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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* SHRIDHAR P. JOSHI, CANDACE LUCAS, and  
ALFRED THOMAS

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Appeal 2014-004812  
Application 13/550,234  
Technology Center 3700

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Before JENNIFER D. BAHR, JAMES P. CALVE, and  
GEORGE R. HOSKINS, *Administrative Patent Judges*.

BAHR, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Shridhar P. Joshi et al. (Appellants) appeal under 35 U.S.C. § 134(a) from the Examiner's decision rejecting claims 1, 2, 4–6, 8–15, and 22–24. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM-IN-PART and enter a NEW GROUND OF REJECTION.

### THE CLAIMED SUBJECT MATTER<sup>1</sup>

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

1. A method comprising:
  - receiving player information in a computing device, wherein the player information indicates activities of players in a casino;
  - analyzing, by the computing device, the player information to determine social acquaintance relationships between the players; and
  - providing, via a network, an indication of the social acquaintance relationships to wagering game network devices.

### REJECTIONS

- I. Claims 1, 2, 6, 8–15, and 22–24 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Moser (US 2003/0232647 A1, pub. Dec. 18, 2003) and Atazky (US 2007/0121843 A1, pub. May 31, 2007).
- II. Claim 4 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Moser, Atazky, and Stewart (US 2006/0089873 A1, pub. Apr. 27, 2006).
- III. Claim 5 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Moser, Atazky, and Kelly (US 2006/0010022 A1, pub. Jan. 12, 2006).

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<sup>1</sup> Claims 23 and 24 depend from claim 21, which has been canceled. Appeal Br. 13, 14 (Claims App.). As claims 23 and 24 are directed to “one or more computer-readable storage devices,” for purposes of this appeal, we treat claims 23 and 24 as depending from claim 22. However, in the event of further prosecution of the subject matter of claims 23 and 24, Appellants may wish to consider amending these claims to reflect a proper dependency.

## DISCUSSION

### *Claims 1, 2, 4–6, and 22–24*

Independent claim 1 is directed to a method comprising, in pertinent part, steps of receiving “player information indicat[ing] activities of players in a casino” and “analyzing . . . the player information to determine social acquaintance relationships between the players.” Appeal Br. 11 (Claims App.). Independent claim 22 is directed to computer-readable storage devices including, in pertinent part, instructions for performing essentially those same steps. *Id.* at 13.

The Examiner found that Moser “is silent regarding analyzing a person’s social acquaintance and online community relationship data and associated promotion data,” but that “Atazky teaches analyzing a person’s online community relationship data and associated promotion data to generate marketing campaigns.” Final Act. 3 (underlining omitted) (citing Atazky ¶¶ 59–62). The Examiner then determined that “[i]t would have been obvious to . . . modify Moser with social networking data as taught [by] Atazky to build better build [sic] personal profiles and thereby improve the success of casino marketing campaigns.” *Id.* (underlining omitted). The Examiner explains that “Atazky teaches . . . that user information may be social relationship data collected about a user via a computer device and that it may be received and analyzed for marketing purposes.” Ans. 5 (citing Atazky ¶¶ 59–65) (underlining omitted).

As Appellants point out, the deficiency in the modification of Moser proposed by the Examiner is that it yields a system and method which *analyzes* social relationship data, in addition to casino activity data, for marketing purposes, but does not address the limitation in claims 1 and 22

that the *player information indicating activities of players in a casino* be analyzed to *determine* social acquaintance relationships. *See* Appeal Br. 6, 9; Reply Br. 3–4. Accordingly, Appellants apprise us of error in the rejection of claims 1 and 22 and their dependent claims 2, 6, 23, and 24.

In rejecting claims 4 and 5, which depend from claim 1, the Examiner’s application of the teachings of Stewart and Kelly does not cure the deficiency in the combination of Moser and Atazky. *See* Final Act. 3–4.

*Claims 8–10 and 12–15*

Appellants argue that the combination of Moser and Atazky “does not teach or suggest an analysis indicating social relationships between players based on information about choices made during wagering games.” Appeal Br. 7–8. More specifically, Appellants submit that “Atazky does not teach or suggest any sort of analysis that that [sic] derives social relationships based on player activities during wagering games and player activities in an online community,” but, rather, “distributes advertisements to social contacts of those who endorse a product or service.” *Id.* at 8. This argument does not identify error in the rejection of claim 8 because it is not commensurate in scope with claim 8. *See In re Self*, 671 F.2d 1344, 1348 (CCPA 1982) (limitations not appearing in the claims cannot be relied upon for patentability).

Notably, independent claim 8 does not require analyzing player information indicating activities of a player in a casino to determine social acquaintance relationships. Rather, claim 8 requires:

wagering game machines configured to provide a first set of player information . . . indicat[ing] choices made by players during a wagering game; a community server configured to provide a second set of player information . . . indicat[ing] online

community activities of the players; and a player information server configured to analyze the first and second sets of player information [to indicate] wagering game content preferences associated with the players and social relationships between certain of the players.

Appeal Br. 12 (Claims App.). As such, claim 8 encompasses a wagering game network comprising a player information server configured to analyze the first set of player information to indicate wagering game content preferences and to analyze the second set of player information to indicate social relationships. The Examiner's rejection includes a finding that Moser teaches a player information server configured to analyze the first set of player information (i.e., monitored gaming activity) to indicate wagering game content preferences, and a finding that Atazky teaches a server configured to analyze a second set of player information (i.e., data on a social network, or online community) to indicate social relationships between members of the social network. Final Act. 2–3 (citing Moser ¶¶ 22–23; Atazky ¶¶ 59–62); *see also* Atazky ¶¶ 98–99 (discussing “social network sites . . . in which users' profiles are defined and the social ties between users are conceived and developed over time” and determining interpersonal relationships “by data mining past interactions, including extraneous collaborative systems, such as email databases or even virally distributed messages”), 217 (disclosing “calculate[ing] each target user's ‘importance’ perceived by all other target user participants” in a social network and extracting or data mining required data from social network databases). The Examiner determined it would have been obvious to use the social networking data as taught by Atazky in Moser's system “to build better build [sic] personal profiles and thereby improve the success of casino marketing campaigns.” Final Act. 3. The Examiner explains that Moser is

silent regarding use of “player information including social relationship data,” but that Atazky teaches collecting social relationship data about a user via a computer device and analyzing that data for marketing purposes. Ans. 5–6. Thus, the Examiner maintains that “the combination of Moser and Atazky make obvious the recited features of claim 8.” *Id.* at 6 (underlining omitted).

Appellants do not identify any deficiencies in either the Examiner’s findings or in the Examiner’s stated rationale for combining the teachings of Moser and Atazky. Accordingly, Appellants do not apprise us of error in the rejection of independent claim 8 or its dependent claims 9, 10, and 12–15, for which Appellants do not present any separate arguments for patentability. *See* Appeal Br. 7–8 (grouping claims 8–10 and 12–15 together and submitting “that claims 9, 10, and 12–15 are allowable for at least the reasons claim 8 is allowable”).

#### *Claim 11*

Claim 11 depends from claim 8 and further recites “a wagering game server configured to provide wagering game content to the wagering game machines based on the preferences and relationships.” Appeal Br. 12 (Claims App.). The Examiner did not make any specific findings directed to this claim limitation in the rejection. *See* Final Act. 2–3; Ans. 2–3. Appellants submit that “claim 11 recites a wagering game server that provides wagering game content (e.g., wagering games) based on relationships between players” and argue that “the cited art does not teach or suggest claim 11’s wagering game server.” Appeal Br. 8.

The Examiner responds by explaining that “Atazky is relied upon to teach collecting social relationship data for marketing”; “Moser is relied

upon for collecting wagering game player information for providing wagering game content”; and “[w]hen combined, the combination of Moser and Atazky make obvious the recited features of claim 11.” Ans. 6 (underlining omitted) (citing Atazky ¶¶ 59–65; Moser ¶¶ 5, 9, 22, 26, 33). We do not discern in paragraphs 5, 9, 22, 26, and 33 of Moser relied upon by the Examiner as disclosing “collecting wagering game player information for providing wagering game content” any disclosure of providing *wagering game content* to the wagering game machines based on the wagering game content preferences and relationships, as called for in claim 11, and the Examiner does not further elaborate on where such disclosure is contained in or may reasonably be inferred from these paragraphs. Neither does the Examiner explain adequately why such a feature would have been obvious in view of the combined teachings of Moser and Atazky.

As such, the Examiner fails to articulate the specific factual findings and analysis necessary to support the conclusion of obviousness of the subject matter of claim 11.

#### NEW GROUND OF REJECTION

Pursuant to our authority under 37 C.F.R. § 41.50(b), we enter the following new ground of rejection.

Claims 22–24 are rejected under 35 U.S.C. § 101 as directed to patent-ineligible subject matter.

Claims 22–24 recite “[o]ne or more computer-readable storage devices” including instructions to be executed on one or more processors. Appeal Br. 13–14 (Claims App.). Aside from the inclusion of instructions thereon, claims 22–24 do not further define the “computer-readable storage

devices” or limit them to any particular type of storage media. Thus, we turn to Appellants’ Specification to see if it provides a definition for “computer-readable storage devices.” Appellants’ Specification does not provide an explicit definition of “computer-readable storage devices,” but does disclose that “the operations can be performed by executing instructions residing on machine-readable media (e.g., software), while in other embodiments, the operations can be performed by hardware and/or other logic (e.g., firmware).” Spec. ¶ 61.

The broadest reasonable interpretation of a claim drawn to a computer readable medium . . . 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 specification is silent. . . . When 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.

David J. Kappos, *Subject Matter Eligibility of Computer Readable Media*, 1351 Off. Gaz. Pat. Office 212 (Feb. 23, 2010).

Appellants’ Specification does not exclude such signal or communication media from the scope of “computer-readable storage devices.” Accordingly, giving claims 22–24 their broadest reasonable interpretation consistent with the Specification, we construe the terminology “computer-readable storage devices” as encompassing transitory propagating signals having instructions. Thus, claims 22–24 cover subject matter that is not patent-eligible under 35 U.S.C. § 101. *See Ex parte Mewherter*, 107 USPQ2d 1857, 1862 (PTAB 2013) (precedential) (holding recited machine-readable storage medium ineligible under § 101 because it encompassed transitory media); *see also In re Nuijten*, 500 F.3d 1346, 1353

(Fed. Cir. 2007) (holding that “transitory embodiments are not directed to statutory subject matter”).<sup>2, 3</sup>

## DECISION

The Examiner’s decision rejecting claims 1, 2, 4–6, 8–15, and 22–24 is affirmed as to claims 8–10 and 12–15, and reversed as to claims 1, 2, 4–6, 11, and 22–24. Pursuant to our authority under 37 C.F.R. § 41.50(b), we enter a new ground of rejection of claims 22–24 under 35 U.S.C. § 101.

## FINALITY OF DECISION

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.” 37 C.F.R. § 41.50(b) also provides:

When the Board enters such a non-final decision, the appellant, within two months from the date of the decision, must exercise one of the following two options with respect to the new ground

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<sup>2</sup> As noted in *Subject Matter Eligibility of Computer Readable Media*, “[a] claim drawn to such a computer readable medium that covers both transitory and non-transitory embodiments may be amended to narrow the claim to cover only statutory embodiments to avoid a rejection under 35 U.S.C. § 101 by adding the limitation ‘non-transitory’ to the claim.”

<sup>3</sup> No inference should be drawn from the absence herein of any other new grounds of rejection, including additional grounds under 35 U.S.C. § 101. *See* 37 C.F.R. § 41.50(b). *See also* Manual of Patent Examining Procedure (MPEP), 9th ed., rev. 07.2015, Nov. 2015, § 1213.02. Under 37 C.F.R. § 41.50(b), the Board may, in its decision, make a new rejection of one or more of any of the claims pending in the case. Since the exercise of authority under 37 C.F.R. § 41.50(b) is discretionary, no inference should be drawn from the decision to exercise that discretion with respect to some claims and grounds but not other claims or other potential grounds.

of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new Evidence relating to the claims so rejected, or both, and have the matter reconsidered by the Examiner, in which event the prosecution will be remanded to the Examiner. The new ground of rejection is binding upon the examiner unless an amendment or new Evidence not previously of Record is made which, in the opinion of the examiner, overcomes the new ground of rejection designated in the decision. Should the examiner reject the claims, appellant may again appeal to the Board pursuant to this subpart.

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same Record. The request for rehearing must address any new ground of rejection and state with particularity the points believed to have been misapprehended or overlooked in entering the new ground of rejection and also state all other grounds upon which rehearing is sought.

Further guidance on responding to a new ground of rejection can be found in the Manual of Patent Examining Procedure § 1214.01.

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-IN-PART; 37 C.F.R. § 41.50(b)