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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ZARKO SVATOVIC

Appeal 2012-011750
Application 11/397,977
Technology Center 3700

Before JOHN C. KERINS, STEFAN STAICOVICI, and
NEIL T. POWELL, *Administrative Patent Judges*.

STAICOVICI, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Zarko Svatovic (Appellant) appeals under 35 U.S.C. § 134 from the Examiner's decision finally rejecting claim 6 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Claims 1-5 have been canceled. We have jurisdiction over this appeal under 35 U.S.C. § 6.

THE INVENTION

Appellant's invention relates to an extended version of the classical chess game played on a 10 by 10, 100 square board including new Esquire pieces. Spec. 5, paras. 10 and 12.

Claim 6, the sole claim, is representative of the claimed invention and reads as follows:

6. A method of playing a modified chess game by a first player against a second player, comprising the steps of:
 - (a) providing a game board consisting of ten horizontal rows and ten vertical columns of squares having alternating light and dark colors, squares having the same properties as the squares of orthodox chess;
 - (b) providing a plurality of playing pieces, including one set of light-colored pieces for the first player and a set of dark-colored pieces for the second player, each set of pieces comprising of ten pawns, one king, one queen, two rooks, two bishops, two knights, and two esquires;
 - (c) initially positioning the set of light-colored pieces, at the start of the game, in the first row of ten squares at a first end of the game board from left to right in the sequence, rook, knight, bishop, esquire, king, queen, esquire, bishop, knight, and rook, with the light-colored pawns being initially positioned, one pawn in each square of the second row often squares;
 - (d) initially positioning the set of dark-colored pieces in the tenth row often squares at the opposing end of the game board, from left to right in the sequence, rook, knight, bishop, esquire, king, queen, esquire, bishop, knight, and rook, with the dark-colored pawns being initially positioned, one pawn in each square of the ninth row often squares;

(e) formatting rules of movement for play wherein each of the queens, the rooks, the bishops, the knights have the same rule of movement as the corresponding piece in orthodox chess;

(f) formatting rules of movement for play wherein each of the kings have the same rule of movement as the corresponding piece in orthodox chess except that the kings move three squares towards the rook instead of two during castling;

(g) formatting rules of movement for play wherein each of the pawns have the same rules of movement as the pawns of orthodox chess, except that each pawn, on its first move, may move forwardly one, two or three squares;

(h) formatting rules of promotion movement of the pawns wherein each of the pawns have the same rules of promotion as the pawns of orthodox chess, except that they may now promote into one more piece, the esquire;

(i) formatting rule of movement of the pawns wherein the rule stays the same as rule in orthodox chess, except that en-passant rule can now in addition to 3rd row be applied on the 4th row,

(j) formatting rules of movement for play wherein each of the esquires moves to a square two squares in either horizontal, either vertical or either diagonal direction; and

(k) formatting rules of movement for play wherein each of the esquires may move over other pieces.

SUMMARY OF DECISION

We REVERSE.

ANALYSIS¹

The Examiner found that, “[c]laim 6 does not require the method be implemented by a particular machine” and “does not particularly require transformation of a particular article in the process.” Ans. 4. According to the Examiner, the “method as claimed involves movement of game pieces to merely change their locations on a game board surface based on hypothetical instructions and abstract ideas.” Ans. 5. Moreover, the Examiner notes that “[i]n playing a board game the steps are performed by individual human beings and not by a machine” (*see* Ans. 7) and “there is **no** concrete (**repeatable**) result or tangible (**real world**) **result**” (*see* Ans. 8).

In response, Appellant takes the position that “the unique chessboard in Claim 6 with its unique pieces and rules of play definitely represents a unique, one of a kind machine that . . . implements and limits the unique steps as they are precisely defined in the claim.” Reply Br. 3.

At the outset, with respect to the Examiner’s mention of a “useful, concrete and tangible result” (Ans. 8), we note that our reviewing court has determined that the “useful, concrete, and tangible result” test associated with *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368, 1373 (Fed. Cir. 1998) is inadequate. *In re Bilski*, 545 F.3d 943, 959-960 (Fed. Cir. 2008) (en banc); *see also Bilski v. Kappos*, 130 S. Ct. 3218, 3231 (2010). While the machine-or-transformation test is not the sole

¹ This is Appellant’s second appeal before the Patent Trial and Appeal Board. In the first appeal (2009-012060, Decision mailed June 6, 2011) (hereafter “Decision,”), the rejection under 35 U.S.C. § 103(a) of claim 6 as unpatentable over Lampman (US 6,095,523, issued Aug. 1, 2000) and Pendexter (US 6,702,287 B1, issued Mar. 9, 2004) was reversed. Decision, 6.

test, the machine-or-transformation test is a useful and important clue, an investigative tool, for determining whether some claimed inventions are patentable processes under § 101. *Id.* at 3227. In this case, we agree with Appellant that the steps of method claim 6 are tied to a specific apparatus, namely, a “modified chess game,” by virtue of the claimed steps of “providing a game board” and “providing a plurality of playing pieces.” *See* App. Br., Claims App’x. and Spec. 4, para. 9. As such, claim 6 is drawn to a method for playing a “modified chess game” that includes “providing” the physical components of the game, *i.e.*, game board and plurality of playing pieces. Furthermore, because the claimed “game board” consists of “ten horizontal rows and ten vertical columns of squares having alternating light and dark colors, squares having the same properties as the squares of orthodox chess” and the “plurality of playing pieces” include “one set of light-colored pieces . . . and a set of dark-colored pieces . . . each set of pieces comprising of ten pawns, one king, one queen, two rooks, two bishops, two knights, and two esquires,” we agree with Appellant that the steps of method claim 6 are tied to a “unique” (particular) machine, namely, a “modified chess game.” *See* Reply Br. 3.

In conclusion, for the foregoing reasons, we do not sustain the rejection of claim 6 under 35 U.S.C. § 101.

SUMMARY

The Examiner’s decision to reject claim 6 is reversed.

REVERSED

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