

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHRISTINA SUMMER CHEN, MATTIAS J. GRUVMAN,
GREGORY EDMUND MURPHY, and JAN ANDREAS ROMAN

Appeal 2007-3198
Application 10/359,340
Technology Center 2100

Decided: April 30, 2008

Before JOSEPH L. DIXON, JEAN R. HOMERE, and JAY P. LUCAS,
Administrative Patent Judges.

DIXON, *Administrative Patent Judge.*

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the Examiner's final rejection of claims 1-28. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

BACKGROUND

Appellants' invention relates to an open grid navigational system for a gaming system using global and local indicators (arrows) to assist a user in reaching a goal (Spec. 1). An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. A method for providing assistance in navigating an object to a goal in an open grid virtual environment, comprising the steps of:
 - (a) continuously displaying a global indicator that generally points in a direction directly from the object toward the goal in the virtual environment, without regard to following a path through the open grid, wherein said global indicator is continuously displayed without regard to a distance from the object to the goal;
 - (b) providing a local indicator that generally points to indicate a direction of a next available turn to be taken in the virtual environment, to follow the open grid in reaching the goal; and
 - (c) displaying the local indicator in the virtual environment at least before the next available turn that can be taken by the object to reach the goal.

PRIOR ART

The prior art references of record relied upon by the Examiner in rejecting the appealed claims are:

Mott	US 5,269,687	Dec. 14, 1993
Ando	US 6,200,138 B1	Mar. 13, 2001
Yoshida	US 6,652,376 B1	Nov. 25, 2003
		(filed Feb. 15, 2000)

REJECTIONS

Claims 1, 11, and 20 stand rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the Specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitation "and without regard to a distance from the object to the goal" is asserted as lacking written support in the originally filed Specification.

Claims 1-7, 9-13, 15-26 and 28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ando and Yoshida.

Claims 8, 14, and 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ando and Yoshida, as applied to claims 1 and 20 above, and Mott.

Rather than reiterate the conflicting viewpoints advanced by the Examiner and Appellants regarding the above-noted rejection, we make reference to the Examiner's Answer (mailed February 21, 2007) for the reasoning in support of the rejections, and to Appellants' Brief (filed October 27, 2006) and Reply Brief (filed April 20, 2007) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to Appellants' Specification and claims, to the applied prior art references, and to the respective positions articulated by Appellants and the

Examiner. As a consequence of our review, we make the determinations that follow.

35 U.S.C. § 112, FIRST PARAGRAPH

With respect to the rejection under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement, the Examiner contends that the limitation added by Appellants concerning “without regard to a distance from the object to the goal” is not explicitly described in Appellants’ Specification. Here, the Examiner contends that the Specification merely describes the global indicator as being independent of path through the open grid and that the global indicator points in the direction of the goal “as the crow flies” which does not sufficiently convey the teachings requiring the global indicator to be displayed without regard to a distance from an object to a goal. (Ans. 3).

First, we note that, as a general premise, a deficiency within an independent claim also indicates a deficiency with respect to each of the respective claims which depend therefrom. Therefore, we interpret the Examiner's rejection of each of the independent claims to extend to each of the respective dependent claims. Therefore, we interpret the rejection as extending to all the claims in the case. From our review of Appellants' Specification, we find that the Examiner has set forth a reasonable basis for the rejection of each of the respective independent claims and their respective dependent claims. Therefore, we look to Appellants' Briefs to show error in the Examiner's initial showing or to show sufficient written description support for the disputed claim language.

Appellants contend that the limitation "without regard to a distance from the object to the goal" is "explicitly described in the specification" (App. Br. 12-14). Appellants rely upon the Specification at pages 11 to 12 describing the global indicator 210 as a compass arrow showing a straight line direction and that Appellants do not indicate that the global indicator is only displayed when a player is within a specific distance of a checkpoint or goal. (App. Br. 13). Appellants argue that based on the description of the global indicator provided in the Specification, there is no reason why one of ordinary skill in the art would be led to believe that the global indicator is not continuously displayed, since no criteria are provided that might have suggested that the global indicator is only displayed for part of the time. We do not find this argument to "explicitly" teach the asserted claim limitation as maintained by Appellants. We do not find the asserted lack of a disclosure in the Specification to be suggestive of what the disclosure actually discloses. Therefore, we do not find this argument persuasive of support for the disputed claim limitation.

Appellants argue that the global indicator is similar to a compass arrow on a compass, and it is clear that Appellants' global indicator is intended to provide an indication of the straight-line direction from the current position of the object in the grid to the next goal. Appellants further argue that one of ordinary skill in the art would expect the global indicator to be displayed continuously, without regard to distance to the goal, since there is no suggestion to the contrary in the description provided. (App. Br. 13). We do not find Appellants' expectation of what one of ordinary skill in the art to be a persuasive showing with respect to the written description requirement. Therefore, we do not find Appellants' argument to be

persuasive of error in the Examiner's initial showing or to show evidence of written description support.

With respect to Appellants' argument concerning the indicator being similar to a compass arrow (App. Br. 13), we do not find the undisclosed "similar" characteristics of a compass (rather than only the compass arrow as recited in the Specification) to the instant claimed invention to be persuasive of the error in the Examiner's rejection.

With respect to Appellants' argument concerning a player being able to take various routes to the next checkpoint and that it is

apparent that the global indicator provides direction without regard to a distance from the object to the goal, because the player can often reach a destination toward which the global indicator points by following any of several routes. Because multiple routes are often available to reach a goal, and the distance traveled on each route can vary, there would be no reason to conclude that the global indicator is displayed based on some criteria related to a distance from the object from the goal.

(App. Br. 14)

Again, we do not find Appellants' argument based upon a lack of disclosure to the contrary to be persuasive with respect to the written description requirement. Appellants' argument when taken as a general rule, would essentially mean that all disclosed inventions meet the written description requirement by silence of necessary facts to the contrary. We find such an argument to be unpersuasive.

Appellants argue that pages 14-15 of the Brief that a lack of a rule basis in the Specification for a negative limitation may not be sufficient to establish a prima facie case of a lack of descriptive support and that figures 3 and 4 of the instant application inherently illustrate that the global indicator

is continuously displayed to generally point in a direction directly from the object towards the goal in the virtual environment, without regard to a distance from the object to the goal, because both figures show the movement of the object towards the goal at two successive positions relative to the goal, yet the global indicator remains unchanged except for the direction in which it points. We disagree with Appellants' conclusion with respect to the two discrete snapshots in figures 3 and 4, and we find it difficult to interpret static snapshots of events to provide written description to support a continual process of displaying a global indicator and its lack of a relationship to its spatial position. Therefore, we do not find Appellants' argument to evidence sufficient written description or to show error in the Examiner's prima facie case.

With respect to Appellants' argument concerning a square with four sides and its treatment with respect to the global indicator, Appellants have indicated no support for such an example in the written description, as filed. Therefore, argument thereto is not persuasive. With respect to Appellants' discussion of figure 3 at pages 15-16 of the Brief, Appellants argue that the quoted text implies that the global indicator is continually displayed so that the operator can determine the instantaneous direction from the vehicle to the next checkpoint. Again, Appellants' reliance is upon that which Appellants find to be implied in the figure. Again, we do not find this argument to be persuasive of error in the Examiner's prima facie case or a showing of sufficient written description.

With respect to figure 3 and figure 4, Appellants argue that one of ordinary skill would reasonably infer that there is no dependence upon distance between the vehicle and the goal or checkpoint, to control the

display of the global indicator since neither figure 3 nor figure 4 provides a display of anything that shows or even suggests such a relationship. (App. Br. 16). Again, we do not find Appellants' speculation as to what one of ordinary skill in the art would infer to be persuasive of error in the Examiner's prima facie case or a showing of sufficient written description.

Appellants further assert the limitation "without regard to a distance from the object to the goal" is inherent and explicit in the disclosure. (App. Br. 16-17). Appellants rely upon the text at pages 11 to 12 of the Specification where in the global indicator is provided on a display and appears generally as a compass arrow showing straight line direction between vehicle 202 in the next checkpoint in a succession of checkpoints that the player much (sic.) reach during game play. Here, we also note that the instant discussion is with respect to a "game" which is not recited in the instant claim language. Furthermore, the "compass arrow" in the Specification appears "generally as" and does not necessarily impart all the aspects or characteristics of a compass to this arrow. Therefore, we do not find Appellants' argument to be persuasive of error in the Examiner's prima facie case or a showing of inherency to provide sufficient written description.

Appellants further opine that the description with respect to figure 5 and the moving vehicle implies that the distances are changing, the direction indicated by the global indicator is not changing because the global indicator continues to currently point in the direction of the vehicle is traveling. Thus, the direction towards which the global pointer points is not dependent upon distance, but only depends on the position of the vehicle 202 relative to checkpoint 236/goal. (App. Br. 19-20). Again, we do not find Appellants'

speculation as to what is implied in the grammatical sentence structures to be persuasive of error in the Examiner's prima facie case or a showing of sufficient written description.

Appellants set forth a summary of the prosecution history in the Reply Brief with respect to the amendments to the claimed invention in an attempt to distinguish over the teachings of Ando. (Reply Br. 2-4). We do not find procedural history persuasive of error in the Examiner's presentation of rejection under 35 U.S.C. § 112, first paragraph. Moreover, we note that Appellants' Specification at page 13, line 13 states that "[a]ccordingly, it is not intended that any limitation be implied by the manner in which the local indicator 214 and global indicator 210 are illustrated relative to the vehicle 202 in these simple examples." Here, we find Appellants' statement to indicate that the drawings do not per se limit or detail the global and local indicators. Therefore, Appellants' arguments thereto for support are not persuasive of error in the Examiner's finding of a lack of written description.

Additionally, we do not find Appellants' argument that the Examiner has conceded that the limitation is adequately described in the Specification based upon the lack of an objection by the Examiner to the amendment to be persuasive of error in the Examiner's showing. (Reply Br. 4-7). Throughout Appellants' Brief and Reply Brief, Appellants cite to numerous portions of the Specification, yet we do not find those portions clearly support Appellants' position that there was adequate written description support at the time of filing for the challenged claim limitations. Therefore, we will sustain the Examiner's rejection of independent claims 1, 11, and 20 as lacking an adequate written description to show possession of the claimed invention at the time of the invention. We will similarly sustain the rejection

of their respective dependent claims which contain the same limitations found to be lacking in their respective parent claims. Therefore, we will sustain the rejection of claims 1-28.

35 U.S.C. § 103

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). “[T]he Examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.” *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). Furthermore,

[T]here must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness’ . . . however, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.

KSR Int’l Co. v. Teleflex Inc., 127 S. Ct. 1727, 1741 (2007)(quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

We have addressed the instant rejection by the Examiner in light of the claim limitations as present in the claims on appeal, but we note that we did not find express written description to support the claim language of "continuously. . . wherein said global indicator is continuously displayed without regard to a distance from the object to the goal." Additionally, we do not find written description support with which to interpret the

continuous display. We find that Ando teaches and fairly suggests a local indicator arrow 208 and continuous display thereof for a duration of time and a transformation from a local indicator arrow 208 to global indicator arrow 210 for a duration of time as shown in figures 13 and 14. Clearly, Ando teaches the desirability of variation in the display of assistance to a user and that the use of a single type of indicator is not sufficient to provide user assistance. Nor do we find a limitation that both the global and local indicators must appear on the screen at the same time in the claimed method.

With respect to independent claim 1, Appellants maintain essentially that claimed global indicator is displayed without regard to distance from the object to the goal and that the direction indication in the display of Ando is dependent on a distance. (App. Br. 21). Appellants further contend that there exists no motivation to combine the cited art and because Appellants' global indicator is completely unlike Yoshida's traveling line. (App. Br. 22). We do not find this argument persuasive of error since it is conclusory and is a comparison of the references to the (claimed) invention, rather than to the merits of the combination of the teachings of the two individual references. While we do agree that the traveling line of Yoshida is a different graphical representation upon the display screen, Yoshida clearly teaches and fairly suggests the desirability of a continual display in some form to provide assistance to the user in navigating an open grid display. Therefore, we do find that Yoshida would have fairly suggested, to the skilled in the artisan, the continuous display of an indicator.

Appellants contend that the continuous enablement of a global indicator that indicates only a general direction towards a goal is not equivalent to a traveling line that definitely and completely indicates a

specific predefined course to be followed around a track. (App. Br. 22-23). We do not find Appellants' argument to be persuasive since the Examiner has relied upon the teachings of Yoshida with respect to the continuous display and Appellants' comparison to a global indicator which indicates "only a general direction towards a goal" is not commensurate in scope with the express language of independent claim 1. Independent claim 1 does not limit the informational content of the global indicator, as argued, and may convey additional information in addition to the general direction toward a goal. Therefore, Appellants' argument is not persuasive of error.

Appellants argue that the combined references failed to teach or suggest the functionality of Appellants' local indicator. (App. Br. 23). Appellants argue that the local indicator appears when the distance to the next turn to be taken is equal or less than a predefined distance, but without regard to a distance from the object to the goal. Appellants' argument that the local indicator appears (on the display) is not commensurate in scope with the express claim language which requires nearly "providing a local indicator..." and "displaying... at least before the next available turn." We find that these limitations are taught and fairly suggested by Ando and the claim language does not differentiate whether the local indicator is always displayed irrespective of distance or is turned on or enabled only within a preset distance. Therefore, we do not find Appellants' argument persuasive of error.

Additionally, we find the teachings of Yoshida at column 2 to fairly suggest the use of multiple indication functions to the player. Yoshida discloses the use of a traveling line with variations in the presentation of the form of the line to additionally provide braking information for the user.

Here, we find Yoshida to fairly suggest a continuous presentation of assistance with an additional presentation of assistance near a point of interest along the path to a goal.

Additionally, Appellants cite to various portions of the Specification in an attempt to distinguish over the combination of Ando and Yoshida, but as discussed above with respect to the rejection under 35 U.S.C. § 112, first paragraph, we do not find that the Specification supports the claim language and hence cannot further distinguish the claim language from the teachings of Ando and Yoshida.

Appellants argue that the global indicator of the present invention points in a straight-line direction to a goal regardless of whether the goal is visible on the display at pages 7-8 and 9 of the Reply Brief. We do not find the argument to the goal being visible to be commensurate in scope with the express claim language of independent claim 1. Therefore, Appellants' argument thereto is not persuasive of error in the Examiner's initial showing of obviousness. Appellants argue that Ando teaches away from the global indicator as recited in the claims and that the direction of the claimed global indicator is "calculated by determining the relative positions of the object and the destination" and that Ando teaches that it is undesirable to calculate the relative positions of the object and the goal. (Reply Br. 9). Again, Appellants' arguments go beyond the express limitations recited in independent claim 1 and are not persuasive of error in the Examiner's initial showing of obviousness. We find no limitation with respect to any calculations recited in independent claim 1. Appellants' claims merely recite the end result of displaying.

Appellants argue that the Examiner has not shown that the global indicator is displayed without regard to a distance from an object to the goal is required by all the claims. (Reply Br. 10-11). Here again, we note that Appellants' claims recite displaying indicators and providing indicators without recitation of any calculations or processing. Therefore, we do not find Appellants' argument that the indicator is displayed without regard to distance persuasive of error since the display of the indicator provides the assistance to the user when displayed without regard to any other factors such as distance. The instant claim language does not differentiate to the processing of data and subsequent display thereof.

Appellants argue that the Examiner has not shown in the prior art a global indicator that is displayed continuously without regard to the distance from the object to the goal is required by all claims. (Reply Br. 11-12). Appellants rely upon the teaching in Ando of a desire not to confuse the game player and that one of ordinary skill in the art would avoid combining the continuously displayed traveling line of Yoshida with the arrow of Ando. We find Appellants' argument to be based upon an overly liberal combination of the teachings of the two references rather than what the teachings would have suggested to one of ordinary skill in the art at the time the invention was made with Yoshida teaching various methodologies to provide plural indications simultaneously in variations to the traveling line to assist the user and prevent confusion. Therefore, we do not find Appellants' argument to be persuasive of error an initial showing of obviousness, and we will sustain the rejection of independent claim 1 and its dependent claims. Additionally, we will sustain the rejection of independent claims 11 and 20 and their respective dependent claims since Appellants

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have not set forth separate arguments for patentability and have elected to group these claims with independent claim 1.

CONCLUSION

To summarize, we have sustained the rejection of claims 1-28 under 35 U.S.C. § 112, first paragraph, and we have sustained the rejection of claims 1-28 under 35 U.S.C. § 103(a).

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

AFFIRMED

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