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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte SAMUEL WALTER RHODES JR.

Appeal 2017-002988
Application 13/037,489
Technology Center 3700

Before: JENNIFER D. BAHR, BRANDON J. WARNER, and SEAN P. O'HANLON, *Administrative Patent Judges*.

O'HANLON, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Samuel Walter Rhodes Jr. (Appellant) appeals under 35 U.S.C. § 134(a) from the Examiner's non-final decision (mailed November 4, 2015) rejecting claims 1–7 as being directed to patent-ineligible subject matter under a judicial exception to 35 U.S.C. § 101.[1] We have jurisdiction over this appeal under 35 U.S.C. § 6(b).

We AFFIRM.

SUMMARY OF THE INVENTION

Appellant's disclosure is directed to a treasure hunt game. Spec. 1:5. Claim 1, the sole independent claim, is reproduced below from page 11 (Claims Appendix) of the Appeal Brief (filed Mar. 15, 2016) (hereinafter "Appeal Br."):

> 1. A method of playing a treasure hunt game comprising the steps of:
>
> broadcasting a series of audio visual episodes featuring a host, wherein said host discloses clues to a location where an item is hidden during each episode of said series;
>
> selling at least one clue to a sponsor, wherein said sponsor discloses said clue publicly by associating said clue with said sponsor's goods, services, or place of business;
>
> allowing contestants to follow said clues in a quest to find said hidden item, wherein contestants may comprise any member of the public, so that the number of contestants is unlimited;
>
> allowing said contestants to find said hidden item and trade said hidden item for a prize; and

[1] The Appeal Brief identifies Appellant as the real party in interest. Appeal Br. 1 (filed Mar. 15, 2016).

broadcasting a presentation of said prize to said contestant during an episode.

ANALYSIS

The Examiner rejects claims 1–7 as being directed to judicially-excepted subject matter—namely, an abstract idea of "a method of playing a game." Non-Final Act. 5–6. According to the Examiner, "[t]he abstract idea may be seen, for instance, as a method of organizing human activities (i.e. a method of playing a live action treasure hunt game hosted by a person with contestants searching for hidden items and being awarded for finding the items)." *Id.* at 5. The Examiner also finds that "the claims are similar to [those] of managing a game of bingo in *Planet Bingo, LLC v. VKGS LLC*[, 576 Fed. App'x 1005] ([Fed. Cir.] 2014) and thus fall into the category of 'certain methods of organizing human activities.'" Ans. 6.

The Examiner further finds that "[t]he additional element(s) or combination of elements in the claim(s) other than the abstract idea per se amount[] to no more than . . . broadcasting means," which the Examiner finds to be "generic and . . . used in conventional ways that are well understood in the art [of] electronically implemented games." Non-Final Act. 5.

Appellant argues that the "claimed method is not held to an abstract idea, but indeed requires several particular machines such as a means for broadcasting, a means for televising, and a means for recording" and "the claimed method includes qualifying acts that are to be performed which result in the transformation of a clue into a tangible reward or prize having monetary value." Appeal Br. 6, 8; Reply Br. 11–12. Continuing, Appellant

argues that "[n]o cases prohibit patenting a method of organizing human activity." Appeal Br. 6. Appellant argues that its "claimed game consists of more than mental steps" and the claims "are not directed to a fundamental economic practice." Reply Br. 7, 8. Appellant also argues that the "claimed method involves the location of a hidden item and several other activities clearly outside of one's mind." *Id.* at 9.

Appellant further argues that, even if the claims are directed to a patent-ineligible abstract idea, the additional claim elements—"such as broadcasting means, televising means, and recording means"—amount to significantly more than the abstract idea. Appeal Br. 7. According to Appellant, the claims "add specific limitations that are not routine or conventional in the field of treasure hunt games" such as an unlimited number of contestants and the inclusion of sponsors. *Id.* at 8; Reply Br. 12–13.

Appellant further argues that "the claims of the instant application clearly do not seek to tie up games, or even more specifically treasure hunt games, such that others cannot practice them." Appeal Br. 9; Reply Br. 13–14.

> Section 101 provides that a patent may be obtained for "any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof." 35 U.S.C. § 101. The Supreme Court has long recognized, however, that § 101 implicitly excludes "laws of nature, natural phenomena, and abstract ideas" from the realm of patent-eligible subject matter, as monopolization of these "basic tools of scientific and technological work" would stifle the very innovation that the patent system aims to promote. *Alice Corp. v. CLS Bank Int'l*, 134 S.Ct. 2347, 2354 (2014) (quoting *Ass'n for Molecular Pathology v. Myriad Genetics,*

> *Inc.*, 133 S.Ct. 2107, 2116 (2013)); *see also Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S.Ct. 1289, 1294-97 (2012); *Diamond v. Diehr*, 450 U.S. 175, 185 (1981).
>
> The Supreme Court has instructed us to use a two-step framework to "distinguish[] 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 2355. At the first step, we determine whether the claims at issue are "directed to" a patent-ineligible concept. *Id.* If they are, we then "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.* (quoting *Mayo*, 132 S.Ct. at 1298). This is the search for an "inventive concept"—something sufficient to ensure that the claim amounts to "significantly more" than the abstract idea itself. *Id.* (quoting *Mayo*, 132 S.Ct. at 1294).

Finjan, Inc. v. Blue Coat Systems, Inc., 879 F.3d 1299, 1303 (Fed. Cir. 2018).

Alice Step One

Turning to *Alice* step one, instead of using a definition of an abstract idea, "the decisional mechanism courts now apply is to examine earlier cases in which a similar or parallel descriptive nature can be seen—what prior cases were about, and which way they were decided." *Amdocs (Isr.) Ltd. v. Openet Telecom, Inc.*, 841 F.3d 1288, 1294 (Fed. Cir. 2016) (citing *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353–54 (Fed. Cir. 2016)). "[W]e must first examine the . . . 'claimed advance' to determine whether the claims are directed to an abstract idea." *Finjan*, 879 F.3d at 1303 (citing *Affinity Labs of Tex., LLC v. DIRECTV, LLC*, 838 F.3d 1253, 1257 (Fed. Cir. 2016)). Abstract ideas may include, but are not limited to, fundamental

economic practices, methods of organizing human activities, an idea of itself, and mathematical formulas or relationships. *Alice*, 134 S. Ct. at 2355–57.

Applying the first step in the analysis, claim 1 is directed to an abstract idea of organizing human activities, such as broadcasting clues to a location where an item is hidden, selling a clue to a sponsor, allowing contestants to follow the clues and to find the hidden item, and broadcasting the presentation of a prize to the contestants. We agree with the Examiner that the claims here recite a method of organizing human activities similar to the method of managing a game of bingo at issue in *Planet Bingo*, in which the court stated the claims were "similar to the kind of 'organizing human activity' at issue in *Alice*." *Planet Bingo*, 576 Fed. App'x at 1008 (citing *Alice*, 134 S. Ct. at 2356); *see also In re Smith*, 815 F.3d 816, 819 (Fed. Cir. 2016) ("[T]he rejected claims, describing *a set of rules for a game*, are drawn to an abstract idea.") (emphasis added); *In re TLI Communications LLC Patent Litigation*, 823 F.3d 607, 613 (Fed. Cir. 2016) ("[W]e have applied the 'abstract idea' exception to encompass inventions pertaining to methods of organizing human activity.") (citing *Intellectual Ventures I LLC v. Capital One Bank (USA)*, 792 F.3d 1363, 1367 (Fed. Cir. 2015)).

Claim 1 recites a method of playing a treasure hunt game including steps of broadcasting, selling, and allowing. Appeal Br. 11 (Claims App.). Claim 1, however, does not require any specific equipment to perform these steps, nor does it recite "a means for broadcasting, a means for televising, and a means for recording" as asserted by Appellant. *See* Appeal Br. 6, 7.

Regarding Appellant's assertion that the recited clue is transformed into a tangible award or prize, we agree with the Examiner that no such transformation is encompassed by claim 1. *See* Ans. 7. The recited clue is intangible information, which cannot be transformed into a physical object. Even considering the clue to be a substrate upon which the information is written, such substrate is not *transformed* into a prize, but is instead *exchanged* or *redeemed* for a separate physical object (a prize)—the "clue" still exists in its original, unchanged condition. *See, e.g.*, Spec. 3:16–20, 4:9–11, 4:17–20.

As with the cases cited above, claim 1, therefore, is directed to an abstract idea.

Alice Step Two

"For the second step of our analysis, we determine whether the limitations present in the claims represent a patent-eligible application of the abstract idea." *Alice*, 134 S. Ct. at 2357.

As noted above, claim 1 merely recites a method of playing a treasure hunt game including steps of broadcasting, selling, and allowing. There are no additional elements to transform the nature of the claim into a patent-eligible application. *See Alice*, 134 S. Ct. at 2359 ("Considered 'as an ordered combination,' the computer components of petitioner's method 'ad[d] nothing ... that is not already present when the steps are considered separately.'"). Appellant directs us to "broadcasting means, televising means, and recording means" (Appeal Br. 6, 7), but, as noted above, no such means are recited in claim 1. Furthermore, "appending purely conventional steps to an abstract idea does not supply a sufficiently inventive concept."

In re Smith, 815 F.3d at 819 (citing *Alice*, 134 S. Ct. at 2357–58). Although Appellant asserts that the claims "add specific limitations that are not routine or conventional in the field of treasure hunt games," such as an unlimited number of contestants and the inclusion of sponsors (Appeal Br. 8), Appellant's contentions are unsupported by any evidence and amount to unpersuasive attorney argument. "Attorney's argument in a brief cannot take the place of evidence." *In re Pearson*, 494 F.2d 1399, 1405 (CCPA 1974).

Nor are we persuaded by Appellant's argument that "the claims of the instant application clearly do not seek to tie up games, or even more specifically treasure hunt games, such that others cannot practice them" (Appeal Br. 9), because, although "preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility." *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015).

For the foregoing reasons, considering the elements of claim 1 both individually and as an ordered combination, we determine that no additional element transforms the nature of the claim into a patent-eligible application.

Accordingly, we sustain the rejection of claim 1, and of its dependent claims 2–7, which are not argued separately, as being directed to patent-ineligible subject matter.

DECISION

The Examiner's decision to reject claims 1–7 is affirmed.

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