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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
14/045,547	10/03/2013	Robert G. Gingher	GING-002	4611
26897	7590	10/19/2017	EXAMINER	
ROBERT GINGHER 29 Magoun Road West Islip, NY 11795			LANEAU, RONALD	
			ART UNIT	PAPER NUMBER
			3714	
			NOTIFICATION DATE	DELIVERY MODE
			10/19/2017	ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ROBERT G. GINGHER

Appeal 2016-002184
Application 14/045,547¹
Technology Center 3700

Before PHILIP J. HOFFMANN, BRUCE T. WIEDER, and
KENNETH G. SCHOPFER, *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 final rejection of claims 2–16. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

According to Appellant, the “invention relates generally to the field of mixed games of chance and skill, such as for example poker, whose outcomes depend in part on the skill of the players, and in particular to the use of a computer to reduce or eliminate the element of chance from a

¹ According to Appellant, the real party in interest is Robert Gingher. Appeal Br. 1.

game.” Spec. ¶ 2. Claims 2, 9, and 16 are the only independent claims on appeal. Below, we reproduce claim 2 as illustrative of the appealed claims.

2. A computer system for substantially reducing chance in a mixed contest of luck and skill between two or more players played on the computer system, comprising:

a processor;

a memory;

software stored on a non-transitory, computer-readable medium which, when loaded into the memory and run by the processor, causes the processor to perform steps of:

providing the players with first elements to play one or more first rounds in the contest;

determining a highest possible score based on skillful play of the elements provided to each player to play in each of the one or more first rounds;

maintaining a record of the highest possible score of each player in the memory;

creating second elements to play one or more second rounds in the contest, such that a total highest possible score of each player for the one or more first rounds and the one or more second rounds are substantially the same for each player; and

providing the players with the second elements to play in a second round.

REJECTION

The Examiner rejects claims 2–16 under 35 U.S.C. § 101 as directed to ineligible subject matter.

ANALYSIS

Based on our review of the record, we are not persuaded by Appellant that the Examiner erred in determining that claims 2–16 are directed to

ineligible subject matter. Thus, for the reasons we discuss below, we sustain the rejection.

As a general matter, we determine whether a claim is directed to patent-eligible subject matter based on the Supreme Court’s framework, as articulated in *Alice Corp. v. CLS Bank Int’l*, 134 S. Ct. 2347 (2014), which follows the two-part test set forth in *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66 (2012). That is, a claim fails to recite patent-eligible subject matter if, in accordance with the first part of the *Alice* test, the claim is directed to an abstract idea, and if, in accordance with the second part of the test, the claim lacks any further claim limitations that, when “consider[ed] . . . both individually and ‘as an ordered combination’ . . . ‘transform the nature of the claim’ into a patent-eligible application.” *Alice*, 134 S. Ct. at 2355 (quoting *Mayo*, 566 U.S. at 78, 79).

Turning to Appellant’s arguments, we are not persuaded that the Examiner’s rejection is in error because the Examiner does not provide adequate evidentiary support for the finding that the claims recite an abstract idea, and because the claims are not, in fact, directed to an abstract idea. *See* Appeal Br. 5–9. Appellant does not cite any controlling authority that requires the Examiner to provide factual evidence to support a finding that a claim is directed to an abstract idea. Instead, the Federal Circuit has repeatedly noted that, initially, the Examiner only need establish a prima facie case, and a “prima facie case is merely a procedural device that enables an appropriate shift of the burden of production.” *Hyatt v. Dudas*, 492 F.3d 1365, 1369 (Fed. Cir. 2007) (citing *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992)). The court has held that the USPTO carries its procedural burden of establishing a prima facie case when its rejection satisfies the

requirements of 35 U.S.C. § 132 by notifying Appellant of the reasons for rejection, “together with such information . . . as may be useful in judging of the propriety of continuing the prosecution of [the] application.” *See In re Jung*, 637 F.3d 1356, 1362 (Fed. Cir. 2011). Therefore, all that is required is that the Examiner sets forth the statutory basis of the rejection in a sufficiently articulate and informative manner as to meet the notice requirement of § 132. *Id.*; *see also Chester v. Miller*, 906 F.2d 1574, 1578 (Fed. Cir. 1990) (“Section 132 is violated when a rejection is so uninformative that it prevents the applicant from recognizing and seeking to counter the grounds for rejection.”).

In this case, in rejecting claims 2–16 under § 101, the Examiner analyzes the claims using the two-step framework set forth in *Mayo*, 566 U.S. at 77–79, “for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts.” *Alice*, 134 S. Ct. at 2354. Specifically, the Examiner notifies Appellant that the pending claims “are directed to the abstract idea of reducing ‘chance in a mixed contest of luck and skill,’” in accordance with the first step in *Alice*. Final Action 3 (emphasis omitted). Further, the Examiner finds that there are no meaningful limitations that transform the claims into something significantly more than the abstract idea itself, but, rather, that

the claim[s] do[] not effect an improvement to another technology or technical field[,] . . . do[] not amount to an improvement to the functioning of a computer itself[,] . . . and . . . do[] not move beyond a general link of the use of an abstract idea to a particular technological environment. The processor as described is nothing more than a standard/generic processor

performing standard steps and storing/processing information thus lacks the addition of ‘significantly more’ in the claims, in accordance with the second step in *Alice*. *Id.* at 4–5. In this regard, the Examiner finds that the claim elements viewed individually and as a whole amount to no more than mere instructions to implement an abstract idea using a generic processor. *Id.* Thus, the Examiner sets forth a proper rejection under § 101 such that the burden shifts to Appellant to explain why the claims are patent-eligible.

Appellant argues that even “[i]f . . . the Examiner is of the opinion that the mere presence of an abstract idea in the claims, i.e., reducing ‘chance in a mixed contest of luck and skill,’ necessarily places the claim into part 2 of the *Alice* test, . . . the claim[s] pass[] muster under part 2 [of the *Alice* test] as well.” Appeal Br. 9; *see also id.* at 9–11. Based on our review of the claim, Appellant does not persuade us that the claims recite significantly more, such that the claims include an “inventive concept” in accordance with *Alice*’s second step.

“[Appellant’s] claims are directed to maintaining ‘a record of the highest possible score of each player in the memory,’ and creating and providing the players with second elements that the computer created that were determined by the computer such that each player has the same opportunity to achieve substantially the same total highest score as his competitors.” Appeal Br. 10–11. However, this is nothing more than collecting, analyzing, and outputting data—steps that the Federal Court has repeatedly held constitute an abstract idea. *See, e.g., Elec. Power Grp. LLC v. Alstom*, 830 F.3d 1350, 1353–54 (Fed. Cir. 2016) (collecting information and “analyzing information by steps people go through in their minds, or by mathematical algorithms, without more, [are] essentially mental processes

within the abstract-idea category”); *see also* *Cybersource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1371 (Fed. Cir. 2011) (methods that can be performed entirely in the human mind are unpatentable). Further, the claims appear to recite, as structure, only generic computer components, which are not enough for patent-eligibility. *See, e.g.*, Final Action 5; *see also, e.g.*, *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1256 (Fed. Cir. 2014) (“[A]fter *Alice*, there can remain no doubt: recitation of generic computer limitations does not make an otherwise ineligible claim patent-eligible.”). Appellant does not show how the claims are technically performed such that they are not routine, conventional functions of a generic computer or processor.

Appellant further argues that “the Examiner has acknowledged that the claim as a whole recites novel and non-obvious (and therefore otherwise patentable) subject matter.” Appeal Br. 11. Even assuming Appellant is correct, such is not dispositive. Although the second step in the *Alice/Mayo* framework is termed a search for an “inventive concept,” the analysis is not an evaluation of novelty or non-obviousness, but rather, a search for “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.’” *Alice*, 134 S. Ct. at 2355 (alteration in original) (quoting *Mayo*, 566 U.S. at 73). “The ‘novelty’ of any element or steps in a process, or even of the process itself, is of no relevance in determining whether the subject matter of a claim falls within the § 101 categories of possibly patentable subject matter.” *Diamond v. Diehr*, 450 U.S. 175, 188–89 (1981). A novel and nonobvious claim directed to a purely abstract idea is, nonetheless, patent-ineligible. *See Mayo*, 566 U.S. at 90–91.

Further, we are not persuaded of Examiner error by Appellant's argument that "the claim does not pre-empt the broad field of online gaming." Appeal Br. 12; *see also id.* at 10–11. There is no requirement for the Examiner to establish pre-emption, and it is well established that "the absence of complete preemption does not demonstrate patent eligibility." *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015) (citing *Alice*, 134 S. Ct. at 2354); *see also OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1362–63 (Fed. Cir. 2015) ("[T]hat the claims do not preempt all price optimization or may be limited to price optimization in the e-commerce setting do not make them any less abstract.").

Thus, based on the foregoing, Appellant does not demonstrate error in the Examiner's rejection of claims 2–16 as directed to ineligible subject matter. Therefore, we sustain the rejection.

DECISION

We AFFIRM the Examiner's rejection of claims 2–16.

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