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Table with 5 columns: APPLICATION NO., FILING DATE, FIRST NAMED INVENTOR, ATTORNEY DOCKET NO., CONFIRMATION NO. Includes details for application 14/147,399, inventor Janusz Jeremiasz Filipiak, and examiner Dyer, Andrew R.

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JANUSZ JEREMIASZ FILIPIAK

Appeal 2018-007890
Application 14/147,399
Technology Center 2100

Before JOSEPH L. DIXON, MAHSHID D. SAADAT, and
KEVIN F. TURNER, *Administrative Patent Judges*.

SAADAT, *Administrative Patent Judge*.

DECISION ON APPEAL

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from the Examiner's decision to reject claims 1, 3, 4, 7, 10, and 20, which are all the claims pending in this application.² We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

¹ We use the word "Appellant" to refer to "applicant" as defined in 37 C.F.R. § 1.42(a) (2017). Appellant identifies the real party in interest as SoInteractive, SA. Appeal Br. 2.

² Claims 2, 5, 6, 8, 9, and 11–19 have been canceled.

STATEMENT OF THE CASE

Introduction

Appellant's disclosure is directed to "a method of creating awards profiles for website visitors" wherein "[t]he awards issued to website visitors in the form of awards profiles are typically badges earned when the website visitors perform or participate in various incentive-programs offered by the websites" "[to] encourage specific actions or behavior by a target audience" in the form of "benefits, such as discounts, vouchers, etc." *See Spec.* ¶¶ 1–3.

Claim 1 is illustrative of the invention and reads as follows:

1. A method of creating an awards profile comprising:

creating an empty image having a fixed two dimensional space;

executing logical encodings, each of the logical encodings having a predefined set of conditions for changing a logical encoding state from an off state to an on state, wherein the predefined set of conditions are assessed in reference to a received user action;

allocating coordinates corresponding to each of the logical encodings to locations within the fixed two dimensional space;

executing graphical encodings that each provide a visual identifier of the predefined set of conditions of the on state of an associated one of the logical encodings; and

overlaying the graphical encodings onto the fixed two dimensional space at the coordinates corresponding to the associated logical encodings.

The Examiner's Rejections

Claims 1, 10, and 20 stand rejected under 35 U.S.C. § 102(a)(1) as being anticipated by Boswell (US 2012/0172131 A1; pub. July 5, 2012).
Final Act. 3–10.

Claims 3, 4, and 7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Boswell and Hirst (*More Olympics Medal Table Visualisations* (<http://blog.ouseful.info/2008/08/24/more-olympics-medal-tablevisualisations/>), Aug. 24, 2008). Final Act. 10–19.

ANALYSIS

In rejecting claim 1, the Examiner finds paragraphs 28 and 39 of Boswell disclose the recited method steps. Final Act. 3–4. Appellant contends the cited portions of Boswell do not expressly or inherently teach the recited features of claim 1. Appeal Br. 14–19. In the Answer, the Examiner further cites other portions of Boswell as disclosing the claim limitations and characterizes Appellant’s argument as “conclusory” and states “Appellant has provided no evidence that the cited portions of Boswell do not disclose the argued claim language and has not provided any logical rationale explaining why Boswell does not disclose the claimed limitation.” Ans. 3–5. The Examiner specifically refers to Figure 20G as disclosing the claimed “empty” spaces, how the computer system is encoded, and predefined conditions for earning a medal is displayed. Ans. 7.

Appellant contends the Examiner’s newly cited teachings in Boswell also fail to anticipate the subject matter of claim 1, particularly the limitation related to the logical encoding, allocating coordinates, and executing/overlaying graphical encodings, as follows:

The Appellant respectfully submits that the empty image, logical encodings, and graphical encodings are separate and distinct claim elements that are separately created or executed as set forth in Appellant’s independent claim 1. The mere disclosure of the medals in Boswell clearly does not teach all of the “empty image having a fixed two dimensional space,”

“logical encodings,” and “graphical encodings that each provide a visual identifier” limitations of Appellant’s independent claim 1 as alleged by the Examiner’s Answer.

Reply Br. 8.

However, as explained above, the logical encodings and graphical encodings are separate and distinct claim elements that are separately executed as set forth in Appellant’s independent claim 1. The mere disclosure of selectively displaying medals in Boswell clearly does not teach both the “executing logical encodings” and “executing graphical encodings that each provide a visual identifier” steps of Appellant’s independent claim 1 as alleged by the Examiner’s Answer.

Reply Br. 13.

Indeed, a coordinate system is not necessary to position medals on a page as taught by Boswell. Moreover, even if coordinates were used, which is not expressly or inherently described by Boswell, there is no disclosure in Boswell that the coordinates allocated within a fixed two dimensional space correspond to the logical encodings, as opposed to the separate and distinct graphical encodings that are overlaid onto the fixed two dimensional space at the coordinates corresponding to the associated logical encodings. The Appellant respectfully submits that coordinates of an item overlaid on an image is different than coordinates associated with logical encodings that are separate and distinct from graphical encodings that are separately executed and overlaid on the fixed two dimensional space as claimed.

Reply Br. 14.

We agree with Appellant that the Examiner’s stated position and the cited portions of Boswell do not clearly identify the specific claim limitations pointed out by Appellant. In fact, rejections based on section 102 must rest on a factual basis wherein the “burden of proof [is placed] on the Patent Office which requires it to produce the factual basis for its rejection

of an application under sections 102 and 103.” *In re Piasecki*, 745 F.2d 1468, 1471–72 (Fed. Cir. 1984) (citing *In re Warner*, 379 F.2d 1011, 1016 (CCPA 1967)). The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. *See In re Warner*, 379 F.2d at 1017.

Here, the Examiner has not produced a factual basis supported by the prior art teachings and by identifying the exact disclosure of Boswell that meet the claimed features, nor has addressed all the limitations argued by Appellant to be missing in the reference. As such, we find the Examiner erred in rejecting independent claim 1, as well as claims 10 and 20 which recite similar limitation discussed above.

Conclusion

For the above reasons, because we are persuaded of Examiner error in rejecting claims 1, 10, and 20, we do not sustain their rejection under 35 U.S.C. § 102(a)(1) as being anticipated by Boswell. We also do not sustain the 35 U.S.C. § 103(a) rejection of claims 3, 4, and 7 as being unpatentable over Boswell and Hirst because the Examiner has not identified any teachings in Hirst to cure the above-identified deficiency of Boswell.

DECISION SUMMARY

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1, 10, 20	102	Boswell		1, 10, 20
3, 4, 7	103	Boswell, Hirst		3, 4, 7
Overall Outcome				1, 3, 4, 7, 10, 20

REVERSED