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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte LEE AMAITIS, DAVID ANTHONY PUCKERIDGE,
CHRISTOPHER JOHN DAVIE, GUY LAIN OLIVER RICHES, and
PETER KENNETH LAWREY

Appeal 2016-006316
Application 14/082,883
Technology Center 3700

Before ANTON W. FETTING, BIBHU R. MOHANTY, and KENNETH G.
SCHOPFER, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellants seek our review under 35 U.S.C. § 134 of the final rejection of claims 40-58 which are all the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b).

SUMMARY OF THE DECISION

We AFFIRM.

THE INVENTION

The Appellants' claimed invention is directed to a system and method for displaying graphic objects or text in an interactive display in a wagering environment (Spec., para. 3). Claim 54, reproduced below, is representative of the subject matter on appeal.

54. A method comprising:
- communicating, by at least one processor, betting product information about a betting product to at least one user;
 - receiving, by the at least one processor, from a first user a first request for a first wager associated with the betting product, the first request comprising a first betting term;
 - receiving, by the at least one processor, from a second user a second request for a second wager, the second request comprising a second betting term;
 - validating, by the at least one processor, the first betting request;
 - determining, by the at least one processor, that a numerical term associated with the second bet request is within a non-zero range from a corresponding numerical term associated the validated first bet request;
 - validating, by the at least one processor, the second bet request based on the act of determining that a numerical term associated with the second bet request is within a non-zero range from a corresponding numerical term associated the validated first bet request; and
 - settling, by the at least one processor, a bet associated with the first bet request and a bet associated with the second bet request.

THE REJECTIONS

The following rejections are before us for review:

1. Claims 40-58 are rejected on the grounds of nonstatutory double patenting as being unpatentable over claims 1-33 of U.S. Patent No. 8,342,942.

2. Claims 40-58 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

FINDINGS OF FACT

We have determined that the findings of fact in the Analysis section below are supported at least by a preponderance of the evidence¹.

ANALYSIS

Rejection under Nonstatutory Double Patenting

The Appellants argue that the rejection of the claims is improper because the rejection “does not show how any specific claim of the present application corresponds to any specific reference claim” (Appeal Br. 6).

In contrast, the Examiner has determined that the rejection of record is proper (Final Act. 2-4, Ans. 5-8).

We agree with the Examiner. The Final Rejection at page 4 states that “[a]lthough the claims at issue are not identical, they are not patentably distinct from each other because they are directed to the same method of bet formation for partial amounts of the proposed wager.” The Answer also states that “[t]he only difference between the application's independent claims and the patent's independent claims is that the patented claims speak in terms of a plurality of bet requests where the application's claims speak in terms of first and second bet requests. There is no essential difference in the claimed subject matter -- only a slight difference in terminology” (Ans. 6, 7).

¹ See *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Patent Office).

Here, the rejection is not so uninformative that it prevents the Appellants from recognizing and seeking to counter the grounds of rejection. See *In re Jung*, 637 F.3d 1356 at 1362. A review of claim 1 for example establishes this determination made by the Examiner to be proper. Regardless, as the Appellants have provided no specific arguments related to the actual claim language at hand, this rejection of record is sustained.

Rejection under 35 U.S.C. § 101

The Appellants argue that the rejection of claim 54 has not been properly identified as an abstract idea (Appeal Br. 8, 10, Reply Br. 2-4). The Appellants also argue that the claim is directed to “significantly more” than the alleged abstract idea (Appeal Br. 10-12).

In contrast, the Examiner has determined that the rejection of record is proper (Final Act. 2, Ans. 2-5, 8-10).

We agree with the Examiner. Under 35 U.S.C. § 101, 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: “laws of nature, natural phenomena, and abstract ideas” are not patentable. See, e.g., *Alice Corp. Pty Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2354 (2014).

In judging whether claim 54 falls within the excluded category of abstract ideas, we are guided in our analysis by the Supreme Court’s two-step framework, described in *Mayo* and *Alice*. *Id.* at 2355 (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1296–97 (2012)). In accordance with that framework, we first determine whether the claim is “directed to” a patent-ineligible abstract idea. If so, we then

consider the elements of the 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 of the abstract idea. *Id.* This is a search for an “inventive concept” an element or combination of elements sufficient to ensure that the claim amounts to “significantly more” than the abstract idea itself. *Id.* The Court also stated that “the mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention”. *Id at 2358.*

Here, we determine that the claim is directed to the concept of placing bets in a wagering environment. This is a fundamental economic practice long prevalent in our system of commerce, and is an abstract idea beyond the scope of § 101. The Specification at para. 3 states that the invention is directed to a system and method for displaying graphic objects or text in an interactive display in a wagering environment.

We next consider whether additional elements of the claim, both individually and as an ordered combination, transform the nature of the claim into a patent-eligible application of the abstract idea, e.g., whether the claim does more than simply instruct the practitioner to implement the abstract idea using generic computer components. We conclude that it does not.

Considering each of the claim elements in turn, the function performed by the computer system at each step of the process is purely conventional. Each step of the claimed method does no more than require a generic computer to perform a generic computer function. The Specification at para. 34 describes the invention being made with any suitable hardware

and software devices. Here, the claimed invention can be made with conventional computer components for their known functions.

We note the point about pre-emption (Appeal Br. 12). While pre-emption “might tend to impede innovation more than it would tend to promote it, ‘thereby thwarting the primary object of the patent laws’” (*Alice*, 134 S. Ct. at 2354 (quoting *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1293 (2012))), “the absence of complete preemption does not demonstrate patent eligibility” (*Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015)). *See also OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1362–63 (Fed. Cir. 2015), cert. denied, 136 S. Ct. 701, 193 (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.”).

For these above reasons the rejection of claim 54 and its dependent claims, which are directed to similar subject matter, is sustained.

We reach the same conclusion as to independent apparatus claim 40 and its dependent claims. Here, as in *Alice*, “the system claims are no different in substance from the method claims. The method claims recite the abstract idea implemented on a generic computer; the system claims recite a handful of generic computer components configured to implement the same idea.” *Alice* 134 S. Ct. at 2351. “[T]he mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention. Stating an abstract idea ‘while adding the words ‘apply it’ is not enough for patent eligibility.” *Id.* at 2358 (quoting *Mayo*, 132 S. Ct. at 1294).

CONCLUSIONS OF LAW

We conclude that Appellants have not shown that the Examiner erred in rejecting claims 40-58 on the ground of nonstatutory double patenting.

We conclude that Appellants have not shown that the Examiner erred in rejecting claims 40-58 under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

DECISION

The Examiner's rejection of claims 40-58 is sustained.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). See 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED