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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte RICK A. HAMILTON II, PAUL A. MOSKOWITZ,
CLIFFORD A. PICKOVER, and ROBERT WISNIEWSKI

Appeal 2016-000984¹
Application 12/330,699²
Technology Center 3600

Before NINA L. MEDLOCK, PHILIP J. HOFFMANN, and
BRUCE T. WIEDER, *Administrative Patent Judges*.

MEDLOCK, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner’s final rejection of claims 1–6, 8–16, 18–25, and 27–32. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ Our decision references Appellants’ Appeal Brief (“App. Br.,” filed March 18, 2015) and Reply Brief (“Reply Br.,” filed October 19, 2015), and the Examiner’s Answer (“Ans.,” mailed August 20, 2015) and Final Office Action (“Final Act.,” mailed October 28, 2014).

² Appellants identify International Business Machines Corporation as the real party in interest. App. Br. 2.

CLAIMED INVENTION

Appellants' claimed invention "generally relates to a system and method for inquiring about products and, in particular, to inquiring about products and providing incentives to users participating in a virtual universe" (Spec. ¶ 1).

Claims 1, 14, 18, and 23 are the independent claims on appeal. Claims 1 and 23, reproduced below, are illustrative of the claimed subject matter:

1. A system comprising:
an information tracking system configured to:
 receive an identifier for a real world product or service purchased by a user in the real world, wherein the identifier is entered by the user into a virtual universe comprising a computer-based real-world simulation where the user interacts with other users and moves through the simulation using an avatar, and the real world product or service is not a virtual item of the virtual universe;
 identify a proximity of the avatar to at least one of a virtual store, a virtual kiosk, and a virtual sales representative within the virtual universe when the identifier is entered by the user into the virtual universe;
 and
 track information in the virtual universe about the product or service, public and/or private information about the user, and the identified proximity, wherein the information about the product or the service is obtained from the identifier for the product or the service and the information about the user is obtained at least from an avatar profile associated with the user's avatar;
a storage system configured to aggregate the information obtained from the information tracking system to build a user profile within the virtual universe, wherein the user profile comprises an avatar ID and a reference pointer, the avatar ID links the user profile to the user's avatar and the reference pointer links the user profile to a data structure comprising the

information about the product or the service, the information about the user, and the identified proximity; and

an incentive system configured to provide one or more incentives to the user for use in the virtual universe by the user's avatar in exchange for the user purchasing the product or service and entering the identifier associated with the product or service into the information tracking system, wherein the one or more incentives include at least one of virtual universe currency, virtual universe points, avatar inventory items, access to restricted areas or functions within the virtual universe, avatar function and representation enhancements, virtual universe property, and virtual universe coupons.

23. A computer program product comprising a computer readable storage device having computer readable program code embodied in the computer readable storage device, the computer readable program code executable by at least one computing device to cause the computing device to:

receive an identifier for a real world product or service purchased by a user in the real world, wherein the identifier is entered by the user into a virtual universe comprising a computer-based real-world simulation where the user interacts with other users and moves through the simulation using an avatar, and the real world product or service is not a virtual item of the virtual universe;

identify a proximity of the avatar to at least one of a virtual store, a virtual kiosk, and a virtual sales representative within the virtual universe when the identifier is entered by the user into the virtual universe;

determine an amount of interaction the user had with others while in the proximity of the at least one of the virtual store, the virtual kiosk, and the virtual sales representative;

track information about the product, the service, the user, the identified proximity, and the amount of interaction in the virtual universe, wherein the information about the product or the service is obtained from the identifier for the product or the service and the information about the user is obtained at least from an avatar profile associated with the user's avatar;

accumulate the tracked information about the product, the service, and the user in a user profile, wherein the user profile comprises an avatar ID and a reference pointer, the avatar ID links the user profile to the user's avatar and the reference pointer links the user profile to a data structure comprising the information about the product or the service, the information about the user, the identified proximity, and the amount of interaction; and

provide an incentive in addition to the product or the service, to the user for use in the virtual universe by the user's avatar in exchange for the user purchasing the product or the service and entering the identifier into the virtual universe within a certain proximity to the at least one of the virtual store, the virtual kiosk, and the virtual sales representative, wherein the incentive includes at least one of virtual universe currency, virtual universe points, avatar inventory items, access to restricted areas or functions within the virtual universe, avatar function and representation enhancements, virtual universe property, and virtual universe coupons.

REJECTIONS

Claims 1–6, 8–16, 18–25, and 27–32 are rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter.

Claims 1–6, 8–13, 18–22, 27–29, 31, and 32 are rejected under 35 U.S.C. § 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter that Appellants regard as the invention.

Claims 1–6, 8–16, and 18–25 are rejected under 35 U.S.C. § 102(b) as anticipated by Kagan et al. (WO 02/20111 A2, pub. Mar. 14, 2002) (hereinafter “Omnisky”).³

Claims 15, 16, and 27–29 are rejected under 35 U.S.C. § 103(a) as unpatentable over Omnisky.

Claims 30–32 are rejected under 35 U.S.C. § 103(a) as unpatentable over Omnisky and Burge et al. (US 6,014,638, iss. Jan. 11, 2000) (hereinafter “Burge”).

ANALYSIS

Non-Statutory Subject Matter

Under 35 U.S.C. § 101, an invention is patent-eligible if it claims a “new and useful process, machine, manufacture, or composition of matter.” 35 U.S.C. § 101. The Supreme Court, however, has long interpreted § 101 to include an implicit exception: “[l]aws of nature, natural phenomena, and abstract ideas” are not patentable. *See, e.g., Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2354 (2014).

The Supreme Court, in *Alice*, reiterated the two-step framework previously set forth in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 132 S. Ct. 1289, 1300 (2012), “for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts.” *Alice Corp.*, 134 S. Ct. at 2355. The first step in that analysis is to “determine whether the claims at issue are directed to one of those patent-ineligible concepts.”

³ Both Appellants and the Examiner refer to the publication as “Omnisky” — a reference to Omnisky Corporation, which is identified on the face of the publication as the “Applicant (*for all designated States except US*).”

Id. If the claims are not directed to a patent-ineligible concept, e.g., an abstract idea, the inquiry ends. Otherwise, the inquiry proceeds to the second step where the elements of the claims are considered “individually and ‘as an ordered combination’” to determine whether there are additional elements that “‘transform the nature of the claim’ into a patent-eligible application.” *Alice Corp.*, 134 S. Ct. at 2355 (quoting *Mayo*, 132 S. Ct. at 1297).

The Court acknowledged in *Mayo*, that “all inventions at some level embody, use, reflect, rest upon, or apply laws of nature, natural phenomena, or abstract ideas.” *Mayo*, 132 S. Ct. at 1293. Therefore, the Federal Circuit has instructed that claims are to be considered in their entirety to determine “whether their character as a whole is directed to excluded subject matter.” *McRO, Inc. v. Bandai Namco Games Am., Inc.*, 837 F.3d 1299, 1312 (Fed. Cir. 2016) (quoting *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1346 (Fed. Cir. 2015)).

Here, in rejecting the pending claims under 35 U.S.C. § 101, the Examiner finds that the claims are directed to providing an incentive program, i.e., to a fundamental economic practice and, therefore, to an abstract idea; and that the claims do not recite limitations that are “significantly more” than the abstract idea itself because the claims do not recite an improvement to another technology or technical field, an improvement to the functioning of the computer itself, or meaningful limitations beyond generally linking the use of an abstract idea to a particular technological environment (Final Act. 2).

Addressing the first step of the *Mayo/Alice* framework, Appellants note that the claimed invention, as recited, for example, in claim 23, is

directed to a method for inquiring about products and providing incentives to users participating in a virtual universe (App. Br. 8). Appellants argue that the claims are not directed to an abstract idea, i.e., a fundamental practice long prevalent in our system; instead, according to Appellants, “a novel method, not previously known, is provided by the present invention” i.e., tracking information about a product, a service, a user, an identified proximity, and an amount of interaction in a virtual universe (*id.*).

Appellants’ argument is not persuasive at least because “[t]he ‘novelty’ of any element or steps in a process, or even of the process itself, is of no relevance in determining whether the subject matter of a claim falls within the § 101 categories of possibly patentable subject matter.” *Diamond v. Diehr*, 450 U.S. 175, 188–89 (1981). A novel and nonobvious claim directed to a purely abstract idea is, nonetheless, patent-ineligible. *Mayo*, 132 S. Ct. at 1304.

We also are not persuaded of Examiner error by Appellants’ argument that the pending claims are patent-eligible because the claimed features “do not unduly preempt too broad a category of innovation” (App. Br. 9–10). Although the Supreme Court has described “the concern that drives this exclusionary principle [i.e., the exclusion of abstract ideas from patent eligible subject matter] as one of pre-emption,” *see Alice Corp.*, 134 S. Ct. at 2354, characterizing pre-emption as a driving concern for patent eligibility is not the same as characterizing pre-emption as the sole test for patent eligibility. “The Supreme Court has made clear that the principle of preemption is the basis for the judicial exceptions to patentability” and “[f]or this reason, questions on preemption are inherent in and resolved by the § 101 analysis.” *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371,

1379 (Fed. Cir. 2015) (citing *Alice Corp.*, 134 S. Ct. at 2354). Although “preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility.” *Id.*

Turning to the second step of the *Mayo/Alice* framework, Appellants argue that the claimed invention amounts to “significantly more” than an abstract idea because the independent claims require “an identifier to be entered by the user into a virtual universe comprising a computer-based real-world simulation where the user interacts with other users and moves through the simulation using an avatar, and the real world product or service is not a virtual item of the virtual universe” (App. Br. 9). Appellants assert, “this is not ‘well-understood, routine conventional activities’ previously known in the industry” (*id.*). But Appellants do not adequately show how the claims are technically performed such that they are not routine, conventional functions of a generic computer. There is no indication in the record that the particular operations recited in the claims require any specialized computer hardware or that the claimed invention is implemented using other than generic computer components. And, the law is clear that the mere recitation of generic computer limitations does not make an otherwise ineligible claim patent-eligible. *See, e.g., DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1256 (Fed. Cir. 2014) (“[A]fter *Alice*, there can remain no doubt: recitation of generic computer limitations does not make an otherwise ineligible claim patent-eligible.”).

Appellants further argue that the claims are patent-eligible because “the computer-implemented processes of the claimed invention are processes designed to solve a technological problem,” e.g., “to allow virtual universes to work with businesses to provide features and environments that

encourage people to return to their virtual universe” (App. Br. 10–11). But encouraging people to return to a virtual universe, i.e., retaining customers, is not a technical problem, it is a marketing problem. And providing incentives to customers as an enticement to return to the virtual universe is a commercial solution, not a technical solution.

Responding to the Examiner’s Answer and referencing the USPTO’s “July 2015 Update: Subject Matter Eligibility,” Appellants further argue that the rejection under § 101 cannot be sustained because the Examiner has failed to show how the claims as a whole are similar to a concept that the courts have identified as a patent-ineligible abstract idea (Reply Br. 3 (“Further Appellants note that ‘a claimed concept is not identified as an abstract idea unless it is similar to at least one concept that the courts have identified as an abstract idea.’ See *Federal Register Notice Vol. 80, No. 146, July 30, 2015: July 2015 Update: Subject Matter Eligibility, page 3.*”)).⁴ However, an Examiner’s failure to follow the Director’s guidance is appealable only to the extent that the Examiner has failed to follow the statutes or case law. To the extent the Director’s guidance goes beyond the case law and is more restrictive on the Examiner than the case law, the failure of the Examiner to follow those added restrictions is a matter for petition to the Director. We are aware of no controlling precedent, nor do Appellants identify any controlling case law, that precludes an examiner

⁴ The July 2015 Update instructs examiners to refer to the body of case law precedent in order to identify abstract ideas by way of comparison to concepts already found to be abstract (*id.* at 3). And the Update further explains that “[t]his discussion is meant to . . . ensure that a claimed concept is not identified as an abstract idea unless it is similar to at least one concept that the courts have identified as an abstract idea” (*id.*).

from finding a claimed concept patent-ineligible unless it is similar to a concept that a court has identified as patent-ineligible.

Further responding to the Examiner's Answer, Appellants argue that the present claims, like the claims in *DDR Holdings*, are “necessarily rooted in computer technology in order to overcome a problem specifically arising in the realm of computer networks” and are patent-eligible because they pertain to a solution, e.g., allowing virtual universes to work with businesses to provide features and environments that encourage people to return to their virtual universe, “based only in computer technology to solve a problem which has no counterpart outside of computer networks” (Reply Br. 4). Yet, the court cautioned in *DDR Holdings* that “not all claims purporting to address Internet-centric challenges are eligible for patent.” *DDR Holdings*, 773 F.3d at 1258. Thus, in *Ultrameercial, Inc. v. Hulu, LLC*, 772 F.3d 709 (Fed. Cir. 2014), although the patentee argued that its claims were “directed to a specific method of advertising and content distribution that was previously unknown and never employed on the Internet before,” 772 F.3d at 714, the court found that this alone could not render the claims patent-eligible where the claims merely recited the abstract idea of “offering media content in exchange for viewing an advertisement,” along with “routine additional steps such as updating an activity log, requiring a request from the consumer to view the ad, restrictions on public access, and use of the Internet.” *Id.* at 715–716.

Similarly here, we find that the invocation of the Internet is not sufficient to transform Appellants' otherwise patent-ineligible abstract idea into patent-eligible subject matter. For example, there is no indication that any specialized hardware is required or that the invocation of the Internet

otherwise adds any inventive concept. We find, as did the Examiner, that the pending claims are directed to the abstract idea of providing an incentive program, and more particularly, to gathering information regarding a particular user or a product or service purchased by the user, and providing an incentive to the user for use in the virtual universe in exchange for the user purchasing the product or service (*see, e.g.*, Ans. 6), i.e., to data collection and analysis, which the Federal Circuit has repeatedly held is a patent-ineligible abstract idea. *See, e.g., Elec. Power Grp. LLC v. Alstom, S.A.*, 830 F.3d 1350, 1354 (Fed. Cir. 2016). That the abstract idea is implemented in the context of a virtual universe merely limits the use of the abstract idea to a particular technological environment, which the Court made clear in *Alice* is insufficient to transform an otherwise patent-ineligible abstract idea into patent-eligible subject matter. *See Alice Corp.*, 134 S. Ct. at 2358.

In view of the foregoing, we are not persuaded that the Examiner erred in rejecting claims 1–6, 8–16, 18–25, and 27–32 under 35 U.S.C. § 101. Therefore, we sustain the Examiner’s rejection.

Indefiniteness

Independent claim 1 is directed to a system comprising, *inter alia*, “an information tracking system” configured to perform various recited functions. Claims 2 and 13 depend from claim 1; claim 2 recites that the information tracking system is further configured to perform additional functions, and claim 13 recites that the tracking and aggregating are implemented on “a computer infrastructure.” Independent claim 18 is substantially similar to claim 1, and recites a system for deploying an application for tracking information comprising, *inter alia*, “a computer

infrastructure” being operable to perform functions substantially similar to those recited in claim 1.

In rejecting independent claims 1 and 18 as indefinite under 35 U.S.C. § 112, second paragraph, the Examiner finds that the terms “information tracking system,” as recited in claim 1, and “computer infrastructure,” as recited in claim 18 are “generic placeholders,” i.e., substitutes for the word ‘means,’” rather than specific structural elements, and the Examiner concludes that Appellants intended, by the use of these terms, to invoke 35 U.S.C. § 112, paragraph 6 (Final Act. 4–6). The Examiner references Appellants’ May 12, 2014 Amendment where Appellants explain:

“[I]nformation tracking system” as recited in claim 1 in view of Applicants’ Specification is a component of the computing device 14 that makes the computing device 14 operable to obtain information about a product, service, and/or use (see, e.g., paragraph [0020] and FIG. 1 of Applicants’ specification). The purpose of providing claim 13 is to further clarify that the tracking and the aggregating are implemented on a computer infrastructure, e.g., the server 12, and not merely a computing device 14 as defined in claim 1 (see, e.g., paragraphs [0020] and [0024] and FIG. 1 of Applicants’ specification).

Amendment at 13. And the Examiner finds that the corresponding structure for the “information tracking system” is “a component of the computing device 14,” and that the structure corresponding to the “computer infrastructure” is server 12 (Final Act. 5–6). The Examiner further notes that a server, as understood in the art, is a “computer or computer program that manages access to a centralized resource or service in a network” (*id.* at 5).

Appellants argue that claims 1, 2, 13, and 18 do not invoke the application of 35 U.S.C. § 112, sixth paragraph, because the claims recite

sufficient structure (App. Br. 11–13). Yet, we find no indication in the record that a person of ordinary skill in the art, on reading the Specification, would understand the term “information tracking system” and/or the term “computer infrastructure” to connote a specific structure, nor any indication that these terms are used in common parlance or by persons of skill in the art to designate particular structure. *See, e.g., Advanced Ground Info. Sys., Inc. v. Life360, Inc.*, 830 F.3d 1341, 1347–48 (Fed. Cir. 2016) (“The standard is whether the words of the claim are understood by persons of ordinary skill in the art to have a sufficiently definite meaning as the name for structure.” (quoting *Williamson v. Citrix Online, LLC*, 792 F.3d 1339, 1349 (Fed. Cir. 2015))). Therefore, we agree with the Examiner that the “information tracking system” and “computer infrastructure” limitations should be regarded as “means plus function” limitations.

Next, we must construe these claim limitations “by identifying the ‘corresponding structure, material, or acts described in the specification’ to which the claim [limitation] will be limited. If we are unable to identify any ‘corresponding structure, material, or acts described in the specification,’ the claim [limitation] is indefinite.” *Robert Bosch LLC v. Snap-On Inc.*, 769 F.3d 1094, 1097 (Fed. Cir. 2015) (internal citations omitted).

Here, these limitations, as disclosed in Appellants’ Specification, are performed by computing device 14 and server 12, i.e., they are computer-implemented limitations. Therefore, the relevant inquiry is whether Appellants’ Specification discloses sufficient corresponding structure, i.e., an algorithm for performing the functions recited in the “information tracking system” and “computer infrastructure” limitations. In other words, Appellants’ Specification must sufficiently disclose an algorithm to

transform the general purpose computer or processor to a special purpose processor programmed to perform the disclosed algorithm. *Aristocrat Techs. Austl. Pty Ltd. v. Int'l Game Tech.*, 521 F.3d 1328, 1338 (Fed. Cir. 2008). Otherwise, an indefiniteness rejection under § 112, second paragraph, is appropriate. *Id.* at 1337–38. *See also Function Media, LLC v. Google, Inc.*, 708 F.3d 1310, 1318 (Fed. Cir. 2013) (holding that a computer-implemented means-plus-function limitation is indefinite because the specification failed to disclose the specific algorithm used by the computer to perform the recited function).

The Examiner bases the § 112, second paragraph, rejection on Appellants' failure to "adequately disclose the corresponding algorithm or processes in order to achieve the claimed functions" (*see, e.g.*, Ans. 12–14). Appellants argue that a person of ordinary skill would understand what is claimed, when the claims are read in light of the Specification (App. Br. 13). But Appellants do not otherwise dispute the Examiner's finding; instead, Appellants maintain that they have no obligation to disclose an algorithm for performing the claimed functions (Reply Br. 11 ("Appellants respectfully disagree that in order to satisfy the rejection under 35 U.S.C. § 112, second paragraph, the Appellants must disclose the hardware plus the algorithm that the hardware uses to perform the function").

We are not persuaded of error on the part of the Examiner. Therefore, we sustain the Examiner's rejection under 35 U.S.C. § 112, second paragraph, of independent claims 1 and 18, and claims 2–6, 8–13, 19–22, 27–29, 31, and 32, which depend therefrom.

Anticipation

Independent Claim 1 and Dependent Claims 2–6 and 8–13

We are persuaded by Appellants' argument that the Examiner erred in rejecting independent claim 1 under 35 U.S.C. § 102(b) because Omnisky does not disclose "identify[ing] a proximity of the avatar to at least one of a virtual store, a virtual kiosk, and a virtual sales representative within the virtual universe when the identifier is entered by the user into the virtual universe," as recited in claim 1 (App. Br. 15–18).

Omnisky is directed to a system for incorporating co-existent interaction between a virtual character and a user in the real world, and discloses that the system comprises a computer sub-system, including a computer device and means for inputting actions of a user in the real world into the sub-system, such that the actions of a user in the real world, at a pre-chosen real world location, are recorded and inputted into the computer sub-system and influence the character in the virtual world (Omnisky, Abstract). Omnisky discloses a scenario, at page 12, line 13 through page 14, line 3, cited by the Examiner, in which the user is engaged in a game in which an Uber Character 20, i.e., an artificially created digital personality that exist within the computerized gaming program, is facing a menacing virtual dragon. Uber Character 20 calls on a Real Character 10, i.e., a live user in communication with the game management server via a desktop personal computer, for help, i.e., to obtain a magic sword as an antidote for Uber Character 20 within the virtual gaming environment. Real Character 10 is informed that the magic sword requires additional points beyond the points in his/her account, and that these additional points can be obtained by purchasing a particular real-world beverage from a particular real-world

vendor. Real Character 10 physically travels to the vendor location and purchases the beverage; the information pertaining to the purchase is then communicated to the gaming system and points are credited to Real Character 10's account.

Appellants argue that rather than disclosing that "an identifier is entered by the user into the virtual universe," as called for in claim 1, Omnisky discloses that the identifier is submitted directly by the real world store to the virtual universe server upon the user's purchase of the real world object (App. Br. 17). Appellants also maintain that Omnisky does not disclose that the virtual identifier is entered by the user into a virtual universe in such a manner that "a proximity of the avatar to at least one of a virtual store, a virtual kiosk, and a virtual sales representative within the virtual universe is definable, traceable, or combinable" (*id.*).

Responding to Appellants' arguments, the Examiner asserts that Omnisky discloses that identification information is not only entered into the virtual universe by the restaurant, i.e., the real-world vendor, but by the user as well (Ans. 18). The Examiner, thus, maintains that "the action of a user having to go to a particular location to allow for the information to be entered into the virtual universe is equivalent to the user entering the identification information into the virtual universe" under a broadest reasonable interpretation (*id.*).

Regarding the identification of the avatar's proximity "to at least one of a virtual store, a virtual kiosk, and a virtual sales representative within the virtual universe," the Examiner takes the position that the virtual store, a virtual kiosk, and a virtual sales representative are non-functional descriptive subject matter that cannot be relied on to distinguish over the prior art (*id.*

at 19). In this regard, the Examiner asserts that the claims “fail to further utilize the locations . . . and, consequently, what these locations are . . . do[es] not alter or affect the steps of the method or the functionality of the system and medium (or even alter or further narrow the structural elements of the system)” (*id.*). According to the Examiner, “the system is merely identifying the location of the avatar with reference to another virtual thing” (*id.*).

We do not agree with the Examiner that a user’s physical travel in the real world corresponds to the user entering an identifier into a virtual universe. Nor do we agree that a virtual store, a virtual kiosk, and a virtual sales representative, as recited in claim 1, may properly be characterized as non-functional descriptive subject matter. Instead, we agree with Appellants that claim 1 recites a functional relationship with respect to these elements that must be given patentable weight. That is, claim 1 requires identifying the proximity of the avatar in relation to at least one of a virtual store, a virtual kiosk, and a virtual sales representative, which is an actual location within the virtual universe and not merely printed matter or a label (Reply Br. 14).

Moreover, even assuming for the sake of argument that the system is merely identifying the location of the avatar with reference to the location of another virtual thing, and the fact that the particular location is a virtual store or virtual kiosk has no patentable significance, as the Examiner maintains (Ans. 19), we fail to see how, and the Examiner does not adequately explain how, Omnisky discloses identifying the location of the avatar in relation to the location of another virtual thing when the identifier is entered by the user into the virtual universe, which the Examiner’s interpretation requires.

In view of the foregoing, we do not sustain the Examiner's rejection of independent claim 1 under 35 U.S.C. § 102(b). For the same reasons, we also do not sustain the Examiner's rejection of dependent claims 2–6 and 8–13.

Independent Claims 14, 18, and 23 and Dependent Claims 15, 16, 19–22, 24, and 25

Independent claims 14, 18, and 23 include language substantially similar to the language of independent claim 1, and stand rejected based on the same rationale applied with respect to claim 1 (*see, e.g.*, Final Act. 10–12). Therefore, we do not sustain the Examiner's rejection under 35 U.S.C. § 102(b) of independent claims 14, 18, and 23, and claims 15, 16, 19–22, 24, and 25, which depend therefrom, for the same reasons set forth above with respect to independent claim 1.

Obviousness

Dependent Claims 15, 16, and 27–29

Claims 15 and 16 and claims 27–29 depend from independent claims 1 and 23, respectively. We are persuaded for the reasons set forth above that the Examiner erred in rejecting independent claims 1 and 23 under 35 U.S.C. § 102(b). For much the same reasons, we do not sustain the Examiner's rejection of dependent claims 15, 16, and 27–29 under 35 U.S.C. § 103(a).

Dependent Claims 30–32

Claim 30 and claims 31 and 32 depend from independent claims 23 and 1, respectively. The Examiner does not rely on Burgle as disclosing the features of independent claims 1 and 23 which we found absent in Omnisky.

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Therefore, we do not sustain the Examiner's rejection of dependent claims 30–32 under 35 U.S.C. § 103(a).

DECISION

The Examiner's rejection of claims 1–6, 8–16, 18–25, and 27–32 under 35 U.S.C. § 101 is affirmed.

The Examiner's rejection of claims 1–6, 8–13, 18–22, 27–29, 31, and 32 under 35 U.S.C. § 112, second paragraph, is affirmed.

The Examiner's rejection of claims 1–6, 8–16, and 18–25 under 35 U.S.C. § 102(b) is reversed.

The Examiner's rejections of claims 15, 16, and 27–32 under 35 U.S.C. § 103(a) are reversed.

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

AFFIRMED