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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/575,075	10/07/2009	Karen A. Kucharski	KUC-2CIP	9290
20808	7590	11/23/2016	EXAMINER	
BROWN & MICHAELS, PC 400 M & T BANK BUILDING 118 NORTH TIOGA ST ITHACA, NY 14850			MENDIRATTA, VISHU K	
			ART UNIT	PAPER NUMBER
			3711	
			NOTIFICATION DATE	DELIVERY MODE
			11/23/2016	ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte KAREN A. KUCHARSKI

Appeal 2014-009409
Application 12/575,075
Technology Center 3700

Before: WILLIAM A. CAPP, LEE L. STEPINA, and
ARTHUR M. PESLAK, *Administrative Patent Judges*.

STEPINA, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134 from a rejection of claims 19–22 and 25–28.¹ We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ The Examiner indicated that claim 24 recites allowable subject matter. Final Act. 5.

CLAIMED SUBJECT MATTER

The claims are directed to a game apparatus and method. Claim 19, reproduced below, is illustrative of the claimed subject matter:

19. A method of playing a game, comprising:

providing at least one player with a plurality of game pieces, each game piece having a geometric or free-form shape, a plurality of theme indications identifying themes, at least one theme indicator having at least one of the plurality of theme indications, in which the theme indications and theme indicators do not depict the game pieces which are provided, and the theme indications and the theme indicators are not designs to be reproduced by the player, and an emission indicator having a plurality of indications for choosing one of a plurality of emissions;

playing the game by the steps of:

at least one player selecting a theme by choosing a theme indication from the plurality of theme indications;

after selecting a theme, the player selecting at least some of the plurality of game pieces and placing the selected game pieces onto a playing field;

the player combining the selected game pieces placed on the playing field, whereby the plurality of game pieces are transformed into a design created by the player which is different than a reproduction of a design on the chosen theme indication, the design being created by the player to illustrate the selected theme indicated by the chosen theme indication;

the player using the emission indicator to choose an emission to be associated with the design, and the player performing the emission.

Appeal Br. 10 (Claims App.)(emphasis added).

REJECTIONS

Claims 19–22 and 25–28 are rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter.²

OPINION

Appellant argues claims 19–22 and 25–28 as a group. *See* Appeal Br. 2–6. We take claim 19 as representative. *See* 37 C.F.R. § 41.37(c)(1)(iv).

The Examiner finds that the method recited in claim 19 is directed to an abstract idea.³ Final Act. 2. Specifically, the Examiner states:

[The c]laimed steps in playing a board/field/surface game are abstract ideas because they simply instruct how business should be conducted, for example rules that may be applied for moving game pieces on a game surface selected from infinite number of possible hypothetical ways game pieces may be moved, placed or assembled. In playing the claimed game there is no concrete (repeatable) result or tangible (real world) result. Accordingly claims are abstract ideas.

Final Act. 2.

Appellant contends that the “providing” step in claim 1 provides physical things, i.e., game pieces, theme indicators, and an emissions indicator, and “[a] method of ‘providing’ them is, therefore, patentable

² The Specification is objected to under 35 U.S.C. § 132(a) as introducing new matter. Final Act. 4. As this matter is an objection, not a rejection, we do not address this issue in this appeal. *See* MPEP § 1201.

³ The Final Office Action (dated September 19, 2013) and the Appeal Brief (dated May 29, 2014) pre-date *Alice Corp. v. CLS Bank International*, 134 S. Ct. 2347 (2014). Although the Examiner’s Answer (dated July 2, 2014) was transmitted after *Alice* was decided (June 19, 2014), the USPTO had not yet issued formal guidance on this case to Examiners at the time the Answer was transmitted, and the Answer does not discuss *Alice*.

subject matter.” Br. 3. Appellant also asserts that the recited method results in a transformation, stating “[t]he individual game pieces might not change in form, but the arrangement of the pieces as claimed does transform the random collection of pieces into a design, physical, tangible and different in form and appearance from the pieces alone.” Br. 4. Appellant further contends that the recited method “is *not* an attempt to capture or preempt all possible applications of the abstract idea of playing games (or any other unknown abstract idea), but rather is *a specific set of steps to accomplish a tangible goal, of playing a specific game using specific physical things.*” Br. 6.

To determine whether a claim is directed to ineligible subject matter, we apply the two-step test explained in *Alice*, 134 S.Ct. at 2355. First, we determine whether the claims at issue are directed to a patent-ineligible concept such as an abstract idea. *Id.* Next, we “examine the elements of the claim to determine whether it contains an ‘inventive concept’ sufficient to ‘transform’ the claimed abstract idea into a patent-eligible application.” *Id.* at 2357.

Regarding step one, we conclude that the method recited in claim 19, directed to providing game components and rules for conducting the game, compares to other practices found to be abstract by our reviewing court. *See, e.g., In re Smith*, 815 F.3d 816, 818–819 (Fed. Cir. 2016) (holding that rules for playing a game of Blackjack including providing a deck of physical playing cards, shuffling the physical playing cards to form a random set of playing cards, and resolving player versus dealer wagers based on specified rules to be a patent-ineligible abstract concept).

As for step two, we conclude that claim 19 adds no more than conventional steps normally associated with games, i.e., providing certain

game components and manipulating them according to the rules of the game. In other words, we find that the steps recited in claim 19, taken individually, and as an ordered combination, do not add enough to claim 19 to transform the recited abstract idea into patent-eligible subject matter. “[A]ppending purely conventional steps to an abstract idea does not supply a sufficiently inventive concept.” *Smith*, 815 F.3d at 819.

Smith does not provide a per se rule against the patentability of games. Specifically, *Smith* states:

That is not to say that all inventions in the gaming arts would be foreclosed from patent protection under § 101. We could envisage, for example, claims directed to conducting a game using a new or original deck of cards potentially surviving step two of *Alice*. The Government acknowledged as much during oral argument.

Id. at 819. Claim 19 recites “providing” certain physical items set forth in italics above. However, claim 19 does not define the components provided in any way that would permit the claimed subject matter to survive step two of the *Alice* test, and as discussed in *Smith*, merely providing conventional playing items such as a conventional deck of cards is insufficient. *See Smith*, 815 F.3d at 818–819. It is difficult to conceive of a game piece that is not either a free-form or geometric shape as recited in claim 19. The recited theme indications, theme indicator, and emission indicator are similarly quite broadly recited. In this regard, Appellant’s Specification states “[t]he game might have a plurality of indicators, such as a deck of cards each bearing a theme indication such that a player pulls a card from a deck to determine the theme to be illustrated.” Spec. 4, ll. 10–12; *see also* Figs. 3a and 3b. The Specification also gives examples of the recited emission indicator. *See* Spec. 6 (describing an emission indicator as a fourteen-sided

die with indications such as “title,” “sound,” and “improv” and further stating “[t]he indications could be code marks rather than the words shown in [Figure 5], and could be provided as a deck of cards bearing indicia, a digital or audio indicator, or other indicators known to the art.”). Thus, to the extent *Smith* provides a safe-harbor for claims directed to the gaming arts, based on the originality of the items used in the game, claim 19 does not fall within it.

As for the physical movement of the items to form a design and the other actions recited in claim 19, we find that nothing recited in claim 19, taken alone or as an ordered combination of steps, adds significantly more to the abstract idea to which claim 19 is directed. *See Smith*, 815 F.3d at 819 (stating “[t]he claims here require shuffling and dealing ‘physical playing cards,’ which Applicants argue bring the claims within patent-eligible territory . . . We disagree.”) (internal citations omitted). Accordingly, we affirm the Examiner’s rejection of claim 19 as directed to patent ineligible subject matter. Claims 21, 22, and 25–28 fall with claim 19.

DECISION

The Examiner’s decision to reject claims 19–22 and 25–28 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