is “not a presentation, such as a virtual PowerPoint slide show.” *Id.* at 10.

We are not persuaded by Appellants’ arguments because as the Examiner correctly finds, Lektion’s clicking on a taxi sign “is a presentation

of a virtual environment” because “[t]he virtual environment is within the computer and is presented to the user thru the display.” Answer 13. We give claims “their broadest reasonable interpretation consistent with the specification” and “in light of the specification as it would be interpreted by one of ordinary skill in the art.” *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004) (citations omitted). It is the Appellants’ burden to precisely define the invention, not the PTO’s. *In re Morris*, 127 F.3d 1048, 1056 (Fed. Cir. 1997). Here, Appellants have not pointed to any lexicographic definition of the term “presentation” in the Specification, or identified any other disclosure therein, to preclude the Examiner finding that clicking on a taxi sign (in a virtual universe) is a presentation. Furthermore, as the Examiner correctly points out, “[A]ppellant’s specification has not ‘defined’ the term presentation as being a power point slide show.” Answer 14.

Appellants also contend that “the Examiner has erroneously equated statistical regression analysis [of Gerace] with Artificial Intelligence [for determining wait state context preferences].” *See* Appeal Br. 8. In particular, Appellants argue that the claims use “artificial intelligence to infer the wait state context preferences” by which

Appellant is referring to using the inferential abilities of artificial intelligence to review some or all of the user's virtual world inventory, past history of travel in the virtual world, past conversations in the virtual world, history of purchases in the virtual world, the amount of money that a user has in the virtual world, the appearance of the avatar, the avatar's friend list in the virtual world, and past waiting room preferences, as provided as example embodiments in the disclosure.

Id. at 11–12.

While acknowledging that “Lecton does not explicitly disclose using artificial intelligence to determine preferences,” the Examiner finds that “Gerace teaches determining preferences using artificial intelligence processes to determine probable wait state content preferences for said user (Col. 2, lines 16–23; Col. 15, lines 24–44)” and concludes that

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the preference determination of Lecton with the artificial intelligence processes of Gerace to produce predictable results in choosing content users would find pleasing or interesting.

Answer 6.

Appellants also argue that the recitation of “artificial intelligence” distinguishes the claims from the Examiner’s reliance on Gerace which Appellants characterize as “statistics and regression analysis.” *See* Appeal Br. 12. Appellants support their argument by citing to extrinsic evidence in a supplemental Information Disclosure Statement, contending that “those ordinarily skilled in the art *would not* consider ‘statistical regression analysis’, ‘statistics’, and ‘artificial intelligence’ to be the same things.” *Id.* at 14.

Appellants rely only upon ¶ [0087] of the Specification to describe the term “artificial intelligence” as

[T]he information on the preference for a user wait state may be based on artificial intelligence (“AI”), wherein the VU system infers that the user is interested in forest locations based on an analysis of the user’s inventory, past history of travel in the VU, past conversations in the VU, a user’s history of purchases, the amount of money that a user has in the VU, [etc].

Appeal Br. 3.

However, we are not persuaded by Appellants' arguments because the Examiner is correct in that

[Appellant's] use of artificial intelligence is that it analyses statistics. The Gerace reference uses analysis on statistics. In particular these statistics include "(i) number of times viewed by a user" (this would be similar to "[sic]past history of travel in the VU) "(ii) number of times selected for further information by the user" (similar to past conversations) "(iii) number of purchases initiated from display of the advertisement to a user" (similar to history of purchases).

Answer 16.

As such, similar to Appellants' Specification, Gerace predicts a user's preference based on the user's activity. The Examiner is also correct in that "Appellant has never shown exactly what the current invention is doing that the prior art has not done" and thus, correctly concludes that, while "Appellant is welcome to be his own lexicographer, and this process can be called Artificial Intelligence or anything else, and the prior art still reads upon it." Answer 16–17.

We thus discern no error in the Examiner's findings and conclusion of obviousness. For the foregoing reasons, we sustain the Examiner's rejection of claims 1–3, 10, 11, 16, and 18 as unpatentable over Lection and Gerace.

Obviousness of claims 5–7 and 20 over Lection, Gerace and Lee and of claims 8, 9, and 12–15 over Lection, Gerace and Hayashi

While the rejections of claims 5–7 and 20 over Lection, Gerace and Lee and of claims 8, 9, and 12–15 over Lection, Gerace and Hayashi are separately listed on page 14 of the Appeal Brief, Appellants have made no additional substantive arguments in response to these rejections, other than

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to request reversal based on the same reasons we discussed above in sustaining the rejection of claim 1. Thus we sustain the Examiner's rejection of dependent claims 5-9, 12-15 and 20 as being unpatentable for the same reasons stated above with respect to claim 1.

DECISION

We AFFIRM the Examiner's decisions to reject claims 1-3, 5-16, 18 and 20.

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

AFFIRMED

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