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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JERALD B. HERREN

Appeal 2015-000359
Application 13/113,833
Technology Center 3700

Before CHARLES N. GREENHUT, JEFFREY A. STEPHENS, and
ERIC C. JESCHKE, *Administrative Patent Judges*.

STEPHENS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE¹

Appellant seeks our review under 35 U.S.C. § 134(a) from the Examiner's Final Office Action ("Final Act.") rejecting claims 1–20. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

¹ This Appeal is related to Appeal No. 2015-000165.

Claimed Subject Matter

Claim 1, reproduced below, is illustrative of the claimed subject matter.

1. A method of conducting a poker game comprising:
 - providing one or more players with one or more tangible challenge game props;
 - dealing poker hands using a randomized deck of conventional playing cards such that each player receives one or more face down playing cards forming a random poker hand comprising less playing cards than the randomized deck of conventional playing cards;
 - responsive to all but a winning player folding, allowing said one or more players to utilize said one or more tangible challenge game props to challenge a winning player at the conclusion of a poker hand;
 - requiring said winning player to reveal at least one of said one or more face down playing cards to at least a player challenging said winning player; and
 - tracking use of the one or more challenge game props by each player.

Rejections

1. Claims 1–20 stand provisionally rejected under 35 U.S.C. § 101 as claiming the same invention as claims 1–18 of co-pending Application No. 12/821,741 (“the ’741 Application”). Final Act. 2–3.²
2. Claims 19 and 20 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. *Id.* at 3–4.
3. Claims 1–20 stand rejected under 35 U.S.C. § 101 as being directed to ineligible subject matter. *Id.* at 4–12.

² The Examiner has withdrawn the alternative rejection based on nonstatutory obviousness-type double patenting in view of Appellant’s submission of a terminal disclaimer. Ans. 4.

ANALYSIS

We have reviewed the Examiner's rejections in light of Appellant's arguments. App. Br. 8–13; Reply Br. 2–3. We concur with Appellant's arguments that the Examiner erred in rejecting claims 1–20 for statutory double patenting under § 101 and in rejecting claims 19 and 20 as indefinite under § 112, second paragraph.

We are not persuaded by Appellant's arguments that the Examiner erred in rejecting claims 1–20 under § 101 as directed to ineligible subject matter. For this rejection, we adopt as our own the findings and reasons set forth by the Examiner in the action from which this appeal is taken and set forth in the Answer. *See* Ans. 5–14.

We highlight and address specific arguments and findings for emphasis as follows.

(1) Double Patenting (Claims 1–20)

Appellant argues the claims recite providing “one or more” face down playing cards and then revealing “at least one of said one or more” cards in response to a challenge. App. Br. 8, 14–18 (independent claims 1, 7, 14, 19, 20). Appellant contends that revealing “at least one of said one or more” cards does not require revealing all of the “one or more” cards received, in contrast to the independent claims of the '741 Application, which require revealing “said one or more” cards. *Id.* at 8. Thus, according to Appellant, the claims are of differing scope and cannot be rejected for statutory double patenting under § 101. *Id.*

The Examiner interprets the claims of the '741 application to be broad enough to encompass revealing only one card, even if the player received

more than one. Ans. 3–4. According to the Examiner, the claims of the '741 Application “fail[] to be explicit that ALL the said one or more face down playing cards must be revealed” (Ans. 4), and “can be read broader where a winning player is required to reveal ‘said one’ or ‘more’ of the previously dealt face down playing cards” (Final Act. 2).

We agree with Appellant that the claims of the '741 Application cannot be reasonably interpreted to encompass revealing fewer than all of the cards received by the player that reveals the cards. Using claim 1 of the '741 Application as an example, we agree with the Examiner that the “dealing” step is broad enough to encompass the players receiving one card or more than one card because it recites receiving “one or more face down playing cards.” The “requiring” step, however, is limited to the exact number of cards received in the “dealing” step, because it refers back to the same cards received in the “dealing” step, i.e., “said one or more face down playing cards.” The claim need not use the term “all” to be so limited. Were the claim intended to encompass revealing fewer than all of the cards received by the winning player, it could have recited “at least one of said one or more face down playing cards,” as recited in the present application. Thus, we agree with Appellant that it is possible to literally infringe claim 1 of the present application without literally infringing claim 1 of the '741 Application. Accordingly, Appellant is not claiming the same invention in both applications. Claim 1 is properly considered representative of claims 2–20 with respect to this issue.

In view of the foregoing, we do not sustain the statutory double patenting rejection of claims 1–20 under 35 U.S.C. § 101.

(2) *Indefiniteness (Claims 19 and 20)*

The Examiner determines that claims 19 and 20 “are directed to two overlapping statutory classes in that, while they appear to recite apparatus claims in a network and poker table further contained steps, they additionally recite the invention in terms of a process.” Final Act. 3. The Examiner relies on the Federal Circuit’s decision in *IPXL Holdings, L.L.C. v. Amazon.com, Inc.*, 430 F.3d 1377 (Fed. Cir. 2005), which held that a claim was invalid as indefinite because it recited both a system and a method for using that system. Ans. 4–5.

In *IPXL Holdings*, the claim at issue was directed to a system including an input means, and further recited that “*the user uses the input means* to either change the predicted transaction information or accept the displayed transaction type and transaction parameters.” *IPXL Holdings*, 430 F.3d at 1384. The court held it was

unclear whether infringement . . . occurs when one creates a system that allows the user to change the predicted transaction information or accept the displayed transaction, or whether infringement occurs when the user actually uses the input means to change transaction information or uses the input means to accept a displayed transaction.

Id. On the other hand, where apparatus or system claims “do not recite functionality divorced from the cited structure,” and “instead claim an apparatus with particular capabilities,” they “do not reflect an attempt to claim both an apparatus and a method.” *UltimatePointer, L.L.C. v. Nintendo Co.*, 816 F.3d 816, 827–28 (Fed. Cir. 2016); *see also Microprocessor Enhancement Corp. v. Tex. Instruments Inc.*, 520 F.3d 1367, 1375 (Fed. Cir. 2008) [hereinafter “*MEC*”] (holding claim not indefinite under *IPXL*

Holdings where it was “clearly limited to a pipelined processor possessing the recited structure and *capable* of performing the recited functions”).

Here, Appellant argues claims 19 and 20 “do not require any specific process or steps to be undertaken to be infringed but rather a processor configured to and a dealer instructed to take certain actions.” App. Br. 9. We agree with Appellant that claim 19 is directed to a “gaming network” that comprises a “processor . . . configured to” perform certain functions. Rather than requiring actual performance of the recited functions, the limitations at issue in claim 19 are clearly limited to a processor configured to perform the recited functions. Similarly, claim 20 is directed to a “gaming system” comprising, among other things, “a dealer instructed to” perform certain functions. Claims 19 and 20 are more similar to those held not indefinite in *UltimatePointer* and *MEC*. The functional language in question here is used to define the attributes of the respective structures, the processor and the dealer. Actual performance of any manipulative steps for which the processor is configured, or to which the dealer is instructed, is not required in order to infringe. Accordingly, claims 19 and 20 do not reflect an attempt to claim both an apparatus and a method.

In view of the foregoing, we do not sustain the rejection of claims 19 and 20 under 35 U.S.C. § 112, second paragraph.

(3) Subject Matter Eligibility (Claims 1–20)

The Examiner concludes that claims 1–20 are not directed to patent eligible subject matter because they claim an abstract idea. Final Act. 4. In particular, the Examiner determines that method claim 1, “while arguably reciting a number of physical steps of dealing cards, is viewed here as an

attempt to claim a new set of rules for playing a card game,” and “a set of rules qualifies as an abstract idea.” *Id.* at 5. The Examiner determines that the particular statutory class (process, machine, manufacture, or composition of matter) is not determinative, and that the underlying invention in each of the claims is the abstract idea of a set of rules for playing a card game. *Id.* at 5–11 (citing *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366 (Fed. Cir. 2011)).

In the rejection, the Examiner applies the USPTO Interim Guidance for Determining Subject Matter Eligibility for Process Claims in View of *Bilski v. Kappos*, 75 Fed. Reg. 43,922 (July 27, 2010) (“Interim Guidance”). *See* Final Act. 5. Thus, in the Final Action, the Examiner evaluates factors such as whether the claims are sufficiently tied to a particular machine, result in a transformation to a different state or thing, or claim an abstract idea, and concludes that the factors weigh against patent eligibility. *Id.* The Interim Guidance was developed before the United States Supreme Court issued its decision in *Alice Corp. v. CLS Bank International*, 134 S. Ct. 2347 (2014), which further explains the application of 35 U.S.C. § 101. In the Examiner’s Answer, the Examiner also applies the *Alice* framework. Ans. 12–14. We affirm the Examiner’s rejection of claims 1–20 under § 101 based on *Alice* and subsequent Federal Circuit precedent as set forth below.

In *Alice*, the Supreme Court discussed its decision in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 132 S. Ct. 1289 (2012), explaining the test for determining whether a claim is directed to patent-ineligible subject matter as follows:

In *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 566 U.S. —, 132 S. Ct. 1289, 182 L. Ed. 2d 321 (2012), we 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. First, we determine whether the claims at issue are directed to one of those patent-ineligible concepts. *Id.*, at —, 132 S. Ct., at 1296–1297. If so, we then ask, “[w]hat else is there in the claims before us?” *Id.*, at —, 132 S. Ct., at 1297. To answer that question, we 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.*, at —, 132 S. Ct., at 1298, 1297. We have described step two of this 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.*, at —, 132 S. Ct., at 1294.

Alice, 134 S. Ct. at 2355 (alterations in original).

Accordingly, we first determine whether the claims at issue are directed to a patent-ineligible concept (such as an abstract idea). If so, we then determine whether there is something else that ensures that they are directed to significantly more than a patent-ineligible concept.

We agree with the Examiner that each of independent claims 1, 7, 14, 19, and 20 is directed to the abstract idea of a set of rules for playing a card game. Final Act. 5; Ans. 5–6, 11–14. The claims here are similar to the claims of *In re Smith*, 815 F.3d 816 (Fed. Cir. 2016), which claimed “[a] method of conducting a wagering game.” 815 F.3d at 817. In that case, the court held that the claims, “directed to rules for conducting a wagering game, compare to other ‘fundamental economic practice[s]’ found abstract by the Supreme Court.” *Id.* at 818 (alteration in original) (quoting *Alice*, 134 S. Ct. at 2357). Here, the Examiner correctly determines that Appellant’s underlying invention is a version of poker that includes the concept of

challenge rights, where a player has the right to force another player to reveal the winning hand. *See* Ans. 10–11. The claimed challenge rights are no less abstract than the rules of the wager game considered in *Smith*.

Appellant contends that the randomized deck of conventional playing cards recited in method claims 1 and 14 “generate random outcomes which cannot be accomplished in the dealer’s (or anyone else’s) mind thereby removing it from the abstract idea or mental step arena.” App. Br. 10. Appellant repeats a similar argument based on the processor and random number generator recited in method claim 7. *Id.* at 12. An unpatentable mental process, however, is merely “a subcategory of unpatentable abstract ideas,” *CyberSource*, 654 F.3d at 1371; thus, abstract ideas encompass more than purely mental processes. For example, as the claims at issue in *Alice* demonstrate, a claim may require use of a computer and still be directed to an abstract idea under step one of the analysis. *See Alice*, 134 S. Ct. at 2356–59 (concluding that the claims were directed to the abstract idea of intermediated settlement, and noting the claimed method was stipulated to require use of a computer). In the present case, we consider Appellant’s arguments as to the presence of playing cards and the challenge prop, as well as structure required for computer implementation, under step two of *Alice*.

In accordance with step two of *Alice*, we consider whether there is something else in the claims such that they are directed to “significantly more” than the abstract idea identified above. *See Alice*, 134 S. Ct. at 2355. Here, the Examiner determines that dealing cards is not central to the purpose of the rules claimed by Appellant, and is considered an extra-solution activity. Ans. 6–7. Similarly, the challenge props are “nothing more than indicators to communicate a player[’]s intent to challenge another

player that could alternatively be done verbally, by gestures or the like.”
Ans. 8. As to independent claims 7, 19, and 20, the Examiner determines the claims merely require generic implementation on a computer in an attempt to recite the function of an abstract idea in how a game is to be conducted between players. Ans. 13.

We agree with the Examiner that the “conventional playing cards,” “challenge game props,” “processor,” and “random number generator” recited in the claims do not add significantly more to the abstract idea of playing a poker game with challenge rights. “Just as the recitation of computer implementation fell short in *Alice*, shuffling and dealing a standard deck of cards are ‘purely conventional’ activities.” *Smith*, 815 F.3d at 819 (citing *Alice*, 134 S. Ct. at 2358–59). Similarly, the sole function of the claimed challenge prop is to represent the challenge rights held by a player and to indicate when those rights will be exercised. Like the conventional playing cards considered in *Smith*, we consider the challenge prop to be a generic implementation of the claimed abstract idea—the concept of challenge rights. Thus, although we agree with Appellant that a tangible or simulated challenge prop is required by the claims (*see* Reply Br. 2–3), the physical presence of an object representing the challenge rights fails to add significantly more to the abstract idea of those rights. Accordingly, we agree with the Examiner that the rejected claims do not have an “inventive concept” sufficient to “transform” the claimed subject matter into a patent-eligible application of the abstract idea.

As to Appellant’s arguments that shuffling and/or dealing cards “transforms” the deck and thereby satisfies the machine-or-transformation test (App. Br. 11–12), we agree with the Examiner (Ans. 9–10) that these

actions do not transform the deck because the cards remain the same, albeit in a different order or location. *Smith*, 815 F.3d at 819 (“Just as the recitation of computer implementation fell short in *Alice*, shuffling and dealing a standard deck of cards are ‘purely conventional’ activities.”); *see also Bilski v. Kappos*, 561 U.S. 593, 604 (2010) (holding that “the machine-or-transformation test is a useful and important clue . . . for determining whether some claimed inventions are processes under § 101,” but that it is “not the sole test”).

Accordingly, for the reasons discussed above and by the Examiner, we are not apprised of error in the Examiner’s rejection of claims 1–20 under 35 U.S.C. § 101 as directed to patent-ineligible subject matter. Thus, we sustain the rejection of claims 1–20.³

DECISION

We reverse the Examiner’s decision to reject claims 1–20 under 35 U.S.C. § 101 as being drawn to the same invention as claimed in the ’741 Application.

We reverse the Examiner’s decision to reject claims 19 and 20 under 35 U.S.C. § 112, second paragraph.

We affirm the Examiner’s decision to reject claims 1–20 under 35 U.S.C. § 101 as being drawn to patent-ineligible subject matter.

³ Should there be further prosecution of claim 20 or other claims similarly reciting a “dealer,” the Examiner may wish to consider whether the “dealer” may encompass a human organism, such that the claim should be rejected under 35 U.S.C. § 101 and Section 33(a) of the Leahy-Smith America Invents Act. *See* “Claims Directed to or Encompassing a Human Organism,” Memorandum to the Patent Examining Corps (Sept. 20, 2011).

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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