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Table with 5 columns: APPLICATION NO., FILING DATE, FIRST NAMED INVENTOR, ATTORNEY DOCKET NO., CONFIRMATION NO. Includes details for application 12/506,666 filed 07/21/2009 by David M. Jimick, attorney JMK1USA, confirmation 4506. Also includes examiner MENDIRATTA, VISHU K, art unit 3711, and notification date 02/02/2015 via electronic mode.

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DAVID M. JIMICK

Appeal 2012-009601
Application 12/506,666
Technology Center 3700

Before JOHN C. KERINS, STEFAN STAICOVICI, and
ANNETTE R. REIMERS, *Administrative Patent Judges*.

STAICOVICI, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE¹

David M. Jimick (Appellant) appeals under 35 U.S.C. § 134 from the Examiner's decision rejecting under 35 U.S.C. § 101: claims 1–6, 9, and 10 as directed to non-statutory subject matter; under 35 U.S.C. § 102(b): claims 7, 8, 11, and 12 as anticipated by Miller (US 4,801,147, issued Jan. 31, 1989); and under 35 U.S.C. § 103(a): claims 1–6, 9, and 10 as unpatentable over Wester (US 5,340,114, issued Aug. 23, 1994) and Syed (US

¹ According to Appellant, the real party in interest is the inventor, David M. Jimick. Br. 3.

2004/0065999 A1, published Apr. 8, 2004). We have jurisdiction under 35 U.S.C. § 6(b).

SUMMARY OF DECISION

We REVERSE.

INVENTION

Appellant's invention relates to "a game designed for competition between two opposing players." Spec. ¶ 1.

Claims 1 and 7 are independent. Claim 1 is illustrative of the claimed invention and reads as follows:

1. A method of playing a game comprising:
 - establishing, on a physical game board, a playing field marked with a two-dimensional array of spaces representing allowable positions for markers, said allowable positions being arranged in mutually perpendicular rows and columns, the field having at least eight rows and at least five columns, the playing field having first and second opposite ends to which the columns are perpendicular;
 - setting up first and second groups of movable markers on said playing field in a starting arrangement, the first group being associated with a first player and the second group being associated with a second, opposing, player, the markers of the first group being distinguishable from the markers of the second group, the markers of the first group being disposed in a pattern consisting of a number of markers in successive allowable positions in a first row closer to one of said opposite ends than to the other, an identical number of markers in successive allowable positions in a second row adjacent said first row, the second row being closer than the first row to said other end of the playing field, each marker in the first row being in the same column as an adjacent marker in the second row, and additional markers disposed in at least one V-shaped pattern, each V-shaped pattern consisting of two oblique rows extending to the

second row from an apex position spaced from the second row by at least one unoccupied space, the second group being disposed in a pattern that is a mirror image of the pattern of the first group, each apex position marker of the second group being in the same column as an apex position marker of the first group, and said rows and V-shaped patterns of the first and second groups of markers comprising substantially all of the markers on the playing field;

wherein the first and second players, taking alternating turns, move their own markers only in row-wise or column-wise directions, in each turn, a player either passes, giving up a turn, or selects a marker, and moves the same in one of three categories of moves, the categories consisting of (a) moving the marker to an adjacent unoccupied allowable space, ending the turn, (b) jumping over an adjacent marker into an unoccupied allowable space on the opposite side of said adjacent marker, ending the turn, and (c) jumping over an adjacent marker into an unoccupied allowable space on the opposite side of said adjacent marker, and continuing to jump one or more adjacent markers into unoccupied spaces on the opposite sides thereof;

wherein each player removes jumped markers from the field if the jumped markers are associated with the other player; and

wherein, at a mutually agreed upon time or under mutually agreed-upon conditions, the player who has jumped and removed the larger number of the opponent's markers is considered a winner.

ANALYSIS

The Non-Statutory Subject Matter Rejection

The Examiner determined that the subject matter of claims 1–6, 9, and 10 does not pass the machine-or-transformation test and concluded that this weighs against the claims being directed to statutory subject matter. *See* Ans. 8–12. The Examiner considers that the steps of independent claim 1 “are abstract ideas because they simply instruct how business should be

conducted.” *Id.* at 5. According to the Examiner, “no particular machine is required to perform the claimed method steps, nor do the steps result in any transformation of a particular article.” *Id.* Thus, although the Examiner acknowledges that claim 1 includes “reciting a number of physical steps of moving game pieces,” nonetheless, Appellant’s claim 1 is “a clear attempt to claim an abstract idea in the form of a new set of rules for playing a board game.” *Id.* Thus, the Examiner concludes that because “the claimed method requires no machine implementation, requires no transformation of a particular article and is seen as an attempt to receive patent protection for an abstract idea in the form of [] new rules . . . the claimed method is not patent eligible.” *Id.* at 5–6.

In contrast to the Examiner’s position, Appellant contends that method claim 1 does pass the machine-or-transformation test. According to Appellant, “[t]he ‘physical game board’ and the ‘first and second groups of movable markers’ constitute a machine in the same sense that the combination of components in any other physical apparatus constitutes a machine.” Br. 17. Furthermore, Appellant contends that transformation takes place as “a change or series of changes in the relative positions of the movable markers on the board.” *Id.* at 20.

The Supreme Court has set forth “a framework for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts.” *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2355 (2014) (citing *Mayo Collaborative Servs. v. Prometheus Labs, Inc.*, 132 S. Ct. 1289, 1294 (2012)). According to the Supreme Court’s framework, we must first determine whether the claims at issue are directed to one of those concepts (i.e., laws of

nature, natural phenomena, and abstract ideas). *Id.* If so, we must secondly “consider the elements of each claim both individually and ‘as an ordered combination’ to determine whether the additional elements ‘transform the nature of the claim’ into a patent-eligible application.” *Id.* The Supreme Court characterizes the second step of the analysis as “a search for an ‘inventive concept’ — *i.e.*, an element or combination of elements that is ‘sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself.’” *Id.*

The Examiner determined, and we agree, that the steps of independent claim 1 “are abstract ideas because they simply instruct how business should be conducted.” Ans. 5. This determination supports the Examiner’s conclusion that, claim 1 is directed to patent-ineligible subject matter. Following the framework set forth in *Alice*, we determine that independent claim 1 is directed to instructions to players to apply the abstract rules of playing a type of board game. Abstract intellectual concepts are not patentable. *Parker v. Flook*, 437 U.S. 584, 589 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 67–68 (1972). Having determined that claim 1 is directed to a patent-ineligible concept, we must secondly consider the elements of claim 1 individually and as an ordered combination to determine whether the additional elements of the claim transform the nature of the claim into a patent-eligible application.

Method claim 1 includes two steps for playing a board game and a set of rules to be followed by players when playing the board game. *See* App. Br. 32–35, Claims App. The steps include: (1) establishing on a physical game board a marked playing field of a two-dimensional array of spaces and (2) setting up on the playing field, in a specific manner, first and second

distinguishable groups of movable markers associated with first and second players, respectively. *See id.* Although we appreciate the Examiner’s position that the steps of claim 1 are not performed by a particular machine and do not result in any transformation of a particular article, nonetheless, according to Supreme Court precedents, the machine-or-transformation test “is not the sole test for deciding whether an invention is a patent-eligible ‘process.’” *Bilski v. Kappos*, 130 S. Ct. 3218, 3227 (2010). In this case, even though the “wherein” limitations of claim 1 describe an abstract idea, i.e., rules, nonetheless, the “setting up” step of first and second distinguishable groups of movable markers, in the claimed manner, “add[s] a degree of particularity,” such as to “‘transform’ the claimed abstract idea into [] patent-eligible [subject matter].” *Alice* at 2357 (quoting *Mayo* at 1298). In other words, the “setting up” step “‘transform[s] the nature of the claim’ into [] patent-eligible [subject matter].” *See id.* at 2355. Claim 1 thus includes “‘additional features,’” i.e., setting up of first and second distinguishable groups of movable markers in the claimed manner, that ensure the claim is “[’]more than a drafting effort designed to monopolize the [abstract idea].” *See id.* at 2357.

Furthermore, while it is true that the method steps are carried out by a human being, they are done so involving the game board and the game pieces arranged in a specific manner as set forth in the claims. The Examiner’s position that the claims are directed to nothing more than an abstract idea, in effect, is inappropriately reading limitations out of the claims.

For these reasons, we do not sustain the Examiner's decision rejecting claims 1–6, 9, and 10 under 35 U.S.C. § 101 as being directed to patent ineligible subject matter.

The Anticipation Rejection Based Upon Miller

The Examiner finds that “Miller teaches a game board with positions and differentiable sets of game pieces for players.” Ans. 6 (citing Miller, Figs. 4–6). The Examiner further finds that “[l]imitations of intended use and rules for playing do not further limit the game structure.” *Id.*

Appellant argues that although Miller teaches a game board with movable markers, Miller fails to teach “a game apparatus defined in terms of a specific starting arrangement of markers.” Br. 27. Thus, according to Appellant, “the apparatus claimed is the combination of playing field and movable markers, with the markers in a defined configuration.” *Id.*

At the outset, we do not agree with the Examiner that, “arranging game pieces on a game board in the beginning of the game only indicates how a game [player] wants to play the game and does not add any further structural features/limitations to the apparatus in claim.” *See* Ans. 12. Rather, the use of the phrase “being disposed^[2]” in claim 7 indicates a required positional relationship between the claimed markers, that is, the markers must be arranged in the claimed manner. As such, we agree with Appellant that “[t]here is no such ‘intended use’ in these claims.” Br. 27. We further agree with Appellant that “Miller’s arrangement of markers does

² An ordinary and customary meaning of the term “dispose” is “to place, distribute or arrange esp. in an orderly way.” *Merriam Webster’s Collegiate Dictionary* (10th Ed. 1997).

not correspond to the [claimed] arrangement.” *Id.* Accordingly, for the foregoing reasons, we likewise do not sustain the rejection of claims 7, 8, 11, and 12 under 35 U.S.C. § 102(b) as anticipated by Miller.

The Obviousness rejection Based Upon Wester and Syed

The Examiner finds that Wester discloses the limitations of independent claim 1, but “does not teach initial set up of game markers in the formation as claimed.” Ans. 7 (citing Wester, Figs. 5–6). The Examiner further finds that Syed teaches a method of playing a board game that “allows players to select any suitable arrangement (0006) of choice for initial setting of the game pieces.” *Id.* (citing Syed ¶ 6). The Examiner thus concludes that it would have been obvious to a person of ordinary skill in the art to arrange the game markers of Wester’s board game in the claimed V-shaped arrangement to make the game both challenging and attractive because “Syed teaches the concept of selecting any suitable arrangement as an initial setting.” *Id.* at 7–8.

Appellant argues that although the claimed initial arrangement of the game markers is possible in a prior art game, nonetheless, the probability that a random arrangement of the game markers would result in the claimed arrangement is so low that the starting arrangement could not have been obvious. Br. 21–22.

In response, the Examiner considers Appellant’s argument “as ‘applicant’s admission’ and an affirmation of examiner[’]s motivation in the obviousness reasoning in Syed even though in low probability.” Ans. 13.

At the outset, we do not agree with the Examiner that Appellant admits that the claimed arrangement would have been obvious to a person of

ordinary skill in the art. Rather, Appellant is taking the position, and we agree, that although Wester's game markers can be arranged in the claimed manner, this does not mean that every arrangement is obvious to try, without evidence or reasoning tending to demonstrate the obviousness of the *particularly* claimed configuration. In other words, while the Examiner's position appears to be that any initial setup arrangement of Wester's game markers would have been obvious in view of Syed's teaching, the Examiner fails to make any finding as to the particular type of initial set-up arrangement called for in the claim, namely, a V-shaped arrangement. We thus find that the Examiner's conclusion of obviousness is not supported by facts, and thus, cannot stand. *See In re Warner*, 379 F.2d 1011, 1017 (CCPA 1967). Moreover, the Examiner has not provided evidence or reasoning to suggest that the possible approaches to solve the problem are "known and finite" or that one of ordinary skill had "good reason to pursue the known options within his or her technical grasp." *See Takeda Chem. Indus., Ltd. v. Alphapharm Pty., Ltd.*, 492 F.3d 1350, 1359 (Fed. Cir. 2007) (discussing the requirements of an "obvious to try"-type obviousness rejection) (internal quotations and citation omitted).

Furthermore, we do not agree with the Examiner's finding that, "it is *inherently* possible for a player to arrange game pieces i[n] a certain way as suggested in applicant's claim 1." Ans. 13 (emphasis added). "Inherency . . . may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999) (internal quotations and citations omitted). The Examiner's finding does not go far

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enough to show that the claimed V-shaped arrangement is *necessarily* present in the gaming method of Wester as modified by Syed.

Accordingly, for the forgoing reasons, we also do not sustain the rejection under 35 U.S.C. § 103(a) of claims 1–6, 9, and 10 as unpatentable over Wester and Syed.

SUMMARY

We REVERSE the the Examiner’s decision to reject claims 1–6, 9, and 10 as directed to non-statutory subject matter.

We REVERSE the Examiner’s decision to reject claims 7, 8, 11, and 12 as anticipated by Miller.

We REVERSE the Examiner’s decision to reject claims 1–6, 9, and 10 as unpatentable over Wester and Syed.

REVERSED

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