UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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Ex parte MALCOLM COLIN PAYNE

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Appeal 2013-000735
Application 12/858,276
Technology Center 3700

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Before JAMES T. MOORE, STEVEN D. A. MCCARTHY, and BRETT C. MARTIN, *Administrative Patent Judges*.

Opinion for the Board filed by *Administrative Patent Judge* MARTIN.

Opinion Concurring filed by *Administrative Patent Judge* McCARTHY.

MARTIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134 from a rejection of claims 1–10. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

CLAIMED SUBJECT MATTER

The claims are directed to "a card game having a novel payout structure." Spec. ¶ 2. Claim 1, reproduced below, is illustrative of the claimed subject matter:

1.   A method of playing a card game including the steps of:
defining a set of qualifying card combinations;
defining a payoff ratio for each of the qualifying card combinations;
accepting a wager of a first value;
providing a dealer a set of cards;
providing a player a set of cards;
determining if the dealer's set of cards contains a qualifying card combination from the set of qualifying card combinations and if the dealer has more than one qualifying card combination, then determining the dealer's qualifying card combination of greatest value, and if the dealer has only one qualifying card combination, then declaring the one qualifying card combination to be the card combination of greatest value;
determining if the player's set of cards contains at least one qualifying card combination from the set of qualifying card combinations;
if the player's set of cards contains at least one qualifying card combination from the set of qualifying card combinations and the dealer's set of cards contains a qualifying card combination from the set of qualifying card combinations, then determining the player's greatest qualifying combination and determining if the player's greatest qualifying card combination is greater than the dealer's card combination of greatest value; and if the player's greatest qualifying combination is greater than the dealer's card combination of greatest value, then paying the player the amount given by multiplying the first value by the payoff ratio associated with the player's greatest qualifying combination and paying the player an amount given by multiplying the first value and the payoff ratio associated with any second qualifying combination, if present, in the player's hand regardless of the relative value of the second qualifying combination to the dealer's qualifying combination.

REFERENCES

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Efremov	US 2004/0248635 A1	Dec. 9, 2004
Mathis	US 2006/0030400 A1	Feb. 9, 2006
Snow	US 2008/0111308 A1	May 15, 2008

REJECTIONS

Claim 1–10 stands rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. Ans. 4.

Claims 1, 2, 5, and 7–10 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Efremov. Ans. 5.

Claim 3 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Efremov and Mathis. Ans. 6.

Claims 4 and 6 stand rejected under 35 U.S.C §103(a) as being unpatentable over Efremov and Snow. *Id.*

OPINION

Conditional Claim Language

We first note that the claims at issue contain various if/then statements that do not encompass the entirety of the potential options. For instance, the claims do not recite what to do if the player's hand has no qualifying card combinations, only what to do if it does. Presumably if no qualifying combination exists, then the player loses his or her bet and play ends for that player. A conditional claim element that is answered in the negative essentially does not exist for the purposes of infringement/invalidity. *See Ex*

Parte Katz, 2010-006083, 2011 WL 514314, *4 (BPAI 2011) (agreeing "with the Examiner that the 'if condition' as employed in the method claim 1 is not a limitation against which prior art must be found").

To elaborate, claim 1 only requires certain steps to be performed "if" the dealer and/or the player has a qualifying card combination. If both the dealer and player have no qualifying card combination, the "defining," "accepting," "providing," and "determining" steps, i.e., the first seven of the nine steps, may all be met and the final two "if" statements may never actually be called into existence. Accordingly, in considering patentability of claim 1, the last two "if" statements, if found to be in the negative (such as in a losing hand situation as described in Efremov), may be considered a nullity for all intents and purposes.

Claim construction is a question of law which is generally reviewed *de novo. In re Donaldson Co.,* 16 F.3d 1189, 1192 (Fed. Cir. 1994) (en banc). Consequently, we are not limited to the Examiner's findings and conclusions with respect to claim construction. *Id.* As such, we construe the "if" clauses of claim 1 as conditional method steps that may not be invoked. Thus, a patentability analysis does not require any finding of such disclosure in the prior art. In this case the Appellant argues only limitations found in the final "if" statement and does not argue that Efremov fails to teach the first seven steps, which the Examiner does find. Ans. 5.

Anticipation by Efremov

Turning to the rejection the Examiner has made regarding the "if" statements, the Appellant asserts that the "presented rejection fails to present a rejection of every limitation." App. Br. 5. According to the Appellant, the Examiner's citation to paragraph 23 of Efremov is insufficient to teach

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portions of the second "if" statement that relate to a second qualifying combination. App. Br. 5. The Appellant further explains that the Examiner's additional reference to paragraph 32 is improper because that portion of Efremov requires that both the first and second combinations be winning combinations, whereas the claims require only a winning combination and a second qualifying combination that may or may not be winning if it were alone. *Id.*

While we agree with the Appellant that paragraph 32 does not appear to meet the claim limitation at issue, we note that Efremov does further elaborate on this second combination later in the patent in a manner that appears to meet the claim language:

> If, in addition to the winning combination, there is a second playing combination, it also pays out. The second combination must include a card that wasn't included in the primary combination.

Efremov ¶ 155. With this additional description, Efremov differentiates the second combination as simply being a "playing combination" that "pays out" as opposed to describing it as a winning combination. Directly prior to paragraph 154, Efremov provides a table explaining what card combinations constitute "accepted playing combinations" and provides the payout ratios for each of them.

We believe that the language the Appellant relies upon refers to the second combination as "winning" in paragraph 32 because it results in a payout, which would be considered "winning" to a player. When describing this in more detail, Efremov explains that the second combination does not necessarily have to be winning as compared to the dealer's hand, as would

be required of the first combination, but may simply be any of the previously listed "accepted playing combinations."

We do not consider this to warrant a new ground of rejection because it merely elaborates on the basis already stated by the Examiner. A reference is considered in its entirety for what it fairly suggests to one skilled in the art. *In re Wesslau*, 353 F.2d 238, 241 (CCPA 1965). The Appellant has not asserted that Efremov fails to teach the limitation at issue, merely that the portions cited by the Examiner are insufficient to meet the claimed limitation. Because the further clarification that does meet the claimed limitation appears within the same reference, we deem this sufficient to support the Examiner's rejection. Accordingly, we sustain the anticipation rejection of claim 1.

The Appellant states that "all of claims 2-10 stand and fall with claim 1." App. Br. 5. Accordingly, the Appellant relies on the arguments presented for the patentability of claim 1 alone in rebutting the various rejections of claims 2–10. As such, the disposition of the rejections of claims 2–10 turns on our analysis of the rejection of claim 1. We, therefore also sustain the additional anticipation rejections of claims 2, 5, and 7–10 as well as the obviousness rejections of claims 3, 4, and 6.

§ 101 Rejection

Because our affirmance of the art-based rejections of claims 1–10 discussed *supra* is dispositive as to each claim on appeal, we do not reach the Examiner's cumulative rejection of claims 1–10 as directed to non-statutory subject matter under 35 U.S.C. § 101. *See* 37 C.F.R. § 41.50(a)(1) (2012) ("The affirmance of the rejection of a claim on any of the grounds

specified constitutes a general affirmance of the decision of the examiner on that claim, except as to any ground specifically reversed.").

DECISION

The Examiner's rejection of claims 1–10 is affirmed.

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).

AFFIRMED

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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Ex parte MALCOLM COLIN PAYNE

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Appeal 2013-000735
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Before JAMES T. MOORE, STEVEN D.A. McCARTHY and
BRETT C. MARTIN, *Administrative Patent Judges*.

McCARTHY, *Administrative Patent Judge*, concurring.

I agree with my colleagues that the Examiner correctly rejects claim 1 under pre-AIA 35 U.S.C. § 102(b) as being anticipated by Efremov. Because the Appellant expressly concedes that the dependent claims stand or fall with claim 1 (*see* Br. 5), we sustain the rejection of those claims as well. Because we sustain the Examiner's rejection of claim 1 under § 102(b), we do not reach the rejection of the claims under pre-AIA 35 U.S.C. § 101.

The Examiner finds that the game described in part in paragraphs 139–42 of Efremov, supplemented by paragraphs 23 and 24, and claim 40, of Efremov, satisfies all of the limitations of claim 1. (*See* Final Off. Act. 3). The Appellant argues that Efremov fails to describe the limitation:

> if the player's greatest qualifying combination is greater than the dealer's card combination of greatest value, . . . paying the player an amount given by multiplying the first value and the payoff ratio associated with any second qualifying combination, if

> present, in the player's hand *regardless of the relative value of the second qualifying combination to the dealer's qualifying combination.*

(Br. 4 (emphasis in original)). Paragraph 155 of Efremov indicates that the Examiner correctly finds that the game described in part in paragraphs 139–42 of Efremov does satisfy this limitation, even if the Examiner fails to cite the paragraph expressly. At the very least, paragraph 155 of Efremov indicates that one of ordinary skill in the art was in possession of a version of the game cited by the Examiner that satisfied the limitation at issue. On this basis, the rejection of claim 1 under § 102(b) is sustained.

As an alternative to the Examiner's reasoning, a prior art patent anticipates a method claim if the claim reads on a method described in the patent. *See Brown v. 3M*, 265 F.3d 1349, 1351 (Fed. Cir. 2001). Claim 1 recites a method. The claim conditions the performance of certain steps of that method on the occurrence of recited conditions precedent. The Appellant does not contest the Examiner's finding that the unconditional limitations of claim 1 read on that the game described in part in paragraphs 139–42 of Efremov. I agree with my colleagues that a round of the game described in part in paragraphs 139–42 of Efremov may fail to satisfy the conditions precedent for the performance of the remaining steps of the claimed method. These facts suffice to find that Efremov anticipates claim 1 independently of the Examiner's decision to reject claim 1.

Our alternative reasoning is based on our finding that claim 1 reads on the game described in part in paragraphs 139–42 of Efremov. The alternative reasoning does not require us to consider any claim limitation a "nullity." It is my understanding that we are affirming the rejection of claim 1 because the Appellant has failed to identify an error in the Examiner's

findings and reasoning. Our affirmance is not dependent on our alternative reasoning based on the presence of conditional limitations in claim 1. On the basis of this understanding, I join my colleagues' decision.