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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ANDREW FEAR

Appeal 2016-003699¹
Application 13/655,510²
Technology Center 3700

Before BART A. GERSTENBLITH, KENNETH G. SCHOPFER, and
AMEE A. SHAH, *Administrative Patent Judges*.

SCHOPFER, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134(a) from the rejection of
claims 1, 3–11, and 13–22. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ Our decision references the Appeal Brief (“Appeal Br.,” filed June 8, 2015 as amended Aug. 4, 2015), Reply Brief (“Reply Br.,” filed Feb. 24, 2016), the Examiner’s Answer (“Ans.,” mailed Dec. 24, 2015), and the Final Office Action (“Final Act.,” mailed Dec. 5, 2014).

² According to Appellant, the real party in interest is Nvidia Corporation. Appeal Br. 3.

BACKGROUND

The Specification relates “to computer gaming and, more specifically, to a quick-resume gaming system and a method of quick-resume gaming.” Spec. ¶ 1.

CLAIMS

Claims 1, 3–11, and 13–22 are on appeal. Claim 1 is illustrative of the appealed claims and recites:

1. A quick-resume gaming system, comprising:
 - a game device configured to support playing a video game application by a user; and
 - a gaming control module coupled to the game device and configured to suspend playing of the video game application at a current game display frame and resume playing of the video game application at the current game display frame directly from a regular display frame, that is not a part of the video game application, based on user initiated suspend and resume control commands, respectively.

Response to Notice of Non-Compliant Appeal Br., App. A, 3.

REJECTIONS

1. The Examiner rejects claims 1, 3–11, and 13–22 under 35 U.S.C. § 101 as being directed to ineligible subject matter.
2. The Examiner rejects claims 1, 3–5, 11, 13–15, 21, and 22 under 35 U.S.C. § 102(b) as anticipated by SNES.³
3. The Examiner rejects claims 1, 3–5, 11, 13–15, 21, and 22 under 35 U.S.C. § 103(a) as unpatentable over SNES in view of Tarantino.⁴

³ “Snes9x: *The Portable Super Nintendo Entertainment System Emulator*,” version 1.53, Apr. 2011.

⁴ Tarantino, US 2002/0055381 A1, pub. May 9, 2002.

4. The Examiner rejects claims 6 and 16 under 35 U.S.C. § 103(a) as unpatentable over SNES in view of Gookin.⁵
5. The Examiner rejects claims 1, 7, 8, 11, 17, and 18⁶ under 35 U.S.C. § 103(a) as unpatentable over Tarantino in view of SNES.
6. The Examiner rejects claims 9, 10, 19, and 20 under 35 U.S.C. § 103(a) as unpatentable over Tarantino in view of SNES and Perlman.⁷

DISCUSSION

Ineligible Subject Matter

The Supreme Court in *Alice* reiterated the two-step framework, set forth previously in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 566 U.S. 66, 78–79 (2012), “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). The first step in that analysis is to “determine whether the claims at issue are *directed to* one of those patent-ineligible concepts.” *Id.* (citing *Mayo*, 566 U.S. at 79) (emphasis added). If so, the second step is to consider the elements of the claims “individually and ‘as an ordered combination’” to determine whether

⁵ Gookin, “*How to Change What Closing the Laptop Lid Does,*” *Troubleshooting Your PC For Dummies*, 3rd ed., Nov. 2013.

⁶ Although the heading for this rejection does not list claims 8 and 18, the body of the rejection lists and addresses the limitations in claim 18. Final Act. 8–9. Additionally, the Examiner refers to this rejection as directed to claim 8 when discussing the rejection of claims 9, 10, 19, and 20. *See id.* at 9 (incorporating the Examiner’s findings regarding Tarantino and claim 8). *See also* Appeal Br. 12 (Appellant acknowledging the rejection of claim 8).

⁷ Perlman et al., US 2011/0122063 A1, pub. May 26, 2011.

the additional elements “‘transform the nature of the claim’ into a patent-eligible application.” *Id.* (quoting *Mayo*, 566 U.S. at 78–79).

In other words, the second step is to “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.* (alteration in original) (quoting *Mayo*, 566 U.S. at 72–73). The Court acknowledged in *Mayo*, that “all inventions at some level embody, use, reflect, rest upon, or apply laws of nature, natural phenomena, or abstract ideas.” *Mayo*, 566 U.S. at 71. We, therefore, look to whether the claims focus on a specific means or method that improves the relevant technology or are instead directed to a result or effect that itself is the abstract idea, and merely invoke generic processes and machinery. *See Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1336 (Fed. Cir. 2016).

Here, the Examiner applies the *Alice* framework and determines:

Claims 11, 13–20, and 22 are directed to a method of saving and restoring data. Saving data is an abstract concept as it is a process that can be done in the mind or by hand. Additionally, the specific steps of saving in the instant application are old and well known as exhibited by the SNES 9x reference. The additional limitations of a game device and a keyboard or pointing device are features of a general purpose computer and do not confer statutory eligibility.

Claims 1, 3–10, and 21 are directed to a “gaming system” and a game device that carries out the same abstract method as above. Similar to above, the inclusion of a generic computing device does not confer statutory eligibility.

Final Act. 4.

Appellant first argues that the claims are not directed to any judicial exception because the claims are “directed toward a concept that is

inextricably tied to computer gaming technology and distinct from the types of concepts found by courts to be abstract.” Appeal Br. 5. We are not persuaded of reversible error by this argument. The Examiner determines that the claims are directed to a judicial exception because they attempt to claim an abstract idea. Final Act. 2–3. The application of an abstract idea to computer technology does not, by itself, indicate that the claims are not directed to a judicial exception. Rather, the *Alice* two-step framework is applied to determine whether the claims are in fact directed to an abstract idea and, if so, whether the claims amount to significantly more than the abstract idea itself.

Further, to the extent Appellant is arguing that the claims are not directed to an abstract idea, we disagree.

Before determining whether the claims at issue are directed to an abstract idea, we must first determine what the claims are directed to.

The “directed to” inquiry . . . cannot simply ask whether the claims *involve* a patent-ineligible concept, because essentially every routinely patent-eligible claim involving physical products and actions *involves* a law of nature and/or natural phenomenon—after all, they take place in the physical world. *See Mayo*, [566 U. S. at 69] 132 S. Ct. at 1293 (“For all inventions at some level embody, use, reflect, rest upon, or apply laws of nature, natural phenomena, or abstract ideas.”) Rather, the “directed to” inquiry applies a stage-one filter to claims, considered in light of the specification, based on whether “their character as a whole is directed to excluded subject matter.” *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1346 (Fed. Cir. 2015); *see Genetic Techs. Ltd. v. Merial L.L.C.*, 818 F.3d 1369, 1375 . . . (Fed. Cir. 2016) (inquiring into “the focus of the claimed advance over the prior art”).

Enfish, 822 F.3d at 1335.

The step-one analysis requires us to consider the claims “in their entirety to ascertain whether their character as a whole is directed to excluded subject matter.” *Internet Patents Corp.*, 790 F.3d at 1346. The question is whether the claims as a whole “focus on a specific means or method that improves the relevant technology” or are “directed to a result or effect that itself is the abstract idea and merely invoke generic processes and machinery.” *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1314 (Fed. Cir. 2016).

The Specification is titled “QUICK-RESUME GAMING” and relates to “computer gaming and... to a quick-resume gaming system and a method of quick-resume gaming.” Spec. ¶ 1. The alleged invention seeks to solve problems related to users having to perform numerous steps in order to resume playing a saved game. *See id.* ¶ 2. The Specification discloses that the solution to this problem presented therein incorporates a general purpose computer and a gaming control module. In particular, the Specification only describes the video game device as “a general purpose computer” with generic computer components including a CPU, system memory, GPU, and frame memory. *Id.* ¶¶ 13, 14. Further, the gaming control module is described generically as “a software module that corresponds to software included with a video game or software that is independent of the video game.” *Id.* ¶ 15. The Specification generally describes that the embodiments disclosed therein allow for a user to “employ a keystroke,” mouse clicks, a game board, or other actions to suspend and resume playing of a video game. *Id.* ¶ 18. In addition to a standalone gaming system, the Specification also describes embodiments in which an internet server or cloud server are employed to perform a quick-resume gaming function. *See,*

e.g., id. ¶¶ 20, 27. Thus, based on the Specification’s description of the problems and solution, the purported advance of the alleged invention is to provide a quick means of saving and restoring game data.

Independent claim 1 provides for a “quick-resume gaming system” including a game device configured to play a video game application and a gaming control module. Appeal Br. 3. The gaming control module is further limited to a module configured to suspend playing of a video game application and resume playing of the application at the current frame from a display frame that is not part of the application based on user commands. *Id.* Independent claim 11 provides for “a method of quick-resume gaming” including the steps of playing a video game application on a game device, suspending playing of the video game application at a current game display frame, and resuming playing of the video game at the current game display frame. *Id.* at 5

In this context, we agree with the Examiner, and Appellant does not persuade us otherwise, that the claims are directed to the abstract concept of saving and restoring data. And we do not see any meaningful distinction between the concept of saving and restoring data in the claims here and concepts also found abstract by our reviewing court. *See, e.g., Smart Sys. Innovations, LLC v. Chicago Transit Auth.*, 873 F.3d 1364, 1372 (Fed. Cir. 2017) (claims directed to the collection, storage, and recognition of data); *see also Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350 (Fed. Cir. 2016) (claims directed to collecting information, analyzing it, and displaying certain results); *Two-Way Media Ltd. v. Comcast Cable Commc’ns, LLC*, 874 F.3d 1329, 1337 (Fed. Cir. 2017) (claims directed to routing information by converting, routing, controlling, monitoring, and accumulating data).

Next, Appellant argues that “the [c]laims do not seek to tie up an allegedly abstract idea of ‘saving and restoring data’ such that no others can practice it.” Appeal Br. 5. Appellant asserts that “the [c]laims are much more specific and not *generically* directed to ‘saving and restoring data’ [and] . . . are directed to a specific application of quick suspension and resumption of video game play.” *Id.* at 6. We are not persuaded of error by this argument. There is no dispute that the Supreme Court has described “the concern that drives [the exclusion of abstract ideas from patent eligible subject matter] as one of pre-emption.” *Alice*, 134 S. Ct. at 2354. But characterizing preemption as a driving concern for patent eligibility is not the same as characterizing preemption as the sole test for patent eligibility. “The Supreme Court has made clear that the principle of preemption is the basis for the judicial exceptions to patentability” and “[f]or this reason, questions on preemption are inherent in and resolved by the § 101 analysis.” *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015) (citing *Alice*, 134 S. Ct. at 2354). “[P]reemption may signal patent ineligible subject matter, [but] the absence of complete preemption does not demonstrate patent eligibility.” *Id.*

Regarding the second step of the *Mayo/Alice* framework, Appellant argues that the claims amount to significantly more than the abstract idea alleged. Appeal Br. 6–7. Specifically, Appellant asserts that the claims apply the abstract idea with a particular machine, i.e., a gaming device. *Id.* at 6. Appellant further contends that the claims tie the idea to the video game environment and represent an improvement to video gaming technology that “allows a user to skip past all startup screens, menus, and saved game selection processes, significantly improving the gaming

experience.” *Id.* at 7. However, we agree with the Examiner that the claims merely limit the abstract concept to a particular environment, i.e., video games, through the use of generic computer equipment and basic computer operations. *See* Final Act. 4; *see also* Ans. 2–3. Further, we agree with the Examiner that the Specification discloses that the video game device may be “a general purpose computer” with generic computer components including a CPU, system memory, GPU, and frame memory. Spec. ¶¶ 13, 14. Still further, the gaming control module is described generically as “a software module that corresponds to software included with a video game or software that is independent of the video game.” *Id.* ¶ 15. We also disagree with Appellant that the claims “represent improvements to a particular technology” such that the claims would amount to significantly more than the abstract idea itself. Appeal Br. 7. Although the claims may apply the abstract concept to the field of video games, the claims do no more than provide the conceptual advice to save data and restore data at the point at which it was saved without providing specific implementation details. We are not persuaded that such amounts to a technical solution or improvement to a particular technology that would elevate the claim to eligibility.

Based on the foregoing, we sustain the rejection of the claims as directed to ineligible subject matter.

Anticipation

With respect to claim 1, the Examiner finds that SNES discloses a gaming system including a game device and gaming control module configured as claimed. Final Act. 5. In particular, the Examiner identifies the emulator SNES9x as distinct from the video game application claimed, and the Examiner finds:

Thus the emulation program is used to execute and play the video game application, which is a game loaded from a ROM file. The emulator acts as the controller or operating system in which the game is executed and therefore the interface of the emulator would be regular display frames, and not part of the game display frames.

Ans. 3. The Examiner further finds, and provides examples showing, that the emulator may be used in a manner in which “the game is not displayed before the particular freeze file is selected and opened” because when the defrost state option is selected in the emulator, “the emulator display of the game... is removed entirely and only the file interface... is displayed. Upon selection of a valid corresponding freeze file, the game is restarted from the frozen display frame and play can resume.” *Id.* at 5–6. The Examiner concludes:

Thus, the prior art of SNES9x teaches the operation of claim 1 by including a game device, the user's computer, and a gaming control module, SNES9x program, coupled to the game device and configured to suspend playing of the video game application, the game in the ROM file as run by the emulation of SNES9x, at a current display frame, by using the freeze command menu option or keyboard shortcuts, and resume playing of the video game application at the current game display frame directly from a regular display frame, that is not a part of the video game application, as detailed above, based on user initiated suspend and resume control commands, the freeze and defrost controls, respectively. Thus, examiner maintains that SNES9x teaches the invention substantially as claimed.

Id. at 6.

As discussed below, we are not persuaded of reversible error in the rejection of claim 1 by Appellant's arguments.

Appellant first argues that SNES does not disclose a gaming module that is configured to resume a game from a regular display frame that is not

part of the video game application. Appeal Br. 8. Appellant asserts that the “defrosting” function relied upon by the Examiner does not teach this limitation because this function “loads the frozen game state from a frame that **is** a part of the game application.” *Id.* Appellant asserts that the Examiner has not provided evidence showing that a user may directly load a frozen game state and that this is not possible using the SNES emulator because a user must first load the video game before opening a frozen game state for that game. *Id.* at 8–9. Appellant also asserts that the Examiner has not adequately shown that it is possible to quick load a frozen file for a different game than the one currently being played, as the Examiner alleges. *Id.* at 9. We disagree at least because the Examiner provides a specific example in the Answer in which a game is resumed from a display frame that is not part of the video game application identified by the Examiner, which Appellant fails to rebut. *See* Ans. 3–6; *see also* Reply Br. 4–6.

In addressing the Examiner’s evidence provided in the Answer, Appellant raises two new arguments. First, Appellant argues that the evidence provided in the Answer is improper because it amounts to an undesignated new ground of rejection. Reply Br. 5. Appellant asserts that this is a new ground of rejection because the evidence provided in the Answer appears to be from a Mac OS based program, while the program relied upon in the rejection is a Windows based program. *Id.* at 4–5. We are not persuaded of reversible error by this argument at least because whether the Examiner has introduced a new ground of rejection in the Answer is a petitionable matter that is not before us on Appeal. *See* 37 C.F.R. § 41.40(a). We also note that SNES states that it “allows you to play most games designed for the SNES [or] Super Famicom Nintendo game system

on your Mac, Linux, Windows and so on,” and thus, the SNES emulator program is not limited to the Windows operating system and may be used with the Mac operating system. SNES at 1.

Second, Appellant argues that the new evidence relied upon by the Examiner in the Answer does not teach the claimed resume control command. Reply Br. 5. Appellant asserts that “under the broadest reasonable interpretation in light of the specification, the relied upon selection does not teach the claimed resume control command” because the Specification describes the resume control command as “a *quick* and *convenient* resume command, *e.g.*, a single keyboard stroke or successive clicks, which allows ‘the player to skip past all startup screens, menus, and saved game selections processes.’” *Id.* (citing Spec. ¶ 18). Appellant asserts that the process relied upon by the Examiner “does the exact opposite in that it requires the player to go through all of the things the resume control command intends to skip past.” *Id.*

We disagree. Although the Specification indicates that the resume command allows “the player to skip past all startup screens, menus, and saved game selection processes,” the Specification also describes that multiple keyboard strokes and/or multiple clicks of the mouse “may be employed to accomplish the suspending and resuming of the video game at the same computer display frame.” Spec. ¶¶ 16, 18. Furthermore, we note that the claim does not limit the system to a single resume control “command” or require that “all startup screens, menus, and saved game selection processes” are skipped when a game is resumed. Thus, we decline to read this requirement into claim 1, and we find that the broadest reasonable interpretation of the claims consistent with the Specification

allows for the resuming of a game based on multiple selections, including the three selections required by the example provided by the Examiner.

Based on the foregoing, we are not persuaded of reversible error with respect to the rejection of claim 1 as anticipated by SNES. Accordingly, we sustain the rejection of claim 1. For the same reasons, we also sustain the rejection of claims 3–5, 11, 13–15, 21, and 22, for which Appellant does not provide separate arguments. 37 C.F.R. § 41.37(c)(1)(iv).

Obviousness: SNES in View of Gookin

With respect to the rejection of claims 6 and 16, Appellant argues only that Gookin does not cure the deficiencies in the rejection of the independent claims. *See* Appeal Br. 11. Having found no deficiencies, we sustain the rejection of claims 6 and 16 for the reasons identified above.

Remaining Obviousness Rejections

Regarding the three obviousness rejections based in part on Tarantino, Appellant relies on the same arguments addressed above with respect to the anticipation rejection of claim 1. *See* Appeal Br. 10–12. Thus, for the reasons discussed above, we sustain the obviousness rejections of claims 1, 3–5, 7–11, 13–15, and 17–22.

CONCLUSION

We AFFIRM the Examiner’s decision rejecting claims 1, 3–11, and 13–22.

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