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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JUSTIN PETERSON

Appeal 2013-002891
Application 12/509,234¹
Technology Center 3700

Before STEFAN STAICOVICI, MICHAEL L. HOELTER, and
THOMAS F. SMEGAL, *Administrative Patent Judges*.

SMEGAL, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Justin Peterson (Appellant) seeks our review under 35 U.S.C. § 134 of the Examiner's Non-Final Rejection of claims 1–5, 9, and 10. Claims 6–8 have been withdrawn. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM and enter a NEW GROUND OF REJECTION pursuant to 37 C.F.R. § 41.50(b).

¹ According to Appellant, the real party in interest is the inventor, Justin Peterson. Br. 3.

CLAIMED SUBJECT MATTER

Appellant's invention relates to a board game where “a chance device controls the amount of movement of a token along a track.” Spec. ¶ 1.

Claims 1 and 9 are independent. An understanding of the invention can be derived from a reading of independent claim 1, which is reproduced below, with emphasis on the key disputed claim limitation.

1. A method of playing a board game teaching that money isn't everything, comprising the actions of:
 - a) providing game apparatus comprising:
 - a playing surface having a path divided into discrete steps with various designated game events associated with steps of the path, a plurality of representations of a pecuniary currency, a plurality of representations of a second, non-pecuniary currency, representative of a personal attribute;
 - b) placing tokens representative of each player on an initial step;
 - c) advancing tokens along the path in accordance with results from chance device and designated events associated with particular spaces;
 - d) gaining or losing of amounts of a player's pecuniary currency determined by designated events representative of life choices and life occurrences;
 - e) gaining or losing of amounts of a player's non-pecuniary currency determined by designated events representative of life choices and life occurrences;
 - f) designating a neutral repository of said currencies as a bank;
 - g) making inter-currency exchanges according to the following rules:
 - allowing exchanges with the bank, at player's option, of non-pecuniary currency for pecuniary currency; prohibiting a player exchanging with the

bank of pecuniary currency for non-pecuniary
currency unless permitted be a designated event;
h) *eliminating a player from winning the game if that
player's non-pecuniary currency reaches a predetermined
cutoff value, independent of amounts of pecuniary currency.*

Brief 13–14, Claims App.

REJECTIONS ON APPEAL

The following Examiner's rejections are before us for review.

1. Claims 1–5, 9, and 10 are rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter. Non–Final Act. 3.
2. Claims 1–5, 9, and 10 are rejected under 35 U.S.C. § 102(b) as being anticipated by Wilkins (US 5,810,359, iss. Sept. 22, 1998. Non–Final Act. 3.
3. Claims 1–5, 9, and 10 are rejected under 35 U.S.C. § 102(b) as being anticipated by Breslow (US 3,759,521, iss. Sept. 18, 1973). Non–Final Act. 3.
4. Claims 1–5, 9, and 10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Breslow or Wilkins. Non–Final Act. 4.

ANALYSIS

Non-statutory subject matter

Claims 1–5

Claim 1 recites a method of playing a board game in which players are eliminated from the game when their non-pecuniary currency reaches a predetermined cutoff value. Brief 14, Claims App. In rejecting the claims under 35 U.S.C. § 101, the Examiner applied the law of patentable subject

matter as it existed on January 23, 2012 (the mailing date of the Non-Final Rejection). The Examiner analyzed the claims under the “machine or transformation test”², determining that the claims are directed to non-statutory subject matter, because the “[c]laims do not require [that the] method be implemented by a particular machine and [the] claims do not particularly require transformation of a particular article during the process.” Non-Final Act. 3.

In particular, the Examiner considered that “[t]he claimed steps in playing a board game are abstract ideas because they simply instruct how business should be conducted. For example, they constitute rules that may be applied for moving game pieces on a game surface selected from infinite number of possible hypothetical ways game pieces may move. In playing a board game there is no concrete (repeatable) result or tangible (real world) result.” *Id.* at 5.

Furthermore, the Examiner finds that

no particular machine is required to perform the claimed method steps, nor do the steps result in any transformation of a particular article, are clear indicators that [applicants] are attempting to patent an abstract idea. None of the steps are performed by a machine, but rather are performed by a human being. Rolling dice, spinning a spinner and selecting a card as a chance selection do not transform dice, spinner or cards. The steps are performed by human being following instructions or abstract rules. Since dice, spinner or cards do not actually perform these steps it is clearly abstract instructions.

² According to the machine or transformation test, a claimed process can be patent-eligible under § 101 if: “(1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing.” See *In re Bilski*, 545 F.3d 943,954 (Fed.Cir.2008) (en banc), *aff’d on other grounds*, *Bilski v. Kappos*, 130 S.Ct. 3218 (2010).

Id. at 6

The Examiner also determines out that

Since 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 a new set of rules, *the examiner takes the position* that the claimed method is not patent eligible.

Id. at 7. (emphasis added). *See also* Answer 9–12.

Appellant first argues that the Examiner bases the rejection “solely on the machine or transformation test as if that is strictly required for a claimed process to be statutory.” Brief 6–7. Appellant acknowledges that the machine or transformation test “provides a valuable clue to a more central question of the claiming of an abstract idea.” Brief 7. However, Appellant contends that “[e]ven if the examiner had made a logical argument that a method of playing a board game is somehow analogous with ‘instruction on how a business is conducted’, there is no rule or precedent cited that states that instruction on conducting business is per-se un-statutory.” *Id.*

Appellant also argues that “**[t]he claims require the use of a random number generator, a specific machine**” that “precludes the claimed steps from being performed as a complete mental process” *Id.* at 7. Thus, Appellant asserts that the claims satisfy the machine-or-transformation test because claim 1 contains the limitation “in accordance with results from chance device” that “inherently requires the presence and use of a chance device” which “is a specific machine.” Brief 9.

However we agree with the Examiner that

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. [The c]laimed method steps are abstract ideas because they simply instruct how business should be conducted.

Answer 11. (emphasis added). We also agree with the Examiner that “[i]n playing a board game the steps are performed by individual human beings and not by a machine.” *Id.*

The Examiner explains the rationale for finding that the claims recite an abstract idea, i.e., that is ineligible subject matter under 35 U.S.C. §101, is based upon application of the interim guidelines identified at page 9 of the Answer. With those guidelines in mind, the Examiner has provided a thorough evaluation of the factors that weigh toward and against eligibility under § 101. *See* Answer 10–12.

Based on that evaluation, the Examiner concludes that

Since 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 a new set of rules*, the examiner takes the position that the claimed method is not patent eligible.

Id. at 12. (emphasis added). We agree, further noting that Appellant does not respond to the Examiner’s determination that the claims are directed to an abstract idea in the form of a new set of rules.

Since the date of the Examiner’s Answer, 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, one must first determine whether the claims at issue are directed to one of those patent-ineligible concepts (i.e., laws of nature, natural phenomena, and abstract ideas). *Id.*

Having made that determination, according to the framework set forth in *Alice*, we must now “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.*

Here, independent claim 1 is directed to a method of playing a board game “teaching that money isn’t everything,” including a series of steps for playing the game. *See* Brief 3–5, Claims App. However, when a claim recites an abstract idea, it must include “additional features” [that] must be more than ‘well-understood, routine, conventional activity.’” *Ultramercial, Inc. v. Hulu, LLC*, 772 F. 3d. 709, 715 (Fed. Cir. 2014). Here Appellant has not persuasively argued that moving tokens relative to a game board based on randomly generated numbers and rules is not conventional practice in the playing of any board game.

Thus, we find that reciting multiple routine, conventional steps, including “providing a game apparatus with a playing surface divided into a path with discrete steps for movement of tokens;” “placing tokens” on an initial step; “advancing tokens along the path in accordance with a chance device;” “gaining or losing pecuniary and non-pecuniary currency as a result

of token advancement;” “making inter-currency exchanges;” and “eliminating a player who’s non-pecuniary currency rises to a predetermined cutoff value,” is insufficient to transform an abstract idea into patent-eligible subject matter. *See Alice*, 134 S. Ct. at 2357–60.

In addition, the claim recitations appear to merely be an attempt to limit the use of the abstract idea of following the rules of the board game and the abstract idea of “teaching that money isn’t everything,” “to a particular technological environment.” *See Bilski*, 130 S.Ct. at 3230. This is insufficient to transform an otherwise abstract idea into patent-eligible subject matter. Thus, we find that the claimed steps do not provide an “inventive concept” sufficient to transform the recited method into patent-eligible subject matter. *Bilski*, 130 S. Ct. at 3230-31.

For these reasons, we agree with the Examiner that claims 1–5 are directed to non-statutory subject matter. However, because our analysis differs from the Examiner’s, we designate our affirmance of the Examiner's rejection as a new ground of rejection pursuant to 37 C.F.R. §41.50(b) to provide Appellant with a fair opportunity to respond.

Claims 9 and 10

Appellants have not presented any separate argument for claims 9 and 10, which unlike claim 1, are not limited to the use of a random number generator, i.e., a “chance device”, or any of the other method steps recited by claim 1, but merely recites the mental step of “encountering simulations of life events.” Thus, we summarily affirm the Examiner’s rejection of claims 9 and 10 as directed to non-statutory subject matter.

Anticipation of claims 1–5, 9 and 10 by Wilkins

Claims 1–5

We are persuaded by Appellant’s arguments that the Examiner failed to establish a prima facie showing of anticipation in rejecting claims 1–5 over Wilkins.

The Examiner finds that Wilkins teaches the method steps of claim 1 including “eliminating player for being bankrupt.” Non-Final Act. 4. The Examiner also determines that the term “non-pecuniary currency” is open to an interpretation that “‘getting out of jail’ or ‘avoiding being bankrupt’ can be treated as non-pecuniary value.” Answer 6.

However Appellant contends that the Examiner’s reliance on “[e]limination by going bankrupt . . . as fulfilling the requirement of elimination by a non-pecuniary currency reaching a predetermined limit” is misplaced, pointing out that “[t]o the contrary, by definition, bankruptcy is related to a lack of monetary (pecuniary) currency.” Brief 12. We agree. Furthermore we note that Wilkins is consistent with Appellant’s contention in teaching that “[a] player is ‘Bankrupt’ if the player owes more [money] than the player can pay either to another player or to the Bank.” *See Wilkins*, col. 9, ll. 53–54.

[U]nless a reference discloses within the four corners of the document not only all of the limitations claimed but also all of the limitations arranged or combined in the same way as recited in the claim, it cannot be said to prove prior invention of the thing claimed and, thus, cannot anticipate under 35 U.S.C. § 102.

Net MoneyIN, Inc., v. VeriSign, Inc., 545 F.3d 1359, 1371 (Fed. Cir. 2008).

For the foregoing reasons, we do not sustain the Examiner's rejection of claims 1–5 as anticipated by Wilkins.

Claims 9 and 10

We have considered Appellant's arguments raised in the Brief, but do not find them persuasive to demonstrate error in the Examiner's rejection of independent claim 9 and dependent claim 10 as anticipated by Wilkins. In particular, we are unable to identify the "relevant limitation of claim 9" to which Appellant refers at page 12 of the Brief.

In contrast to claim 1, claim 9 does not contain the limitations which formed the basis for our not sustaining the Examiner's rejection of claims 1–5 as anticipated by Wilkins. Instead, claim 9 merely recites a "second currency representative of an aspect of a player's simulated ... mental, well-being" Brief 15, Claims Appendix.

In determining the scope of patent claims, we give claims their "broadest reasonable interpretation consistent with the specification" and "in light of the specification as it would be interpreted by one of ordinary skill in the art." *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004) (citations omitted). It is Appellant's burden to precisely define the invention, not the PTO's. *In re Morris*, 127 F.3d 1048, 1056 (Fed. Cir. 1997). In this case, Appellant has not pointed to a lexicographic definition of "second currency" in the Specification or provided any other disclosure that would limit that term from including non-pecuniary currency, or precluding the Examiner from finding that "'getting out of jail' or 'avoiding

being bankrupt' can be treated as [having] non-pecuniary value.”
Non-Final Act. 4.

We agree with the Examiner that Wilkins “teaches non-pecuniary currency as in players obtaining deeds, other properties and benefits during the game”, that “Wilkins ['] cards Fig. 4, 5, 2a-3b are related to events related to experiences in real life” and that “it can be seen that these articles [which] clearly indicate words (get out of jail, advance [on board]) essentially means these are non-pecuniary related events.” Answer 13-14.

For the foregoing reason, we sustain the Examiner’s rejection of claims 9 and 10 as anticipated by Wilkins.

Anticipation of claims 1-5, 9, and 10 by Breslow

Claims 1-5

We are persuaded by Appellant’s arguments that the Examiner failed to establish a prima facie showing of anticipation in rejecting claims 1-5 over Breslow.

The Examiner finds that Breslow teaches the method steps of claim 1 including “eliminating player by rule (2:8-15).” Non-Final Act. 3. However, the Examiner misreads Breslow. As Appellant correctly points out, the section of Breslow cited by the Examiner reads “elimination of all of the player’s bad trait cards”, thus teaching “elimination[s] of the effect of bad trait cards which has no correspondence to the ‘elimination of players’ element of the present application's claims.” Brief 11.

For the foregoing reasons, we will not sustain the Examiner’s rejection of claims 1-5 as anticipated by Breslow. *See Net MoneyIN*, 545 F.3d at 1371.

Claims 9 and 10

Because we affirm the rejection of claims 9 and 10 under 35 U.S.C. § 102(b) as anticipated by Wilkins, as discussed *infra*, we find it unnecessary to also reach a decision about the cumulative rejection of claims 9 and 10 as anticipated by Breslow. *See* 37 C.F.R. § 41.50(a)(1) (“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”).

Obviousness of claims 1–5, 9, and 10 over Breslow or Wilkins

Claims 1–5

We are also persuaded that the Examiner failed to establish a *prima facie* showing of obviousness in rejecting claims 1–5 under 35 U.S.C. § 103(a) as being unpatentable over either Breslow or Wilkins.

As with the anticipation rejections, the Examiner finds that

[T]he cited references are related to events related to experiences in real life. In order to make the game attractive to potential players it would have been obvious to modify to include events related to well being, health and state of a person. One of ordinary skills in art at the time the invention was made would have suggested modifying the theme to attract potential players.

Non-Final Act. 5.

However, Appellant contends that “Breslow teaches away from this by using gain of ‘good traits’ to engender winning rather than the loss of health or health related measure as the determinative event that engenders losing [sic] the game.” Brief 13. Similarly, Appellant contends that

“Wilkins, as do most board games, teaches far away from this by using the loss of all money as the determinative event that engenders losing [sic] the game.” *Id.* We agree that the Examiner’s reasoning lacks rational underpinnings. In *KSR Int’l Co. v. Teleflex Inc.*, the Supreme Court stated that “rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *See KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007).

Accordingly, for the forgoing reasons, we also do not sustain the rejection under 35 U.S.C. § 103(a) of claims 1–5 over Breslow or Wilkins.

Claims 9 and 10

Because we affirm the rejection of claims 9 and 10 under 35 U.S.C. § 102(b) as anticipated by Wilkins, as discussed *infra*, we find it unnecessary to also reach a decision about the cumulative rejection of claims 9 and 10 under 35 U.S.C. § 103(a) as unpatentable over either Breslow or Wilkins. *See* 37 C.F.R. § 41.50(a)(1) (“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 . . .”).

DECISION

The rejection of claims 1–5, 9, and 10 under 35 U.S.C. § 101 is AFFIRMED.

The rejection of claims 1–5 as anticipated by either Wilkins or Breslow under 35 U.S.C. § 102(b) is REVERSED.

The rejection of claims 9 and 10 as anticipated by Wilkins under 35 U.S.C. § 102(b) is AFFIRMED.

The rejection of claims 1–5 as obvious over either Wilkins or Breslow under 35 U.S.C. § 103(a) is REVERSED.

We do not reach the rejection of claims 9 and 10 as anticipated by Breslow under 35 U.S.C. § 102(b) or as obvious over either Wilkins or Breslow under 35 U.S.C. § 103(a).

For the reasons set forth above, pursuant to 37 C.F.R. § 41.50(b) we designate the decision to affirm the Examiner’s rejection of claims 1–5 under § 101 to be a NEW GROUND OF REJECTION, because it contains a new rationale for affirmance.

Regarding the affirmed rejection(s) that have not been denominated as new grounds of rejection, 37 C.F.R. § 41.52(a)(1) provides that “Appellant[s] may file a single request for rehearing within two months from the date of the original decision of the Board.” In addition to affirming the Examiner’s rejection(s) of one or more claims, this decision contains NEW GROUNDS OF REJECTION pursuant to 37 C.F.R. § 41.50(b). Section 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.” Section 41.50(b) also provides that Appellants, WITHIN TWO MONTHS FROM THE DATE OF THE 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 . . .

Should Appellants elect to prosecute further before the Examiner pursuant to 37 C.F.R. § 41.50(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the Examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If Appellants elect prosecution before the Examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Patent Trial and Appeal Board for Final Action on the affirmed rejection, including any timely request for rehearing thereof.

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; 37 C.F.R. § 41.50(b).

JRG