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Table with 5 columns: APPLICATION NO., FILING DATE, FIRST NAMED INVENTOR, ATTORNEY DOCKET NO., CONFIRMATION NO.
12/901.031 10/08/2010 Brian M. Yu 16725 (131) 9079

66078 7590 09/27/2016
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EXAMINER

LAYNO, BENJAMIN

ART UNIT PAPER NUMBER

3711

NOTIFICATION DATE DELIVERY MODE

09/27/2016

ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte BRIAN M. YU

Appeal 2014-006962
Application 12/901,031
Technology Center 3700

Before ANTON W. FETTING, CYNTHIA L. MURPHY, and
MATTHEW S. MEYERS, *Administrative Patent Judges*.

MURPHY, *Administrative Patent Judge*.

DECISION ON APPEAL

The Appellant¹ appeals under 35 U.S.C. § 134 from the Examiner's rejection of claims 1–11 and 16–20.² We have jurisdiction over this appeal under 35 U.S.C. § 6(b).

We AFFIRM.

¹ The Appellant identifies the real party in interest as “Mattel, Inc.” (Appeal Br. 2.)

² Claims 12–15 have been allowed. (*See* Final Action 2.)

STATEMENT OF THE CASE

The Appellant's invention relates to "[a]n educational card game to provide amusement to players." (Spec. ¶ 6.)

*Illustrative Claim*³

1. A method of playing a card game, comprising:

dealing an equal number of cards from a plurality of cards to each one of a plurality of players of the card game so that each player has a predetermined number of cards, wherein each one of the plurality of cards has a noun imprinted on a face of each one of the plurality of cards;

rolling a die having a plurality of faces imprinted with at least one character so that one of the plurality of faces is an uppermost face of the die;

announcing a word corresponding to the at least one character appearing on the uppermost face of the die, wherein at least two of the plurality of players select a card from their corresponding predetermined number of cards that complements the announced word;

determining one of the cards selected by the at least two of the plurality of players that best complements the announced word;

awarding a point to the player whose selected card was determined to best complement the announced word; and

repeating the steps of rolling, announcing, determining and awarding until a winner of the game is determined when one of the plurality of players is awarded a predetermined amount of points.

³ This illustrative claim is quoted from the Claims Appendix ("Claims App.") set forth on pages 16–22 of the Appeal Brief.

*Rejections*⁴

I. The Examiner rejects claims 1–11 and 18–20 under 35 U.S.C. § 101 as attempting to patent non-statutory subject matter. (Final Action 3.)

II. The Examiner rejects claims 16 and 17 under 35 U.S.C. § 102(b) as anticipated by Mercado-Torres.⁵ (*Id.* at 5.)

ANALYSIS

Claims 1, 8, and 16 are the independent claims on appeal. (Claims App.) Independent claims 1 and 8 each recites “[a] method of playing a card game,” and independent claim 16 recites “[a] game.” (*Id.*) Claims 2–7 and 18–20 depend directly or indirectly from independent claim 1; claims 9–11 depend directly or indirectly from independent claim 8; and claim 17 depends directly from independent claim 16. (*Id.*)

Rejection I

Independent claim 1 recites the steps of “dealing” cards having nouns imprinted thereon, “rolling a die,” “announcing a word” corresponding to “[a] character appearing on the uppermost face of the die,” “determining” which card “best complements the announced word,” and “awarding a point to the player whose selected card was determined to best complement the announced word.” (Claims App.) Independent claim 8 recites similar dealing, rolling, identifying, choosing, determining, and awarding steps. (*Id.*) The Examiner determines that these claimed methods are “an attempt to claim a new set of rules for playing a card game” which is “an abstract

⁴ The Examiner’s rejection of claims 8–11 under 35 U.S.C. § 112 (*see* Final Action 7) has been withdrawn (*see* Answer 9).

⁵ US 4,966,366 issued October 30, 1990.

idea.” (Answer 5, emphasis omitted.) The Examiner also determines that the additional elements recited in these claims “are not considered to impose a meaningful limit on the abstract idea attempting to be claimed.” (Final Action 5, emphasis omitted.)

The Appellant argues that the methods recited independent claims 1 and 8 amount to more than merely abstract ideas, and thus qualify as patent-eligible subject matter. (Appeal Br. 8, 12.) We are not persuaded by the Appellant’s position because, although the Examiner’s rejection was couched in pre-*Alice* guidelines, the Examiner’s findings are sufficient to satisfy the now-applicable two-step *Alice* analysis.⁶ And the Appellant does not adequately address why the Examiner’s *Alice*-pertinent findings are incorrect, incomplete, unsupported, or otherwise deficient.

Regarding the first step of the *Alice* analysis (i.e., determining whether the claims at issue are directed to a patent-ineligible concept), as indicated above, the Examiner characterizes the claimed methods as “a new set of rules for playing a card game.” (Answer 5, emphasis omitted.) The

⁶ The Examiner applied the Interim Guidance (discussing *Bilski v. Kappos*, 561 U.S. 593 (2010)) which was developed before the United States Supreme Court issued its decision in *Alice Corp. v. CLS Bank International*, 134 S. Ct. 2347 (2014). In *Alice*, the Supreme Court reiterated the two-step framework previously set forth in *Mayo Collaborative Services v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1300 (2012), “for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of these concepts.” *Alice*, 134 S. Ct. at 2355. The first step in the analysis is to “determine whether the claims at issue are directed to one of those patent-ineligible concepts.” *Id.* If so, the second step is to consider the elements of the claims “individually” and “as an ordered combination” to determine whether there are additional elements that “transform the nature of the claim” in a patent-eligible application. *Id.* (quoting *Mayo*, 132 S. Ct. at 1297).

Specification also conveys that “a method of playing a card game” is provided. (Spec. ¶ 7.) Moreover, the Appellant does not assert that the claimed methods are directed to something other than a new set of rules for playing a card game. (See Appeal Br. 11–13; Reply Br. 4–6.) As such, we agree with the Examiner that the claims are directed to a new set of rules for playing a card game and thus they are directed to an abstract idea.⁷

Regarding the second step of the *Alice* analysis (i.e., determining whether there are additional elements that transform the nature of the claim in a patent-eligible application), we agree with the Appellant that the claims recite “physical elements (cards and die) to achieve performance of the method.” (Appeal Br. 8, 12.) However, we agree with the Examiner that “[c]ard games traditionally involve the use of a physical deck of cards” (Answer 5); and the Specification conveys that the claimed cards and the steps associated therewith are conventional (see Spec. ¶¶ 1–5).⁸ Further, the Appellant does not assert that, and we do not see how, the rolling of a multifaceted die somehow brings the claimed methods within patent-eligible territory. Thus, we agree with the Examiner that the additional elements

⁷ See *In re Smith*, 815 F.3d 816, 819 (Fed. Cir. 2016) wherein, ultimately, the Federal Circuit held that claims describing a set of rules for a game are to be regarded as an abstract idea; see also *Planet Bingo, LLC v. VKGS LLC*, 576 F. App’x 1005, 1008 (Fed. Cir. 2014) (non-precedential) wherein the Federal Circuit held that the claimed method of “managing a game of Bingo” was directed to an abstract idea.

⁸ The Federal Circuit has indicated that “claims directed to conducting a game using a new or original deck of cards [could] potentially surviv[e] step two of *Alice*.” *Smith*, 815 F.3d at 819. Here, however, the claimed cards appear to be the same as those used in an already popular card game. (See Spec. ¶ 1.)

recited in claims 1–11 and 18–20 do not impose meaningful limits on the abstract idea of a set of rules for playing a game. (*See* Final Action 5.)

Thus, we sustain the Examiner’s rejection of claims 1–11 and 18–20 under 35 U.S.C. § 101 as attempting to patent non-statutory subject matter.

Rejection II

As indicated above, independent claim 16 recites a “[a] game,” as opposed to a method. (Claims App.) Independent claim 16 requires this game to comprise “a plurality of game cards” and “a multifaceted die.” (*Id.*) The Examiner finds that Mercado-Torres discloses a game comprising a plurality of game cards and a multifaceted die that meet the limitations recited in claims 16 and 17. (*See* Final Action 5–6.) The Appellant does not point, with particularity, to flaws in this finding by the Examiner.

Independent claim 16 further requires the game to comprise “a rule set that includes a plurality of rules for playing the game.” (Claims App.) The Examiner considers such rules to be functional limitations and finds that the game structure disclosed in Mercado-Torres (i.e., the game cards and the die) are inherently capable of performing such functions. (*See* Answer 7–8.) In other words, the prior art components (i.e., game cards and die) could be used to play a game according to the rules recited in claims 16 and 17.

The Appellant argues that Mercado-Torres “simply does not disclose” the rules set forth in claims 16 and 17. (Reply Br. 6.) We are not persuaded by this argument because the Appellant does not adequately address the Examiner’s findings regarding inherency. The Appellant does not, for example, contend that the game cards and/or the die disclosed in Mercado-Torres do not possess the characteristics necessary to play a game according

to the recited rule set.⁹ Insofar as the recited “rule set” is intended to cover a printed set of rules, or instructions, this is not sufficient to distinguish the claimed game from the prior art.¹⁰

Thus, we sustain the Examiner’s rejection of claims 16 and 17 under 35 U.S.C. § 102(b) as anticipated by Mercado-Torres.

DECISION

We AFFIRM the Examiner’s rejections of claims 1–11 and 16–20.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

⁹ See *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997) (“Although Schreiber is correct that [the prior art reference] did not address the use of the disclosed structure [for the recited function],” the absence of such disclosure “does not defeat” a finding of anticipation).

¹⁰ See *In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004) (The Appellants is not “entitled to patent a known product by simply attaching a set of instructions to that product.”).