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REED SMITH LLP 101 Second Street Suite 1800 SAN FRANCISCO, CA 94105			MENDIRATTA, VISHU K	
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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* MIMI KINGSLEY

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Appeal 2015-000821<sup>1,2</sup>  
Application 13/665,259  
Technology Center 3700

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Before PHILIP J. HOFFMANN, TARA L. HUTCHINGS, and  
ROBERT J. SILVERMAN, *Administrative Patent Judges*.

HOFFMANN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134(a) from the rejection of claims 12–17 and 21–29. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

According to Appellant, the invention relates “to a tile-based multi-player board game that may be implemented as a physical board game or an electronic game.” Spec. 1, ll. 5–6. Claims 12, 22, and 23 are the only

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<sup>1</sup> Our decision references Appellant’s Specification (“Spec.,” filed Oct. 31, 2012) and Appeal Brief (“Br.,” filed May 19, 2014), as well as the Examiner’s Answer (“Answer,” mailed June 30, 2014).

<sup>2</sup> According to Appellant, Warifu LLC is the real party in interest. Br. 1.

independent claims under appeal. *See Br., Claims App.* Below, we reproduce claim 12, as representative of the appealed claims.

12. A method of playing a board game, the game board comprising M rows and N columns, the method comprising:

placing a Corner Tile at each of four corners of the game board;

placing a Frame Tile, the Frame Tile having an indicia of a numeral, on a first end of each of the second through M-1 rows;

placing a Frame Tile on a second end of each of the second through M-1 rows, wherein the indicia of a numeral on the Frame Tile for each second end of each row matches the indicia of a numeral on each of the respective Frame Tiles on the first end of each of the second through M-1 rows;

placing a Frame Tile, the Frame Tile having an indicia of a numeral, on a first end of each of the second through N-1 columns;

placing a Frame Tile on a second end of each of the second through sixth rows, wherein the indicia of a numeral on the Frame Tile for each second end of each row matches the indicia of a numeral on each of the respective Frame Tiles on the first end of each of the second through N-1 columns;

assigning a unique set of Game Tiles to each player or team;

each player or team in turn placing a Game Tile from the unique set on a playing square, each playing square comprising a space in rows two through M-1 and columns two through N-1, each Game Tile having an indicia of a numeral; and

each player or team continuing in turn to place Games Tiles on playing squares until one player or team has placed its respective Game Tiles completely filling the playing squares on any row or column, such that a sum of the indicia of the numbers on the Game tiles in the playing squares matches the indicia of a

numeral on the Frame Tiles located at either end of the row or column.

*Id.*

#### REJECTION

The Examiner rejects claims 12–17 and 21–29 under 35 U.S.C. § 101 as directed to non-statutory subject matter. *See, e.g.*, Answer 2–3.

#### ANALYSIS

The Examiner rejects claims 12–17 and 21–29 under 35 U.S.C. § 101 as directed to non-statutory subject matter. *See, e.g.*, Answer 2–3. In the rejection, the Examiner indicates that the rejection is “based upon [the USPTO’s] . . . ‘Interim Guidance for Determining Subject Matter Eligibility for Process Claims in View of *Bilski v. Kappos*’” (75 Fed. Reg. 43,922 (July 27, 2010)). *Id.* at 3. The Examiner sets forth the following rationale to support the rejection:

Claimed steps in playing a board game are abstract ideas because they simply instruct how business should be conducted, for example rules that may be applied for placing game pieces on a game surface selected from infinite number of possible hypothetical ways game pieces may be placed. In playing this board game there is no repeatable result or real world result. The claim is an effort to patent abstract rules. Accordingly claims are abstract ideas.

*Id.* at 2–3. The Examiner further determines that

[t]he claimed invention does not recite a sufficient tie to a machine or apparatus. The machine or apparatus should implement the process (method steps), and not merely be an object upon which the process operates. The claims should be clear as to how the machine or apparatus implements the process. The claimed apparatus of “a plurality of game tiles”, “game

board with frame tiles and corner tiles” are merely objects upon which the process (method steps) operates, and do not by itself implement the process (method steps). The claimed steps of “placing a frame tile, placing a corner tile”, “assigning a set of game tiles”, “filling the player squares” do not inherently require the use of a specific machine to perform the steps. The machine or apparatus limitations should make clear that the use of the machine or apparatus in the claimed process imposes a meaningful limit on the claim’s scope, and does use a machine involving more than insignificant extra-solution activity.

Also, there is no transformation in these method claims. The claimed steps of “placing a frame tile, placing a corner tile”, “assigning a set of game tiles”, “filling the player squares” do not inherently require the use of a specific machine to perform the steps do not transform the “plurality of game tiles” or “game surface with frame tiles or corner tiles” into a different state or thing. The step of “placing a game tile on a surface” only seems to produce a visual situation (making a game piece visible). The game pieces remains a game pieces and the playing surface remains a playing surface from beginning to end of the process and do not transform into a different state.

Answer 6–7 (emphasis omitted). Further, the Examiner determines that

several factors weighing toward and against patent eligibility have been analyzed by the Examiner, including but not limited to the machine and transformation factors and the abstract idea or general concept factors discussed above. See the . . . Federal Register notice . . . for a complete list of factors that were considered by the Examiner in the above analysis. Specifically, the lack of implementation by a particular machine or the transformation of a particular article, and the apparent attempt to claim an abstract idea in the form of a new set of rules are all factors that weigh against eligibility. The fact the claim may be more than a mere statement of a concept in that an actual method of playing the game is claimed versus just a new set of rules may be a factor weighing towards patent eligibility. However, in this case that factor weighing towards eligibility is not given much weight since the use of the concept, as expressed in the method, would effectively grant a monopoly over the concept. It is this

Examiner's opinion that the factors in this case weighing against patent eligibility far outweigh the factors weighing toward patent eligibility.

Answer 8–9 (emphasis omitted).

Although the Examiner discusses whether the claimed game is directed to an abstract idea (*see, e.g.*, Answer 7–9), the Examiner's analysis appears to be largely based on the machine-or-transformation test, which was displaced by the Court's decision in *Bilski v. Kappos*, 561 U.S. 593 (2010). As such, it is not clear that the Examiner's reasoning is consistent with the "Interim Guidance for Determining Subject Matter Eligibility for Process Claims in View of *Bilski v. Kappos*," which was in place at the time of the Final Office Action. In any event, we proceed to analyze the question of whether the claimed invention is directed to unpatentable subject matter under the framework of the Court in *Alice Corp. v. CLS Bank Int'l*, 134 S.Ct. 2347 (2014) which followed the two-part test set forth in *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S.Ct. 1289, 1293 (2012).

First, as to whether the claim is directed to an abstract idea, law of nature, or natural phenomenon, *see Alice*, 134 S.Ct. at 2355, the Examiner does not establish that the claimed board game is directed to an abstract idea. To the extent that the Examiner states that the abstract idea is "abstract rules" (Ans. 3), the Examiner fails to demonstrate sufficiently that the combination of the claimed rules with the claimed game board and claimed tiles is abstract.

Because we resolve this issue after consideration of the first step of the *Alice* test, we need not reach the second step of the *Alice* test, e.g., as to whether there are further claim limitations that contain an "inventive concept" sufficient to "transform" an abstract idea into a patent-eligible

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application. *See Alice*, 134 S.Ct. at 2357; USPTO 2014 Interim Guidance on Patent Subject Matter Eligibility, 79 Fed. Reg. 74,618, 74,621 (Dec. 16, 2014). For these reasons, we do not sustain the Examiner's rejection under 35 U.S.C. § 101 of claims and its dependent claims.

DECISION

We REVERSE the Examiner's rejection of claims 12–17 and 21–29.

REVERSED