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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ALEXANDER STERN

Appeal 2016-003422¹
Application 12/934,291²
Technology Center 3700

Before BRUCE T. WIEDER, KENNETH G. SCHOPFER, and
MATTHEW S. MEYERS, *Administrative Patent Judges*.

SCHOPFER, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the rejection of claims 1–3, 5–19, 33, 34, and 36. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ Our decision references the Appeal Brief (“Appeal Br.,” filed Aug. 12, 2015) and Reply Brief (“Reply Br.,” filed Feb. 11, 2016), and the Examiner’s Answer (“Ans.,” mailed Dec. 11, 2015) and Final Office Action (“Final Act.,” mailed Dec. 30, 2014). According to Appellant claims 4, 20–32, 35 have been cancelled.

² According to Appellant, “Alexander Stern, the sole inventor is the real party in interest.” Appeal Br. 2.

BACKGROUND

The Specification “relates generally to lotto games, and more particularly to lotto games allowing player to choose bet combinations.”

Spec. 1.

CLAIMS

Claim 1 is the only independent claim on appeal and recites:

1. A method for playing lotto game based on use of a particular feature of playing cards, such that each single card is a combination of a value of card and a suit, said method is played on a non-transitory computer readable storage medium with an executable program stored thereon, wherein said program instructs a microprocessor to perform the following steps:

writing down bets placed by a player using computer-based tools provided by said program, said bets are made according to selected by the player type of the game - casino style game or lottery, bet amount and chances to win, said bets are selected from betting on single cards, cards of a particular suit, cards of a particular value, suits, values of cards, combinations, variations and permutations thereof;

picking out all cards at random one by one from a standard set of 52 playing cards and writing down an order of their picking, which brings about creation of random sequences of cards of different types and random sequences of suits and values of cards, wherein each card picked out at random takes part in the creation of said random sequences fulfilling several function at the same time: as a single card, as a value of card of a particular suit and as a suit of card of a particular value; said random sequences forming results of the game are permutations containing combinations and variations of different numbers of said cards, suits and values of cards;

writing down said random sequences in the course of the game separately from each other including ordinal numbers of said cards, suits and values of cards in these random sequences

respectively, using computer-based tools provided by said program;

comparing results of the game with bets made by each player and determining whether a successful bet has occurred, and in the affirmative case, calculating winning amount which is granted to a player according to a probability of success of his bet.

Appeal Br. 57–58.

REJECTIONS

1. The Examiner rejects claims 1–3, 5–19, 33, 34, and 36 under 35 U.S.C. § 101 as directed to ineligible subject matter.
2. The Examiner rejects claims 1–3, 5–19, 33, 34, and 36 under 35 U.S.C. § 103(a) as unpatentable over Dargue³ in view of Official Notice.

DISCUSSION

Ineligible Subject Matter

As an initial matter, we note that Appellant has grouped all claims together with respect to this rejection. We select and discuss claim 1 as representative of these claims. *See* 37 C.F.R. § 41.37(c)(iv).

The Supreme Court has 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.” *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2355 (2014) (citing *Mayo Collaborative Servs. v. Prometheus Labs, Inc.*, 132 S. Ct. 1289, 1294 (2012)). According to the Supreme Court’s framework, we must first determine whether the claims at issue are directed to one of those concepts (i.e., laws of nature, natural phenomena, and abstract ideas). *Id.* If so, we

³ Dargue, US 2007/0052172 A1, pub. Mar. 8, 2007.

must secondly “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.* The Supreme Court characterizes the second step of the 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.*

Claim 1 is drawn to “[a] method for playing a lotto game” comprising the steps of “writing down bets,” “picking out all cards [from a standard 52-card deck] . . . and writing down an order of their picking, which brings about creation of random sequences,” “writing down said random sequences,” and “comparing results of the game with bets made.” Appeal Br. 57–58.

We find that the method of playing a lotto game as recited claim 1, is a method of playing a wagering game and is similar to the claims at issue in *In re Smith*, 815 F.3d 816 (Fed. Cir. 2016). In *Smith*, the claims were directed to a “method of conducting a wagering game.” *See id.* at 817. The court stated: “On the first step, we conclude that Applicants’ 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. *See also id.* at 819 (“[W]e conclude that the rejected claims, describing a set of rules for a game, are drawn to an abstract idea.”). We see no meaningful distinction between the lotto game of claim 1 and a wagering game, and thus, agree with the Examiner that the claim is directed to the abstract idea of “a general concept or rules for playing a game” under step 1 of the *Alice* framework. Final Act. 6.

Regarding the second step of the *Alice* analysis (i.e., determining whether there are additional elements that transform the nature of the claim with a sufficient inventive concept), we find that the claims do no more than require conventional steps normally associated with wagering games, i.e. placing bets, picking cards from a standard deck of cards, and resolving outcomes based on the cards picked and the wagers placed. “[A]ppending purely conventional steps to an abstract idea does not supply a sufficiently inventive concept.” *See In re Smith* at 879. Thus, we agree with the Examiner that the additional elements, including the use of a “computer readable storage medium” and “computer-based tools” recited in the claims do not impose meaningful limits on the abstract idea of a set of rules for playing a game. *See Final Act. 9. See also In re Smith* at 817 (Affirming rejection of claims under 35 U.S.C. § 101 “[b]ecause the claims cover only the abstract idea of rules for playing a wagering game and use conventional steps of shuffling and dealing a standard deck of cards.”)

In response to the rejection, Appellant argues that the claims include a particular application of the abstract idea including specific characteristics of a computer program that transform the abstract idea into patentable subject matter. *See Appeal Br. 9–28*. In particular, Appellant indicates that the claims are patentable because “the kit of computer-based tools [used to implement the invention] is particular to the present invention and essential for its implementation. These computer-based tools having the particular table structure are [an] essential part of the apparatus for playing the lotto game.” *Appeal Br. 17*. However, we find that the claim itself refers only to a generic computer application, including a reference to an executable program on a non-transitory computer readable storage medium and the use

of “computer-based tools.” Nothing in the claim itself suggests a “particular practical application of abstract ideas,” contrary to Appellant’s assertion. *Id.* at 9. Finally, Appellant asserts that the method may not be performed by mental processes alone because “human mistakes will surely be made.” Appeal Br. 21–22. However, the fact that the claimed method may be hard to perform mentally, does not mean that it cannot be done and does not elevate the claim to patent eligibility. We also note that the Specification discloses that “[i]n the disclosed invention a dealer and a player are humans and/ or automated systems.” (Spec. 3, ll. 5–6) and “when the method is implemented as a computer version, the program is based on a random numbers generator that has been already invented” (*id.* at 9, ll. 25–27).

Based on the foregoing, we are unpersuaded of error in the rejection of claims 1–3, 5–19, 33, 34, and 36 under 35 U.S.C. § 101. Accordingly, we sustain this rejection.

Obviousness

Claim 1 requires that all cards are picked at random and the sequences of card values and card suits are written down separately. Thus, the plain language of the claim requires that each of the 52 cards in a standard card deck are picked out randomly, a 52 card sequence of card values is written down, and a separate sequence of 52 card suits is written down. We agree with Appellant that the rejection does not establish that Dargue teaches these claim requirements or that they would have otherwise been obvious. *See* Appeal Br. 45–52. We find that the Examiner has not pointed to any disclosure in Dargue of recording a sequence of card values separate from a sequence of card suits.

In rejecting claim 1, the Examiner states:

Dargue is considered to show in fig. 1 at least 4 random sequences of 5 different types face down. He further shows betting on single cards selected by a player on a chance to win (abstract, ln. 2), picking out cards at random at ln. 4. The number of cards picked is considered an obvious matter of choice. To have selected 24 sequences of five types would have been an obvious rearrangement of printed matter. *In re Ngai*, 70 USPQ2d 1862 (Fed. Cir. 2004), *In re Gulack*, 217 USPQ 410 (Fed. Cir. 1983) and *In re Miller*, 164 USPQ 46 (CCPA 1969).

Final Act. 15–16. The Examiner goes on to discuss Appellant’s arguments at length, but we see no indication, either in the Examiner’s explanation or Dargue’s disclosure itself, that Dargue teaches separately recording card values and card suits as required by the claim.

Accordingly, on the record before us, we do not sustain the rejection of claim 1 as obvious. We also do not sustain the rejection of dependent claims 2, 3, 5–19, 33, 34, and 36 for the same reasons.

CONCLUSION

We AFFIRM the rejection of claims 1–3, 5–19, 33, 34, and 36 under 35 U.S.C. § 101, and we REVERSE the rejection of claims 1–3, 5–19, 33, 34, and 36 under 35 U.S.C. § 103(a).

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