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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte LEO ZUNIGA, JEREMY RUSSO, BRENT GIBSON,
ERIC FEURSTEIN, and ROBERT LEYLAND

Appeal 2019-005134
Application 13/721,710
Technology Center 3700

Before CHARLES N. GREENHUT, JAMES P. CALVE, and
JEREMY M. PLENZLER, *Administrative Patent Judges*.

GREENHUT, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from the Examiner's decision to reject claims 11, 13–17, and 19–26. *See* Non-Final Act. 2–10. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM-IN-PART AND DESIGNATE NEW GROUNDS OF REJECTION.

¹ We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies the real party in interest as appeal is the assignee of this application, Activision Publishing, INC. Appeal Br. 1.

CLAIMED SUBJECT MATTER

The claims are directed to an interactive video game with toys having interchangeable parts. Claim 11, reproduced below, is illustrative of the claimed subject matter:

11. A computer-implemented method for use in providing a video game, comprising:
- receiving information from a plurality of toy parts coupled together to form a toy assembly;
 - determining a configuration of the toy assembly based on the information from the plurality of toy parts;
 - displaying a virtual character corresponding to the toy assembly for use in the video game based on the determined configuration; and
 - conducting video game play using the virtual character; wherein the information includes a unique identification and attribute information for each toy part.

REFERENCES

The prior art relied upon by the Examiner is:

Reference Name	Document ID	Pub. Date
Fabricant	US 4,136,480 A	Jan. 30, 1979
Kawai	US 4,869,701 A	Sept. 26, 1989
Galyean	US 6,290,565 B1	Sept. 18, 2001
Ha	US 2007/0015582 A1	Jan. 18, 2007
Hong	US 2008/0081694 A1	Apr. 3, 2008
Fiegenger	US 2009/0137323 A1	May 28, 2009
Polchin	US 2009/0197658 A1	Aug. 6, 2009

REJECTIONS

Claims 11 and 13–17 are rejected under 35 U.S.C. § 102(b) as being anticipated by Galyean. Non-Final Act. 2–5.

Claim 19 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Galyean and Fiegenger. Non-Final Act. 5–6.

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Claim 20 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Galyean and Hong. Non-Final Act. 6.

Claim 21 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Galyean and Ha. Non-Final Act. 6–7.

Claim 22 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Galyean and Fabricant. Non-Final Act. 7–8.

Claims 23, 25, and 26 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Galyean and Kawai. Non-Final Act. 8–9.

Claim 24 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Galyean, Kawai and Polchin. Non-Final Act. 10.

OPINION

Claims 11, 13–17, and 19–22

Claims 11 and 13–17 are argued as a group. Appeal Br. 4–7. We select claim 11 as representative. 37 C.F.R. § 41.37(c)(1)(iv)(2018).

The Examiner finds that Galyean discloses a computer-implemented method for use in providing a video game having all the limitations of claim 11. Non-Final Act. 2–3. Particularly, the Examiner finds that Galyean discloses “wherein the information includes a unique identification and attribute information for each toy part.” *See* Ans. 11–12; Non-Final Act. 2–3. The Examiner considers the plug portions 500 of accessory parts of Galyean’s toy, which includes a plurality of toroidal rings that can be used to code an identification number, to read on “a unique identification.” Non-Final Act. 3. The Examiner considers passiveness or aggressiveness of the mouth parts and slowness or fastness of fins as “attribute information.” Ans. 12; Non-Final Act. 3.

Appellant argues that “a toy part providing an identification number or code is discussed by Galyean, and it appears that this identification code is used by subroutines 816 to calculate the behavior of a particular character.” Appeal Br. 6. Appellant also argues that “the identification number and code in Galyean cannot be both the ‘a unique identification’ and ‘attribute information of claim 11.’” Appeal Br. 6; Reply Br. 2. In addition, Appellant argues that “[t]here are no corresponding figures or text in Galyean for attribute information stored [on] . . . part of the toy parts.” Reply Br. 2. Appellant also argues that “Galyean simply does not disclose receiving both a unique identification and attribute information from a toy part, and the Examiner’s Answer points to no disclosure in Galyean disclosing receiving attribute information, in addition to a unique identification, from a toy part.” Reply Br. 4.

The Examiner explains that “when an aggressive mouth part 416 is plugged into socket 406, the character might act aggressively, that is attack other characters, approach other characters in a threatening manner, etc., which means that the gaming system will receive the attribute information via the socket.” Ans. 10; Non-Final Act. 3. We do not agree with the Examiner that the cited disclosure provides persuasive evidence that attribute information, i.e. the aggressiveness, is *received from* a toy part as required by claim 11. It is possible, for example, that the aggressiveness information of the mouth part is stored separately from the toy parts, but linked to the unique identification from the toy. Thus, the Examiner’s rejection cannot be sustained on the grounds set forth by the Examiner.

However, Galyean discloses:

In accordance with a preferred embodiment, the parts 202–208 may have sensors built in so that they can control the operation

of the virtual character in the virtual environment constructed by computer 100. For example, tail part 208 may be a thin, flexible membrane which has bend sensors embedded in it. When the tail is bent, the computer can sense the bending movement and cause the graphical character to swim forward. Similarly, mouth parts 202 may have hinged 40 jaws which, when moved, cause the jaws and the character on the computer screen to move. In addition the toy body 102 may be provided with a tilt sensor (not shown) which senses the body position and may be used to detect when a user desires the image of the toy to move.

Galyean col. 4 ll. 32–44.

Galyean also discloses:

In FIG. 8, the main program loop 802 receives data from the physical toy 800 and also receives information from virtual environment “sensors” 804. The data from the toy could include, for example, data from internal switches or sensors, which data indicates the type and position of accessory parts plugged into the toy body, data from manipulation sensors on the toy indicating the user is moving an accessory part or data generated by a tilt sensor indicating that the user is moving the toy body.

Galyean col. 9 ll. 14–22.

In addition, Galyean discloses “[a]s previously mentioned, this data exchange can be performed, for example, by reading the outputs of the analog-to-digital converters located within the body of the toy as shown in FIG. 6B.” Galyean col. 10 ll. 41–44. Furthermore, Galyean discloses “[n]ext, in step 906, the main program loop initiates each of the character subroutines 806–808 passing in the environmental data detected by the virtual environment sensor output or by data exchange performed with the toy.” Galyean col. 10 ll. 47–52. Here, Galyean discloses bend or tilt sensors on the toy part that dynamically detect a bend of a tail or a body position. Galyean col. 4 ll. 36–43.

Position, or the state of bending, is “attribute information for each toy part” within the broadest reasonable meaning of that phrase. The dynamic bent tail or the body position information is not the unique identification coded which is fixed on the toroidal rings that plugs into the toy. Galyean discloses the data is from internal switches or sensors and received from the toy. Galyean col. 9 ll. 14–15. Therefore Galyean discloses receiving “attribute information” from a plurality of toy parts because the main program loop receives “attribute information” from sensors from the toy parts in Galyean via the exchanged data. Galyean also teaches “a unique identification” because Galyean discloses “a plurality of toroidal rings,” which is not the same as the sensors, “can be used to code an identification number.” Galyean col. 6 ll. 17–21.

Appellant argues that “[t]here are no corresponding figures or text in Galyean for attribute information stored [on] part of the toy parts.” Reply Br. 2. Appellant does not recite “attribute information stored on part of the toy parts” in claim 11. “The invention disclosed in [Appellant’s] written description may be outstanding in its field, but the name of the game is the claim.” *In re Hiniker Co.*, 150 F. 3d 1362, 1369 (Fed. Cir. 1998).

Appellant’s argument is not commensurate with the scope of claim 11 because the claim requires “receiving information from a plurality of toy parts,” not that the information is stored on the toy part. *See In re Self*, 671 F.2d 1344, 1348 (CCPA 1982) (limitations not appearing in the claims cannot be relied upon for patentability). Receiving information from sensors on a toy part meets this limitation. Thus, we find that Galyean discloses the received information, which includes “a unique identification” and “attribute information,” from the toy parts.

In view of the foregoing discussion, we agree with the Examiner's ultimate decision to reject claim 11 based on Galyean. As we have modified the Examiner's findings and reasoning, we designate this opinion as including a new ground of rejection under 37 C.F.R. § 41.50(b) so as to afford Appellant the procedural options for response associated therewith.

Claim 19

Claim 19 is argued individually. Appeal Br. 7–8.

The Examiner finds Galyean's video game does not disclose "updating the attribute information for each toy part based on the video game play" of claim 19. Non-Final Act. 5. The Examiner finds that Fiegenger satisfies the above limitation of claim 19. Non-Final Act. 5–6.

Appellant argues that "Fiegenger only discloses storing progress in a game and does not include any discussion of updating information about attributes of the toy on the mass storage device, and does not discuss updating information for different parts of a toy." Appeal Br. 7. Appellant also argues that "Fiegenger does not teach the 'updating the attribute information for each toy part based on the video game play,' specified in claim 19." Appeal Br. 7–8.

The Examiner answers that Fiegenger teaches "[t]he status of the game is saved back (updated) to the memory storage in the toy." Ans. 13. We do not agree with the Examiner's determination that the saving of a status of a game inherently constitutes, or falls within the broadest reasonable construction of "updating the attribute information for each toy part." Saving a status of a game can update the status of a game on a toy part, but does not necessarily update attribute information *of a toy part*. The Examiner has not apprised us of any reason why a status of a game would be reasonably

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considered as an attribute information of the toy part. Thus, we are not apprised as to how Fiegenger meets the disputed limitation of claim 19. Accordingly, we do not sustain the rejection on the grounds set forth by the Examiner.

Claim 20

Claim 20 is argued individually. Appeal Br. 8–9.

The Examiner finds that Galyean does not disclose “the attribute information includes at least health of the toy part” of claim 20. Non-Final Act. 6. The Examiner finds that Hong satisfies the above limitation of claim 20. Non-Final Act. 6.

Appellant argues that “Hong only teaches that attributes or characteristics include the health of the toy in general,” and “[t]here appears to be no mention of storing health information for particular parts of the toy.” Appeal Br. 9. The Examiner answers that paragraph 36 of Hong discloses “[e]ach toy may be associated with one or more characteristics 74, such as to represent the toy’s health, emotional contentment, hunger, and the like.” Ans. 14. We do not agree with the Examiner’s determination that the *toy’s* health falls within the broadest reasonable construction of health of the *toy part*. Health of a *toy* in general does not necessarily reflect health of an *individual toy part* on the toy. The Examiner has not apprised us of any reason why health of a *toy* would be reasonably considered as health of a *toy part*. Thus, we are not apprised as to how Hong meets the disputed limitation of claim 20. Accordingly, we do not sustain the rejection on the grounds set forth by the Examiner.

Claim 21

Claim 21 is argued individually. Appeal Br. 9–10.

The Examiner finds that Galyean does not disclose the limitation “the attribute information includes at least an experience level of the toy part” of claim 21. Non-Final Act. 7. The Examiner finds that Ha satisfies the above limitation of claim 21. Non-Final Act. 7. Particularly, the Examiner finds that “number of games played information of a toy read[s] on the claimed experience level of the toy part.” Non-Final Act. 7; Ans. 14.

Appellant argues that Ha discloses “the ability level and the experience level of the corresponding user are continuously updated on the mobile communication terminal 150,” and Ha does not teach “the attribute information includes at least an experience level of the toy part.” Appeal Br. 9. The Examiner appears to have overlooked the claim language in finding it is satisfied by the subject matter of the Ha reference. Ha teaches the experience level of the *user* who is playing the game from cited paragraphs. The Examiner has not apprised us of any reason why the experience level of the *user* would reasonably be considered an experience level of the *toy part*. Thus, we agree with Appellant that Ha does not teach “the attribute information includes at least an experience level of the toy part.”

Accordingly, we do not sustain the rejection on the grounds set forth by the Examiner.

Claim 22

Claim 22 is argued individually. Appeal Br. 10–11.

The Examiner finds that Galyean does not disclose “determining whether the configuration of the toy assembly is acceptable and when the configuration is not acceptable, requesting reconfiguration of the toy assembly” of claim

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22. Non-Final Act. 7. The Examiner finds that Fabricant satisfies the above limitation of claim 22. Non-Final Act. 7–8.

Appellant argues that Fabricant discloses “[a]ny errors in the assembly of the puzzle are apparent through the frame holding the puzzle,” and discloses “[t]he child may then remove the pieces through the opening in the frame and try again.” Appeal Br. 10. Then, Appellant concludes that Fabricant does not teach “‘requesting reconfiguration of the toy assembly’ if the configuration is wrong.” Appeal Br. 10.

The Examiner answers that Fabricant discloses “[s]hould the puzzle be assembled incorrectly, the error will be evident on both sides of the frame, whereupon the child will be challenged to remove the pieces, one by one through the opening 26, and to try again.” Ans. 15. We do not agree with the Examiner that “requesting reconfiguration,” which is a non-passive action, could be reasonably construed as including Fabricant’s error determination, which is a passive visualization of an incorrect placement of the assembled puzzle. The Examiner has not apprised us of any reason why the error in and of itself could be reasonably considered to meet the limitation “determining whether the configuration of the toy assembly is acceptable and when the configuration is not acceptable, requesting reconfiguration of the toy assembly” of claim 22. Thus, we agree with Appellant that Fabricant does not meet the above limitation of claim 22.

However, we find that Kawai discloses:

Further, according to the fabricated toy, the toy can also be designed so that the sound generated in the case where the toy has been assembled correctly (as directed in the instruction manual) are different from those in the case of incorrect assembly, with the result that it is possible for infants to assemble a plurality of members correctly.

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Kawai col. 1 ll. 43–48.

The Examiner uses this disclosure of Kawai to satisfy the limitation “the program instructions for providing for video game play including program instructions for determining if the toy assembly is configured in a valid configuration” of claim 23. Non-Final Act. 9. Appellant has not controverted Kawai’s teaching in regards to this limitation. Kawai teaches a sound notification for correct or acceptable assembly, and a different sound when the assembly is not correct or not acceptable. The different sound in the case of incorrect assembly satisfies the limitation “a requesting reconfiguration of the toy assembly” of claim 22. Thus, we find that Kawai teaches “determining whether the configuration of the toy assembly is acceptable and when the configuration is not acceptable, requesting reconfiguration of the toy assembly” of claim 22. Kawai col. 1 ll. 43–48. We conclude that it would have been obvious to one having ordinary skill in the art before the effective filing date of the claimed invention to modify Galyean in view Kawai in order to avoid possible player confusion, the same motivation provided by the Examiner in rejecting claim 23 in view of Galyean and Kawai. Non-Final Act. 10. Accordingly, we modify the Examiner’s rejection of claim 22 to additionally be based on our discussion of Kawai above. We designate our reliance on Kawai as introducing a new ground for rejection under 37 C.F.R. § 41.50(b)(2018).

Claims 23, 25–26² are argued as a group. Appeal Br. 11–12. We select claim 23 as representative of claims 23, 25, and 26 under 37 C.F.R. § 41.37(c)(1)(iv) and presume Appellant intended to argue claim 24 premised only on dependency from claim 23.

The Examiner finds that Galyean discloses a video game system meeting all the limitations of claim 23, except for the limitation “the program instructions for providing for video game play including program instructions for determining if the toy assembly is configured in a valid configuration.” *See* Non-Final Act. 8–9. The Examiner finds that Kawai satisfies the above limitation and that “one ordinary skilled in the art at the time of the invention would have modified Galyean [] in view of [Kawai³] to include the aforementioned method in order avoid possible player confusion (i.e. by determining and indicating a valid toy assembly configuration).” Non-Final Act. 9–10.

The Examiner specifically finds that Galyean discloses “the toy parts each including an identification of the toy part,” and “at least one of the toy parts storing attribute information for a character representing the toy assembly in game play.” Non-Final Act. 8–9.

Appellant argues that “[t]he OA fails make a prima facie case that ‘toy parts each including an identification of the toy part’ and ‘at least one of the

² Claim 24 is dependent claim on claim 23. The Examiner has rejected claim 24 as being unpatentable over Galyean, Kawai, and Polchin. Non-Final Act. 10. Appellant has not separately argued claim 24.

³ The Examiner wrote Galyean III in view of Lee in the office action. Non-Final Act. 10. From the record, we believe Lee is a typo. Hence, we replace Lee with Kawai, and also replace Galyean III with Galyean because Galyean III is the same reference as Galyean.

toy parts storing attribute information for a character representing the toy assembly in game play’ as specified by claim 23.” Appeal Br. 11. Appellant specifically argues that “[t]here are no corresponding figures or text in Galyean for attribute information stored or part of the toy parts, and the Examiner's Answer points to no such disclosure in Galyean.” Reply Br. 2. We agree with Appellant’s argument. The Examiner has not apprised us of any disclosures from either Galyean or Kawai that could be reasonably considered as disclosing “at least one of the toy parts *storing* attribute information for a character representing the toy assembly in game play.” (Emphasis added). Accordingly, we do not sustain the rejection of claim 23, or the rejections of those claims depending therefrom, on the grounds set forth by the Examiner.

CONCLUSION

The Examiner’s rejections are affirmed-in-part.

More specifically,

We AFFIRM the decision of the Examiner to reject claims 11, 13–17, and 19 as being anticipated by Galyean. As we have modified the Examiner’s position in doing so, we designate this opinion as including a new ground of rejection.

We REVERSE the decision of the Examiner to reject claim 20 as being unpatentable over Galyean and Hong.

We REVERSE the decision of the Examiner to reject claim 21 as being unpatentable over Galyean and Ha.

We REVERSE the decision of the Examiner to reject claim 22 as being unpatentable over Galyean and Fabricant. However, we enter a new

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grounds of rejection of claim 22 as being patentable over Galyean and Kawai.

We REVERSE the decision of the Examiner to reject claims 23, 25, and 26 as being unpatentable over Galyean and Kawai.

We REVERSE the decision of the Examiner to reject claim 24 as being unpatentable over Galyean, Kawai, and Polchin.

DECISION SUMMARY

Claims	35 U.S.C. §	Basis/References	Affirmed	Reversed	New Grounds
11, 13–17	102(b)	Galyean	11, 13–17		11, 13–17
19	103(a)	Galyean, Fiegenger		19	
20	103(a)	Galyean, Hong		20	
21	103(a)	Galyean, Ha		21	
22	103(a)	Galyean, Fabricant			22
23, 25, 26	103(a)	Galyean III, Kawai		23, 25, 26	
24	103(a)	Galyean, Kawai, Polchin		24	
Overall Outcome			11, 13–17	19, 20, 21, 23–26	11, 13–17, 22

TIME PERIOD FOR RESPONSE

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). Section 41.50(b) provides “[a] new ground of rejection

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pursuant to this paragraph shall not be considered final for judicial review.”

Section 41.50(b) also provides:

When the Board enters such a non-final decision, the Appellant, within two months from the date of the decision, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new Evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the prosecution will be remanded to the examiner. The new ground of rejection is binding upon the examiner unless an amendment or new Evidence not previously of Record is made which, in the opinion of the examiner, overcomes the new ground of rejection designated in the decision. Should the examiner reject the claims, appellant may again appeal to the Board pursuant to this subpart.

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same Record. The request for rehearing must address any new ground of rejection and state with particularity the points believed to have been misapprehended or overlooked in entering the new ground of rejection and also state all other grounds upon which rehearing is sought.

Further guidance on responding to a new ground of rejection can be found in the Manual of Patent Examining Procedure § 1214.01.

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

AFFIRMED IN PART; 37 C.F.R. § 41.50(b)