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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte BRIAN DOUGLAS BUHR

Appeal 2019-002095
Application 12/634,653
Technology Center 3700

Before STEFAN STAICOVICI, WILLIAM A. CAPP, and
LISA M. GUIJT, *Administrative Patent Judges*.

STAICOVICI, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant¹ appeals under 35 U.S.C. § 134(a) from the Examiner's decision in the Final Office Action (dated May 14, 2018) rejecting claims 9, 10, 61, 67, 68, 73, 75, 76, 80, 82, and 84–89. We have jurisdiction over this appeal under 35 U.S.C. § 6(b).

SUMMARY OF DECISION

We AFFIRM.

¹ We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. Sony Interactive Entertainment America LLC is identified as the real party in interest in Appellant's Appeal Brief (filed Oct. 12, 2018). Appeal Br. 3.

INVENTION

Appellant's invention relates to "game controllers having customizable settings." Spec., para. 2. Claims 84 and 85 are independent. Claim 84 is illustrative of the claimed invention and reads as follows:

84. A gaming system comprising:

a first game controller, wherein the first game controller has a plurality of buttons that are assigned a default set of game controller commands;

a first game console coupled to the first game controller;

a server coupled to the first game controller via the first game console over a computer network,

wherein the server includes a controller settings store, wherein the controller settings store is configured to store game controller mapping information corresponding to a user account, wherein the game controller mapping information maps the default set of game controller commands assigned to the plurality of buttons of the first game controller to a modified set of game controller commands;

a second game controller, wherein the second game controller has a plurality of buttons that are assigned the default set of game controller commands; and

a second game console coupled to the second game controller, wherein the server is coupled to the second game controller via the second game console over the computer network, wherein the second game console is configured to obtain the game controller mapping information for the user account via the computer network from the server for use of the game controller mapping information by the second game controller, wherein the game controller mapping information is used to modify the default set of game controller commands assigned to the plurality of buttons of the second game controller to the modified set of game controller commands.

REJECTIONS

- I. The Examiner rejects claims 9, 10, 67, 68, 73, 75, 76, 80, 82, 84, 85, 87, and 89 under 35 U.S.C. § 103(a) as being unpatentable over Feldman² and Shi.³
- II. The Examiner rejects claim 61 under 35 U.S.C. § 103(a) as being unpatentable over Feldman, Shi, and Horvitz.⁴
- III. The Examiner rejects claims 86 and 88 under 35 U.S.C. § 103(a) as being unpatentable over Feldman, Shi, and Ogata.⁵

ANALYSIS

Rejection I

Claims 9, 80, 84, and 87

Appellant does not present arguments for the patentability of claims 9, 80, and 87 apart from independent claim 84. *See* Appeal Br. 23. Therefore, in accordance with 37 C.F.R. § 41.37(c)(1)(iv), we select claim 84 as the representative claim to decide the appeal of the rejection of these claims, with claims 9, 80, and 87 standing or falling with claim 84.

The Examiner finds Feldman discloses most of the limitations of independent claim 84, but “does not appear to explicitly disclose a server that distributes game controller commands from one game controller to another.” Final Act. 2–3 (citing Feldman, paras. 19, 21, 32, 37, 38, 42, 43, Figs. 1, 2). Nonetheless, the Examiner finds that “Shi teaches that users can

² Feldman et al., US 2006/0097453 A1, published May 11, 2006.

³ Shi et al., US 2009/0163175 A1, published June 25, 2009.

⁴ Horvitz et al., US 2005/0132014 A1, published June 16, 2005.

⁵ Ogata, US 6,710,766 B1, issued Mar. 23, 2004.

access a VSIM server where they can store their personalized settings for a device,” such as a phone, and, when traveling, can download such settings to a new device, such as a rental phone. Ans. 5 (emphasis omitted);⁶ Final Act. 8 (“[T]he teachings of Shi . . . [show] how a user using one device can upload their personal settings to a server to then be downloaded to a new device ([0053]).”). Thus, according to the Examiner, the combined teachings of Feldman and Shi disclose a server coupled to first and second game controllers via first and second game consoles, respectively, that allows a user to employ the settings from the first game controller and console as settings for the second game controller and console. Final Act. 3 (citing Feldman, para. 49; Shi, para. 53).

Citing to paragraphs 32, 37, and 42 of Feldman and paragraph 53 of Shi, Appellant argues that neither Feldman nor Shi discloses a “second game console” that “is configured to obtain the game controller mapping information for the user account via the computer network from the server for use of the game controller mapping information by the second game controller.” Appeal Br. 8–14. According to Appellant, Feldman’s paragraph 32 describes a controller with inputs, such as, joysticks and buttons, for playing a game; paragraph 37 describes a switching device for entering information to configure the controller; paragraph 42 describes a switching matrix for mapping the controller inputs to any suitable game function; and Shi’s paragraph 53 describes customizing a rented mobile handset with personal data and settings by storing onto and downloading from a server the personal data and settings. *Id.*

⁶ Examiner’s Answer, dated Nov. 21, 2018.

We are not persuaded by Appellant’s arguments because “[n]onobviousness cannot be established by attacking references individually where the rejection is based upon the teachings of a combination of references. [Each reference] must be read, not in isolation, but for what it fairly teaches in combination with the prior art as a whole.” *See In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). Here, we appreciate that Feldman does not disclose a “second game console,” as called for by claim 84. However, as correctly noted by the Examiner, “in the combination of Feldman and Shi there . . . [are] two gaming consoles.” Ans. 6 (emphasis omitted). In particular, Feldman discloses a first game controller 12 and processor 14 (game console) including, *inter alia*, switching device 24, 26 for configuring controller 12 by assigning game functions (game controller commands) to various controller input joysticks and buttons that are different from the choices made by the game designer (default set of game controller commands). Feldman, paras. 32–34. Shi discloses a cellular network to upload personalized settings from a first mobile phone to a server, and, upon accessing a user account, to download the personalized settings to a second mobile phone, when the user is traveling. Shi, Abstract, para. 53.

Hence, Feldman discloses a first game controller and a first game console⁷ and selectively configuring the first the game controller with

⁷ We note the Examiner’s shorthand writing to describe a device including a game controller and a game console as “controller/console.” *See, e.g.*, Ans. 5; Reply Brief 2 (filed Jan. 16, 2019, hereinafter “Reply Br.”). We do not agree with Appellant’s position that the Examiner considers a “controller” to be the same or similar as a “console” as these terms are not used by the

personalized game mapping information. Shi discloses a network (cellular) to upload data, i.e., personalized settings, from a *first* device (first mobile handset) to a server, and, upon accessing a user account, to download the stored data to a *second* device (second mobile handset). Thus, in the gaming system of Feldman, as modified by Shi, a user configures a first game controller with personalized game settings, as per Feldman, and then, according to Shi, uploads the settings via a network from the first game controller to a server, and upon accessing a user account, downloads the stored settings to a second game controller. As such, we agree with the Examiner that the combined teachings of Feldman and Shi disclose a second game controller and a second game console, “wherein the second gaming console is . . . configured in a similar manner with the user’s personalized settings just like the first gaming console.” Ans. 6.

Appellant further argues that “[n]o prima facie case of obviousness of claim 84 is made because no articulated reasoning as to why it would have been obvious to combine Feldman with Shi is provided.” Appeal Br. 15. According to Appellant, the Examiner’s reasoning “is merely conclusory.” *Id.*

We are not persuaded by Appellant’s argument because the Examiner’s reasoning to combine the teachings of Feldman and Shi to allow a user to “have access to his personal settings of a gaming controller when he is on a device that is new or temporary to the user” has rational underpinnings. *See* Final Act. 6. The Examiner explains, and we agree, that:

Examiner interchangeably. *See id.* at 2–5; *see also* Final Act. 2 (describing Feldman’s controller 12 and console 14 as different elements).

[A] user in Feldman would be able to have his/her controller settings (Feldman [0032]) which they really like, but now they are visiting a friend, or using a temporary system (Shi [0053]) and they want to use their really cool controller settings (Feldman [0032]) which luckily using the method of Shi they are able to upload their awesome controller settings to a server and then are able to download them to the new temporary device (Shi [0053]).

Final Act. 8 (emphasis omitted). Appellant does not persuasively explain why the Examiner's findings and reasoning are in error.

Citing to paragraph 49 of Feldman and paragraph 53 of Shi, Appellant argues that Feldman does not disclose a server and Shi does not disclose storing "game controller mapping information" on a server. *See* Appeal Br. 16–22. According to Appellant, although Feldman discloses that various processor functions are distributed among remotely located processors, "none of the processors . . . in Feldman is a server or a part of a server." *Id.* at 18. More specifically, Appellant asserts that the processors disclosed in Feldman's paragraph 49 are located either within controller 12 or game processor 14. *Id.* at 20. Appellant further contends that in contrast to "a server [which] is defined as 'a computer in a network that is used to provide services (such as access to files or shared peripherals or the routing of e-mail) to other computers in the network'," none of the processors of Feldman provides such a service to another processor. Reply Br. 15 (citing online Merriam-Webster dictionary). Appellant further asserts that the "personal settings" of Shi are not "game functions" that can be assigned "to controller input devices of a controller" of Feldman, but rather, constitute "personal data," such as, ring tones, videos, mp3 music files, photos, wall paper, and text files. *Id.* at 17.

We are not persuaded by Appellant's arguments that Feldman fails to disclose a server. In particular, paragraph 49 of Feldman discloses that the various functions of the control, sensor, signal, game, and switching device processors may be distributed among various computer systems that are disposed remotely of each other and communicate via a network (LAN, WAN, Internet, Intranet, wireless (cellular), hardwire, modem connection). We further agree with the Examiner's finding that Feldman's paragraph 42 further describes the switching device as "external of the controller." *See* Ans. 4. Thus, a skilled artisan would readily understand from Feldman's paragraphs 42 and 49 that Feldman discloses a switching device as a remotely located computer system, i.e., processor, which via a network, provides a service, i.e., mapping information, to another computer system, i.e., controller input devices. *See In re Jacoby*, 309 F.2d 513, 516 (CCPA 1962) ("An artisan must be presumed to know something about the art apart from what the references disclose.").

Stated differently, similar to Appellant's definition of a "server," Feldman discloses the control, sensor, signal, game, and switching device processors as parts of a computer network where the switching device constitutes a computer system on the network and provides a service, i.e., game controller mapping information, to another computer system, i.e., game controller, on the same network. We, thus, agree with the Examiner that "even though Feldman does not use the explicit word of 'server[,] the components of a server and what a server is . . . [as] described in [0049]." Ans. 7.

Furthermore, the Examiner is correct that in contrast to Feldman, Shi *explicitly* discloses using a server for uploading and downloading

personalized settings (*see id.* at 7–8) and, thus, the combined teachings of Feldman and Shi disclose a server. Although we appreciate that Shi’s server does not upload and download game controller mapping information, we note that the content of the information (i.e., Shi’s personalized settings or Feldman’s game controller mapping information) does not change the structure of the gaming system recited in claim 84. Apart from the content of the information, Appellant does not persuasively show any structural difference between a server configured to store game controller mapping information, as called for by claim 84, and the server of Shi that uploads and downloads personalized settings. Moreover, as the Examiner’s rejection is based on a combination of Feldman and Shi, the server of Feldman, as modified by Shi, uploads and downloads game controller mapping information.

In conclusion, for the foregoing reasons, we sustain the rejection under 35 U.S.C. § 103(a) of independent claim 84 as unpatentable over Feldman and Shi. Claims 9, 80, and 87 fall with claim 84.

Claim 10

Appellant argues that the combined teachings of Feldman and Shi do not disclose that “the game controller mapping information is provided to the server by way of a computer readable” because (1) Feldman does not disclose a server and (2) Shi’s “personal data” does not constitute “game controller mapping information.” *See* Appeal Br. 40–45 (citing Feldman, para. 49; Shi, para. 53).

As we are not persuaded by such arguments for the reasons set forth *supra*, we likewise, sustain the rejection of claim 10 over the combined teachings of Feldman and Shi.

Claims 67, 68, 73, 75, 76, 82, 85, and 89

Appellant relies on the same arguments discussed *supra*. See Appeal Br. 23–39. Therefore, for the same reasons discussed above, we also sustain the rejection under 35 U.S.C. § 103(a) of claims 67, 68, 73, 75, 76, 82, 85, and 89 as unpatentable over Feldman and Shi.

Claims 87 and 89

Each of dependent claims 87 and 89 requires, *inter alia*, that “the second game console has a biometric sensor.” See Appeal Br. 63 (Claims App.).

The Examiner finds that because Shi discloses a “biometric sensor . . . configured to sense biometric information of a user to allow access to the user account,” “the combination of Feldman and Shi teaches that the second game console has a biometric sensor,” as called for by claims 87 and 89. Final Act. 4, 6 (citing Shi, para. 37) (emphasis omitted).

Appellant argues that Shi’s paragraph 37 does not disclose that “the second game console has a biometric sensor,” as called for by claims 87 and 89. Appeal Br. 45. According to Appellant, “[t]here is no disclosure or suggestion in Shi of the ‘game console,’ as is recited in claims 87 and 89.” *Id.* at 47.

Appellant's argument once more is attacking the disclosures of Feldman and Shi individually, whereas the Examiner's rejection is based on a combination of Feldman and Shi. Although we appreciate that Shi does not disclose a gaming console, but rather a mobile handset having a biometric sensor, we note that the Examiner employs Feldman for teaching a gaming console and Shi for disclosing a biometric sensor. *See* Final Act. 2, 4, 6. We agree with the Examiner that "adding . . . [Shi's] biometric sensor to the gaming console of Feldman would have been obvious [to a skilled artisan] such that only particular users may gain access to a personalized setting store." Ans. 9 (citing Feldman, para. 49; Shi, paras. 37, 53). Thus, the Examiner is correct that the combination of Feldman and Shi discloses a second gaming console with a biometric sensor, as called for by claims 87 and 89. *Id.*

Accordingly, for the foregoing reasons, we also sustain the rejection of claims 87 and 89 over the combined teachings of Feldman and Shi.

Rejection II

As Appellant does not argue the rejection under 35 U.S.C. § 103(a) of claim 61 as unpatentable over Feldman, Shi, and Horvitz, we summarily sustain the rejection of this claim. *See* Appeal Br. 6.

Rejection III

Each of independent claims 86 and 88 requires, *inter alia*, that "the first game console includes a slot for receiving a computer-readable medium." *See* Appeal Br. 62–63 (Claims App.).

The Examiner finds that because Ogata discloses a game console having a slot for receiving a computer readable medium holding game controller mapping information, in the combination of Feldman, Shi, and Ogata “the first game console is configured to send the game controller mapping information to the server via the computer network.” Final Act. 7 (citing Feldman, para. 49; Shi, para. 53; Ogata, col. 14, ll. 14–25, Fig. 1). According to the Examiner, “[i]t would have been obvious to one of ordinary skill in the art at the time of the invention to include [Ogata’s] memory slots in the gaming console [of Feldman, as modified by Shi,] so that personalized computer information could be quickly saved and easily transported.” *Id.* at 8.

Appellant first argues that because (1) Feldman does not disclose a server and (2) Shi’s “personal data” does not constitute “game controller mapping information,” the combination of Feldman and Shi does not disclose “that ‘the first game console is configured to send the game controller mapping information to the server via the computer network’.” Appeal Br. 48–55.

We are not persuaded by Appellant’s argument because Appellant is once more attacking the disclosures of Feldman and Shi individually, whereas the Examiner’s rejection is based on a combination of Feldman and Shi. For the reasons discussed *supra* in Rejection I, in the gaming system of Feldman, as modified by Shi, a user configures a first game controller with personalized game settings, as per Feldman, then, according to Shi, uploads via a network the personalized game settings from the first game controller to a server, and upon accessing a user account, downloads the stored personalized game settings to a second game controller. Moreover,

as noted above in Rejection I, we agree with the Examiner that “even though Feldman does not use the explicit word of ‘server[,] the components of a server and what a server is . . . [as] described in [0049].” Ans. 7 (emphasis omitted).

Appellant further argues that:

No reason is provided as to why it would be obvious to [a skilled artisan to] combine the “game consoles” of Feldman with the “VSIM server” and “personal data and settings” of Shi to arrive at the recitation, in claims 86 and 88, that “the first game console is configured to send the game controller mapping information to the server via the computer network.”

Appeal Br. 56. According to Appellant, “the inclusion of the ‘memory slots in the gaming console so that personalized computer information could be quickly saved and easily transported’ is merely conclusory” and is not a reason to combine Feldman and Shi “to arrive at the recitation . . . that ‘the first game console is configured to send the game controller mapping information to the server via the computer network’.” *Id.* at 56–57.

We are not persuaded by Appellant’s arguments because including memory slots “so that personalized computer information could be quickly saved and easily transported” provides adequate reasoning why a skilled artisan would combine the teachings of Feldman, Shi, and Ogata and *not* Feldman and Shi. The reasoning to modify the gaming system of Feldman, according to Shi, was discussed *supra* in Rejection I, where we agreed with the Examiner that allowing a user to “have access to his personal settings of a gaming controller when he is on a device that is new or temporary to the user” has rational underpinnings. *See* Final Act. 6; Ans. 10.

In conclusion, for the foregoing reasons, we also sustain the rejection under 35 U.S.C. § 103(a) of claims 86 and 88 as unpatentable over Feldman, Shi, and Ogata.

CONCLUSION

Claim(s) Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
9, 10, 67, 68, 73, 75, 76, 80, 82, 84, 85, 87, 89	103(a)	Feldman, Shi	9, 10, 67, 68, 73, 75, 76, 80, 82, 84, 85, 87, 89	
61	103(a)	Feldman, Shi, Horvitz	61	
86, 88	103(a)	Feldman, Shi, Ogata	86, 88	
Overall outcome			9, 10, 61, 67, 68, 73, 75, 76, 80, 82, 84–89	

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