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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte EVAN ACOSTA, EDWARD DRAKE, and MARK ARANA

Appeal 2019-001693
Application 13/911,067¹
Technology Center 3600

Before HUNG H. BUI, JEREMY J. CURCURI, and
JOHN F. HORVATH, *Administrative Patent Judges*.

BUI, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant seeks our review under 35 U.S.C. § 134(a) from the Examiner's Final Rejection of claims 12, 13, 17, and 20–23, which are all the claims pending in the application. Claims 1–11, 14–16, and 18–19 have been cancelled. Claims 24–35 have been withdrawn from consideration. App. Br. 9 (Claims App.). We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.²

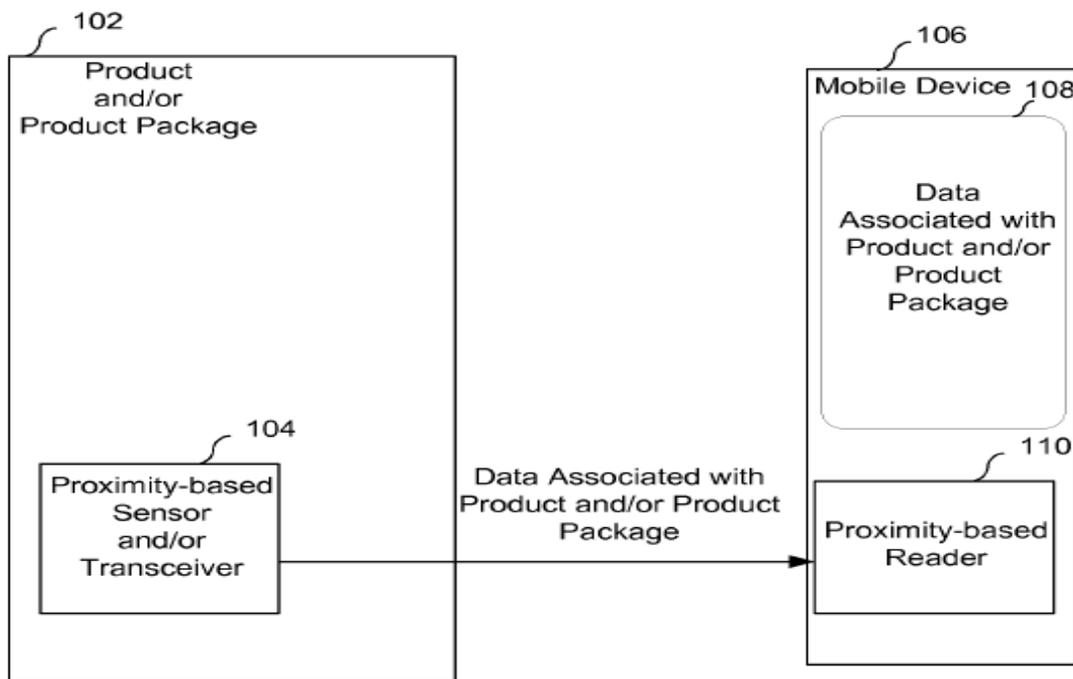
¹ We use the word “Appellant” to refer to “applicant(s)” as defined in 37 C.F.R. § 1.42. The real party in interest is Disney Enterprises, Inc. App. Br. 2.

² Our Decision refers to Appellant's Appeal Brief (“App. Br.”) filed April 29, 2018; Reply Brief (“Reply Br.”) filed December 20, 2018; Examiner's Answer (“Ans.”) mailed November 29, 2018; Final Office Action (“Final Act.”) mailed October 31, 2017; and original Specification (“Spec.”) filed June 5, 2013.

STATEMENT OF THE CASE

Appellant's Invention

Appellant's invention relates to “a proximity-based device within a product and/or a product package [that] sends [media] data associated with the product and/or the product package to a mobile device [as shown in Figure 1] when the mobile device is within a proximity to the proximity-based device.” Spec. ¶¶ 7, 20–21; Abstract. Figure 1 is reproduced below:



Appellant's Figure 1 shows interaction between mobile device 106 and proximity-based transmitter 104 within product package 102, when mobile device 106 is within the proximity of product package 109.

According to Appellant, “the product may be a media product, e.g., a Blu-ray disk, DVD, video game, or the like.” Spec. ¶ 20.

The media [data] provided to the user [at the mobile device] may include information about the contents of the package or the product, e.g., a menu of the discs inside the package, a list of items inside the package, previews, bonus games, quantity of

discs, promotions, coupons, special offers, a video (such as a video involving an action figure and/or a movie), music (such as music corresponding to an action figure and/or a movie), an offer to purchase a digital copy of a movie (such as with a movie character corresponding to an action figure), additional information, or the like.

Spec. ¶ 21. The proximity-based device may be a “proximity-based sensor and/or transceiver [], e.g., RFID chip, RFID tag, Near Field Communication (“NFC”) chip, NFC tag, Bluetooth, or the like.” Spec. ¶ 21. In another aspect of Appellant’s invention, the content provided to the mobile device can be used to display “a virtual magazine of the contents of the media product,” where “the user may swipe through all the data in a digital magazine format.” Spec. ¶ 28.

Representative Claim

Claims 12 and 23 are independent. Representative claim 12 is reproduced below:

12. A method comprising:

[1] receiving, at a proximity-based receiver within a mobile device, a virtual magazine of items associated with an object stored within a product package, from a proximity-based transmitter within the product package, based upon the proximity-based receiver being within a proximity to the proximity-based transmitter;

[2] displaying the virtual magazine at the mobile device to provide a user with an immersive experience based on the virtual magazine prior to purchasing the object;

[3] receiving a plurality of user inputs corresponding to a plurality of swipes; and

[4] changing the display of the virtual magazine based on the plurality of swipes to render different pages of the virtual magazine on the mobile device.

App. Br. 10–11 (Claims App.) (bracketing added).

Evidence Considered

Name	Reference	Date
Arponen et al. “Arponen”	US 2012/0218084 A1	Aug. 30, 2012
Pereymer	US 2014/0040070 A1	Feb. 6, 2014
Bradley et al. “Bradley”	US 2013/0290106 A1	Oct. 31, 2013
Zilliacus et al. “Zilliacus”	US 8,010,621 B2	Aug. 30, 2011
Robson et al. “Robson”	US 2006/0113371 A1	June 1, 2006

EXAMINER’S REJECTIONS³

(1) Claims 12, 17, and 20–22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Arponen and Pereymer. Final Act. 8–11.

(2) Claim 13 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Arponen, Pereymer, and Robson. Final Act. 11.

(3) Claim 23 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Arponen, Pereymer, and Zilliacus. Final Act. 16–19.

³ Claims 1 and 5–11 were rejected under 35 U.S.C. § 112(a) as failing to comply with the written description requirement. Final Act. 2–3. Similarly, claims 1 and 5–10 were rejected under 35 U.S.C. § 103(a) as being obvious over Robson and Bradley. Final Act. 4–7. However, the Examiner has withdrawn these rejections (App. Br. 2). As such, these rejections of claims 1 and 5–11 are no longer on appeal.

Issue on Appeal

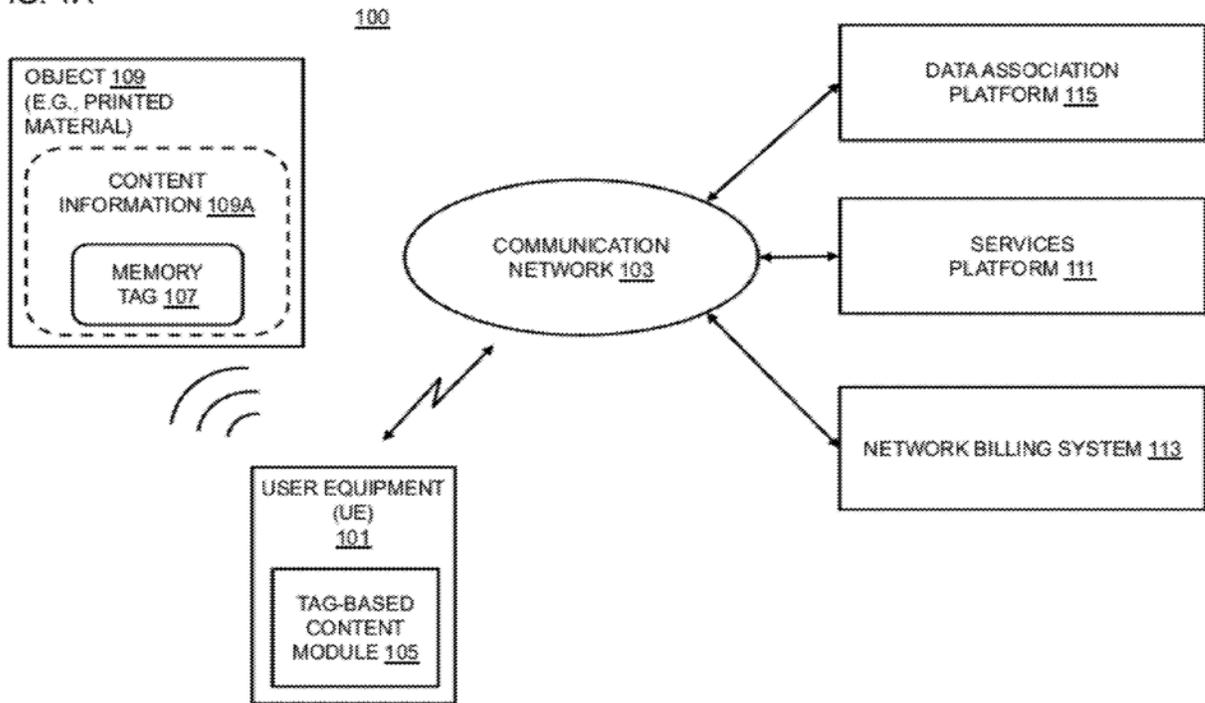
Based on Appellant's arguments, the dispositive issue on appeal is whether the cited prior art (Arponen and Pereymer) teaches or suggests "receiving, at a proximity-based receiver within a mobile device, a virtual magazine of items associated with an object stored within a product package, from a proximity-based transmitter within the product package, based upon the proximity-based receiver being within a proximity to the proximity-based transmitter," as recited in Appellant's claim 12. App. Br. 3-4; Reply Br. 2-4 (emphasis added).

ANALYSIS

With respect to independent claim 12, the Examiner finds Arponen teaches all aspects of Appellant's claimed "method," including the disputed limitation: "receiving, at a proximity-based receiver within a mobile device, virtual advertisement contents associated with an object stored within a product package, from a proximity-based transmitter within the product package, based upon the proximity-based receiver being within a proximity to the proximity-based transmitter." Final Act. 8 (citing Arponen ¶¶ 23, 25, 27, 28, 32-37, 57-60, 76-79, 97, Figs. 1, 2A, 4B, 4C).

Arponen's Figure 1A is reproduced below:

FIG. 1A



Arponen's Figure 1 shows interaction between mobile device 101 and proximity-based transmitter (memory tag) 107 within product package (object) 109, including receiving "virtual advertisement contents" from product package (object) 109, when mobile device 101 is within the proximity of product package (object) 109.

The Examiner does not find that Arponen teaches, and therefore relies on Pereymer for expressly teaching that Arponen's "advertisement contents" can include Appellant's claimed "virtual magazine of items associated with an object stored within a product package," so that the "virtual magazine" can be received and displayed by the mobile device, and different pages of the "virtual magazine" can be swiped or scrolled, via user interactions. Final Act 9-19 (citing Pereymer ¶¶ 63, 76-91, 110, 114, 121). Based on these teachings, the Examiner concludes it would have been obvious to modify Arponen to transmit, receive, and display "advertisement contents" in

Pereymeyer’s “virtual magazine” in order to “provide the user with additional details associated with the products/product packages” and to “increase user experience and satisfaction.” *Id.* at 10

Appellant argues (1) the combination of Arponen and Pereymer does not teach or suggest a “virtual magazine of items associated with an object stored within a product package,” as recited in claim 12; and (2) “one of ordinary skill in the art would know to only perform a partial replacement of the advertisement in Arponen with only the formatting of the electronic magazine of Pereymer” and “[s]uch a result could only be reasonably deduced by one of ordinary skill in the art after varying ‘all parameters’ or trying ‘each of numerous possible choices until one possibly arrived at a successful result,’ which is not permissible.” App. Br. 4–5 (citing *In re Stepan Company*, 2016-1811, 8 (Fed Cir. 2017)). According to Appellant, the Examiner has not demonstrated “why one of ordinary skill in the art, based on *In re Stepan*, would be motivated to replace an advertisement of links to local dry cleaners with a virtual magazine of local dry cleaners.” Appellant also argues that, “[w]ithout the benefit of hindsight and varying all parameters, one of ordinary skill in the art would not have had a reasonable expectation of success in modifying Arponen to have a virtual magazine based on the contents of a product package.” Reply Br. 2–3.

We do not find Appellant’s arguments persuasive. Rather, we find the Examiner has provided a comprehensive response to Appellant’s arguments supported by a preponderance of evidence. Ans. 5–6. Therefore, we adopt the Examiner’s findings and explanations provided therein. *Id.* At the outset, we note both Arponen and Pereymer teach Appellant’s claimed “virtual magazine of items associated with an object stored within a product

package,” as recited in claim 12. Ans. 5–6 (citing Arponen ¶ 35; Pereymer ¶¶ 63, 76–91, 110, 114, 121).

For example, paragraph 35 of Arponen describes that content associated with low-cost radio frequency (RF) memory tag 107 (e.g., NFC tag, RFID tag, or Blu-tooth device (*see* Arponen ¶¶ 36, 39)) of a package (object) 109, as shown in Figure 1A, includes “a magazine, a newspaper, products.” Paragraph 59 of Arponen further clarifies the:

“additional information” from the RF memory tag 107 may also include an electronic representation of the object 109 (e.g., an electronic version of a hardcopy magazine or catalog), one or more media files, one or more documents, one or more links to content, purchasing information, advertising information, an electronic catalog, or a combination thereof.”

Arponen ¶ 59 (emphasis added). Paragraphs 79–80, and 83 of Arponen further describe (1) “interactive content—i.e., buttons, links, actionable content—for allowing the user to execute various actions” and (2) the print media representation of the information stored in RF memory tag 107, such as the virtual magazine of items as recited in Appellant’s claim 12, “may be scrolled [or swiped] through by the user (e.g., via scroll selectors **469** [shown in Figure 4C, or scroll bar 475, shown in Figure 4D].”

Because Arponen teaches all aspects of Appellant’s claim 12, including the disputed limitation: “receiving, at a proximity-based receiver within a mobile device, a virtual magazine of items associated with an object stored within a product package, from a proximity-based transmitter within the product package, based upon the proximity-based receiver being within a proximity to the proximity-based transmitter,” Pereymer is not needed to support the Examiner’s obviousness rejection. A disclosure such as

Arponen that anticipates under 35 U.S.C. § 102 typically renders the claim unpatentable under 35 U.S.C. § 103 in all but rare cases. *See In re Pearson*, 494 F.2d 1399, 1402 (CCPA 1974); *cf. Cohesive Tech v. Water Corp.*, 543 F.3d 1351, 1363 (Fed. Cir. 2008) (“novelty under 35 U.S.C. § 102 and nonobviousness under 35 U.S.C. § 103 are separate conditions of patentability”).

To the extent that Pereymer is required and/or relied upon, Pereymer also teaches that (1) advertisement content can be presented in “a magazine [of items] which has interactive features such as web links, videos, and photos” and (2) a page index view of the magazine can be used to allow the user to execute “various types of finger swiping or tapping gestures to initiate a desired action,” which support the Examiner’s conclusion of obviousness. Pereymer ¶¶ 63, 76–91.

Because both Arponen and Pereymer teach Appellant’s claimed “virtual magazine of items associated with an object stored within a product package,” as recited in claim 12, we are not persuaded by Appellant’s arguments that (1) *In re Stepan Co.*, No. 2016-1811 (Fed. Cir. Aug. 25, 2017) is applicable, and (2) in the absence of hindsight, “one of ordinary skill in the art would not have had a reasonable expectation of success. *See In re Cree*, 818 F.3d 694, 702, n.3 (Fed. Cir. 2016) (Appellant’s hindsight argument is of no moment where the Examiner provides a sufficient, non-hindsight reason to combine the references).

For the reasons set forth above, Appellant has not persuaded us of Examiner error. Accordingly, we sustain the Examiner’s obviousness rejection of independent claim 12, and dependent claims 17 and 20–12, which Appellant does not argue separately. App. Br. 5.

With respect to independent claim 23, Appellant argues patentability “for similar reasons as independent claim 12.” App. Br. 5. Accordingly, we also sustain the Examiner’s obviousness rejection of independent claim 23 for the same reasons discussed above relative to claim 12.

CONCLUSION

On the record before us, we conclude Appellant has not demonstrated the Examiner erred in rejecting claims 12, 13, 17, and 20–23 under 35 U.S.C. § 103(a). As such, we **AFFIRM** the Examiner’s Final Rejection of claims 12, 13, 17, and 20–23.

DECISION SUMMARY

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
12, 17, 20–22	103	Arponen, Pereymer	12, 17, 20–22	
13	103	Arponen, Pereymer, Robson	13	
23	103	Arponen, Pereymer, Zilliacus	23	
Overall Outcome			12, 13, 17, 20–23	

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