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HOFFMAN WARNICK I.L.C. 540 Broadway 4th Floor ALBANY, NY 12207			SORKOWITZ, DANIEL M	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte CHRISTOPHER J. DAWSON, CARL P. GUSLER, RICK A.
HAMILTON II, and CLIFFORD A. PICKOVER

Appeal 2012–004396
Application 12/044,459
Technology Center 3600

Before ANTON W. FETTING, MEREDITH C. PETRAVICK and
THOMAS F. SMEGAL, *Administrative Patent Judges*.

SMEGAL, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Christopher J. Dawson et al (Appellants) seek our review under 35 U.S.C. § 134 of the Examiner's final rejection of claims 1–25 under 35 U.S.C. §102 (e) as anticipated by Glazer (US 2007/0179867 A1, pub. Aug. 2, 2007). We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE and enter a new ground of rejection pursuant to 37 C.F.R. § 41.50(b).

CLAIMED SUBJECT MATTER

An understanding of the invention can be derived from a reading of independent claim 1, which is reproduced below.

1. A method, performed on a computer system, for ameliorating an offer of transport that a first avatar online in a virtual universe is targeted to receive from a second avatar online in the virtual universe for teleporting to another virtual region within the virtual universe for exposure to an advertisement, the method comprising:

using the computer system to perform the following:

detecting that the second avatar has sent the first avatar the offer of transport to the virtual region for exposure to the advertisement via a virtual universe client that provides interaction with the virtual universe;

intercepting the offer of transport prior to being received by the first avatar; and

determining whether to present the offer of transport to the first avatar.

Clms. App’x, Appeal Br. 41.

ANALYSIS

NEW GROUND OF REJECTION

Pursuant to our authority under 37 C.F.R. § 41.50(b), we enter a NEW GROUND OF REJECTION against claims 1–25 under § 112, second paragraph, as being indefinite for failure to particularly point out and distinctly claim the subject matter which the Appellants regard as the invention.

The language of a claim satisfies § 112, second paragraph, only if “one skilled in the art would understand the bounds of the claim when read in light of the specification.” *Exxon Research & Eng'g Co. v. United States*, 265 F.3d 1371, 1375 (Fed. Cir. 2001). Conversely, “a patent is invalid for

indefiniteness if its claims, read in light of the specification delineating the patent, and the prosecution history, fail to inform, with reasonable certainty, those skilled in the art about the scope of the invention.” *Nautilus, Inc. v. Biosig Instruments, Inc.*, 134 S.Ct. 2120, 2124 (2014). “It is the applicants' burden to precisely define the invention, not the PTO's. See 35 U.S.C. § 112, ¶ 2 ... [T]his section puts the burden of precise claim drafting squarely on the applicant.” *In re Morris*, 127 F.3d 1048, 1056 (Fed. Cir. 1997).

Claim 1 recites “detecting that the second avatar has sent the first avatar the offer of transport,” “intercepting the offer of transport prior to being received by the first avatar” and “determining whether to present the offer of transport to the first avatar.” Independent claims 13, 21 and 25 each contain one or more similar limitations.

These limitations are indefinite because an avatar is a figment of a user's imagination. The Specification's description of an Avatar is consistent with its generally accepted meaning that avatars “are personas or representations of the users of the virtual universes and generally take the form of two-dimensional or three-dimensional human or fantastical representations of a person's self.” Spec. para. 0002.

An avatar, being simply a representation or persona, does not exist in a form that can send an offer, receive an offer, or have an offer presented to it. As a result, there is no way to know the metes and bounds of how the avatar sends an offer, receives an offer, and has an offer presented to it.

To the extent Appellants mean to say each of these occur by the avatar appearing on a screen to send, receive or be offered the offer, again, such screen images have meaning only in the mind of the beholder and the avatars do not, themselves, send or receive an offer or be the subject of a

presentation of an offer. Such an interpretation would also strip the limitations of any meaning simply by disconnecting a display device, which itself is incapable of implementing software processes. The lack of meaning as to these limitations is particularly acute as these are the limitations Appellants most rely on to distinguish from the art.

The rejection of Claims 1–25 under 35 U.S.C. §102(e) as anticipated by Glazer.

We do not sustain the rejection of claims 1–25 under 35 U.S.C. §102(e) as anticipated by Glazer because this rejection is necessarily based on speculative assumptions as to the meaning of the claims. *See In re Steele*, 305 F.2d 859, 862-63 (CCPA 1962). It should be understood, however, that our decision in this regard is based solely on the indefiniteness of the claimed subject matter and does not reflect on the adequacy of the prior art evidence applied in support of the Examiner’s rejection.

DECISION

The decision of the Examiner to reject claims 1–25 is REVERSED.

We enter a new ground of rejection of claims 1–25 under 35 U.S.C. §112, second paragraph. The decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides that, “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.” 37 C.F.R. § 41.50(b) also provides that Appellants, WITHIN TWO MONTHS FROM THE DATE OF THIS 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 proceeding will be remanded to the Examiner.

(2) *Request rehearing*. Request that the proceeding be reheard under § 41.52 by the Board upon the same record.

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).

REVERSED; 37 C.F.R. § 41.50(b)