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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* HOWARD PFEIFER and STEVE ZOLOTO

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Appeal 2017-003379  
Application 12/940,967  
Technology Center 3700

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Before STEFAN STAICOVICI, LEE L. STEPINA, and  
FREDERICK C. LANEY, *Administrative Patent Judges*.

STAICOVICI, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Howard Pfeifer and Steve Zoloto (“Appellants”)<sup>1</sup> appeal under 35 U.S.C. § 134(a) from the Examiner’s decision in the Final Office Action (dated Dec. 11, 2015, hereinafter “Final Act.”) rejecting claims 7–15 and 39–57.<sup>2</sup> We have jurisdiction over this appeal under 35 U.S.C. § 6(b).

SUMMARY OF DECISION

We AFFIRM.

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<sup>1</sup> Bally Gaming, Inc. is identified as the real party in interest in Appellants’ Appeal Brief (filed Apr. 1, 2016, hereinafter “Appeal Br.”). Appeal Br. 3.

<sup>2</sup> Claims 1–6 and 16–38 are canceled. Appeal Br. 37 (Claims App.).

## INVENTION

Appellants' invention relates to "methods and apparatus for controlling an audio parameter of a plurality of wagering game machines." Spec., para. 2.

Claims 7, 11, 45–47, and 52 are independent. Claim 52 is illustrative of the claimed invention and reads as follows:

52. A method comprising:
- playing audio at each of a plurality of wagering game machines at a separate, respective user-selected volume level while each wagering game machine is playing an independent wagering game;
  - randomly triggering, by at least one of one or more processors, a shared game among the plurality of wagering game machines;
  - in response to the triggering, adjusting, by at least one of the one or more processors, a volume level at each of the plurality of wagering game machines from the separate, respective user-selected volume level to a common volume level that is common to the plurality of wagering game machines; and
  - playing audio at each of the plurality of wagering game machines at the common volume level while each wagering game machine is participating in the shared game.

## REJECTIONS<sup>3</sup>

- I. The Examiner rejects claims 7–15 and 39–57 under 35 U.S.C. § 101 as being directed to ineligible subject matter.

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<sup>3</sup> Appellants' request to withdraw the finality of the Examiner's Final Office Action (*see* Appeal Br. 19) is a petitionable matter under 37 C.F.R. § 1.181, not an appealable matter, and is not within the jurisdiction of the Board. *See In re Mindick*, 371 F.2d 892, 894 (CCPA 1967); *see also* MPEP § 706.07(c).

- II. The Examiner rejects claims 7–15 and 39–57 under 35 U.S.C. § 103(a) as being unpatentable over Rothschild et al. (US 2005/0130732 A1, published June 16, 2005, hereinafter “Rothschild”) and Tyndall et al. (US 2007/0111800 A1, published May 17, 2007, hereinafter “Tyndall”).

## ANALYSIS

### *Rejection I*

Section 101 of the Patent Act defines patent-eligible subject matter: “Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.” 35 U.S.C. § 101. In interpreting this statutory provision, the Supreme Court has held that its broad language is subject to an implicit exception for “laws of nature, natural phenomena, and abstract ideas,” which are not patentable. *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2355 (2014).

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.” *Id.* at 2355 (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66 (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 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.* (quoting *Mayo*, 566 U.S. at 79, 78).

### *Step One*

The Examiner determines that the claims “are directed to managing an audio/video presentation.” Final Act. 2. Then, the Examiner chooses claim 52 “as representative of the other independent claims” and determines that it describes “the abstract idea of adjusting a volume level of independently operated game machine to a common volume [level] when there is a common audio presentation.” *Id.* According to the Examiner, “[t]his is an *abstract idea of itself* similar to the array of cases in the area of ideas of themselves the court held ineligible.” *Id.* (emphasis added).<sup>4</sup> The Examiner further determines that, “given the claims are directed to the technological field of managing the audio levels in the field of gaming, the case is similar in that regard to Planet Bingo<sup>[5]</sup>, Gametek<sup>[6]</sup>, and *In re Webb*<sup>[7]</sup> where the claims were held abstract and ineligible.” *Id.* at 2–3.

Moreover, the “Examiner contends that the steps to impose control over game machines at various user-selected volumes to a common volume commensurate with a common activity can be accomplished *manually*.” *Id.*

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<sup>4</sup> Citing *July 2015 Update: Interim Eligibility Guidance Quick Reference Sheet*, USPTO (2015), <http://www.uspto.gov/sites/default/files/documents/ieg-july-2015-qrs.pdf>.

<sup>5</sup> *Planet Bingo, LLC v. VKGS LLC*, 576 F. App’x 1005 (Fed. Cir. 2014).

<sup>6</sup> *Gametek LLC v. Zynga, Inc.*, Nos. CV 13-2546 RS, CV-13-3089-RS, CV-13-3472-RS, CV-13-3493-RS, 2014 WL 1665090 (N.D. Cal. Apr. 25, 2014), *affd.* 597 F. App’x. 644 (Fed. Cir. 2015).

<sup>7</sup> *Ex Parte Webb*, Appeal No. 2012-001567 (PTAB Mar. 24, 2014) (*aff’d* Rule 36 by *In re Webb*, 609 Fed. App’x 643 (Mem) (Fed. Cir. 2015)).

at 3 (emphasis added). The Examiner explains that “the system has a human analog” because “[o]nce a triggering condition occurs, manual instructions can be announced for all users to tune their game machines to a common volume.” Examiner’s Answer 3 (dated Oct. 18, 2016, hereinafter “Ans.”).

First, we agree with Appellants that there is substantially more to the claims than “adjusting . . . a volume level . . . to a common volume level,” as recited by claim 52. *See* Reply Brief 2 (filed Dec. 19, 2016, hereinafter “Reply Br.”). For example, independent claim 45 requires “an independent game mode,” “a shared game mode,” “a plurality of secondary display elements . . . configured to function together as a single continuous display,” “one or more central processing units,” “playing audio files associated with a corresponding independent wagering game,” and “triggering [a] shared game.” Appeal Br. 40–41 (Claims App.). Similar limitations can be found in independent claims 46 and 47.

However, reducing all claims to “adjusting . . . a volume level . . . to a common volume level,” as recited in claim 52, alone, threatens to “describ[e] the claims at such a high level of abstraction and untethered from the language of the claims all but ensures that the exceptions to § 101 swallow the rule.” *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1337 (Fed. Cir. 2016). Indeed, determining that the instant claims are directed to a single element recited in claim 52 is tantamount to the violation of reducing the *Alice* step-one inquiry to “simply ask[ing] whether the claims involve a patent-ineligible concept.” *Id.* at 1335.

Secondly, although we appreciate the Examiner’s position that “adjusting a volume level . . . to a common volume level” can be accomplished manually (*see* Final Act. 3), nonetheless, we note that the

phrase “an idea ‘of itself’” has been used to describe a mental process that “can be performed in the human mind, or by a human using a pen and paper.” *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1372 (Fed. Cir. 2011). Here, the Examiner fails to explain adequately how adjusting a volume level constitutes a mental process performed in the human mind or by a human using a pen and paper.

Thirdly, even though the courts have declined to specifically define abstract ideas, nonetheless, they have identified abstract ideas by comparing a claimed concept to concepts previously identified as abstract ideas by the courts. *See Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1334 (Fed. Cir. 2016). Here, the Examiner’s reliance on *Planet Bingo*, *Gametek*, and *Webb* is misplaced. As correctly noted by Appellants, the claims at issue “are not directed to the game-play mechanisms of a wagering game, a shared game, or other game that may be executed or presented on any of the gaming machines.” Appeal Br. 27.

More specifically, in *Planet Bingo*, the claimed methods are directed to managing a game of “Bingo”; in *Gametek* the claims are directed to a commercial transaction where players are allowed to purchase additional objects during a game; and in *Webb* the claims at issue are directed to a set of rules for playing a card game. *Id.* at 26–27; *see also* Ans. 4–5. As such, although like *Planet Bingo*, *Gametek*, and *Webb*, Appellants’ invention is related to gaming, nonetheless, the abstract concepts of managing a game, creating a commercial transaction, or setting rules for administering a wagering game are not related to the concept of the instant claims, which according to the Examiner is “adjusting a volume level . . . to a common volume [level].” *See* Final Act. 2. We, thus, agree with Appellants that the

Examiner’s reliance on *Planet Bingo*, *Gametek*, and *Webb* is based “on the most vaporous of connections,” which is “some association with games or gaming—rather than evaluating the actual limitations set forth in the [instant] claims.” Reply Br. 3.

Accordingly, for the foregoing reasons, the Examiner has not adequately demonstrated that the claims are directed to an abstract idea, under the first step of the *Alice* framework, and, thus, we do not proceed to the second step. *See Enfish*, 822 F.3d at 1339 (citing *Alice*, 134 S. Ct. at 2355). Therefore, we do not sustain the rejection of claims 7–15 and 39–57 under 35 U.S.C. § 101 as directed to ineligible subject matter.

#### *Rejection II*

Appellants argue the rejection under 35 U.S.C. § 103(a) of independent claims 7, 11, 45–47, and 52 together as a group. *See* Appeal Br. 32 (“For the Board’s convenience, independent claims 7, 11, 45-47, and 52 will be considered as a group.”). Therefore, like Appellants, we select claim 52 as the representative claim to decide the appeal, with claims 7, 11, and 45–47 standing or falling with claim 52.

The Examiner finds that Rothschild discloses a gaming method played among a plurality of gaming machines including, *inter alia*, playing an independent wagering game on each gaming machine, randomly triggering a shared bonus game among the gaming machines, and switching graphical and audio features from the basic game to the particulars of the shared bonus game. Final Act. 4–5 (citing Rothschild, paras. 3, 6, 20, 21, 27, 28, Fig. 3). The Examiner further finds that Rothschild fails to disclose adjusting the audio volume from user-selected levels on each gaming machine to a



specified common value on all machines. *Id.* at 5. Nonetheless, the Examiner finds that Tyndall discloses a method for adjusting audio volume levels of a plurality of gaming machines from an independent mode where the audio level of each gaming machine is user-selected to the “same level” on all the machines when desired by the gaming establishment, such as to broadcast a general message. *Id.* at 6 (citing Tyndall, paras. 12, 13, 26, 30, 44, 46, 49, 50, 51, Fig. 5). Thus, the Examiner concludes that:

[O]ne of skill in the art would recognize that use of the known technique of Tyndall to control user-selected volumes to a modified and synchronized common volume into the gaming machines of Rothschild would achieve the predictable result of overriding user-selected game machine volumes with a specified common volume to draw more attention to the bonus game event as players are able to hear an[d] anticipate the arrival of the bonus event to their game machine as it is heading toward them.

*Id.* at 7 (citing Rothschild, para. 29).

Appellants first argue that Rothschild does not trigger a “shared game” among a plurality of gaming machines. Appeal Br. 33. According to Appellants, “it is not clear . . . when Rothschild’s ‘shared game’ is believed to be triggered among the plurality of gaming machines.” *Id.* Appellants explain that because the bonus feature of Rothschild’s Duck Duck Goose game occurs sequentially on multiple gaming machines, “Rothschild fails to adjust the volume levels of multiple machines in response to a single trigger, as recited in claim 52, but instead must adjust each volume level individually and sequentially in response to the respective triggers at each machine.” *Id.* In the alternative, Appellants assert that if triggering occurs in “unison” on all of Rothschild’s machines, then the machines are always in a shared game

mode and, thus, “cannot be switched from independent to shared game mode as the independent mode is essentially undefined.” *Id.* at 33–34.

We are not persuaded by Appellants’ arguments because the Examiner is correct in that “the triggering of the machine[] to make the machine eligible [for a bonus event] is different from the execution [(i.e., the display)] of the bonus event.” Ans. 8. Rothschild discloses that a bonus game starts “when symbols 24 on the reels align with selected pay lines 26, in accordance with a pay table.” *See* Rothschild, para. 20 (emphasis omitted). Rothschild further discloses that controller 64 controls visual bonus indicator 28, i.e., the goose, across a plurality of machines 10. *See* Rothschild, paras. 25, 36, Fig. 7d. As such, although the visual bonus indicator 28 is displayed sequentially on each machine does not mean that the bonus game has not been triggered for all machines to participate in the bonus game. Stated differently, by having visual bonus indicator 28, i.e., the goose, controlled across all machines of a bank of machines 48, visual bonus indicator 28 is then displayed sequentially on each machine as part of the Duck Duck Goose (bonus) group game. Therefore, as Rothschild switches from an “independent” game mode, where symbols 24 are not aligned with pay lines 26, to a “shared” game mode, where they are, and visual bonus indicator 28 is controlled across a plurality of machines 10, Rothschild discloses triggering a “shared game,” as called for by claim 52.

Secondly, Appellants contend that in light of the Specification and the understanding of a person skilled in the art, the phrase “shared game” requires “concurrent participation” of all machines during the “shared” (bonus) game. Appeal Br. 33–35 (citing Spec., para. 20; Bennett, para. 40 (US 2010/0137052 A1, pub. June 3, 2010); Lima, para. 19 (US

2009/0011825 A1, pub. Jan. 8, 2009)). In contrast, because Rothschild's bonus event, i.e., the goose, travels sequentially between machines, Rothschild's bonus game is triggered sequentially on each machine and, thus, the bonus game does not constitute a "shared game," as called for by claim 52. *Id.* at 35.

We appreciate Appellants' position that the Specification describes a "shared game" as "[w]agering game machines . . . [that] *cooperatively* function together in a *coordinated* manner." Appeal Br. 34 (citing Spec., para. 20) (emphasis added). However, we do not agree with Appellants that just because Rothschild's visual bonus indicator 28, i.e., the goose, travels sequentially between displays 58, 60, 62 of machine bank 48, this does not mean that a "shared game" is not being played on these machines. As discussed *supra*, even though visual bonus indicator 28 is displayed sequentially on each machine, because visual bonus indicator 28 is controlled across a plurality of machines 10 this means that the Duck Duck Goose group (bonus) game is played on all machines. We further agree with the Examiner that the phrase "cooperatively function together in a coordinated manner is broader [and] includes sequential operations . . . so long as they are coordinated." Ans. 8. The Examiner is correct in that although Rothschild's goose is displayed sequentially on multiple gaming machines, nonetheless, all the machines in Rothschild are "engaged in a shared bonus event," that is, all of the machines of machine bank 48 cooperate in a coordinated manner such that the goose travels among displays 58, 60, 62. *See id.*; *see also* Rothschild, Fig. 3. Moreover, such an interpretation is consistent with the description in Bennet of a "shared game" where "one gaming machine . . . is at least *partly dependent* on at least one

other gaming machine.” Bennet, para. 40 (emphasis added). Similarly, in Lima, as players play against each other in a “community game” (Lima, Abstract), the gaming machines “cooperate in a coordinated manner,” as per Appellants’ Specification or are “partly dependent” on each other, as per Bennet.

Appellants further argue that the Examiner’s reasoning for switching from a user-selected volume level to a common level, as taught by Tyndall, when Rothschild’s gaming machines play a shared bonus game, lacks rational underpinnings. Appeal Br. 35–36. Appellants contend that “there is no benefit” for providing a common volume level on all of Rothschild’s machines “because each of the machines executes the Duck Duck Goose bonus feature at different times” and, thus, “switching the volume level of all the machines cannot provoke anticipation regarding only one of the machines.” Reply Br. 8. According to Appellants, “[t]he most effective approach would be to set the volume of the participating game machine higher than the other game machines, because the singular higher volume can provide directional cues to the whereabouts of the goose indicator.” Appeal Br. 36.

We are not persuaded by Appellants’ arguments for the following reasons. First, we note that Appellants’ argument is premised on the faulty proposition that Rothschild’s gaming machines do not all participate in the Duck Duck Goose group (bonus) game. However, for the reasons discussed *supra*, even though visual bonus indicator 28 is displayed sequentially on each machine, because visual bonus indicator 28 is controlled across a plurality of machines 10 means that the Duck Duck Goose group (bonus) game is played on all machines.

Secondly, we note that Rothschild discloses changing the “audio performance of gaming machines . . . when a visual bonus indicator is shown” and that the sequential display of visual indicator 28 “provide[s] an incentive for players to play gaming machines that the visual bonus indicator 28 appears to be heading toward.” Rothschild, paras. 27, 29 (emphasis omitted). Hence, we agree with the Examiner that “Rothschild allows a player to anticipate when the bonus ‘appears to be headed towards them’ . . . such that one of [ordinary] skill in the art would appreciate that this is a result of *audio* and visual cues.” Ans. 9 (emphasis added). We, thus, agree with the Examiner that the skilled artisan would modify the volume setting of Rothschild’s machines to a common value, as taught by Tyndall, “to draw more attention to the bonus game event as players are able to hear an[d] anticipate the arrival of the bonus event to their game machine as it is heading toward them.” Final Act. 7. Hence, as Rothschild’s bonus game is triggered on all machines visual bonus indicator 28 appears sequentially and audio performance is changed and, thus, modifying the volume setting of Rothschild’s machines to a common value, as taught by Tyndall, to provide an incentive to users to play those machines where the bonus is heading, does not lack rational underpinnings.

In conclusion, for the foregoing reasons, we sustain the rejection of claim 52 under 35 U.S.C. § 103(a) as unpatentable over Rothschild and Tyndall. Claims 7, 11, and 45–47 fall with claim 52.

As for the rejection of dependent claims 8–10, 12–15, 39–44, 48–51, and 53–57, Appellants do not set forth any other substantive arguments. *See* Appeal Br. 32–36. Accordingly, for the same reasons discussed *supra*, we

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likewise sustain the rejection of dependent claims 8–10, 12–15, 39–44, 48–51, and 53–57 over the combined teachings of Rothschild and Tyndall.

#### SUMMARY

The Examiner’s decision to reject claims 7–15 and 39–57 under 35 U.S.C. § 101 as directed to ineligible subject matter is reversed.

The Examiner’s decision to reject claims 7–15 and 39–57 under 35 U.S.C. § 103(a) as unpatentable over Rothschild and Tyndall 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