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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte FRANK R. MORRISON III, BRANDON HUNT,
JEFFREY DAVID HENSHAW, MICHAEL GALLOP,
IVAN P. TRINDEV, and ERIC NEIL LOCKARD

Appeal 2016-005249
Application 13/715,913
Technology Center 3700

Before PHILIP J. HOFFMANN, BRADLEY B. BAYAT, and
AMEE A. SHAH, *Administrative Patent Judges*.

HOFFMANN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellants¹ appeal from the Examiner's rejection of claims 1, 2, 4–13, and 15–20. We have jurisdiction under 35 U.S.C. § 6(b). The Board heard the appeal on July 3, 2018.

We AFFIRM.

¹ According to Appellants, “[t]he real party in interest is Microsoft Technology Licensing, LLC.” Appeal Br. 3.

According to Appellants, the invention is directed “to acquiring a digital content item by presenting a partial functionality version of the digital content item[,] and progressively adding functionality until sufficient content portions have been received for providing a full functionality version of the digital content item.” Spec. ¶ 10. Claims 1, 12, and 18 are the independent claims on appeal. Below, we reproduce claim 1 as illustrative of the appealed claims.

1. A method of acquiring a video game including a plurality of content portions, the method comprising:

receiving and loading into computer memory a first set of the content portions, the first set including less than an entirety of the content portions;

computer-executing a partial functionality version of the video game using the first set of content portions before all of the plurality of content portions are received and loaded into computer memory;

receiving and loading into computer memory a second set of the content portions while the partial functionality version of the video game is computer-executing; and

adding functionality to the partial functionality version of the video game using the second set of content portions without interrupting computer-execution of the partial functionality version of the video game.

Appeal Br., Claims App. (Claim 1).

REJECTIONS AND PRIOR ART

The Examiner rejects the claims as follows:

- I. claims 1, 2, 4–13, and 15–20 under 35 U.S.C. § 101 as ineligible subject matter;

- II. claims 1, 2, 4, 7, 11–13, and 18 under 35 U.S.C. § 102(b) as anticipated by Chihaya (US 2009/0062007 A1, pub. Mar. 5, 2009); and
- III. claims 5, 9, and 10 under 35 U.S.C. § 103(a) as unpatentable over Chihaya and Archer et al. (US 2013/0079132 A1, pub. Mar. 28, 2013) (“Archer”).

ANALYSIS

Rejection I

An invention is patent-eligible if it claims a “new and useful process, machine, manufacture, or composition of matter.” 35 U.S.C. § 101. The Supreme Court, however, has long interpreted § 101 to include an implicit exception: “[l]aws of nature, natural phenomena, and abstract ideas” are not eligible for patenting. *See, e.g., Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2354 (2014).

The Supreme Court, in *Alice*, reiterated the two-step analysis previously set forth in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 566 U.S. 66 (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.*, 134 S. Ct. at 2355. The first step in that analysis is to “determine whether the claims at issue are directed to one of those patent-ineligible concepts.” *Id.* If the claims are not directed to a patent-ineligible concept, e.g., an abstract idea, the inquiry ends. Otherwise, the inquiry proceeds to the second step, where the elements of the claims are considered “individually and ‘as an ordered combination’” to determine whether there are additional elements that

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

Regarding the first step of the analysis, the Supreme 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. Therefore, we look to whether the claims focus on a specific means or method that improves the relevant technology, or instead whether the claims are directed to a result or effect that itself is the abstract idea, and merely invoke generic processes and machinery. *See English, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1336 (Fed. Cir. 2016).

Regarding independent claim 1, based on our review of the record, including Appellants’ Appeal Brief (*see* Appeal Br. 9–13) and Reply Brief (*see* Reply Br. 2–3), and the Examiner’s Final Office Action (*see* Final Action 2, 7) and Answer (*see* Answer 3), we agree with the Examiner that the claim is directed to the abstract idea of acquiring a video game.

Specifically, Appellants argue that claim 1 is not directed to an abstract idea because

[i]n the claim, “acquiring” is not used to refer to an abstract transfer of legal rights (e.g., acquisition of purchased ownership rights). “Acquiring” instead refers to the technical process by which the game is loaded onto a computing device so that the game can be played by the computing device. In other words, “acquiring” has to do with computer networks, computer storage devices, and/or computer memory, not contracts or abstract legal rights

(Appeal Br. 10). We are not persuaded, however, because Appellants’ claim 1 is similar to the claims in *RaceTech*, where the Federal Circuit affirmed the district court’s finding that claims reciting a “video server,” a “game server,” a “gateway,” and “game terminals” are directed to an

abstract idea. *RaceTech, LLC v. Kentucky Downs, LLC*, 167 F. Supp. 3d 853, 860–61, 863–64, 867–68 (W.D. Ky. 2016), *aff'd*, 676 F. App'x 1009 (Fed. Cir. 2017). By way of further example, Appellants' claim 1 is similar to the claims in *White Knuckle Gaming*, where the Federal Circuit agreed with the district court that claims reciting an “internet-based method of updating . . . software . . . [are directed to] an abstract idea.” *White Knuckle Gaming, LLC, v. Electronic Arts, Inc.*, 1:15-cv-00150 (D. Ut. 2016), *aff'd*, 683 F. App'x 931 (Fed. Cir. 2017).

Appellants argue that claim 1 is not directed to an abstract idea because it is not directed to a fundamental economic practice, and is not directed to a method of organizing human activity. Appeal Br. 11–12. This is not persuasive because, in the Answer, the Examiner does not rely on a finding that the claims are directed to a fundamental economic practice or method of organizing human activity to determine that the claims are directed to an abstract idea. *See, e.g.*, Answer 3.

Appellants argue that claim 1 is not abstract because the claim is not directed to an idea of itself. Appeal Br. 12. We disagree. We look to whether the claims focus on a specific means or method that improves the relevant technology, or instead whether the claims are directed to a result or effect that itself is the abstract idea, and merely invoke generic processes and machinery. *See Enfish*, 822 F.3d at 1336. There is no other computing element or component recited in claim 1 other than a generic “computer memory,” (Appeal Br., Claims App. (Claim 1)). Further, claim 1 does not purport to improve the “computer memory,” but, instead, the claim merely invokes the use of the memory during execution of the video game. *Id.*

Appellants argue that claim 1 is not directed to an abstract idea because it is not directed to a mathematical relationship or formula. Appeal Br. 12–13. This is not persuasive because, in the Answer, the Examiner does not rely on a finding that the claims are directed to a mathematical relationship or formula to determine that the claims are directed to an abstract idea. *See, e.g.*, Answer 3.

Regarding the second step, Appellants argue that even “assuming[,] *arguendo*, that claim 1 . . . [is] directed to an abstract idea, . . . [when considered as a whole,] claim 1 is also directed to ‘*something more*’ than the abstract idea” in accordance with the second step of the *Alice/Mayo* analysis. Appeal Br. 13–14. Appellants do not persuade us, however.

Claim 1 “do[es] not require any nonconventional computer, network, or display components, or even a ‘non-conventional and non-generic arrangement of known, conventional pieces,’ but merely call[s] for performance of the claimed” receiving and executing of information by and within a generic and conventional memory. *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1355 (Fed. Cir. 2016). Restated, the claim uses a generic memory and performs routine computer functions such as executing the instructions of a computer program or video game. Taking the claim elements separately, the functions performed by the memory—receiving and loading into memory, and “computer-executing” instructions—are purely conventional. When considered as an ordered combination, there is nothing that is not already present when the steps are considered separately. Contrary to Appellants’ argument, claim 1 does not improve the functioning of memory, and does not improve any other technology or technical field. Instead, the claim represents an improvement

to the abstract idea of acquiring a video game. That is not enough to transform an abstract idea into a patent-eligible invention. *See Visual Memory LLC v. NVIDIA Corp.*, 867 F.3d 1253, 1258 (Fed. Cir. 2017) (“[W]e must. . . ask whether the claims are directed to an improvement to computer functionality versus being directed to an abstract idea.” (internal quotations omitted)).

Appellants argue that, like the claims in *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245 (Fed. Cir. 2014), Appellants’ claimed invention is necessarily rooted in computer technology to overcome a problem specifically arising in the realm of computers. Appeal Br. 14. We are not persuaded, however, because unlike the situation in *DDR Holdings*, the problem of reducing wait time is not one necessarily rooted in the realm of computer, and there is no indication here that the purported solution (i.e., the claimed memory) is used other than in its normal, expected, and routine manner (i.e., receiving, storing, and executing information).

Appellants argue that the § 101 rejection is in error because the “rejection fails to make a prima facie case of ineligibility.” Appeal Br. 15; *see also id.* at 15–16. We are unpersuaded, because in the Answer the Examiner has clearly articulated the reasons as to why the claim is directed to an abstract idea, and has notified Appellants of the reasons for the rejection “together with such information and references as may be useful in judging of the propriety of continuing the prosecution of [the] application,” such that the Examiner sets forth a prima facie case. 35 U.S.C. § 132. Answer 3–6. Further, Appellants’ argument regarding the Examiner’s discussion related to “‘just-in-time’ acquisition of resources” is not

persuasive, inasmuch as the Examiner does not rely on any such discussion in the Answer to support the § 101 rejection. Appeal Br. 16.

Although we have carefully considered Appellants' arguments regarding claims 6, 8, 12, 15, 18, and 19, we are not persuaded that the Examiner errs in finding that each of these is directed to an abstract idea, in accordance with step 1 of the *Alice/Mayo* analysis, and none of the claims recites 'something more' than the abstract idea, in accordance with step 2 of the *Alice/Mayo* analysis, for substantially the same reasons as claim 1, discussed *supra*. See Appeal Br. 16–32.

Rejection II

With respect to the Examiner's rejection of claim 1, Appellants argue that the rejection is in error for the following reasons:

Chihaya does not disclose a partial functionality version of its hidden object game. Chihaya only discloses a full functionality version of the hidden object game. In particular, Chihaya does not disclose, for example, that a pictorial background is first downloaded and presented, then later a list of objects to be found is downloaded and presented, and then later the hidden objects themselves are downloaded and presented. Likewise, Chihaya does not disclose first downloading and presenting the pictorial background or hidden objects at a lesser resolution or in anything other than a fully functional state. According to the teachings of Chihaya, only a full functionality version of the video game is computer-executed.

Appeal Br. 33. Appellants do not persuade us of error, however, for the following reasons.

As set forth above, claim 1 recites, after the preamble, the following method steps:

receiving and loading into computer memory a first set of the content portions, the first set including less than an entirety of the content portions;

computer-executing a partial functionality version of the video game using the first set of content portions before all of the plurality of content portions are received and loaded into computer memory;

receiving and loading into computer memory a second set of the content portions while the partial functionality version of the video game is computer-executing; and

adding functionality to the partial functionality version of the video game using the second set of content portions without interrupting computer-execution of the partial functionality version of the video game

Appeal Br., Claims App. (Claim 1). The claim does not define what is meant by “a partial functionality version” of a video game, other than to indicate that it is “computer-execut[ed].” *See id.* Further, although Appellants reference paragraph 9 of their Specification as “describ[ing] some of the advantages of computer-executing a partial functionality version of the game” (*id.* at 32), Appellants do not establish that the Specification sufficiently defines or further limits what is meant by a partial functionality version of a video game. Still further, independent claim 1 only recites that the partial functionality version updates while the video game is “computer-executing” (*id.* at Claims App. (Claim 1)), and does not require that the partial functionality version updates *while someone is playing the game*, for example. Thus, in the absence of persuasive evidence or a persuasive line of argument convincing us of the contrary, the Examiner adequately supports the finding that the teaching in Chihaya of a “computing device [that] automatically connects with a server to update the game with data containing new episodes of the game,” discloses the claimed “partial functionality version” of a video game (as well as the claimed updating of the partial functionality version). Final Action 3.

Therefore, based on the foregoing, we sustain the Examiner's rejection of claim 1 as anticipated by Chihaya. Inasmuch as Appellants do not separately argue against the Examiner anticipation rejection of claims 4 and 11 that depend from claim 1, we also sustain the rejection of these dependent claims.

Appellants separately argue against the Examiner's anticipation rejection of dependent claim 2. Specifically, Appellants argue that the Examiner errs because Chihaya does not disclose "claim 2[']s require[ment] that the additional content portions are progressively received and additional functionality is progressively added 'until sufficient content portions are received and loaded into computer memory for providing a full functionality version of the video game.'" Appeal Br. 33 (citing Claim 2). Appellants fail to persuade us, however, that the argued recitation is not disclosed by Chihaya's "download[ing] new episodes upon reaching in-game milestones," which "Appellant[s] acknowledge" is disclosed by Chihaya. *Id.* at 22. More specifically, we are not persuaded by Appellants' argument that "[a]ccording to claim 2, a single download is performed." *Id.*; *see also* Answer 7 ("[The] Examiner is unable to locate any recitation of 'a single download' in claim[] 2.").

Appellants separately argue against the Examiner's anticipation rejection of dependent claim 7. In particular, Appellants argue that the rejection is in error because

claim 7 further requires that "adding functionality includes initially presenting a virtual game element with a partial functionality and subsequently presenting the virtual game element with a full functionality as additional content portions are received." As claimed, the same game element is first presented with partial functionality, and then later with full

functionality. No game element of Chihaya is first presented with partial functionality and then later, after downloading additional content, with full functionality.

Appeal Br. 34. Appellants, however, do not address the Examiner's specific findings (Final Action 4) that Chihaya's Abstract, which discusses the acquisition of "new episodes of the game" (Chihaya Abstract), discloses the claimed step of adding functionality to a partial functionality virtual game element. In the absence of such argument, Appellants do not persuade us of error. Thus, we sustain claim 7's rejection.

Although Appellants separately argue against the Examiner's anticipation rejection of independent claim 12, Appellants' arguments are substantially the same as those discussed above for claim 1. Appeal Br. 34. Thus, we sustain claim 12's rejection for similar reasons as claim 1.

Regarding Appellants' separate argument against the Examiner's anticipation rejection of dependent claim 13, Appellants' arguments are substantially the same as those discussed above for claim 7. Appeal Br. 35. Thus, we sustain claim 13's rejection for similar reasons as claim 1.

Although Appellants separately argue against the Examiner's anticipation rejection of independent claim 18, Appellants' arguments are substantially the same as those discussed above for claims 1 and 7. Appeal Br. 35–36. Thus, we sustain claim 18's rejection for similar reasons as claims 1 and 7.

Rejection III

With respect to the Examiner's obviousness rejection of dependent claim 5, Appellants argue that the rejection is in error because "[n]either Chihaya nor Archer discloses providing a user-controlled character or entity prior to computer-executing a full functionality version of the video game."

Appeal Br. 37. Appellants, however, do not address the Examiner’s specific findings that “Archer suggests—where Chihaya does not disclose—where the first set of the content portions includes a user-controlled character or entity of the video game (Fig[ure] 6A),” and that “[i]t would have been obvious . . . to combine the disclosures of Archer and Chihaya” to provide the argued recitation. Final Action 6. In the absence of such argument, Appellants do not persuade us of error. Thus, we sustain claim 5’s rejection.

With respect to the Examiner’s rejection of dependent claim 9, Appellants argue that the Examiner errs for the following reason:

[C]laim 9 requires that the partial functionality version of the game includes a partial functionality multiplayer game. Neither Chihaya nor Archer discloses computer-executing a partial functionality multiplayer game prior to computer-executing a full functionality version of the video game.

Appeal Br. 38. Appellants, however, do not address the Examiner’s specific findings that “Archer suggests—where Chihaya does not disclose—where the partial functionality version of the video game includes a partial functionality multiplayer game” (Final Action 6 (citation omitted)), and that “[i]t would have been obvious . . . to combine the disclosures of Archer and Chihaya” to provide the argued recitation (*id.*). In the absence of such argument, Appellants do not persuade us of error. Thus, we sustain claim 9’s rejection.

With respect to the Examiner’s obviousness rejection of dependent claim 10, Appellants argue that the rejection is in error because

claim 10 requires that the first set of the content portions includes a multiplayer game engine. Neither Chihaya nor Archer discloses receiving and computer-executing a multiplayer game engine prior to computer-executing a full functionality version of the video game.

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Appeal Br. 38. Appellants, however, do not address the Examiner’s specific findings that “Archer suggests—where Chihaya does not disclose—where the first set of the content portions includes a multiplayer game engine of the video game” (Final Action 7 (citation omitted)), and that “[i]t would have been obvious . . . to combine the disclosures of Archer and Chihaya” to provide the argued recitation (*id.*). In the absence of such argument, Appellants do not persuade us of error. Thus, we sustain claim 10’s rejection.

DECISION

We AFFIRM the Examiner’s rejections under 35 U.S.C. §§ 101, 102(b), and 103(a) of claims 1, 2, 4–13, and 15–20.

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