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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte PATRICK SOON-SHIONG

Appeal 2019-005280
Application 15/843,918
Technology Center 2400

Before DENISE M. POTHIER, JASON J. CHUNG, and STEPHEN E. BELISLE, *Administrative Patent Judges*.

CHUNG, *Administrative Patent Judge*.

DECISION ON APPEAL

Pursuant to 35 U.S.C. § 134(a), Appellant[1] appeals the Final Rejection of claims 23–48.[2] We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

INVENTION

The invention relates to collaboration system technologies. Spec. ¶ 2. Claim 23 is illustrative of the invention and is reproduced below:

> 23. A collaboration system, comprising:
> a collaboration database storing a plurality of collaboration interface components; and

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[1] We use the word "Appellant" to refer to "applicant" as defined in 37 C.F.R. § 1.42. According to Appellant, Nant Holdings IP, LLC is the real party in interest. Appeal Br. 2.

[2] Claims 1–22 are cancelled. Appeal Br. 17.

> at least one processor configured to control an object recognition engine communicatively coupled with the collaboration database, and the object recognition engine being configured to:
>
> receive sensor data related to a game object via an input interface;
>
> identify a set of object characteristics from the sensor data;
>
> select the set of collaboration interface components having the selection criteria satisfied by the object characteristics;
>
> *instantiate a collaboration interface comprising a game instantiated based on the game object from the set of components on at least a first electronic device*; and
>
> configure the first electronic device to generate a first collaboration command via the instantiated collaboration interface.

Appeal Br. 17 (Claims Appendix) (emphasis added).

REJECTIONS[3]

The Examiner rejects claims 23–32, 36, and 40–47 under 35 U.S.C. § 103 as being unpatentable over the combination of Rodriguez (US 2011/0134204 A1; published June 9, 2011) and Thomas (US 2013/0079128 A1; published Mar. 28, 2013). Final Act. 2–25.

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[3] In the event of further prosecution, the Examiner should consider whether the italicized text in claim 23 above (and similarly recited claims 45–48) satisfies the definiteness requirement set forth in 35 U.S.C. § 112(b). For example, there is no antecedence for "the set of components." Also, claim 23 recites "instantiate *a collaboration interface* comprising *a game* instantiated based on the game object" (emphases added). But because an instantiation of "a collaboration interface" first occurs, and that is followed by "a game" (rather than "a collaboration interface") that was instantiated, it is unclear whether "a collaboration interface" is synonymous with "a game" or distinct. Although the Board is authorized to reject claims under 37 C.F.R. § 41.50(b), no inference should be drawn when the Board elects not to do so. *See* Manual of Patent Examining Procedure ("MPEP") § 1213.02 (9th Ed., Rev. 10.2019, June 2020).

The Examiner rejects claims 33 and 34 under 35 U.S.C. § 103 as being unpatentable over the combination of Rodriguez, Thomas, and Chandrasekaran (US 2010/0169269 A1; published July 1, 2010). Final Act. 25–27.

The Examiner rejects claims 35 and 39 under 35 U.S.C. § 103 as being unpatentable over the combination of Rodriguez, Thomas, and Arun (US 2007/0124374 A1; published May 31, 2007). Final Act. 27–29.

The Examiner rejects claim 37 under 35 U.S.C. § 103 as being unpatentable over the combination of Rodriguez, Thomas, and Fernandez (US 2004/0260669 A1; published Dec. 23, 2004). Final Act. 30.

The Examiner rejects claim 38 under 35 U.S.C. § 103 as being unpatentable over the combination of Rodriguez, Thomas, and Mityagin (US 2009/0054123 A1; published Feb. 26, 2009). Final Act. 30–31.

The Examiner rejects claim 48 under 35 U.S.C. § 103 as being unpatentable over the combination of Rodriguez, Stachniak (US 2013/0326376 A1; published Dec. 5, 2013), and Thomas. Final Act. 31–36.

ANALYSIS

A. Claims 23 and 25–48

The Examiner finds Rodriguez teaches all the limitations recited in claim 23 except "a game instantiated based on the game object from the set of components on at least a first electronic device." Final Act. 2–6; Ans. 4–7. The Examiner finds Thomas teaches injecting a created game object into an ongoing computer game, which the Examiner maps to the limitation "a game instantiated based on the game object from the set of components on at least a first electronic device" recited in claim 23 (and similarly recited

claims 45–48). Final Act. 6 (citing Thomas ¶ 88); Ans. 7. The Examiner concludes a person having ordinary skill in the art at the time of the invention (hereinafter "PHOSITA") would have combined Rodriguez's collaboration system and Thomas's injection of created game objects to increase the functionality of Rodriguez's collaboration system beyond group collaboration to the game players within a gaming industry. Final Act. 6; Ans. 7–9.

Appellant argues Thomas fails to teach "a game instantiated based on the game object from the set of components on at least a first electronic device" because Thomas's game is ongoing. Appeal Br. 7–10 (citing Thomas ¶ 88; Spec. ¶ 88); Reply Br. 2–4. Appellant argues Thomas teaches away from the claimed invention because Thomas's game is ongoing and, therefore, a PHOSITA would be led in a direction divergent from Appellant's path taken. Appeal Br. 10–11. Appellant argues the Examiner fails to provide adequate motivation to combine because the Examiner's motivation is generic (rather than a particular claimed manner to reach the claimed invention). *Id.* at 11–14 (citing MPEP § 2141(I)(C); Reply Br. 5–6.

At the outset, Appellant is construing Thomas too narrowly. Thomas ¶ 88. Although paragraph 88 of Thomas uses the word "ongoing," the moment a created object is inserted into an ongoing game, there is a new interface/game (i.e., the old interface/game plus the newly created game object). *Id.* Thus, Thomas teaches injecting a created game object into an ongoing computer game, which teaches the limitation "a game instantiated based on the game object from the set of components on at least a first electronic device" recited in claim 23. *Id.* (cited at Final Act. 6; Ans. 7).

The independent claims do not contain language that precludes this reasonable interpretation of Thomas.

We also find Appellant's teaching away argument unpersuasive. Appeal Br. 10–11. The Federal Circuit has held that "[a] reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant." *In re Kahn*, 441 F.3d 977, 990 (Fed. Cir. 2006) (quoting *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994)). In this case, as discussed in the preceding paragraph, Thomas does not teach away because it reasonably teaches the limitation "a game instantiated based on the game object from the set of components on at least a first electronic device" recited in claim 23 and does not lead an artisan in a divergent direction from the claimed invention. Final Act. 6; Ans. 7.

We also find unpersuasive Appellant's argument that the Examiner fails to provide adequate motivation to combine because the Examiner's motivation is generic. Appeal Br. 11–14 (citing MPEP § 2141(I)(C)); Reply Br. 5–6. We agree with the Examiner's rationale that a PHOSITA would have recognized that combining Rodriguez's collaboration system and Thomas's injection of created game objects would have increased the functionality of Rodriguez's collaboration system beyond group collaboration to the game players within a gaming industry. Final Act. 6; Ans. 7–9. We, therefore, conclude the Examiner has set forth sufficient "articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) (quoting *Kahn*, 441 F.3d at 988).

Accordingly, we sustain the Examiner's rejections of: (1) independent claims 23 and 45–48; and (2) dependent claims 25–44 under 35 U.S.C. § 103.

B. Claim 24

The Examiner finds Thomas teaches instantiation. Final Act. 6 (citing Thomas ¶ 88); Ans. 4–7, 10. The Examiner finds Rodriguez teaches displaying team members co-located at multiple sites, which the Examiner maps to the limitation "the construction engine is configured to construct a plurality of collaboration interfaces to be instantiated." Final Act. 7 (citing Rodriguez ¶¶ 25–26); Ans. 9–10.

Appellant argues Rodriguez fails to teach "the construction engine is configured to construct a plurality of collaboration interfaces to be instantiated" as claim 24 recites because Rodriguez's displaying team members co-located at multiple sites has nothing to do with instantiation. Appeal Br. 14–15; Reply Br. 6–8.

Regarding Appellant's first argument, one cannot show nonobviousness "by attacking references individually" where the rejections are based on combinations of references. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986) (citing *In re Keller*, 642 F.2d 413, 425 (CCPA 1981)). In this case, the Examiner relies on Thomas, when combined with Rodriguez, to teach instantiation. Final Act. 2–6 (citing Thomas ¶ 88); Ans. 4–7, 10. The Examiner also relies on Rodriguez to teach displaying team members co-located at multiple sites (i.e., displaying each team member at least suggests instantiation), which teaches or suggests the limitation "the construction engine is configured to construct a plurality of collaboration

interfaces to be instantiated," when combined with Thomas. *See* Final Act. 6–7 (citing Rodriguez ¶¶ 25–26); Ans. 9–10.

Moreover, Thomas teaches injecting a created game object into an ongoing computer game (i.e., after the created game object is injected into the computer game, each of the subsequent picture frames of the game play is a new instantiated interface), which at least suggests the limitation "the construction engine is configured to construct a plurality of collaboration interfaces to be instantiated" recited in claim 23 (and similarly recited claims 45–48). Final Act. 6 (citing Thomas ¶ 88); Ans. 7.

Accordingly, we sustain the Examiner's rejection of claim 24 under 35 U.S.C. § 103.

We have only considered those arguments that Appellant actually raised in the Briefs. Arguments Appellant could have made, but chose not to make, in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(iv) (2018).

CONCLUSION

Claim(s) Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
23–32, 36, 40–47	103	Rodriguez, Thomas	23–32, 36, 40–47	
33, 34	103	Rodriguez, Thomas, Chandrasekaran	33, 34	
35, 39	103	Rodriguez, Thomas, Arun	35, 39	
37	103	Rodriguez, Thomas, Fernandez	37	
38	103	Rodriguez, Thomas, Mityagin	38	
48	103	Rodriguez, Stachniak, Thomas	48	
Overall Outcome			23–48	

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). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED