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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte BRIAN R. BOKOR, ANDREW B. SMITH, and STEVEN K.
SPEICHER

Appeal 2015-004692
Application 12/275,726
Technology Center 2100

Before ST. JOHN COURTENAY III, CATHERINE SHIANG, and
JOHN P. PINKERTON, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's Final Rejection of claims 1–23. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

Invention

The disclosed and claimed invention on appeal:

relates to virtual worlds, such as simulations of the real-world or real-life, and the like, and more particularly to avatar profile creation and linking in a virtual world, such as allowing grouping of avatar attributes, including grouping gestures, clothing, moods, appearance, accessories, equipment, or other

avatar attributes, that may be associated with or linked to events and/or locations in a virtual world.

(Spec. 2, ¶1).

Representative Claim

1. A method for creating and linking a profile in a virtual world, comprising:

presenting, by a processor, an interface for creating a grouping profile for application to a user's avatar in response to the user's avatar to be transported to one of a particular virtual world location, event and activity, wherein the grouping profile includes at least one attribute;

allowing, by the processor, assignment of the at least one attribute to the grouping profile;

allowing, by the processor, definition of an application criteria;

associating the application criteria with the grouping profile, wherein the application criteria is usable to determine if the grouping profile is applicable to the user's avatar based on the one of the particular virtual world location, event and activity to which the user's avatar is to be transported;

receiving, by the processor, one of a virtual world location, event and activity selected by the user to which the user's avatar is to be transported;

[L1] *presenting another interface to the user to request information to determine that the grouping profile to be applied to the user's avatar matches the selected one of the virtual world location, event and activity prior to transporting the user's avatar;*

[L2] *in response to the user's selection of one of a virtual world location, event and activity, applying the applicable grouping profile to the avatar prior to transporting the avatar; and*

[L3] *allowing the user to review and edit the grouping profile applied prior to transporting the avatar.*

(Contested limitations L1, L2, and L3 are emphasized).

*Rejections*¹

¹ In the Final Action (2), the Examiner rejected claims 19 and 20 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Because the Answer is silent regarding this rejection, the Examiner appears to have withdrawn the § 101 rejection in response to the entry on appeal of the after-final amendment, received on July 24, 2014. (*See* Advisory Act. 1). *See* 37 C.F.R. § 41.39(a)(1). However, we note the addition of “non-transitory” by amendment to the “computer usable storage medium” recited in the *body* of claim 19 does not cure the problem, because of the open-ended “comprising” language recited in the preamble of claim 19: “A computer program product . . . *comprising*.” (Emphasis added). *See Genentech, Inc. v. Chiron Corp*, 112 F.3d 495, 501 (Fed. Cir. 1997) (“‘Comprising’ is a term of art used in claim language which means that the named elements are essential, *but other elements may be added and still form a construct within the scope of the claim.*”)(Emphasis added). We further note the Specification (¶ 15) describes “a computer program product embodied *in any tangible medium of expression* having computer usable *program code embodied in the medium*,” and thus fails to limit the scope of the “computer program product” recited in claim 19 to non-transitory forms by a definition per se, or by providing a clear and unambiguous disclaimer. (Emphasis added). *See also* Spec. (¶ 17) (“The computer usable medium may include a propagated data signal with the computer-usable program code embodied therewith, either in baseband or as part of a carrier wave.”). Therefore, we conclude the “computer program product . . . *comprising*” language recited in the *preamble* of claim 19 does not preclude the inclusion of additional *transitory* (non-statutory) storage *mediums* in the *body* of the claim, under a broad but reasonable interpretation. “The four categories together describe the exclusive reach of patentable subject matter. If a claim covers material not found in any of the four statutory categories, that claim falls outside the

- A. Claims 1–4, 7, and 11–23 are rejected under 35 U.S.C. § 103(a) as being obvious over the combined teachings and suggestions of Blattner et al. (US 2007/0113181 A1, May 17, 2007), Morse et al. (US 5,802,296, Sept 1, 1998), Jolliff et al. (2009/0300525 A1, Dec. 3, 2009), and Narayanan et al. (2009/0158170 A1, June 18, 2009).
- B. Claim 5 is rejected under 35 U.S.C. § 103(a) as being obvious over the combined teachings and suggestions of Blattner, Morse, Jolliff, Narayanan, and Hildreth (2009/0079813 A1, Mar. 26, 2009).
- C. Claims 6 and 8–10 are rejected under 35 U.S.C. § 103(a) as being obvious over the combined teachings and suggestions of Blattner, Morse, Jolliff, Narayanan, and Mo et al. (2009/0144173 A1, June 4, 2009).

Grouping of Claims

Based on Appellants’ arguments in the Appeal Brief, we decide the appeal of the claims rejected under rejection A, on the basis of independent claim 1. *See* 37 C.F.R. § 41.37(c)(1)(iv). We address rejections B and C, *infra*.

plainly expressed scope of § 101 even if the subject matter is otherwise new and useful.” *In re Nuijten*, 500 F.3d 1346, 1354 (Fed. Cir. 2007). Therefore, in the event of further prosecution of this application, we leave it to the Examiner to consider a new ground of rejection of claims 19 and 20 under 35 U.S.C. § 101. Although the Board is authorized to reject claims under 37 C.F.R. § 41.50(b), no inference should be drawn when the Board elects not to do so. *See Manual of Patent Examining Procedure* (MPEP) § 1213.02 (9th Ed., Rev. 07.2015, Nov. 2015).

ANALYSIS

We have considered all of Appellants' arguments and any evidence presented.² We disagree with Appellants' arguments, and we adopt as our own: (1) the findings and reasons set forth by the Examiner in the action from which this appeal is taken, and (2) the reasons and rebuttals set forth in the Answer in response to Appellants' arguments. (Ans. 3–6). However, we highlight and address specific findings and arguments for emphasis in our analysis below.

Rejection A of Independent Claim 1 under 35 U.S.C. § 103(a)

Combinability under §103

At the outset, we find unpersuasive Appellants' contention the Examiner has improperly combined the cited references under 35 U.S.C. §103. (e.g., “a person of ordinary skill in the art would not be motivated to combine the teachings of Blattner and Morse and such motivation only comes from Appellant's disclosure, which constitutes impermissible hindsight.” — App. Br. 16). In support, Appellants urge (*id.*):

While Morse may teach transporting avatars from one virtual world location to another, there is no teaching or suggestion in either Blattner or Morse that the assigned personalities for instant messaging or chat may be applied to the *transportation* of avatars in Morse and such suggestion or teaching only comes from Appellant's disclosure.

(Emphasis added).

As reproduced in the Brief (16), the Examiner finds “moving from one chat or messaging environment to another is a form of transportation.”

² Regarding all contested limitations, we only consider Appellants' arguments to the extent such arguments are directed to subject matter actually claimed.

(Final Act. 15. The Examiner concludes: “The different interactions (i.e. transporting) within virtual environments are obvious functionalities which can be incorporated within different systems.” (*Id.*). Although Appellants urge that “assign[ing] personalities for instant messaging or chat (applied at the time an instant message is sent, per Blattner) . . . is not *transporting* between environments” (App. Br. 16.), we note Appellants fail to point to a definition in the Specification for “transporting” avatars that would preclude the Examiner’s broader interpretation.³

In reviewing the record, we are of the view that Appellants’ invention is simply a combination of familiar elements performing known functions (as taught by the cited Blattner, Morse, Jolliff, and Narayanan references) that would have realized a predictable result. On this record, Appellants have not shown how the invention claimed would have been more than a combination of prior art elements according to known methods to yield predictable results. *See KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 416 (2007).

Regarding Appellants’ allegation of impermissible hindsight reconstruction (App. Br. 16), the Supreme Court guides: “[r]igid preventative rules that deny factfinders recourse to common sense . . . are neither necessary under our case law nor consistent with it.” *KSR* 550 U.S. at 421. Here, we find the Examiner provided sufficient articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. (e.g., *see* Final Act. 3–6). Appellants do not point to any

³ Because “applicants may amend claims to narrow their scope, a broad construction during prosecution creates no unfairness to the applicant or patentee.” *In re ICON Health and Fitness, Inc.*, 496 F.3d 1374, 1379 (Fed. Cir. 2007) (citation omitted).

evidence of record that shows combining the references in the manner proffered by the Examiner (*id.*) would have been “uniquely challenging or difficult for one of ordinary skill in the art” or would have “represented an unobvious step over the prior art.” *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007) (citing *KSR*, 550 U.S. at 418). Nor have Appellants provided objective evidence of secondary considerations which our reviewing court guides “operates as a beneficial check on hindsight.” *Cheese Systems, Inc. v. Tetra Pak Cheese and Powder Systems, Inc.*, 725 F.3d 1341, 1352 (Fed. Cir. 2013).

Therefore, on this record, and by a preponderance of the evidence, we are not persuaded the Examiner erred by improperly combining the references under 35 U.S.C. §103.

Contested Limitations under 35 U.S.C. §103

Issue: Under 35 U.S.C. § 103(a), did the Examiner err in finding the cited combination of Blattner, Morse, Jolliff, and Narayanan would have taught or suggested contested limitations L1, L2, and L3:

[L1] *presenting another interface to the user to request information to determine that the grouping profile to be applied to the user’s avatar matches the selected one of the virtual world location, event and activity prior to transporting the user’s avatar;*
[L2] *in response to the user’s selection of one of a virtual world location, event and activity, applying the applicable grouping profile to the avatar prior to transporting the avatar; and*
[L3] *allowing the user to review and edit the grouping profile applied prior to transporting the avatar[.]*

within the meaning of claim 1? ⁴ (Emphasis added).

⁴ We give the contested claim limitations the broadest reasonable interpretation consistent with the Specification. *See In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997); *see also, e.g., Spec.* (¶ 54) (“The following

Contested Limitation L1 of Claim 1

Regarding contested limitation L1, Appellants contend, *inter alia*, the Examiner’s findings regarding Jolliff (¶ 96) are incorrect at least because there “may not be a grouping profile associated with every activity.” (App. Br. 12). Appellants point to the Specification (¶ 42), and urge that “confirming an activity does not mean that a profile is being confirmed.” (App. Br. 12). We decline to read limitations from the Specification into the claim.⁵

At the outset, we consider the Examiner’s citation to paragraph 96 of Jolliff (e.g., “the mobile device 301 may be configured with software instructions to *ask the user* [(i.e., ‘request information’ — claim 1),] whether it has correctly diagnosed the current activity (such as running), or ask the user to name the current activity.”), as further buttressed by paragraph 97 of Jolliff:

[0097] . . . Alternative embodiments may ask the user (such as by way of a prompt presented on the display) the *nature of an activity* in order to learn and associate the recorded sensor and setting data with the specific activity. Instead of asking the user to define the *nature of the activity*, the mobile device 301 may ask the user to identify a particular avatar to be associated with the present activity in the future. In this manner, the displayed avatar may more accurately represent the user's status.

claims are in no way intended to limit the scope of the invention to the specific embodiments described herein.”).

⁵ “This court has repeatedly ‘cautioned against limiting the claimed invention to preferred embodiments or specific examples in the specification.’” *Williamson v. Citrix Online, LLC*, 792 F.3d 1339, 1346–47 (Fed. Cir. 2015) (*quoting Teleflex, Inc. v. Ficosa N. Am. Corp.*, 299 F.3d 1313, 1328 (Fed. Cir. 2002)).

Given this evidence (Jolliff ¶¶ 96, 97), we find contested limitation L1 (“*presenting another interface to the user to request information to determine that the grouping profile to be applied to the user’s avatar matches the selected one of the virtual world location, event and activity prior to transporting the user’s avatar*”) is taught or suggested by Jolliff, when combined with the teachings and suggestions of the additional cited references.

We find Jolliff (¶¶ 96, 97) prompts the user to confirm the profile matches the virtual world location,⁶ as well as teaching the virtual event and virtual activity. Moreover, by asking “the user to identify a particular avatar to be associated with the present activity *in the future*” (Jolliff ¶ 97, emphasis added), we find Jolliff teaches or suggests the contested *temporal aspect* of limitation L1: “presenting . . . *prior to transporting the user’s avatar*”) (Emphasis added). Further, we find the contested temporal limitations of claim 1 would merely realize a predictable result if performed in the sequence claimed. We additionally find Morse teaches *transporting an avatar*, within the broadest reasonable interpretation of claim 1. (See Morse, col. 4, ll. 43–45, “Basic avatars . . . can move from locale to an adjacent locale in the virtual world”)

Contested Limitations L2 and L3 of Claim 1

Regarding contested limitation L2 (“*in response to the user’s selection of one of a virtual world location, event and activity, applying the applicable grouping profile to the avatar **prior to transporting the avatar***”), and contested limitation L3 (“*allowing the user to review and edit the*

⁶ See Jolliff (¶97) (“For many activities, the GPS sensor location and data will provide a good indication of the avatar to display.”).

grouping profile applied prior to transporting the avatar[,]” Appellants again ground their arguments urging patentability principally on the recited *temporal limitations* (App. Br. 14–15):

a reference to a “later date” in Narayanan does not meet Appellant’s recitals, which state that (a) “in response to the user’s selection of one of a virtual world location, event and activity applying the applicable grouping profile to the avatar *prior to transporting the avatar*” (emphasis added), and (b) [sic] “allowing reviewing and editing of the grouping profile of an avatar that has been applied *prior to transporting the avatar*”; Narayanan does not disclose modifying attributes *after* a grouping profile has already been applied and *prior to transporting*.

However, regarding limitation L2, Narayanan (¶ 25) teaches a applying a present *default profile* at a “later date:”

In this way, an avatar otherwise created for a given virtual environment, such as a social network, may be modified to include attributes relevant for another given virtual environment, such as an activity based virtual environment, when the avatar is utilized *at some later date* to interact in the other given virtual environment.

(Emphasis added).

Narayanan (¶ 25) also teaches allowing the user *to review and edit the grouping profile applied prior to transporting the avatar* (e.g., to a future second virtual environment), within the meaning of claim 1:

Naturally, a user going through avatar creation may have an option to reject profile elements provided from any one or more of the provided profiles. In accordance with the present system, an avatar created by a user for interaction in a first virtual environment may be utilized, without further intervention by the user, in a second virtual environment.

We find the contested L2 and L3 temporal limitations (“prior to transporting the avatar”) would merely realize a predictable result if performed in the sequence claimed. (Claim 1). We note the Examiner’s rejection is based on the *combined* teachings and suggestions of Blattner, Morse, Jolliff, and Narayanan.

Although Appellants advance a nominal separate argument under a separate heading for claims 22 and 23 (App. Br. 17–19), we find Appellants merely reproduce the record, recite the claim language, and assert the limitations are not taught by the cited references.⁷ Because Appellants fail to advance a separate, substantive argument, dependent claims 22 and 23 fall with representative claim 1, from which they depend. See “*Grouping of Claims*” *supra*.

For the aforementioned reasons, and based upon a preponderance of the evidence, we are not persuaded the Examiner erred regarding representative claim 1. Accordingly, we sustain rejection A of independent claim 1, and rejection A of the grouped claims (not argued separately), which fall with claim 1. See “*Grouping of Claims*” *supra*.

⁷ See *In re Lovin*, 652 F.3d 1349, 1357 (Fed. Cir. 2011) (“[W]e hold that the Board reasonably interpreted Rule 41.37 to require more substantive arguments in an appeal brief than a mere recitation of the claim elements and a naked assertion that the corresponding elements were not found in the prior art.”). Accord *Ex parte Belinne*, No. 2009-004693, 2009 WL 2477843, at *4 (BPAI Aug. 10, 2009) (“Informative”) (“Appellants’ argument . . . repeatedly restates elements of the claim language and simply argues that the elements are missing from the reference.”)

Rejection B of Dependent Claim 5 under §103

Dependent claim 5 recites: “The method of claim 1, wherein allowing assignment of the at least one attribute to the grouping profile comprises allowing the user to define a new attribute.” The Examiner (Final Act. 11) finds: “Hildreth discloses allowing the user to provide additional attributes to the appearance of the avatar based on a user preference (profile) (Paragraph 43; attributes are provided).” Regarding the Examiner’s additional reliance on the Hildreth reference, Appellants urge (App. Br. 21):

Hildreth therefore makes no disclosure, teaching, or suggestion related to *grouping profiles or user-defined new attributes to a grouping profile*, but rather relates only to alteration of specific features of appearance in general. One of ordinary skill in the art would not look to Hildreth for combination with the other cited references. Accordingly, there is *no prima facie* obviousness of Claim 5.

We note paragraph 43 of Hildreth describes, in pertinent part: “The appearance of the user representation 121 (e.g., the appearance of the avatar) may vary based on the identity of the caller, time of day, user preferences, or other factors.” We further note the Examiner relies on, inter alia, the primary Blattner reference (¶¶ 125–129) for teaching or suggesting the contested “grouping profiles or user-defined new attributes to a grouping profile,” as argued by Appellants. (App. Br. 21). For example, Blattner (¶ 127) describes online personas associated with one of the avatars. As discussed above, Narayanan (¶ 25) describes a default profile and attributes. We emphasize the Examiner’s rejection of claim 5 is based on the *combined* teachings and suggestions of Blattner, Morse, Jolliff, and Narayanan, and Hildreth.

Given the evidence cited by the Examiner (i.e., Hildreth ¶ 43); *see* Final Act. 11–12), we find the Examiner’s proffered combination of the teachings of Blattner, Morse, Jolliff, and Narayanan, and Hildreth, would have realized predictable results such that Appellants’ claim 5 would have been rendered obvious. Because Appellants have not persuaded us the Examiner erred, we sustain rejection B of claim 5.

Rejection C of Remaining Claims 6 and 8–10 under §103

Appellants do not separately argue the patentability of dependent claims 6 and 8–10, and, instead rely on the arguments previously presented for independent claims 1, 17, and 19. (App. Br. 22). For the reasons discussed above regarding claim 1, we find these arguments unpersuasive. Accordingly, we sustain the Examiner’s rejection C of claims 6 and 8–10 as being obvious over the cited combination of prior art.

Reply Brief

To the extent Appellants advance new arguments in the Reply Brief not in response to a shift in the Examiner’s position in the Answer, we note arguments raised in a Reply Brief that were not raised in the Appeal Brief or are not responsive to arguments raised in the Examiner’s Answer will not be considered except for good cause. See 37 C.F.R. § 41.41(b)(2).

Appeal 2015-004692
Application 12/275,726

DECISION

We affirm the Examiner's rejections of claims 1–23 under 35 U.S.C. § 103(a).

No time for taking any action connected with this appeal may be extended under 37 C.F.R. § 1.136(a)(1). *See* 37 C.F.R. § 41.50(f).

AFFIRMED