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540 Broadway
4th Floor
ALBANY, NY 12207

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SCHEUNEMANN, RICHARD N

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte RICK A. HAMILTON II,
BRIAN M. O'CONNELL,
CLIFFORD A. PICKOVER, and
KEITH R. WALKER

Appeal 2017-001440
Application 12/133,466¹
Technology Center 3600

Before HUBERT C. LORIN, PHILIP J. HOFFMANN, and
CYNTHIA L. MURPHY, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Rick A. Hamilton, II, et al. (Appellants) seek our review under 35 U.S.C. § 134(a) of the Final Rejection of claims 1, 2, 4, 7–12, 14, 17–21, and 23. We have jurisdiction under 35 U.S.C. § 6(b).

SUMMARY OF DECISION

We REVERSE.

¹ The Appellants identify International Business Machines Corporation as the real party in interest. App. Br. 1.

THE INVENTION

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

1. A method for providing customer service in a virtual universe using at least one computing device, comprising:

analyzing information associated with a real-world product with a problem at a support location service in the virtual universe to determine a land location within the virtual universe of a product support center for the product,

wherein the product support center is controlled by a common commercial entity related to the support location service, the common commercial entity providing at least one of: the real-world product or a related service for the real-world product to a user of the real-world product;

providing an avatar, controlled by the user, with a teleportation invitation to the product support center, using the at least one computing device;

providing an automated avatar at the product support center in response to the avatar accepting the teleportation invitation, using the at least one computing device; and

using the automated avatar to demonstrate at least one possible solution for the problem,

wherein the automated avatar demonstrates the at least one solution using a graphic virtual rendering of the product and a graphic virtual rendering of the solution in the virtual universe.

The following rejection is before us for review:

Claims 1, 2, 4, 7–12, 14, 17–21, and 23 are rejected under 35 U.S.C. § 101 as being judicially-expected subject matter.

ISSUE

Did the Examiner err in rejecting claims 1, 2, 4, 7–12, 14, 17–21, and 23 under 35 U.S.C. § 101 as judicially-excepted subject matter?

ANALYSIS

The rejection of claims 1, 2, 4, 7–12, 14, 17–21, and 23 under 35 U.S.C. § 101 as being directed to judicially-excepted subject matter.

Alice Corp. Proprietary Ltd. v. CLS Bank International, 134 S. Ct. 2347 (2014) identifies a two-step framework for determining whether claimed subject matter is judicially-excepted from patent-eligibility under 35 U.S.C. § 101.

According to *Alice* step one, “[w]e must first determine whether the claims at issue are directed to a patent-ineligible concept,” such as an abstract idea. *Alice*, 134 S. Ct. at 2355.

In that regard, the Examiner determined that “[c]laims(s) 1, 2, 4, 7–12, 14, 17–21, and 23 are directed to providing customer support in a virtual universe, an abstract idea.” Final Rej. 4. According to the Examiner,

[t]he present claims are similar to the claims in the Federal Circuit case, *Digitech Image Tech, LLC v. Electronics for Imaging, Inc.* In that case, the court found the claims were directed towards a method for organizing information into a new form and thus a non-eligible abstract idea. Similarly here, the claims include methods of manipulating information into a new form. Exemplary claim 1 recites limitations that include, “analyzing information,” “providing an avatar,” “providing an automated avatar,” and “using the automated avatar to demonstrate at least one possible solution.” The limitations merely recite a highly generalized idea of manipulating data to provide solutions to problems.

Final Rej. 4–5.

The Examiner takes a broad view of what the claims are directed to.
The Appellants have another view.

Clearly, none of the steps in claim 1 are directed simply to “providing customer support” or “organizing information” as asserted by the Examiner. The Examiner asserts that the claimed method simply manipulates data and does not recite an improvement to the industry. (Final Office Action, Page 5). However, one of ordinary skill in the art would recognize that providing an automated avatar that demonstrates a solution on a virtual rendering of the particular product in question is not “directed to customer support” as understood by the definition above, but that it is directed to a narrow concept that is not an abstract idea. The ability to demonstrate a particular solution on a particular product in a virtual universe does not attempt to monopolize customer support in a virtual universe, instead providing a clear and distinct aspect of customer support. Thus, the claims are not directed to an abstract idea, as alleged by the Examiner. A thorough interpretation of the claimed subject matter illustrates this fact rather effectively.

App. Br. 9.

“The § 101 inquiry must focus on the language of the Asserted Claims themselves.” *Synopsys, Inc. v. Mentor Graphics Corp.*, 839 F.3d 1138, 1149 (Fed. Cir. 2016). *See Accenture Global Servs., GmbH v. Guidewire Software, Inc.*, 728 F.3d 1336, 1345 (Fed. Cir. 2013) (admonishing that “the important inquiry for a § 101 analysis is to look to the claim”); *see also Content Extraction & Transmission LLC v. Wells Fargo Bank, Nat’l Ass’n*, 776 F.3d 1343, 1346 (Fed. Cir. 2014) (“We focus here on whether the claims of the asserted patents fall within the excluded category of abstract ideas.”).

Before determining whether the concept to which the claims at issue are directed to is an abstract idea, one must first determine what that concept is, if it is a concept.

The “directed to” inquiry [] cannot simply ask whether the claims *involve* a patent-ineligible concept, because essentially every routinely patent-eligible claim involving physical products and actions *involves* a law of nature and/or natural phenomenon—after all, they take place in the physical world. *See Mayo*, 132 S.Ct. at 1293 (“For all inventions at some level embody, use, reflect, rest upon, or apply laws of nature, natural phenomena, or abstract ideas.”). Rather, the “directed to” inquiry applies a stage-one filter to claims, considered in light of the specification, based on whether “their character as a whole is directed to excluded subject matter.” *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1346 (Fed. Cir. 2015); *see Genetic Techs. Ltd. v. Merial L.L.C.*, 818 F.3d 1369, 1375, 2016 WL 1393573, at *5 (Fed. Cir. 2016) (inquiring into “the focus of the claimed advance over the prior art”).

Enfish, LLC v. Microsoft Corp., 822 F.3d 1327, 1335 (Fed. Cir. 2016).

With respect to computer-enabled claimed subject matter, it can be helpful to determine whether “the claims at issue [] can readily be understood as simply adding conventional computer components to well-known business practices” or not. *Id.* at 1338. *See also Affinity Labs of Tex., LLC v. DIRECTV, LLC*, 838 F.3d 1253, 1257 (Fed. Cir. 2016). In *Enfish*, the court found that the “plain focus of the claims” there was on “an improvement to computer functionality itself, not on economic or other tasks for which a computer is used in its ordinary capacity.” *Id.* at 1336.

“In determining the eligibility of respondents’ claimed process for patent protection under § 101, their claims must be considered as a whole.” *Diamond v. Diehr*, 450 U.S. 175, 188 (1981). The question is whether the claims as a whole “focus on a specific means or method that improves the relevant technology” or are “directed to a result or effect that itself is the abstract idea and merely invoke generic processes and machinery.” *McRO*,

Inc. v. Bandai Namco Games Am. Inc., 837 F.3d 1299, 1314 (Fed. Cir. 2016).

In this case, the preambles of the independent method claims 1 and 23 do recite “providing customer support in a virtual universe.” A claim’s preamble can form a basis for characterizing the concept to which a claim is directed, and here that would be “providing customer support in a virtual universe” (Final Rej. 4). *See Two-Way Media Ltd. v. Comcast Cable Communications, LLC*, 874 F.3d 1329, 1340 (Fed. Cir. 2017) (“First, we see no error here in the district court citing to the preamble in its review of whether the claims are directed to an abstract idea. *See, e.g., BASCOM*, 827 F.3d at 1348 (citing preamble for distillation of abstract idea). The district court’s inquiry centered on determining the ‘focus’ of the claims, and was thus in accord with our precedent. *E.g., Elec. Power Grp.*, 830 F.3d at 1353.”).

However, there is more going on here. As the Appellants point out, much of the claimed subject matter is devoted to a virtual universe. Albeit providing customer service in a virtual universe is a goal, the focus of the claims is on a mechanism for doing so that is particular to the virtual universe within which it is carried out. That mechanism employs avatars (“an avatar, controlled by the user” and an “automated avatar”) and the avatars themselves perform certain necessary functions. According to claim 1, “an avatar, controlled by the user, [is provided] with a teleportation invitation to [a] product support center,” “an automated avatar [is provided] at the product support center in response to the avatar accepting the teleportation invitation,” and “the automated avatar [is used] to demonstrate

at least one possible solution for [a] problem [at a support location service in the virtual universe] wherein the automated avatar demonstrates the at least one solution using a graphic virtual rendering of the product and a graphic virtual rendering of the solution in the virtual universe.”

Thus, taken as a whole, claim 1 is focused on an avatars-centric mechanism by which a possible solution to a problem at a support location service in a virtual universe can be demonstrated. It is not directed simply to customer service scheme within a virtual universe *per se*. As a whole, claim 1 is directed to an avatars-centric mechanism for “demonstrat[ing] [] at least one solution [to a problem at a support location service in a virtual universe] using a graphic virtual rendering of the product and a graphic virtual rendering of the solution *in the virtual universe*” (claim 1).

Further, “[t]he ‘abstract idea’ step of the inquiry calls upon us to look at the ‘focus of the claimed advance over the prior art’ to determine if the claim’s ‘character as a whole’ is directed to excluded subject matter.” *Affinity Labs*, 838 F.3d at 1257 (quoting *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016); *see also Enfish*, 822 F.3d at 1335, quoted in *Apple, Inc. v. Ameranth, Inc.*, 842 F.3d 1229, 1241 (Fed. Cir. 2016).

According to the Specification,

[t]he present invention is directed to virtual universe customer support. More specifically, the present invention provides a methodology for obtaining customer support for “real-world” products via a virtual universe to provide efficient customer support, and to assist in problem identification and resolution. The virtual universe assists consumers by proposing and rendering solutions to common problems based on information provided by the consumer. Additionally, the

present invention allows support specialists to interact with customers and to show the customer how to resolve a support issue.

Para. 5. The virtual customer support to which the invention is directed is described in Fig. 1.

The Specification describes a technique for providing virtual customer support as depicted in Fig. 1. It involves determining a location within the virtual universe where a product support center is available. Para. 19.

“Once the product 12 and associated land location 16 of the product support center 18 are determined, an invitation to teleport the avatar 20 to that land location 16 can be presented to the customer 10.” Para. 24. Then the customer identifies a problem related to the product in order to receive assistance from the product support center. Para. 27. Assistance is provided via an automated avatar. “To assist a customer 10 with the most common problems, the product support center 18 can provide an automated avatar 44 which is configured to walk the customer 10 through one or more possible solutions Specific parts of the product 12 can be highlighted, as necessary, on the virtual rendering 46 of the product 12.” Para. 29.

In light of what the Specification describes, the advance over the prior art by the claimed invention is in employing an avatars-centric mechanism for providing an avatars-centric mechanism for providing customer service in a virtual environment. This is the heart of the invention.

Given the focus of the claims as a whole is an avatars-centric mechanism for “demonstrat[ing] [] at least one solution [to a problem at a support location service in a virtual universe] using a graphic virtual rendering of the product and a graphic virtual rendering of the solution in the

virtual universe” (claim 1) and, in light of the Specification, the heart of the invention is in employing an avatars-centric mechanism for providing an avatars-centric mechanism for providing customer service in a virtual environment, the claims are reasonably characterized as being “directed to” an avatars-centric mechanism for graphically demonstrating a solution to a problem at a support location service in a virtual universe. “[P]roviding customer support in a virtual universe” is not what the claims are reasonably characterized as being “directed to.” It is too broad a characterization. Nor is the difference between such a broad characterization and what the claims are reasonably characterized as being directed to a matter of the degree of abstraction to which the characterization is described. The former reflects a view of the claims as covering customer service, a fundamental business practice, and suggests the claims are describing a customer service scheme that one might encounter in the real world but presented in a virtual environment. The latter focusses, more accurately, on the avatars-centric mechanism defined by the claims.

For the foregoing reasons, the Examiner’s determination under *Alice* step one is not sustainable. Consequently, we do not reach the merits of Examiner’s determination under *Alice* step two.

DECISION

The decision of the Examiner to reject claims 1, 2, 4, 7–12, 14, 17–21, and 23 is reversed.

REVERSED