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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MARK H. JONES

Appeal 2015-001914
Application 13/673,448¹
Technology Center 3700

Before JOHN C. KERINS, STEFAN STAICOVICI, and LEE L. STEPINA,
Administrative Patent Judges.

STAICOVICI, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Mark H. Jones (Appellant) appeals under 35 U.S.C. § 134(a) from the Examiner's final decision rejecting under 35 U.S.C. § 101 claims 1–7 and 9–21 as directed to non-statutory subject matter.² We have jurisdiction over this appeal under 35 U.S.C. § 6(b).

¹ According to Appellant, the real party in interest is the inventor, Mark H. Jones. Br. 1 (filed July 9, 2014).

² Claim 8 is canceled. *See* Appellant's Amendment, filed May 30, 2013, 4.

SUMMARY OF DECISION

We AFFIRM and enter a NEW GROUND of REJECTION pursuant to our authority under 37 C.F.R. 41.50(b).

INVENTION

Appellant's invention relates to "a multi-player card game utilizing a customized deck of playing cards and multiple wagering levels." Spec. para. 2.

Claims 1, 11, and 21 are independent. Claim 1 is illustrative of the claimed invention and reads as follows:

1. A method of playing a card game, comprising:
 - providing a deck of playing cards consisting essentially of a first quantity of Numbered cards each having a specified numerical face value and a second quantity of Wild cards each having an assignable numerical face value, the Numbered cards comprising an equal number of cards having face values of 3X, 5X and 8X, respectively, where X is a nonzero number;
 - providing a playing surface having at least one player position and one dealer position, the at least one player position having a plurality of associated wagering areas;
 - shuffling the deck of playing cards;
 - dealing three cards from the deck to the at least one player position and three cards to the dealer position in a manner so as to conceal the face value of the cards in the dealer position from the player;
 - drawing one card from the deck as a Fire card and displaying it face-up in a Fire card position disposed on the playing surface, and if the Fire card is a Numbered card then nullifying all like cards sharing the same face value;
 - assigning each Wild card a face value of 8X or 5X or 3X;
 - requiring the player to either make a Wild card wager by placing a first wager amount in one of the plurality of associated wagering areas or fold;

dealing two cards from the deck to the at least one player position and two cards to the dealer position in a manner so as to conceal the face value of the cards in the dealer position from the player;

requiring the player to either make an additional wager by placing a second wager amount in another of the plurality of associated wagering areas or fold;

revealing the face values of the cards in the at least one player position and the cards in the dealer position;

computing the numerical sum of face card values in the at least one player position and in the dealer position; and

declaring the player a winner if the numerical sum of the cards in the at least one player position is greater than the numerical sum of the cards in the dealer position.

ANALYSIS

The Examiner finds that “the claimed method is directed *only to a set of predefined rules of playing a card game* and is viewed here as an *attempt to claim a new set of rules for playing a card game.*” Final Act. 6. The Examiner notes that “[f]ollowing rules and instructions is a general concept that is abstract and sweeping as to cover both known and unknown uses of the concept and be performed through any existing or future-devised machinery.” *Id.* (citing Interim Guidance for Determining Subject Matter Eligibility for Process Claims in View of *Bilski v. Kappos*, 75 Fed. Reg. 43,922, 43,925 (Factor D(2)) (July, 27, 2010) [hereinafter *Bilski Interim Guidance*]). The Examiner concludes that “Applicant’s claims attempt to *patent and preempt an abstract idea* of the game in all fields, and thus is ineligible subject matter under 35 U.S.C. 101.” *Id.* (citing *Bilski v. Kappos*, 130 S. Ct. 3218, 3231 (2010)).

Appellant asserts that “the claims at issue are directed to methods of playing a wagering game having specific steps; they do not amount to a

monopoly on the abstract idea of wagering, of playing a game or of playing a card game of chance itself.” Br. 12. Appellant argues that although “the claims require a method of playing a card game of chance, the game can only be played with a unique and non-convention[al] set of cards.” *Id.* Appellant also argues that the method uses a Fire card and Wild cards that are used in a manner that is “unquestionably unconventional.” *Id.* at 13. Appellant thus contends that because “the claims recite several unconventional steps that confine the claims to a particular, useful application of the principle . . . and because the claims do not amount to a monopoly on an abstract idea, the claims recite patent-eligible subject matter.” *Id.*

In response, the Examiner reiterates that, “[f]ollowing rules and instructions is a general concept that is abstract.” Ans. 8 (citing *Bilski Interim Guidance*). The Examiner states that “[u]se of the ‘deck of playing cards’ . . . to carry out the claimed steps . . . is merely insignificant extra-solution activity in the context of the claimed invention, ‘a method of playing a card game’, and does not impose meaningful limits on the scope of the claim.” *Id.* at 9.

Subsequent to the filing of the present appeal, the Supreme Court decided *Alice Corp. Pty. Ltd. v. CLS Bank International*, 134 S.Ct. 2347 (2014), in which a two-step test for patent eligibility was set forth, which supersedes the *Bilski Interim Guidance* that was applied by the Examiner. Several decisions followed *Alice* and the USPTO provided updated Subject Matter Eligibility Guidance to provide a basis for determining whether an invention claims ineligible subject matter. One of the decisions following *Alice* was directed to a “method of conducting a wagering game” using a

deck of “physical playing card,” and was determined to be drawn to an abstract idea. *See In re Smith*, 815 F.3d 816, 819 (Fed. Cir. 2016). There, the court held that “shuffling and dealing a standard deck of cards are ‘purely conventional’ activities,” and 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.” *Id.* at 819. However, the court stated that not “all inventions in the gaming arts would be foreclosed from patent protection under § 101,” and that it was possible for “claims directed to conducting a game using a new or original deck of cards potentially surviving step two of *Alice*.” *Id.*

Here, following the two-step test for patent eligibility in *Alice*, first, we determine whether the claims at issue are directed to a patent-ineligible concept such as an abstract idea, and, second, 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.” *Alice*, 134 S. Ct. at 2357 (quoting *Mayo Collaborative Servs. v. Prometheus Labs, Inc.*, 132 S. Ct. 1289, 1294, 1298 (2012)). Under the first step of the test, we find that the claimed “method of playing a card game” is drawn to an abstract idea much like *Alice*’s method of exchanging financial obligations and *Smith*’s method of conducting a wagering game, because “claims, describing a set of rules for a game, are drawn to an abstract idea.” *Smith*, 815 F.3d at 819. However, “[a]bstract ideas, including a set of rules for a game, may be patent-eligible if they contain an ‘inventive concept’ sufficient to ‘transform’ the claimed abstract idea into a patent-eligible application.” *Id.* (quoting *Alice*, 134 S. Ct. at 2357). In view of this

guidance, under the second step of the test, we determine whether there are unconventional activities that supply a sufficiently inventive concept.

The independent claims require “providing a deck of playing cards . . . having face values of 3X, 5X and 8X,” which Appellant asserts is a non-standard deck of cards. *See* Br. 12. Although we appreciate that using only the 3’s, 5’s, and 8’s cards in a game is different from the most common use of a deck of cards, nonetheless, Appellant is merely using a subset of a standard deck of cards. *See* Spec., Figs. 3–6. The claims do not require 48 cards as depicted in the embodiment of Figure 1, and the recited deck of cards would be met by taking all of the 3’s, 5’s, and 8’s from a standard deck, or would be met by taking the 3’s, 5’s, and 8’s cards from multiple standard decks, if more cards were required. Using a subset of a conventional deck of cards is not a difference that amounts to a sufficiently inventive concept to distinguish over *Smith*. For example, euchre and pinochle are well known card games that use a stripped deck, that is, a standard set of playing cards from which some cards are removed.³

The claims also require “drawing one card from the deck as a Fire card . . . and if the Fire card is a Numbered card then nullifying all like cards,” which Appellant asserts is “unquestionably unconventional.” Br. 13. Notwithstanding that this limitation is contingent on a condition that may not occur, one of the same conventional cards is used as the Fire card, and thus, Appellant is designating a new meaning to existing cards. Known card games designate a new meaning to existing cards that follow a specific card, as in a variation of seven-card stud poker known as “Chase the Lady,” or

³ *See, e.g.*, <http://www.catsatcards.com/Articles/TheDeck.html> (last visited November 17, 2016).

that occur in a particular column, as a “good” card (wild card), or a “bad” card (nullifying card), as in a variation of Cincinnati known as “Good Cards Bad Cards.”⁴ Accordingly, the use of a “Fire card” is conventional.

The claims also require “assigning each Wild card a face value of 8X or 5X or 3X,” which Appellant also asserts is “unquestionably unconventional.” *Id.* A “Wild card” by definition is “a playing card that can represent any other card in a game.” *Merriam-Webster Collegiate Dictionary* (11th ed. 2005). Here, because only the 3’s, 5’s, and 8’s cards are used in the game, assigning a value of 8, 5, or 3, is conventional. The claims further require using a playing surface, shuffling, dealing, wagering, and declaring a winner based on the highest sum of the cards, which are “purely conventional” activities. *See Smith*, 815 F.3d at 819.

In *Alice*, the Supreme Court determined that *Alice*’s claims to methods were ineligible because “the claims at issue amount to ‘nothing significantly more’ than an instruction to apply the abstract idea of intermediated settlement using some unspecified, generic computer.” *Alice*, 134 S.Ct. at 2360 (quoting *Mayo*, 132 S. Ct, at 1294). This holding in *Alice* is analogous to the present matter in that Appellant is seeking patent protection for a method of playing a card game, including providing a deck of playing cards, shuffling and dealing the cards, wagering, revealing the face values of the cards, and declaring a winner based on the highest numerical sum of the cards. We are of the opinion that, as in *Alice*, “nothing significantly more” is claimed by Appellant, because the steps are conventional. Nor does

⁴ *See e.g.*, <http://www.scottharker.com/pokerrules.html> (last visited November 17, 2016).

Appellant persuasively indicate how such claimed steps render these rules anything other than an abstract idea as the Examiner finds. *See* Final Act. 5–6.

Accordingly, and based on the analysis above, we are not persuaded the Examiner’s rejection of method claims 1–7 and 9–21 as being ineligible subject matter is improper. However, because our analysis relies on findings and reasoning that the Examiner did not use, we enter a new ground of rejection under 35 U.S.C. § 101 with respect to claims 1–7 and 9–21 as being directed to ineligible subject matter, in order to afford Appellant a fair opportunity to respond.

SUMMARY

The Examiner’s decision to reject claims 1–7 an 9–21 under 35 U.S.C. § 101 as being directed to ineligible subject matter is AFFIRMED, but this affirmance is designated as a New Ground of Rejection under 37 C.F.R. § 41.50(b), because it relies on reasons different from and/or additional to those stated by the Examiner and also to provide Appellant a fair opportunity to respond.

This decision contains new grounds of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.” 37 C.F.R. § 41.50(b) also provides:

When the Board enters such a non-final decision, the appellant, 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 [E]xaminer, in which event the prosecution will be remanded to the [E]xaminer. The new ground of rejection is binding upon the examiner unless an amendment or new Evidence not previously of Record is made which, in the opinion of the [E]xaminer, overcomes the new ground of rejection designated in the decision. Should the [E]xaminer reject the claims, appellant may again appeal to the Board pursuant to this subpart.

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same Record. The request for rehearing must address any new ground of rejection and state with particularity the points believed to have been misapprehended or overlooked in entering the new ground of rejection and also state all other grounds upon which rehearing is sought.

Further guidance on responding to a new ground of rejection can be found in the Manual of Patent Examining Procedure § 1214.01.

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; 37 C.F.R. § 41.50(b)